O/0338/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK REGISTRATION NOS.
917869442, 917869446 AND 917869429
IN THE NAME OF
MONTY CO. GROUP SL

AND

APPLICATIONS FOR REVOCATION FOR NON-USE
UNDER NOS.
CA000506420, CA000506417 AND CA000506424
BY MONTY FINANCE UK LTD

BACKGROUND AND PLEADINGS

1. Monty Co. Group SL ("the proprietor") is the registered proprietor of the following trade marks:

UK registration no. 917869442 ("the first registered mark")

UK registration no. 917869446 ("the second registered mark")

UK registration no. 917869429 ("the third registered mark")

2. All of the above registered marks (collectively referred to as "the registrations") were filed on 6 March 2018 and completed the registration process on 11 August 2018. The first and second marks were registered for the following services:

Class 35: Advertising; Business management; Business administration; Office functions.

Class 36: Insurance; Financial affaires; Money dealings; Real estate affairs; International transfers and sending of consignments on an international scale.

Class 38: Telecommunications.

The third mark was registered for the following services:

Class 35: Office functions; Business administration; Business management; Advertising.

Class 36: Money dealings; International transfers and sending of consignments on an international scale; Financial affaires; Insurance; Real estate affairs.

Class 38: Telecommunications.

3. The registrations are comparable marks. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the above registered marks were converted into comparable UK trade marks. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.[1]

4. On 14 August 2023, Monty Finance UK LTD ("the applicant") sought complete revocation of the registrations for non-use under section 46(1)(a) of the Trade Marks Act 1994 ("the Act").[2] The period in respect of which non-use is claimed

[1] See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.
[2] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires

under Section 46(1)(a) is 12 August 2018 to 11 August 2023, with an effective date of revocation of 12 August 2023.

5. The registered proprietor filed defences and counterstatements for each of the registrations, denying the claims made.[3]

6. On 30 October 2023 the revocation proceedings were consolidated pursuant to Rule 62(1)(g) of the Trade Marks Rules 2008.[4]

7. The cancellation applicant is represented by DLA Piper UK LLP and the registered proprietor by Trademarkit LLP. Only the registered proprietor filed evidence. This will be summarised to the extent that it is considered appropriate. Neither party requested a hearing, however both parties filed written submissions in lieu. This decision is taken following a careful consideration of all the papers.

Preliminary issue

8. On 13 February 2024, the evidence was considered to be excessive, and it was therefore directed that it be reduced in accordance with TPN 1/2015. This was duly complied with.

EVIDENCE

9. The registered proprietor filed three witness statements of Joseph T Montero Prego. One witness statement is dated 26 December 2023 and is accompanied by exhibits JTMP1 – JTMP3. The two remaining witness statements are dated 18 October 2023, with one including annexes 1 and 2, and the other by 11 annexes 1 to 11.

tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

[3] Form TM8N's, paragraph 8.

10. Mr Prego is the President and Chief Executive of the proprietor, a position he has held since 10 October 2003.

11. He states that the registrations are not used directly by the proprietor, but it is the holding company who consents to use being made by its two subsidiaries, these being Monty Global Services S.L. and Monty Global Payments S.A. In accordance with s.46(1)(a), use with the proprietor's consent is acceptable for the purposes of proving genuine use.

12. Founded in 2003 with its headquarters in Madrid, it is stated that the proprietor is "a technology-based financial business specializing in international money transfers"[5]. The business covers 150 countries across Europe, Asia, Africa and South America, "and boasts an impressive network of more than 200,000 payment points, facilitating secure transactions for its customers.[6]"

13. The proprietor has provided the following first dates of use and states that the marks have been in continuous use, "in respect of various financial affairs, money dealings and transfer services, and some telecommunication services, without interruption"[7]. The witness goes on to state that the services are offered to businesses and individuals primarily in respect of money/transfer/payment services and currency conversion services:

Mark	**Registration No.**	**Date of First Use in European Union**	**Date of First Use in United Kingdom**
MONTY & Co Group	UK00917869429	10 October 2003	11 August 2015
MONTY Global Payments	UK00917869442	25 March 2004	11 August 2015
MONTY Global Services	UK00917869446	15 March 2004	11 August 2015

[5] Para 4 of the witness statement dated 26 December 2023
[6] Ditto
[7] Para 7 of the above witness statement

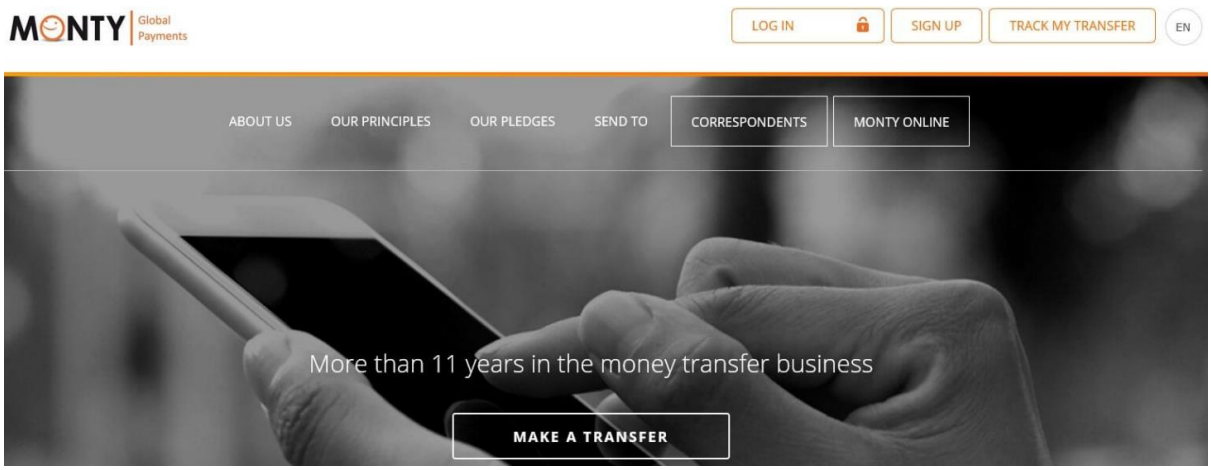
14. The witness goes on to state that "The total global annual turnover figures for services sold under each of [the proprietor's] trade mark are as follows:"[8]

Year	First registered mark	Second registered mark	Third registered mark
2018	€15,654,802	€1,356,461	€122,394
2019	€15,020,506	€1,397,396	€123,863
2020	€16,534,819	€1,429,290	€124,854
2021	€16,430,676	€1,534,592	€124,230
2022	€19,557,321	€1,781,178	€132,304

15. It is stated that based upon the rough estimation that about 4% of the figures above account for the UK, there is annual turnover of €600k - €780k for the first registration, €52k - €72k for the second registration and around €5k per annum for the third. It is not stated how much of the remaining turnover relates to Europe. However, it is stated that between 31 December 2020 and 11 August 2023, the proprietor conducted a total of 1,260 transactions in the UK, involving 175 issuers. These transactions amounted to a total of €341,403 in value. Concurrently, 2,250 transactions were received from 884 issuers, resulting in a total transaction value of £1,342,956 during the same period."[9]

16. The evidence includes extracts of the website montyglobal.com dated between 9 May 2009 and 5 June 2023 which Mr Prego states shows use throughout the relevant period[10]. I can see that the first registered mark appears on the website, along with multiple references to them providing money transfer services. For example, as follows:

[8] Para 10 of the witness statement
[9] Para 11
[10] Exhibit JTMP1



17. The witness goes on to state that the proprietor offers remittance services from European countries through a network of 1,818 "agents" and that the "agents function in a similar way to franchisees and are responsible for advertising, marketing, promotional services."[11] Further, that there are 1096 agents operating in Spain, 726 in Italy, 61 in France and 2 in Portugal. A list of agents and the year of registration, which spans the relevant period and prior to IP Completion Day, has been submitted.[12] The list of correspondents does not include companies from the UK, but does include around 1,800 companies in Spain, Italy, Portugal, Germany, France, Belgium and the Netherlands.

18. I also note that one witness statement also makes reference to the proprietor's mobile app called "Clicktransfer", which is used to transfer money. This website is also referenced in one of the two other witness statements, which it refers to as "Clicktransfer, powered by Monty Global Payments" which are described as "a user-friendly online platform designed for seamless money transfers". It is stated that the App is used to transfer money and has been operating since 2014. However, as highlighted by the applicant in its submissions, the proprietor has only provided evidence in respect of montyglobal.com and the extract for clicktransfer.us does not include reference to the registrations in question. Therefore, this evidence does not assist the proprietor.

19. That concludes my summary of the evidence.

[11] Para 13
[12] Exhibit JTMP2

LEGISLATIVE PROVISIONS

20. The relevant provisions of section 46 of the Act are as follows:

> "(1) The registration of a trade mark may be revoked on any of the following grounds –
>
> > (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
> >
> > (b) […]
> >
> > […]
>
> (2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
>
> (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:
>
> Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the

commencement or resumption began before the proprietor became aware that the application might be made.

(4) […]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date."

21. Section 100 of the Act is also relevant, which reads:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

22. As the registrations are comparable marks, the proprietor can rely upon use of the marks in the EU for any and all parts of the relevant period which fall prior to IP Completion Day i.e. 31 December 2020.[13] The only use after that date that is of relevance is use in the UK.

CASE LAW

23. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

[13] Paragraph 8 of Part 1, Schedule 2A of the Act.

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36];

Sunrider at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the

purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council [2013]* RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

'19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

…

22. … it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as

insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard 12 to the interests of the proprietor, the opponent and, it should be said the public.'"

24. Therefore, proven use of a mark which fails to establish that the "commercial exploitation of the mark is real" because the use would not be viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark is not, therefore, genuine use.

25. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

'[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or

her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.'

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

26. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

27. I also bear in mind the Court of Appeal's decision in *Laboratoire de la Mer Trade Mark* [2006] FSR 5. Neuberger LJ (as he then was) stated that:

"48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be "genuine", the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be

"consistent with the essential function of a trademark" as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler."

Assessment of the evidence

28. Before I go on to make my findings on whether there is genuine use, it is convenient to address the question of variant forms.

29. I note from the evidence that the proprietor has sought to demonstrate use of three trade mark registrations. These being:

30. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

31. Having reviewed the evidence there appears to be more use of the first registration compared to the others. In particular, it is consistently present on the website. When comparing the use made of the first registration, the alterations or omissions of the other two registrations do not alter the distinctive character of the mark as a whole. The word MONTY, along with the coloured smiley faced letter "O" are all present and that matter which is not present, i.e. "Services" rather than "Payments" in the second, and "& CO Group" rather than "Global Payments" in the third, are of little, if any, distinctive character.

32. In view of the above, I find that use of the first registered mark is acceptable variant use of the second and third registered marks. I shall proceed on this basis.

Sufficient use

33. I remind myself that the relevant period, under s.46(1)(a) of the Act, for each of the registrations is 12 August 2018 to 11 August 2023, with an effective date of 12 August 2023.

34. An assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself. As indicated in the case law above, use does not need to be quantitively significant to be genuine, however it does need to be shown that there has been real commercial exploitation of the marks.

35. The evidence also includes invoices. As rightfully pointed out by the applicant the invoices have not been translated and therefore it is not clear what the goods or services the invoices cover. However, the first registration, is consistently present at the top.

36. The evidence does provide annual turnover figures, which are not insignificant. However, these figures are said to cover all of the services provided. This, in itself, does not establish genuine of the registrations in relation to any specific services in the specifications. In respect of the UK, it is stated that these are in the thousands of Euros for each mark (hundreds of thousands in respect of the first registered mark). Although the remaining turnover is not specifically broken down into territories, it is reasonable to infer a reasonable proportion relates to Europe. It is also reasonable to conclude that as the rest of the evidence relates to the transferring of money that a proportion of it relates to such services.

37. The evidence also includes website extracts which show the registrations. Most notably there are website extracts dated 31 August 2018 and 10 August 2020 which are during the relevant period and prior to IP Completion Day.

38. Other than references to turnover and sales, there is no other evidence of use within the UK after IP Completion Day (31 December 2020). However, I note that the marks have been used consistently within the EU up until this time, and if use is deemed to be genuine, use prior to IP Completion Day alone is sufficient to prove use overall.

39. Taking all of the above into account, and taking the evidence as a whole, I find that the evidence sufficiently demonstrates use of the registrations for the transferring of money, in particular internationally.

Fair specification

40. The next question to consider is whether, or the extent to which, the evidence shows use of the marks at issue in relation to all of the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr

Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

41. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair

specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

42. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the CJEU that that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

43. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

44. The registrations cover the following services:

Class 35: Advertising; Business management; Business administration; Office functions.

Class 36: Insurance; Financial affaires; Money dealings; Real estate affairs; International transfers and sending of consignments on an international scale.

Class 38: Telecommunications.

45. I agree with the applicant's submission that there is no evidence to support or demonstrate use of the registrations in respect of the class 35 and 38 terms. Therefore, these terms will be revoked.

46. With regard to the class 36 specification, and as already outlined, the evidence has demonstrated sufficient use, but not for all of the terms.

47. Mr Prego describes the proprietor as being "a technology-based financial business specializing in international money transfers". Further, the website makes references to the proprietor providing money transfer services and remittance services. It is for these services that the proprietor has demonstrated use. It is noted that the proprietor transfers money across numerous countries and therefore there will be a change of currency involved.

48. The registered proprietor submits that the term "financial services, namely money transfer and payment services, and currency conversion services" is encompassed by the broader Class 36 terms "money dealings" and "financial affaires". Although it argues that use has been shown for all services covered by the registrations, I consider those broader terms to be too wide. A fairer specification should therefore reflect the proprietor's submission. It should also include "remittance services", as this describes the facilitation of transferring money, and remove "namely" as it serves no real benefit or purpose in trade mark specifications:

Class 36: Money transfer and payment services; currency conversion services; remittance services.

CONCLUSION

49. The applications for revocation on the ground of non-use under section 46(1)(a) have been partially successful. Consequently, the registrations shall be revoked with effect from 12 August 2023 for all services, except for the following:

    Class 38: Money transfer and payment services; currency conversion services; remittance services.

COSTS

50. The applicant has been more successful than the proprietor and so it is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice ("TPN") 1/2023.[14] I have applied what I consider to be an appropriate reduction to account for the only partial success. I award the applicant the sum of £1050, calculated as follows:

Preparing a statement and considering the other side's statement:	£250
Considering the proprietor's evidence and preparing submissions in lieu:	£200
Official fees:	£600
Total:	**£1050**

51. I therefore order Monty Co. Group SL to pay Monty Finance UK Ltd the sum of £1050. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

[14] TPN 1/2023 applies to proceedings commenced on, or after, 1 February 2023.

Dated this 22nd day of April 2026

Mark King

For the Registrar