O/0747/26

TRADE MARKS ACT 1994

<u>CONSOLIDATED PROCEEDINGS</u>

IN THE MATTER OF APPLICATION NO. UK00004049619

IN THE NAME OF MADE TO DO MORE LIMITED

TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS:

FLEXIPAY FROM FUNDING CIRCLE

AND

FlexiPay

from Funding Circle

IN CLASSES 9, 35, 36

AND IN THE MATTER OF OPPOSITION NO. OP000452178

BY SHOP TJC LIMITED

AND

IN THE MATTER OF UK REGISTRATION NO. UK00002530826

FOR THE FOLLOWING TRADE MARK:

FLEXI-PAY

IN THE NAME OF SHOP TJC LIMITED

IN CLASS 36

AND APPLICATIONS FOR A NON-USE REVOCATION THEREOF UNDER NO. CA000507334 AND FOR A DECLARATION OF INVALIDITY THERETO UNDER NO. CA000508608

BOTH BY MADE TO DO MORE LIMITED

BACKGROUND AND PLEADINGS

1. This decision involves cross-proceedings wherein Shop TJC Limited ("***STJC***") and Made To Do More Limited ("***MTDM***") brought actions against one another. I will summarise the relevant proceedings below, beginning with STJC's opposition on the basis that it was brought first.

STJC's opposition

2. On 9 May 2024, MTDM applied to register in the UK the series of (two) trade marks shown on the cover page of this decision, under number UK00004049619 ("***the '619 marks***"). On 25 October 2024, the '619 marks were accepted and published in the Trade Marks Journal in respect of the following goods and services:

Class 9: Computer software relating to financial services, including the provision of loans and credit; credit cards; card readers for bank cards; telephone credit cards; electronic bank cards; coded bank cards; encoded prepaid payment cards; magnetically encoded debit cards; computer software for facilitating secure credit card transactions.

Class 35: Business consultancy services in the field of finance, loans, the provision of credit, and financial information; credit card registration services; administrative services relating to credit card registration; data processing; advisory, consultancy and information services all relating to all the aforesaid services.

Class 36: Financial services; banking services; credit services; financing services; loan financing; installment loans; issuance of credit and debit cards; provision of credit and debit cards; bank card, credit card, debit card, and electronic payment card services; credit card payment services; electronic credit and debit card transactions; processing of payments in relation to credit and debit cards; financial services related to the issuance of bank cards; payment card services; automated banking services relating to credit card transactions; advisory, consultancy and information services relating to all the aforesaid services.

3. On 27 January 2025, STJC opposed the trade mark application in its totality under sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("***the Act***").

4. Under sections 5(1), 5(2) and 5(3), STJC relies upon the following mark trade mark:

   Representation: FLEXI-PAY

   Uk registration no. UK00002530826 ("***the '826 mark***")

   Filing date: 5 November 2009

   Registration date: 24 June 2011

   Relying upon all of its services, for which it is registered, namely:

Class 36:	Financial services; credit services; monetary services; loan services; advisory and consultancy services relating to all the aforesaid.

5. By virtue of its earlier filing date, the '826 mark qualifies as an earlier mark under section 6(1) of the Act. As the '826 mark completed its registration procedure more than five years before the filing date of the opposed '619 marks, it is subject to the use provisions set out in section 6A of the Act.

6. Under sections 5(1) and 5(2)(b) of the Act, STJC claims that the respective services and marks are identical or highly similar with the result that there is a likelihood of confusion.

7. Under section 5(3), STJC contends that the respective marks and services are identical or highly similar. It is also argued that STJC, or its predecessors in title, have used the '826 mark since 2008 developing a significant reputation and the relevant consumers would think that a link exists between the respective marks. This will result in an unfair advantage by MTDM as well as be detrimental to STJC's reputation and the '826 mark's distinctiveness.

8. Under section 5(4)(a) of the Act, the opponent relies upon a sign identical to the mark relied upon under section 5(2)(b) namely, FLEXI-PAY, which STJC claims to have been using throughout the UK since 2008. STJC claims to have used the

signs in relation to the same services as listed in paragraph [1]. STJC claims that use of the ‘619 marks would be contrary to the law of passing off.

9. MTDM denied all the allegations made by STJC and puts the ‘826 mark to proof of use.

MTDM’s revocation application

10. The ‘826 mark stands registered in the name of STJC.

11. On 11 March 2025 and 10 May 2024 MTDM[1] respectively filed for a declaration of invalidation of the ‘826 mark (in its entirety) under section 47 and section 3(1)(a), 3(1)(b) and 3(1)(c) of the Act and sought revocation for non-use (in its entirety) under sections 46(1)(a) and 46(1)(b) of the Act.

12. Under section 46(1)(a) of the Act, MTDM alleges non-use by STJC of the ‘826 mark in the five-year period following the date on which the mark was registered, i.e. 25 June 2011 – 24 June 2016 (“***the first relevant period***”). The earliest possible revocation date is 25 June 2016.

13. Under section 46(1)(b) of the Act, MTDM claims non-use of the ‘826 mark for the period of 8 May 2019 - 7 May 2024 (“***the second relevant period***”) claiming an effective date of revocation of 8 May 2024.

14. Under sections 3(1)(a), 3(1)(b) and 3(1)(c) of the Act, MTDM contends that the ‘826 mark is incapable of distinguishing STJC’s services in that the average consumer commonly understands “FLEXI-PAY” as describing a flexible act of payment. Therefore, the ‘826 mark is descriptive of the services and devoid of distinctive character.

15. Under sections 46(1)(a) and 46(1)(b), STJC denies that there has been no use of the ‘826 mark.

16. Under sections 3(1)(a), 3(1)(b) and 3(1)(c), STJC denies all of MTDM’s claims.

17. On 30 September 2025, the Office informed the parties that opposition 454597 and revocations 508881 and 508883 were being consolidated.

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[1] Cancellation action number CA000507334 was initially filed by Camulon Ltd. On 27 June 2025, the cancellation applicant requested to substitute Camulon Ltd with Made To Do More Limited. With official letter of 31 July 2025, the Tribunal confirmed this substitution.

18. MTDM is represented by Reddie & Grose LLP. Shop TJC Limited is represented by Cleveland Scott York.

RELEVANCE OF EU LAW

19. 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 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.

EVIDENCE AND SUBMISSIONS

20. During the evidence rounds neither party filed written submissions, but they both filed evidence. STJC filed evidence in chief in the form of a witness statement from Ravi Gupta dated 10 February 2025 and exhibits EXH1-EXH21. Mr Gupta is the Financial Controller and Secretary of STJC and he has held this position since 23 June 2021. Further evidence in chief was filed by STJC in the form of a witness statement of Alicia Claire Instone dated 30 September 2025 accompanied by exhibits ACI01 – ACI0. Ms Instone is a Chartered Trade Mark Attorney at Cleveland Scott York LLP (STJC's representative).

21. MTDM filed evidence in chief consisting of two witness statements by Georgina Rose Tanner, the first dated 30 September 2025, accompanied by exhibits GR01 - GRT10; the second dated 31 October 2025, accompanied by exhibits GRT11 – GRT13. Ms Tanner is a trainee trade mark attorney at Reddie & Grose LLP (MTDM's representative).

22. All the witnesses are duly authorised to provide evidence on behalf of their respective parties. Neither party requested a hearing, but MTDM filed submissions in lieu of a hearing.[2] I will not summarise the parties' evidence or submissions. I will refer to the parties' evidence and submissions to the extent that I deem

[2] Dated 18 March 2026.

necessary throughout my decision. This decision is taken following careful consideration of all the papers.

DECISION

MY APPROACH

23. The opposition is exclusively based on STJC's '826 mark. If the '286 mark is not found to have been validly registered under sections 3(1)(a), 3(1)(b) and 3(1)(c), this will be deemed to have never existed, and the opposition against MDTM's '619 marks based upon sections 5(1), 5(2)(a), 5(2)(b) and 5(3) will fall away. Similarly, the non-use revocation action will be moot as it will not grant MTDM a higher degree of success. In the event the invalidity based upon sections 3(1)(a), 3(1)(b) and 3(1)(c) is unsuccessful, I will consider the revocation action in that it has a direct effect on the opposition proceedings insofar as any level of success (if any) will determine whether STJC will be able to rely upon its '826 mark for the opposition against MDTM's '619 marks. I will, therefore, begin by considering the invalidation action brought by MTDM (namely, CA508608).

THE INVALIDATION

Statutory provisions

24. Section 47 of the Act states:

> "(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).
>
> Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.
>
> […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[…]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed."

25. Section 3(1) of the Act provides as follows:

"3(1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

26. Section 1(1) of the Act states:

"1(1) In this Act "trade mark" means any sign which is capable—

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging."

The relevant public

27. The above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.[3] Only MTDM filed specific submissions on this point. It is argued that the relevant consumer consists of members of the general public who will seek financial advice or support to manage their finances in the form of loans or credit repayments. MTDM therefore contends that these consumers will pay an elevated degree of attention in the selection of the services at hand.[4]

28. STJC's services for which the '826 mark is registered are financial services including monetary services (e.g., credit and loan services) as well as financial advisory and consultancy. The average consumer for these services will include members of the general public, and businesses. The average consumer is likely to be concerned with factors such as the quality of the service provider, customer service standards, terms and conditions relating to the monetary services (especially for loan services), and security of financial information. Consequently, I agree with MTDM that the average consumer (whether businesses or members of the general public) will be paying a between medium and high degree of attention during the purchasing process.

Relevant Date

29. The relevant date for the assessment under section 3 of the Act is the filing date of the '826 mark which in this case is **5 November 2009**.[5] I shall bear this date in mind whilst considering the claims.

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[3] *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04.
[4] MTDM's submissions in lieu at [39].
[5] *Imagination Technologies v OHIM*, Case C-542/07.

Section 3(1)(a)

30. MTDM submits that FLEXI-PAY cannot function as a trade mark for the services for which it is registered because it is descriptive, non-distinctive and it holds no capacity to distinguish STJC's services from those of other undertakings.[6]

31. Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *AD2000 Trade Mark*, said that section 3(1)(a) permits registration provided that the mark is 'capable' to the limited extent of "not being incapable" of distinguishing.[7] Consequently, if I am satisfied that the mark complies with sections 3(1)(b) or (c) of the Act, the 'incapable of distinguishing' objection under section 3(1)(a) is bound to fail. Alternatively, if either of the grounds under section 3(1)(b) or (c) succeed, the outcome under section 3(1)(a) becomes moot.

32. In any event, this ground fails for the reasons given by Arnold J (as he then was) in *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch):

> "44. [...] As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art. 4, the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.
>
> 45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:
>
>> "80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark*

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[6] MTDM's submissions in lieu at [25].
[7] [1997] RPC 168.

[2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I 5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. **Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services**." (My emphasis)

33. The '826 mark is a word and, thus, the subject matter of the protection is clear and precise. Furthermore, the mark is not incapable of distinguishing any goods or services. It follows that **the section 3(1)(a) ground fails**.

Section 3(1)(c)

34. Section 3(1)(c) prevents the registration of marks which designate the kind, quality, quantity, intended purpose, or other characteristics of the services. I bear in mind when undertaking the assessment that the purpose of this section is to ensure signs designating a characteristic of the services remain free for use by traders.

35. The case law relating to this section, which corresponds with Article 7(1)(c) of the EU Trade Mark Regulation (formerly the CTM Regulation), was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

> "91. The principles to be applied under art. 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:
>
>> '33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L40, p. 1), see, by analogy, [2004] ECR 1-1669, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr & Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. 1-12447; [2004] E.T.M.R. 9' [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).
>>
>> 36. […] due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P)

[2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45; and *Lego Juris v OHIM* (C-48/09 P, paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie,* paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/89 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] E.C.R. I-2779, paragraph 35; and Case C-363/99 *Koninklijke KPN Nederland* [2004] E.C.R. I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104; *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No 40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods of services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time or production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that this list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word “characteristic” highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).’

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux Merkenbureau* (C-363/99) [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

36. Whether the ‘826 mark is descriptive must be assessed through the eyes of the relevant parties, as the CJEU held in *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. In paragraph 24 of that decision, it described the relevant parties as in trade or the average consumers of the goods (or services) in question, “*reasonably well-informed and reasonably observant and circumspect*”. The case law quoted above in *Starbucks* makes it clear that a mark will be caught by this section if the relevant parties can easily recognise that it designates a characteristic of the goods (or services), such as their nature or intended purpose.

37. Mr Gupta indicates that, on 22 September 2023, STJC acquired the rights for the Ideal World branding.[8] STJC’s evidence shows that STJC operates the Ideal World website along with the homonymous TV shopping channel and transactional websites.[9] The evidence features extracts from the WayBack Machine database, dated between July 2011 and October 2025, showing the Ideal World website

[8] Mr Gupta’s witness statement at [8].
[9] EXH1, page 1.

where a range of different products are sold alongside the FLEXI-PAY mark. The evidence indicates that FLEXI-PAY is a payment option that allows customers to spread a product's cost (excluding postage and packaging) across 2, 3 or 4 monthly instalments, interest free.[10] The evidence shows that STJC places the indication FLEXI-PAY on those products that can be purchased in instalments so that consumers are aware that for those goods, such a flexible method of payment is available. The image below shows an example of FLEXI-PAY used in this way. The image also shows that FLEXI-PAY is used in combination with "x2", "x3" or "x4" to indicate the number of instalments available for that product (Figure 1).

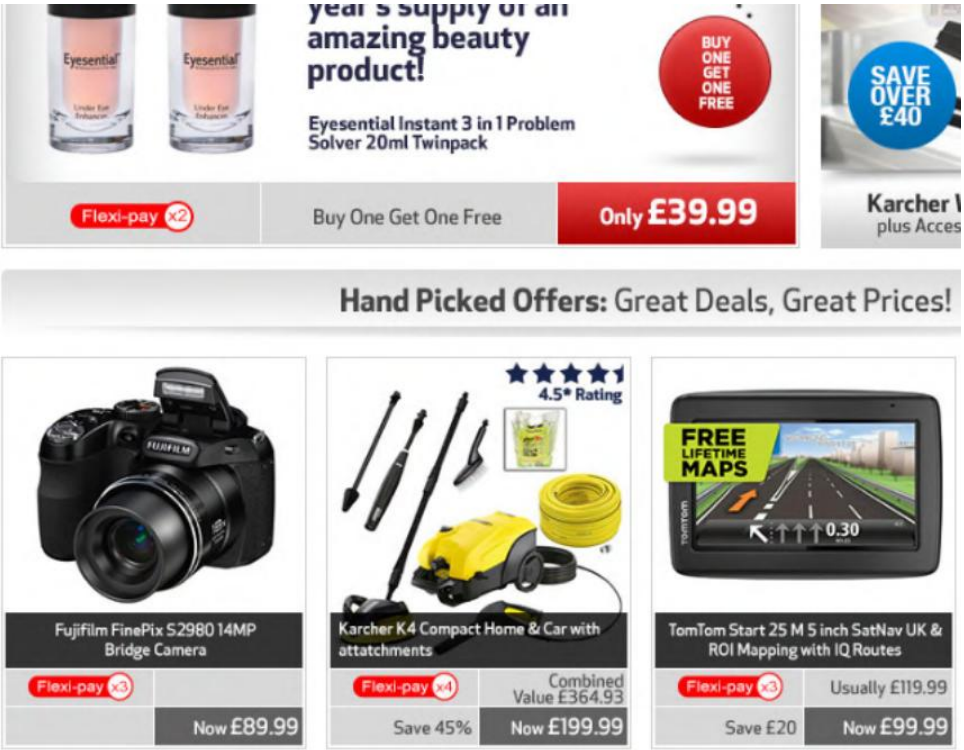

Figure 1 – EXH4, page 6

[10] EXH2, page 3.

38. The evidence also shows that some of the transactional websites display at the bottom the wording “Pay with Flexi Pay”. This again indicates that “Flexi Pay” is a method of payment. For example, see the image below:

Figure 2 – EXH15, page 2

Detail of Figure 2

39. The evidence also shows screenshots of infomercials available on YouTube, dated between 26 July 2011 and 22 May 2019. The evidence shows FLEXI-PAY displayed as on-screen text to inform the viewers of the possibility to purchase the

advertised products with an adjustable payment method (i.e., in instalments). See Figure 3 below.

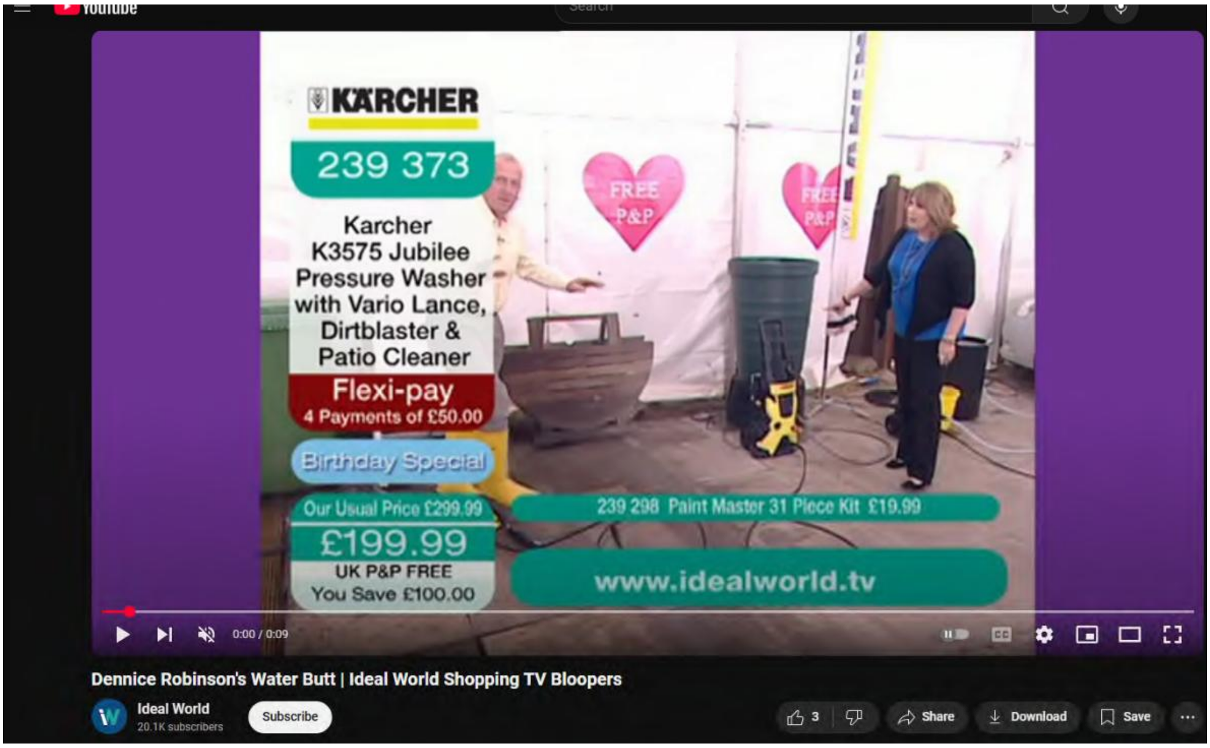

Figure 3 – EXH8, page 6

40. STJC does not clarify to what extent the UK consumers were exposed to FLEXI-PAY via this online channel. Most of this part of the evidence refers to the Ideal World YouTube channel which, in 2015, counted just over 20 thousand subscribers

globally. However, as this is a global figure, it does not give a clear reference for the UK market.

41. The evidence also displays some uses of FLEXI-PAY on Facebook and X, dated within the relevant period, to indicate it is a flexible payment method for a variety of goods (see respectively Figure 4 and Figure 5).

Figure 4 – EXH9, page 1

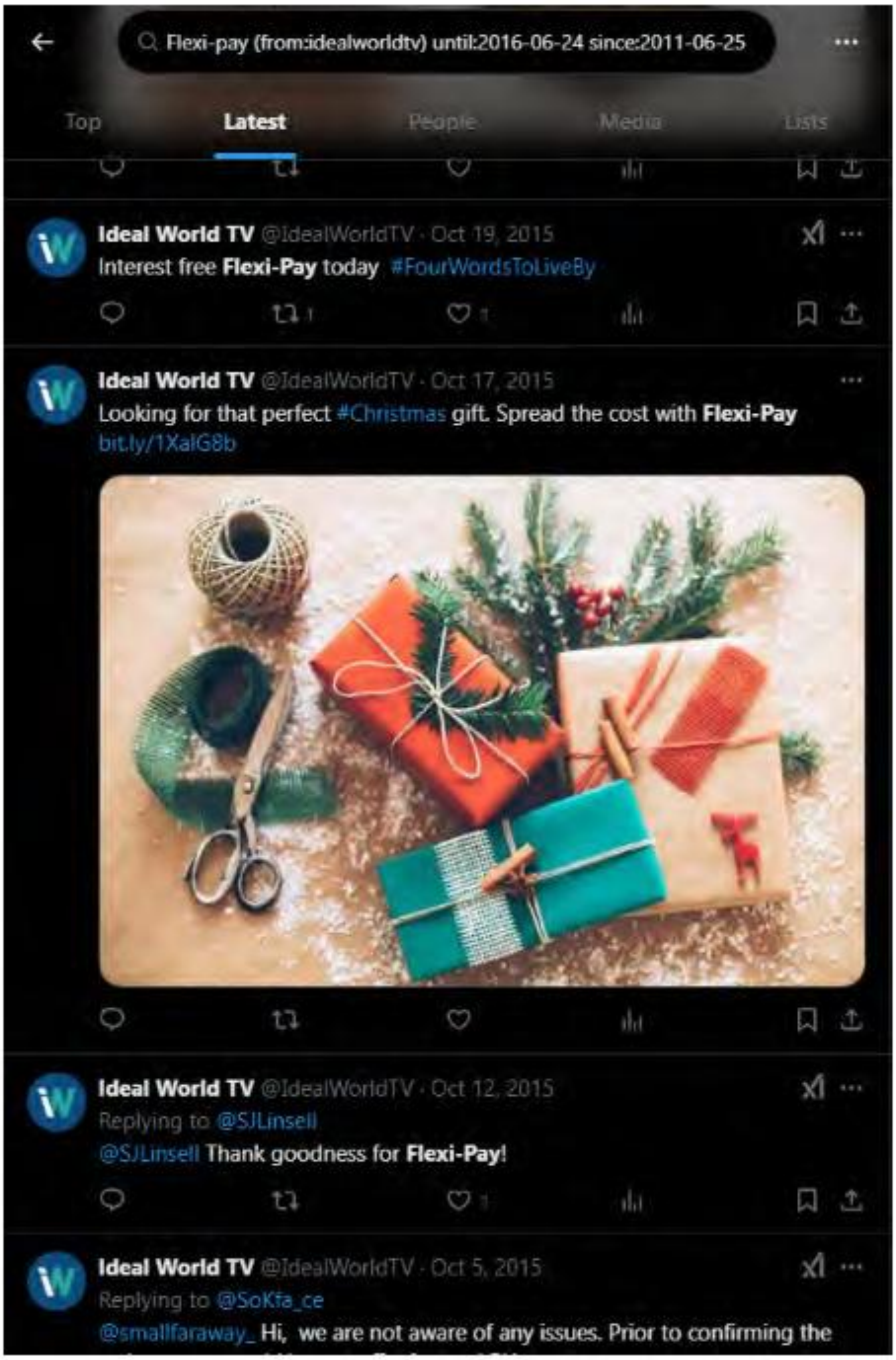

Figure 5 – EXH10, page 4

42. The evidence provided clearly shows that FLEXI-PAY is used on STJC's online shopping website, TV channels and social media to inform the consumers that the products can be purchased with the flexible payment method of different instalments.

43. The screenshots extracted from the X account (Figure 5) particularly show how FLEXI-PAY is used in a descriptive manner. For example, some of the posts state the following:[11]

- "*Interest free Flexi-Pay today*"
- "*SAVE £30 on this Acer Tablet with tonight's POD! The perfect gift for a student and is available on Flexi-Pay!*"
- "*Spread the cost with Flexi-pay and bag yourself a HANNspree 40 inch Widescreen TV today for £133.33!*"

44. The evidence also reproduces one screenshot of an X post stating "*easy shopping with 5 Flexi-Pay instalments!*".[12]

45. The evidence also shows a singular invoice for one of the consumer goods purchased on the Ideal World website (or TV channel). The invoice features FLEXI-PAY as payment option included in the purchase (Figure 6).

Delivery Address

[redacted]

Billing Address

[redacted]

Card Details

Card Type: [redacted]
Card Number: 4567********0[redacted]
Expiry Date: 0615

Product	Qty	Price	Flexi-pay
NutriBullet Nutrition Extractor 12 Piece Bundle	1	£89.99	included

Your Payment Plan with

Today (ex P&P)	26/10/2014	26/11/2014
£30.01	£29.99	£29.99

Figure 6 – EXH11, page 2

[11] EXH10, pages 4 and 7.
[12] EXH20, page 1.

46. The evidence shows uses of the word-only FLEXI-PAY as registered as well as in the acceptable variant uses of the word FLEXI-PAY (in white) placed on a red elliptic background.[13]

47. Ms Instone, on behalf of STJC, also provided evidence. Ms Instone filed a Google Chrome extract resulting from the search of FLEXI-PAY in the UK. The extract reports that:

> “Flexi-pay" refers to various split-payment options and lines of credit offered by different companies in the UK, allowing individuals and businesses to spread the cost of a purchase or expense over a set period. Examples include HSBC's Flexipay for retail purchases, Currys Flexpay for tech, and Funding Circle's FlexiPay for businesses, all providing flexibility in payment terms and amounts to manage cash flow.”[14]

48. MTDM provides evidence showing that various third-party businesses, apart from STJC and MTDM, use FLEXI-PAY to indicate the possibility for consumers to purchase their goods or services with a flexible payment plan (e.g., spreading the cost with instalments). The evidence shows that third-party companies such as, for example, HSBC, Apple, Google Play, Hughes, Pocket HRMS, Ordo Eviden, Utilita Energy, Vision RCL, and Valorem Partners use the word combination “FLEXI” and “PAY” (whether hyphened or conjoined) in the UK to communicate to consumers that they can set the payment of their purchased goods or services in a flexible manner.[15] I provided some examples below.

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[13] *Colloseum Holdings AG v Levi Strauss & Co* (Case C12/12) at [32].
[14] ACI01, page 1.
[15] GRT01 – GRT05.

02/05/2025, 14:52 HSBC Flexipay Support | Help With Installment Payments

Menu HSBC UK Log on

Managing your HSBC Flexipay account

From making overpayments to paying your loan off early, find out how to manage your HSBC Flexipay account.

Figure 7 – GRT03, page 1

29/09/2025, 15:47 Flexi pay

Flexi Pay Flooring

Make your dreams a reality with high quality flooring and flexible payment plans.

Book An Appointment

Figure 8 – GRT06, page 21

49. Looking at the evidence provided by the parties, I do not consider that the contexts in which FLEXI-PAY is used have a typical trade mark function. STJC uses FLEXI-PAY to communicate to its consumers that STJC provides a financial service which allows users to purchase its goods with a flexible payment method encompassing a number of instalments. The evidence also shows that the informative message conveyed by FLEXI-PAY is used by different businesses to communicate the same or similar message.

50. From the above, it is clear that FLEXI-PAY is generally used in a descriptive sense by various brands to communicate the meaning of a flexible method of payment and no trade mark sense is attached exclusively to STJC's business.

51. With regard to the class 36 services for which FLEXI-PAY has been registered, I find that the mark merely describes the intended purpose of the services, namely, financial, credit, monetary and loan services (including advisory and consultancy services) aimed at providing the consumers with greater flexibility in managing finances and allowing them to make purchases without the need for immediate full payment.

52. I also acknowledge that the parties' evidence post-dates the relevant date for assessment. Nonetheless, I see no reason to conclude that the position would have been any different prior to the relevant date. In any event, there is an element to futurity to the assessment section under 3(1)(c), in that it will be sufficient if the mark could be used in such a way. In accordance with the case law cited at paragraph [35], above, it is not necessary to show that a description was already in use at the relevant date, but that the sign could be used and recognised as a description in the future.[16] I am satisfied that the latter has been shown.

53. FLEXI-PAY is a combination of a well-known abbreviation and an ordinary dictionary word: "FLEXI" and "PAY". Whilst the dictionary evidence provided by MTDM for the meaning of "FLEXI-" refers to American English,[17] I note that the Manual of Trade Marks Practice states the following:

"**Flexi**

[16] See also *Labowicz v EUIPO* Case T-237/15.
[17] GRT01.

'Flexi' is a well known abbreviation for 'flexible'. Whether used alone or as a prefix, the word will be treated as if they were the word 'flexible' and an objection under section 3(1)(b) and (c) will be raised where the totality is considered descriptive. This will normally only apply when flexibility is a desirable characteristic of the goods/services applied for foe example 'FLEXIPIPE' (for pipes) would not be acceptable as it is desirable for pipes to be flexible."

54. The dictionary word "flexible" indicates something that is "susceptible of modification or adaptation to various purposes or uses".[18]

55. PAY consists of the common English dictionary word meaning "to give money or its equivalent in return for goods, services, etc."[19]

56. It follows that the word combination FLEXI-PAY conveys the descriptive message that STJC's services consist of or allow a manner of payment that is susceptible of modification or adaptation. Therefore, the mark is clearly aimed at communicating the desirable characteristic/intended purpose of the services, namely, financial services (including credit, monetary and loan services) that enable the consumers to pay for their purchases with greater flexibility (e.g., in instalments) allowing them to obtain their desired goods (or services) whilst managing their finances.

57. For the sake of clarity, I appreciate that the evidence provided by the parties is dated after the relevant date. However, this does not detract from the fact that, already at the relevant date, FLEXI-PAY could have been used for such descriptive purposes as shown in the evidence.

58. It follows that **the invalidation based on section 3(1)(c) ground succeeds in full**.

Section 3(1)(b)

59. I now turn to the invalidation based upon section 3(1)(b). MTDM, in its statement of grounds, contends that FLEXI-PAY is non-distinctive for the services at hand in

[18] Oxford English dictionary available at https://www.oed.com/dictionary/flexible_adj?tab=meaning_and_use#4088487.
[19] Oxford English dictionary available at https://www.oed.com/dictionary/pay_v1?tab=meaning_and_use#31295914.

that the relevant consumers will understand this word combination as describing or referencing “flexible payment”.

60. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s. 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG16*[20] as follows:

> “29 [...] the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).
>
> 30. Under that provision, marks which are devoid of any distinctive character are not to be registered.
>
> 31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).
>
> 32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se,

[20] (C-265/09 P).

three-dimensional marks and slogans (see, to that effect, respectively, Case C 447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

61. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b). In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union ("CJEU") stated that:

"25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46)."

62. The public interest underlying section 3(1)(b) of the Act is described in *BORCO*: the mark "must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings".

63. As already mentioned above, FLEXI-PAY conveys the positive message that STJC's financial services (including credit, monetary and loan services) enable the consumers to pay for their purchases with greater flexibility (e.g., in instalments)

allowing them to obtain their desired goods (or services) whilst managing their finances.

64. I also found that the indication FLEXI-PAY has been used by different businesses, separate from the proprietor, to convey the same or similar message. It is clear from the case law that for a mark to possess distinctive character, it must serve to identify the services in issue as originating from a particular undertaking, and in this case, the words FLEXI-PAY are descriptive of STJC's financial services. On this basis, the '826 mark is incapable of identifying the services as originating from one particular undertaking. In other words, the mark will not trigger in the mind of the average consumer a trade origin specific message. The words will be perceived as origin neutral.

65. For this reason, the mark would not be able to do the job of identifying the commercial source of the services and would not, therefore, perform the essential function of a trade mark which is to distinguish the registered proprietor's services from those of other traders.

66. It follows that **the invalidation based on section 3(1)(b) ground succeeds in full**.

Acquired distinctiveness

67. I have found the '826 mark to be *prima facie* objectionable under sections 3(1)(b) and (c). As noted above, the proprietor has also filed evidence to show use of the mark.

68. For any acquired distinctive character claim in accordance with section 47(1), the relevant date of the assessment is the date of the application for invalidation, namely **11 March 2025**. STJC must have acquired distinctive character prior to that date.[21]

69. The Court of Justice of the European Union provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with

[21] *Oberbank AG & Banco Santander SA v Deutscher Sparkassen-und Giroverband eV* Joined cases C-217/13 and C-218/13 at [61].

regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

> "51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.
>
> 52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.
>
> 53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37)."

70. STJC did not make any claim that the '826 mark had acquired enhanced distinctiveness by the relevant date. However, if I am satisfied that the contested mark had acquired enhanced distinctiveness by the date of the application for invalidation then this is sufficient to avoid the mark falling foul of section 3(1). It is also important to bear in mind that the relevant market for assessing acquired distinctiveness is the UK market; evidence of use in other jurisdictions is, therefore, irrelevant.

71. Mr Gupta gives an account of the ownership transfers that occurred for the ‘826 mark until the mark was finally assigned to STJC on 22 September 2023. Mr Gupta confirms that the ‘826 mark has been used in the first and second relevant periods by STJC and its predecessors in title.[22]

72. As noted above, the evidence consists of numerous extracts from the WayBack Machine database, dated between July 2011 and October 2025, showing screenshots of the Ideal World website (or TV channel) offering for sale a selection of different products and showing the FLEXI-PAY sign to indicate the possibility for consumers to purchase the goods flexibly, i.e. in instalments.

73. The evidence also shows extracts from the Ideal World’s YouTube channel (dated between July 2011 and May 2019) as well as the Facebook and the X social media accounts (dated respectively July 2012 – December 2024 and November 2011 - November 2023) advertising for sale a variety of goods and using FLEXI-PAY to inform consumers of the possibility to purchase some of the goods with interest-free monthly instalments.

74. I note that no details have been provided by the proprietor to indicate the size of the relevant market or its share of that market. I have not been provided with any turnover evidence, nor have I been provided with marketing figures or examples of marketing of STJC’s FLEX-PAY mark. Although I appreciate that the evidence features one invoice, I found above that this part of the evidence reinforces the argument that the ‘826 mark is used to indicate that the goods are paid in instalments, rather than showing economic origin.

75. The evidence also fails to show if consumers would perceive FLEXI-PAY as a commercial origin indicator for STJC (or the respective predecessors in title of the mark). As already discussed above, the evidence provided exclusively shows descriptive (or non-distinctive) uses of the mark in relation to the financial services for which it has been registered.

76. Taking account of the proprietor’s evidence, overall, it is wholly insufficient to demonstrate that the ‘826 mark has acquired a distinctive character prior to 11

[22] Mr Gupta’s witness statement at [3] – [13].

March 2025. Therefore, the acquired distinctiveness proviso to section 3(1) does not apply.

<u>OUTCOME OF THE INVALIDITY PROCEEDINGS</u>

77. The application for invalidation number **CA000508608** against the proprietor's mark has succeeded in full. As a result, the '826 mark is, subject to any successful appeal, hereby declared invalid and deemed as if it had never been registered for any of the services covered by its specification.

78. The non-use revocation action number **CA000507334** filed against the '826 mark has become moot in that, if successful, it would not provide MTDM with a greater result than the one obtained with the invalidation.

79. Regarding the opposition number OP000452178, STJC no longer has an earlier mark to rely upon in the section 5(1), 5(2)(a), 5(2)(b) and 5(3) proceedings, and as such, these grounds of opposition fall away.

80. However, as noted above, STJC also relies upon section 5(4)(a), and its unregistered right (that being the FLEXI-PAY sign), to oppose MTDM'S application. On this basis, I must consider the section 5(4)(a) claim.

STJC's opposition under Section 5(4)(a)

81. Section 5(4)(a) of the Act states as follows:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa) […]

b) […]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark".

82. Subsection (4A) of section 5 of the Act states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

83. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

84. The section 5(4)(a) ground requires STJC to have filed evidence to establish that it had a goodwill in its FLEXI-PAY sign at the relevant date.

85. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O 410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4

of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

86. As the applicant has filed no evidence of use of its mark, I have only the prima facie relevant date to consider i.e. 9 May 2024.

Goodwill

87. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start."

88. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith*, *Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

89. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

90. The evidence filed in regard to this claim is the same evidence filed in defence of the revocation action on which I already commented at paragraphs [37] – [46].

91. I remind myself that goodwill arises as a result of trading activities and it must be more than nominal (trivial).[23] From my account of the evidence above, most of which is dated before the relevant date, it mostly consists of FLEXI-PAY being displayed on the Ideal World website along with some evidence showing the sign reproduced on screen in YouTube infomercials and on social media platforms. It is not clear from the evidence the reach of these media in the UK. More importantly, STJC has not provided any turnover figures, and I have only been provided with one invoice, in which the customer address has been redacted. Therefore, I have no evidence before me to establish that STJC had any UK customers before the relevant date. I also have not been provided any advertising figures for the sign, as well as the marketing spend invested for the sign or the market share it occupies.

[23] *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20).

Taking all of the above into account, I find that the section 5(4)(a) case fails as I have been provided with insufficient evidence to prove the existence of any protectable level of goodwill in STJC and its FLEXI-PAY sign at the relevant date.

92. However, I shall nonetheless proceed as if the evidence filed does show a small level of protectable goodwill in the opponent (which would have been STJC's best case based on the limited evidence filed), and its FLEXI-PAY sign at the relevant date.

Misrepresentation and damage

93. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is
>
>> "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

94. And later in the same judgment:

> "[...] for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and

concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

95. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

> "64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

96. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

> "Establishing a likelihood of deception generally requires the presence of two factual elements:
>
> > (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
> >
> > (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.
>
> While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other. The question whether deception is likely is one for the court, which will have regard to:
>
> > (a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

97. The respective marks share identical "*financial services*" in class 36 and MTDM's financial-related goods and services in classes 9 and 35 are similar to STJC's financial services in class 36. Therefore, even where the services are not identical, they are within the same field of financial activity. I have also already identified the relevant public at paragraphs [27] and [28].

98. Looking at the respective marks, they overlap in the words "FLEXI" and "PAY" being hyphened in the STJC's sign and conjoined in the '619 marks. The marks differ in the addition of the wording "FROM FUNDING CIRCLE" in the '619 marks. I found above in this decision that the word combination "FLEXI" and "PAY" is descriptive and non-distinctive for the financial services at hand; thus, I agree with MTDM that the distinctive element in the '619 marks is "FROM FUNDING CIRCLE" (irrespective of its presentation in a capitalised or lower-case typeface). I also bear in mind that the addition of "FROM FUNDING CIRCLE" in the '916 marks is not reproduced in STJC's sign.

99. I am reminded of the words of Lord Simonds in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39 where he stated that:

"Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered."

100. In my view, that is the case here. Whilst I bear in mind that STJC's sign and MTDM's marks share the elements "FLEXI" and "PAY", the differences between them are, in my view, sufficient to avoid misrepresentation arising. As noted above, STJC's "FLEXI-PAY" sign, which is a combination of the abbreviation of "flexible" and the ordinary dictionary word "pay", is descriptive and non-distinctive of STJC's financial services. I bear in mind that these elements are presented slightly differently in MTDM's '619 marks, that being as a singular word without the hyphen ("FLEXIPAY"/"FlexiPay"). Moreover, the additional elements in the '619 mark, being "FROM FUNDING CIRCLE", will highlight for the public that these are two different undertakings who both happen to be using descriptive/non distinctive "FLEXI PAY" elements as part of their trade names, for goods and services which are all within the same field of financial activity. Whilst those differences may seem relatively small, in the context of marks/signs that are not very distinctive, a greater degree of discrimination will be paid by the public, thus avoiding any misrepresentation. As there is no misrepresentation, there can be no damage.

CONCLUSION ON THE OPPOSITION PROCEEDINGS

101. The opposition under section 5(4)(a) fails in its entirety.

102. The opposition is unsuccessful and the trade mark series number **UK00004049619** can therefore proceed to registration.

COSTS

103. As the successful party, MTDM is entitled to a contribution towards its costs. MTDM has filed a request for off-scale costs arguing that STJC's opposition was unnecessary and it acted vexatiously forcing MTDM to file evidence and

submissions to support its own invalidation and revocation actions as well as defending from STJC's opposition.[24]

104. Rule 67 of the Trade Marks Rules 2008 provides:

> "The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid."

105. Tribunal Practice Notice ("TPN") 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. The TPN stipulates that costs off the scale are available "to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour".

106. Although I appreciate that MTDM had to incur in legal costs to defend against STJC's opposition, STJC was entitled to bring the opposition against MTDM's application and there is nothing to suggest that STJC has acted unreasonably during the proceedings which would justify an off-scale cost award. MTDM was also entitled to file the additional revocation and invalidation actions against STJC in defence of its mark, and STJC cannot be held responsible for MTDM choosing to pursue such a defence. Therefore, MTDM's request for off-scale costs is refused. Based upon the scale published in Tribunal Practice Notice (TPN) 1/2023. The sum is calculated as follows:

Official fee (x2)	£400
Filing the notices of revocation/invalidation, preparing a counterstatement and considering the other side's statement in the opposition	£650
Preparing evidence and considering and commenting on the other side's evidence	£600
Preparing submissions in lieu of a hearing	£500
Total:	**£2,150**

[24] MTDM's email dated 4 June 2026.

107. I therefore order Shop TJC Limited to pay Made To Do More Limited the sum of **£2,150**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 18th day of August 2026

Andrea Rossi
For the Registrar