O/1067/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00004008229

BY FINANCE BUDDY LTD

TO REGISTER THE FOLLOWING TRADE MARK:

FinanceBuddy

IN CLASS 9

AND

AN OPPOSITION THERETO UNDER NUMBER OP000447362

BY UNICREDIT S.P.A.

BACKGROUND AND PLEADINGS

1. On 29 January 2024, Finance Buddy Ltd ("***the Applicant***") applied to register in the UK the trade mark shown on the cover page of this decision ("***the Contested Mark***"). The application was accepted and published for opposition purposes on 8 March 2024. Registration is sought for the following goods:

   Class 9: Finance App.

2. On 8 May 2024, UNICREDIT S.P.A. ("***the Opponent***") opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 ("***the Act***").[1]

3. The Opponent relies upon the following two earlier United Kingdom trade marks for the opposition ("***the Earlier Marks***"):

   "*The first earlier mark*"

   UK00915225972[2]

   BUDDYBANK

   Filing date: 17 March 2016

   Registration date: 26 August 2016

   For the purposes of these proceedings, the Opponent is relying on the following goods and services, for which the first earlier mark is registered:

   Class 9: Automatic bank machines; Automatic cash points; Cash registers; Calculators; Apparatus for processing card transactions and data

[1] The opposition was originally based on Sections 5(2(b) and 5(4)(a). The Opponent subsequently amended the form TM7 and removed the Section 5(4)(a) ground.

[2] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives. The Opponent's first earlier mark is a comparable UK trade mark. Therefore, it retains its original filing date and registration date of the EUTM from which it derives.

relating thereto and for payment processing; Apparatus for verifying data on magnetically encoded cards; Smart cards [integrated circuit cards]; Magnetically encoded cards; Smart cards containing programs for identifying clients and for processing financial transactions and payments; Magnetic, optical and magneto-optical data media; Computer hardware; Computer software for financial services, banking services, business management and consultancy; Computer software which enables creation, modification, uploading, displaying, tagging, sending, sharing or providing via any other means of data, including images, graphic elements, sounds, text, or audio and visual information, via the Internet or other communications networks; Computer software and hardware for connecting computers to a network for facilitating interactive multimedia connections; Computer software for researching and retrieving information, websites and other resources on computer networks; Computer software for use in creating and designing websites; Electronic data receivers for recording, transfer, processing and reproduction of images, sounds and data; Parts and fittings the aforesaid goods; Mobile phones, telephone apparatus; Spectacles [optics]; Cameras.

Class 36: Insurance and financial information and consultancy services; Actuarial services; Banking; Monetary affairs; Currency trading and exchange services; Financial management, administration and evaluation of financial investments; Financing and procuring of financing; Consultancy relating loans; Providing consultancy in relation to loans, banking affairs, investment management, mutual investment funds and mutual financial funds; Financial administrative services; Financing services; Pension fund administration services; Home financing and home loans; EVALUATION OF MOVABLES; Brokerage of shares; Tax payment processing services; Pension valuation; Employee pension plan administration; Administration of pensions and

pension funds; Public and private equity financing; Electronic funds transfer; Brokerage agencies in relation to credit and insurance; Issuing of travellers' cheques; Credit cards, debit cards, ATM cards, cheque guarantee cards and loyalty cards; Processing electronic payments made with pre-paid cards; Home banking; Financial planning and investment consultancy; Providing financial and monetary exchange services; Money transfer; Appraisals, brokerage, rental, management and valuation in relation to real estate; Real estate acquisition; Rent collection; letting and Real estate property leasing; Issuance of tokens of value for use in relation to loyalty schemes; Insurance underwriting; Administration of insurance portfolios; Provision of insurance policies; Provision of insurance premium quotations; Information, advice, assistance, and consultancy services relating to the aforesaid.

"*The second earlier mark*"

UK00918286209[3]

Filing date: 10 August 2020

Registration date: 29 December 2020

[3] The Opponent's second earlier mark is a comparable UK trade mark. The comparable UK mark now recorded on the UK trade mark register has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date and registration date of the EUTM from which it derives.

For the purposes of these proceedings, the Opponent is relying on the following goods and services, for which the second earlier mark is registered:

Class 9: Automatic bank machines; Automatic cash points; Cash registers; Calculators; Apparatus for processing card transactions and data relating thereto and for payment processing; Apparatus for verifying data on magnetically encoded cards; Integrated circuit cards [smart cards]; Magnetically encoded cards; Smart cards containing programs for identifying clients and for processing financial transactions and payments; Magnetic, optical and magneto-optical data media; Computer software for financial services, banking services, business management and consultancy; Spectacles; Cameras [photography].

Class 36: Insurance and financial information and consultancy services; Actuarial services; Banking; Monetary affairs; Currency trading and exchange services; Financial management, administration and evaluation of financial investments; Financing and procuring of financing; Consultancy relating loans; Providing consultancy in relation to loans, banking affairs, investment management, mutual investment funds and mutual financial funds; Financial administrative services; Financing services; Pension fund administration services; Home financing and home loans; EVALUATION OF MOVABLES; Brokerage of shares; Tax payment processing services; Pension valuation; Employee pension plan administration; Administration of pensions and pension funds; Public and private equity financing; Electronic funds transfer; Brokerage agencies in relation to credit and insurance; Issuing of travellers' cheques; Credit cards, debit cards, ATM cards, cheque guarantee cards and loyalty cards; Processing electronic payments made with pre-paid cards; Home banking; Financial planning and investment consultancy; Providing financial and monetary exchange services; Money transfer; Appraisals, brokerage, rental, management and

valuation in relation to real estate; Real estate acquisition; Rent collection; letting and Real estate property leasing; Issuance of tokens of value for use in relation to loyalty schemes; Insurance underwriting; Administration of insurance portfolios; Provision of insurance policies; Provision of insurance premium quotations; Information, advice, assistance, and consultancy services relating to the aforesaid.

4. Given their filing dates, the Opponent's marks are earlier rights, in accordance with section 6 of the Act. As the first earlier mark completed its registration procedure more than five years before the filing date of the opposed Contested Mark, it is subject to the use provisions set out in section 6A of the Act.

5. As the second earlier right has not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon all of the goods and services for which the second earlier mark is registered without having to establish genuine use.

6. Under section 5(2)(b), the Opponent claims, in its statement of grounds, that due to the high similarity between the marks and the identity/similarity of the goods and services, there exists a likelihood of confusion, including a likelihood of association.[4]

7. The Applicant filed a defence and counterclaim denying the grounds of the opposition.[5]

8. The Applicant is not legally represented. The Opponent is represented by Stevens Hewlett & Perkins.

EVIDENCE AND SUBMISSIONS

9. During the evidence rounds, the Opponent filed evidence in the form of a witness statement by Peter William Cornford, signed and dated 1 October 2024. Peter William Cornford is a Chartered Trade Mark Attorney and Partner of Stevens

[4] Form TM7 and statement of grounds dated 31 May 2024 at [14].
[5] Form TM8 and counterstatement dated 26 July 2024 at [8].

Hewlett and Perkins. The witness statement is accompanied by two exhibits labelled PWC1 and PWC2. The Opponent filed a further witness statement of Daniele Alessandro Luison, signed and dated 10 October 2024. Daniele Alessandro Luison is the legal counsel and special attorney of UniCredit S.P.A. The witness statement is accompanied by five exhibits labelled ABC1 – ABC5. The Opponent also filed a witness statement of Martina Diani, signed and dated 8 November 2024. Martina Diani is a qualified translator and employee of LingoYou Group S.r.l, a professional translation company. The witness statement is accompanied by three exhibits labelled MD1 – MD3. The Applicant filed written submissions dated 5 February 2025. Neither party requested a hearing, but the Opponent filed written submissions in lieu.

10. I do not intend to summarise the evidence and submissions at this stage. However, I confirm that I have taken all filed documents into account and will refer to and summarise them to the extent that I deem necessary below.

RELEVANCE OF EU LAW

11. 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.

PRELIMINARY ISSUES

Section 5(3) claim

12. In its statement of grounds, the Opponent submits that "*Opponent will during the course of these proceedings bring evidence of its reputation […]".* The Opponent's consideration of matters such as those reproduced above are noted but nonetheless appear more consistent with a section 5(3) claim. For clarity, section 5(2)(b) is the only pleaded ground in the present proceedings and, in the absence of a direct pleading and any supporting evidence, the scope of the opposition does not extend, for example, to grounds such as section 5(3) of the Act.

The first earlier mark should be revoked for non-use

13. The Applicant asserts that the first earlier mark has not been used and, therefore, it "*should be subject to revocation due to non*-use".[6] On the date of filing of the opposition the Applicant does not appear to have either filed or previously obtained the revocation of the first earlier mark. Therefore, the Applicant's argument does not have any bearing in these proceedings. For the sake of completeness, it is worth noting that, according to case law, where the revocation date of the Earlier Mark falls after the filing date of the Contested Mark, the Opponent can still rely upon its earlier mark because it was still a valid mark when the Contested Mark was filed.[7] In any case this circumstance does not apply to the proceedings at hand.

No actual confusion argument

14. The Applicant contends that "*the opponent has not provided any consumer complaints, survey evidence, or market research demonstrating that UK consumers associate the two brands*".[8]

15. Although I acknowledge these comments, I must clarify that the absence of actual confusion will not have any bearing on whether there exists a likelihood of confusion between the Contested Mark and the Earlier Marks. Whilst evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant.[9] This is because the absence of confusion may be attributable to the Earlier Marks having only been used to a limited extent, in relation to only some of the goods or services for which they are registered, or in such a way that there has been no possibility of the one being mistaken for the other.[10]

Party argues they market the mark differently from the other party

[6] Applicant's counterstatement dated 24 July 2024 at [4].
[7] BL O/220/12, [27] - [42].
[8] Applicant's written submissions dated 5 February 2025 at [5.3].
[9] *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283.
[10] *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

16. In its counterstatement the Applicant submits that "*[…] "Finance Buddy" is designed to provide significant social impact by assisting individuals in managing their finances during the ongoing cost of living crisis. Our platform aims to offer financial advices, tools, and resources to help people navigate these challenging times, thereby making a meaningful contribution to society. The Applicant's mark is positioned to support those in need, emphasising its unique role and distinction from the Opponent's inactive mark*".[11]

17. In this regard, I am required to make the assessment of the likelihood of confusion notionally and objectively based on the Opponent's goods and services, as registered, and the Applicants' goods, as applied for, in accordance with the relevant case law. That assessment requires that I must not take into account the actual way that either party has used their marks in the marketplace or the kinds of goods or services that those marks have been used in relation to thus far. Rather, I must consider all of the circumstances in which the mark applied for might be used if it were registered.[12] This is because trade mark registrations are items of property which may be sold by the Applicant and/or Opponent to third parties in the future and may therefore be used in a different way, or upon/in relation to different goods and/or services, than those used by the current proprietors of those marks. In this connection, in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-171/06P, the Court of Justice of the European Union ("CJEU") stated:

> "59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

[11] Applicant's counterstatement dated 24 July 2024 at [5].
[12] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, [66].

18. As such, it is not appropriate to take that factor into account in my assessment. However, I will make an assessment, later in this decision, as to who the average consumer could be for the goods and/or services at issue.

DECISION

Proof of use

19. I will begin by assessing whether there has been genuine use of the first earlier mark.

The law

20. Section 6A of the Act states:

> "(1) This section applies where
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if – (a) within the relevant period the earlier trade mark has 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, or (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes – (a) 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 (b) 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.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

21. As the first earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7. - (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) […]

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day -

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union".

22. Section 100 of the Act states:

"100. 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."

23. Consequently, the onus is upon the Opponent to prove that genuine use of the registered trade mark was made in the relevant period. The relevant period in which use must be established is the five-year period ending on the date of filing of the Contested Mark, i.e. **30 January 2019 - 29 January 2024** ("***the relevant period***"). By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for almost the first two years of the relevant period which fall prior to IP Completion Day (i.e., 31 December 2020).

Case law

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

> "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 I9223, 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 subcategory 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]."

25. 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 or services protected by the mark" is, therefore, not genuine use.

Evidence of use

26. Mr Cornford states, in his witness statement, that after conducting an online search for terms containing the term 'BUDDY' (i.e., 'BUDDY BANKING SERVICES'; 'BUDDY BANKING'; 'BUDDY BANKING FINANCIAL SERVICES'; 'BUDDY BANKING FINANCE') the only "live" references (or uses) of the word 'BUDDY' as a trade mark in the UK for the financial sector is use by the Opponent. To this end, Mr Cornford provides some internet extracts resulting from the search of the words listed above (containing the word 'BUDDY') for financial services, and showing that, apart from the Opponent's uses for this term, other uses of 'buddy' online refer

to companies that are outside of the UK (e.g., Sweden, USA, UAE, India, and South Africa), dissolved or scams.[13] Focusing on the evidence referring to the first earlier mark, the evidence shows:[14]

- One link from Google play for 'buddy UniCredit'. This is undated.
- One link from 'Unicreditgroup.eu', dated 25 October 2023, for an online article titled "UniCredit launches buddy R-Evolution".
- One link from 'www.reuters.com', dated 25 October 2023, for an online article titled "UniCredit revamps Buddy online banking service to ease…"
- One link from 'Unicreditgroup.eu', dated 16 February 2016, for an online article titled "buddybank – the bank that's always by your side". This is dated outside of the relevant period.

27. Mr Cornford's witness statement also refers to exhibit PWC2 consisting of internet extracts showing that banks (e.g., Barclays, NatWest, Lloyds) offer a variety of services encompassing banking and finance services. Mr Cornford states that this evidence is aimed at showing that "financial services" and "banking services" are connected. This evidence constitutes an argument for the similarity of the parties' services rather than evidence of use. I will refer to this evidence later in this decision as deemed appropriate.

28. I now turn to Daniele Alessandro Luison's witness statement. Mr Luison states that the "Buddybank" mobile banking services was launched in Italy in 2018 and that it was first presented in the UK at the FinovateEurope in 2019. Mr Luison provides the Finovate's profile[15] and reports that FinovateEurope is the major international conference in fintech with more than 1,000 attendants of which more than 600 from the banking and finance sector. Mr Luison also states that on 25 October 2023 Reuters announced the launch of "Buddybank". The evidence reproduces one article from Reuters ('www.reuters.com'), dated 25 October 2023, titled "UniCredit revamps Buddy online banking service to ease cloud shift".[16] It is unclear whether the article targets the UK market. Additionally, the article refers to the Opponent's

[13] See, respectively, PCW1 at pages 5-10, 15/16 and 14.
[14] PWC1, pages 2 and 3.
[15] ABC1.
[16] ABC2 pages 3 and 4.

new application as “Buddy R-Evolution”. Differently from Mr Luison’s statement, there is no mention in the article of “BUDDYBANK”.

29. The evidence contains fourteen more articles in Italian, all dated 25 October 2023, from various online magazines (i.e., Il Sole 24 Ore, La Repubblica Economia (La Stampa), Teleborsa, Corriere, Forbes, Vertaeattari, Aziendabanca, Italpress, EconomyUp, Wall Street Italia, Citywire, Startmarg, and Milano Finanza).[17] Mr Luison states, in his witness statement, that although the articles are in Italian, they all have the same content as the abovementioned Reuters’ article and come from the same Opponent’s press release. The articles clearly target the Italian market. Although the articles are in Italian, I note that many of them feature, in their titles, either the word “Buddy” or “Buddy R-Evolution”. No title contains the word combination “BUDDYBANK”.

30. Mr Luison also reports that the Opponent is the official banking partner of the Davis Cup. The evidence features a picture showing the Davis cup on a backdrop featuring the word “BUDDY” and the words “OFFICIAL BANKING PARTNER OF THE DAVIS CUP” (Figure 1).[18] Mr Luison states that although the Davis Cup was held in Malaga (Spain), also UK viewers would have watched it. Mr Luison did not provide further evidence in this regard. The evidence provided is undated and Mr Luison’s does not clarify to which year the evidence refers.

[17] ABC2 pages 5 – 30.
[18] ABC3.

Figure 1

31. Mr Luison provides a list of articles from various Italian newspapers dated 25/26 October 2023. The articles are all in Italian.[19] Mr Luison states that some of the Italian newspapers listed in the evidence (i.e., Corriere dell Sera, la Repubblica, La Stampa an Il Sole 24 Ore) also circulate in the UK and they are read by Italians residing in the UK in 2023 and working in the financial sector. Whilst I appreciate Mr Luison's statement, I note that Italian residing in the UK does not represent the relevant consumer for the goods and/or services at hand. Mr Luison did not provide any evidence in this regard. As will be further specified below, the relevant consumer is likely to be the English-speaking general or professional public in the UK. Therefore, the evidence at hand does not target the relevant consumer. Furthermore, as it is dated after IP Completion Day (i.e., 31 December 2020), evidence targeting consumers within the EU (i.e., Italians) is out of scope.

32. Mr Luison indicates that the Opponent in 2024 sponsored a tour named "Vertical Summer Tour 2024" which is Italy's most famous travelling holiday village. Part of the evidence describes the Vertical Tour format for the year 2021 (of which the Opponent was not a sponsor). This is a holiday road trip where people travel from

[19] ABC4.

one holiday destination to another, over more than a month, stopping in each location for a few days. The locations consist of holiday villages where sports, fun activities and various leisure activities are organised/provided and where brands have the opportunity to expose their marks to which potential consumers (or users) are exposed for most part of their holiday.[20] The evidence shows that in 2024 the Opponent sponsored the Vertical Tour Summer "to raise awareness of the buddy model". Mr Luison reports that the "BUDDY" trade mark was visible prominently during the tour. To this end, the evidence features a few images showing the sign "BUDDY" used for marketing purposes (see Figure 2 and Figure 3).[21]

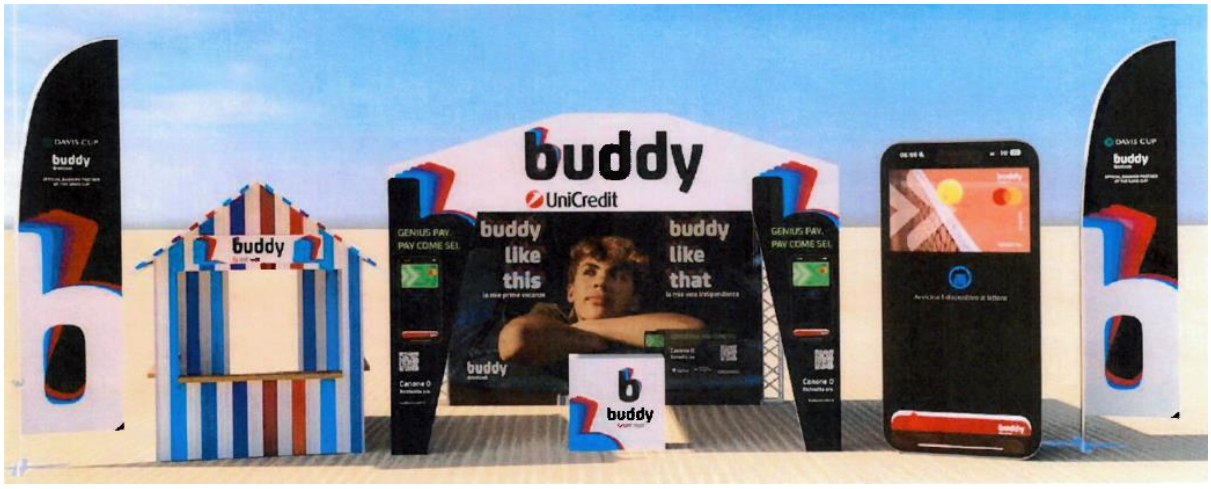

Figure 2

[20] ABC5 pages 19 – 28.
[21] ABC5 pages 6 and 7.

Figure 3

33. The evidence also indicates that the tour took place in various Italian cities.[22] The evidence is in Italian and, thus, clearly targets the Italian market. Mr Luison states, in his witness statement, that many British people are present at the tours whilst on holyday. However, no evidence was provided in this regard. Furthermore, although the evidence is dated 2024, the Vertical Summer Tour seems to take place during the summer months (e.g., July and August). Therefore, the evidence is seemingly placed outside of the relevant period.

34. The evidence also contains some invoices relating to the Opponent's expenditure for the Vertical Summer Tour's marketing activities indicating the Opponent spent over one million euro for this marketing initiative.[23]

[22] MD3 page 2.
[23] MD3, pages 3 – 13.

Form of the mark

35. Before I move on to assess if the Opponent has shown genuine use, I must first consider if I find the use of the first earlier mark as shown in the evidence to be use of the mark as registered. As outlined *in Lactalis McLelland Limited v Arla Foods AMBA*, Case BL O/265/22,[1] the use of the mark in a different form may also constitute use of the mark as registered.

36. The first earlier mark consists of the all-capitalised conjoined words "BUDDYBANK" in standard typeface. The evidence features the mark "buddy" in lower case (see, for example, Figure 1) and, in some instances, with the initial "b" slightly stylised (see Figure 2 and Figure 3).

37. The mark "BUDDYBANK" is registered mostly for hardware and software for monetary and finance purposes in class 9 (e.g., automatic bank machines; computer software for financial services, banking services, business management and consultancy) and banking/finance services in class 36. Therefore, I find the mark's term "BANK" to be lowly distinctive and "BUDDY" to be the main distinctive element in the mark. Whether a word mark is depicted in lower- or upper-case letters does not affect the mar's overall impression.[24] Therefore, the use of "BUDDY", also in lower case, consists of genuine use of the mark being this its main distinctive element. Although the mark is used with some stylisation (i.e., the stylised "b") that does not affect the mark's distinctiveness. Thus, I consider the mark's variant uses to be acceptable variant uses in accordance with the guidance in *Lactalis*.

38. For the sake of completeness, I note that in many Italian articles provided, the title features the word "buddy R-Evolution". Although the distinctiveness of the registered mark is in "BUDDY", I find that the addition of the distinctive element "R-Evolution" alters the distinctive character of the registered trade mark. Therefore, the word combination "buddy R-Evolution" is not an acceptable variant use of the first earlier mark.

[24] Case T-254/06, *RadioCom*, at [43].

Assessment of evidence of use

39. I will now consider the global assessment of genuine use. The assessment is made by looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[25] As indicated in the case law cited above, use does not need to be quantitively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".[26]

40. The case law summarised in the passage from *easygroup* and *Awareness Limited* quoted above makes it clear that real commercial exploitation of the trade mark must be shown and that the onus is on the Opponent to provide sufficiently solid evidence to show that the mark has been genuinely used within the five-year period set out in paragraph [23] above.

41. In my account of the evidence in this decision, I have identified significant shortcomings. Most of the evidence is in Italian and appears to be directed solely at the Italian market. While I acknowledge that the Opponent invested considerably in promoting the "BUDDY" mark, the evidence indicates that these marketing efforts occurred outside the relevant period, specifically, during the summer of 2024, and were focused exclusively on Italy. Although Mr Luison asserts that British tourists also visit the Italian locations where the Vertical Summer Tour takes place, no supporting evidence has been provided to substantiate this claim. In any case, even if I were to take into account this evidence and accept that all the submitted evidence pertains to the UK market, it would still fall short of demonstrating genuine use of the first earlier mark for the relevant goods and/or services. This because the evidence consists of some online articles covering the launch of the "BUDDY" application in Italy in 2023, limited marketing activity involving the display of the mark in select summer holiday destinations in 2024, and associated marketing expenditure. The Opponent has not provided any data on UK-specific revenue, sales volumes, market share, service distribution, app

[25] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.
[26] *easyGroup* at [106].

download figures, advertising materials, or evidence of the impact of its promotional efforts within the UK market.

42. As confirmed recently by Iain Purvis KC,[27] it is not the role of the Tribunal to fill in obvious gaps in the evidence and, in my view, that is what would be required to make a finding of genuine use in relation to any particular goods and/or services. The evidence that has been provided is inconclusive and requires too much inference and speculation. While it is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof, in my view, even considering that there is no *de minimis* rule, the above examples of use provided, along with the statements by the different witnesses, fall short of representing efforts to create and maintain a share of the UK market for the goods and/or services relied upon.

Outcome

43. The Opponent must establish that it has made genuine use of its mark number UK00915225972 during the five-year relevant period to be able to rely upon it for the purposes of these proceedings. Therefore, the opposition is unsuccessful insofar as it concerns the first earlier mark number UK00915225972. The opposition continues for the remaining second earlier mark number UK00918286209 and for which evidence of use is not needed.

DECISION

Section 5(2)(b)

44. Sections 5(2)(b) and 5A of the Act state:

> "5(2) A trade mark shall not be registered if because –
>
> […]

[27] Sitting as the Appointed Person in BL O/0725/25. See [37]. I note this decision was published after the commencing of these proceedings; however, the message is the same as that communicated in *Awareness Limited v Plymouth City Council*, cited earlier in my decision.

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Relevant Law

45. The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

<u>The principles</u>

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

46. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

47. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

48. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme*

v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

49. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

> "[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

50. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

> "[…] the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded."

51. I have already outlined at paragraph [3] the goods and services upon which the Opponent relies for these proceedings. The Applicant's contested goods are "*Finance App*" in class 9.

Class 9

- "*Finance App*"

52. The Opponent submits that the Applicant's "*Finance app*" is identical to, for example, "*Computer software for financial services, banking services, business management and consultancy*" in class 9 as well as similar to other of the Opponent's services relating to finance and financial services.[28] The Applicant did not provide specific submissions on the goods' similarity (or dissimilarity) apart from those mentioned below.

53. Computer software refers to a set of instructions, data, or programs used to operate computers and perform specific tasks. An application is a software program (i.e., a type of computer software) designed to perform specific tasks or functions for the end user. Accordingly, I find that the Opponent's goods encompass the Applicant's contested goods and, thus, they are identical in line with *Meric*. I the eventuality I am mistaken, I find that the respective terms share the same nature (i.e., software designed to perform tasks by executing instructions on a computing device), method of use (both goods are designed to be executed by machines, typically computers or other digital devices such as smartphones) and share the same intended purpose (provide financial services). The goods at hand also share the same users as consumers can choose from different providers (and different software) to obtain banking or finance services. Accordingly, the goods are in competition with each other.

54. Turning to the respective goods' channels of trade, the Applicant seems to contend that the contested goods have a broader scope of financial assistance, whereas the Opponent's goods mostly relate to banking services.[29] The Opponent addresses the Applicant's argument contending that it is incorrect to assert that there is some difference between "financial services" and "banking services".[30] To this end, the Opponent provides evidence showing that banks such as Barclays, Lloyds and NatWest, also provide a wide range of financial services.[31] The Opponent also argues that many services of financial nature operate by means of an app or, in some instances, the provision of an app by a financial services provider is integral to access those services.[32]

[28] Opponent's statement of grounds dated 31 May 2024 at [12] and [13].
[29] Applicant's counterstatement dated 24 July 2024 at point 1.
[30] Peter William Cornford's witness statement dated 1 October 2024 at [4].
[31] PCW2.
[32] Submissions in lieu dated 12 March 2025 at [12].

55. I find that the respective goods to compare are the Applicant's "*Finance App*" and the Opponent's "*Computer software for financial services, banking services, […]*". I have considered both parties' submissions and I agree with the Opponent that the respective goods overlap in their market sectors (i.e., finance/financial market sectors). Therefore, the respective goods share the same trade channels as both products are delivered through banking institutions and financial service providers. Application software is a subset of computer software (designed to help users perform specific tasks) and depends on it to operate. Therefore, I find the respective goods are complementary in so far as the Opponent's computer software would be indispensable (or important) for the functioning of the Applicant's software (or application software) in such a way that customers may think that the responsibility for those goods lies with the same undertaking. Overall, I find the goods to be similar to a very high degree.

The average consumer and the purchasing act

56. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

57. The Opponent contends that although the goods at hand will sometimes be provided to professionals, most consumers who use banking and financial services are part of the general public. It is also submitted that the goods' price ranges from essentially free to "visible commission based transactions" and, thus, the attention

paid by the average consumer will not be high.[33] The Applicant did not provide submissions on this point.

58. I acknowledge the Opponent's arguments. The average consumer for the goods for which I found identity or similarity in class 9, i.e., computer software application/program for financial and banking services, is the general public, for example, users downloading a software or software application onto their devices to access financial/banking services. However, the relevant consumers may also be businesses (e.g., banks) wanting specialist software for their business operations (e.g., banks or financial institutions that use specialised software to offer their financial services).

59. The cost and frequency of purchase for the goods will vary depending on the type and speciality of software and it is likely to range from relatively low for mobile applications to relatively high for more technical software. Several factors may influence the average consumer when purchasing the goods, such as suitability, technical function, and the compatibility of the software with existing systems. Based on these factors, I find that the average consumer for the software goods will pay at least a medium degree of attention with a higher degree of attention for the professional public. Following from the above, I will assess the likelihood of confusion from the perspective of the general public since they are the group who will pay the lower degree of attention.[34]

60. The goods are likely to be obtained by self-selection from websites, e-commerce platforms, or app stores. The goods may also be purchased following advertisements on social media or other specialised online platforms. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase of the goods through advice sought from a sales assistant or representative, and word-of-mouth recommendations.

Comparison of trade marks

[33] Opponent's submissions in lieu dated 12 March 2025 at [14].
[34] Case T-356/14, [25] – [26].

61. It is clear form *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, that:

> "[…] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

62. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

63. The marks to be compared are as follows:

The Opponent's earlier mark	**The Applicant's Contested Mark**
("*the second earlier mark"*) 	**FinanceBuddy**

Overall Impression

64. The Opponent contends that "*due to the non-distinctive character of the word FINANCE, the word BUDDY is the only distinctive element of the Applicant's Sign and plays the dominant role in the overall impression of the mark*".[35] The Opponent also argues that whilst the "b" device and the name "UniCredit" are both distinctive components, the word "BUDDY" is the dominant distinctive component in the mark whereas the word "BANK", although it should not be disregarded, plays a subservient role to "BUDDY".[36] The Applicant submits that "*[…] the combination of words in each trade mark creates a distinct overall impression. The word "Finance" in "Finance Buddy" serves not merely as a descriptive term but as an integral part of the brand identity. Similarly, the word "Bank" in "Buddy Bank" carries its own distinctive weight*".[37]

65. The second earlier mark is presented in greyscale and combines both verbal elements and a logo. Set against a square black background, the design features the words "b", "buddy", and "bank" arranged vertically in white. At the top, the letter "b" appears in a modern, stylised form with a layered, three-dimensional effect. The foreground "b" is bold and white, while a second, slightly tilted and offset "b" sits behind it, creating a sense of depth and shadow. This overlapping design gives the impression that the rear "b" is either emerging from or partially concealed behind the primary letter. Beneath the stylised "b", the words "buddy bank" are displayed in bold, rounded lowercase letters, stacked one above the other. Below this, the phrase "Powered by UniCredit" appears in two lines of smaller text: "Powered by" in very small font, and "UniCredit" in a slightly larger, bold typeface. To the left of "UniCredit" is a circular logo featuring a diagonal slash, matching the size of the word. Given the prominent size and central placement of the "buddy bank" wording, this verbal element stands out as the most dominant feature of the mark. However, the stylised "b" also carries some weight in the mark's overall impression due to its size and stylisation and it is unlikely to be overlooked by consumers.

66. In the second earlier mark I find "BUDDY" to be the most distinctive among the dominant elements. The relevant consumers will understand term "BANK" with its

[35] Opponent's statement of grounds dated 31 May 2024 at [7].
[36] Opponent's submissions in lieu dated 12 March 2025 at [16].
[37] Applicant's counterstatement dated 24 July 2024 at [1].

ordinary dictionary meaning and will merely see it as descriptive or strongly allusive of the nature/type of the goods or of the service provider (i.e., banks) and attribute to it little trade mark significance.

67. The Contested Mark is a word only mark consisting of the word combination "FinanceBuddy". Neither "Finance" nor "Buddy" dominate over the other and, thus, they both equally contribute to the mark's overall impression. Although I appreciate the Applicant's argument outlined above, I find "Buddy" to be the main distinctive element in the Contested Mark. This because the relevant consumers will perceive "Finance" as descriptive of the nature/type of the goods at hand (finance software applications).

Visual similarity

68. The Applicant submits that the respective marks present different structures and arrangements and that whilst "Buddy" is common in both marks, the words "Finance" and "Bank" do not create a visual similarity.[38] The Opponent contends that whilst there are several additional visual elements to the second earlier mark, the respective marks are visually similar in that they both are of average length in terms of letters, half of the Contested Mark is identical to half of the Opponent's mark and the overlapping half carries greater weight in both marks as it is the most distinctive element for both of them.[39]

69. I acknowledge the parties' submissions. I already provided a detailed visual description of the respective marks at [65] – [67]. In particular I found that although the second earlier mark contains the words "Powered by UniCredit" paired with a circular device containing a diagonal slash (or an inverted "tick" symbol), these are placed at the bottom of the mark and they are considerably smaller than the other verbal elements in the mark (i.e., "b" and "buddy bank"). Thus, it follows that consumers will likely pay little or no attention to such words. Therefore, consumers, when confronted with the second earlier mark, will focus their attention to the predominant elements "b" and "buddy bank".

[38] Applicant's counterstatement dated 24 July 2024 at [2].
[39] Opponent's submissions in lieu dated 12 March 2025 at [18].

70. The Contested Mark consists of the word combination "FinanceBuddy" in standard typeface and with each word composing the mark (i.e., "Finance" and "Buddy") capitalised.

71. The respective marks overlap in the word "buddy" respectively placed in a central and dominant position in the second earlier mark and at the end of the Contested Mark after "Finance".

72. I note that consumers read from left to right (and from top to bottom) and are likely to pay more attention to the beginnings of marks,[40] they will likely notice the difference between the initial word "Finance" in the Contested Mark and "Buddy" in the second earlier mark. To this regard, I must remind myself that the principle laid down in *El Corte Inglés* (and other case law) is not a hard and fast rule of law. Rather, it is a practical rule of thumb, based on experience and observation. It amounts to no more than "All else being equal, the average consumer will tend to pay more attention to the beginnings of marks than other parts of marks, because consumers read from left to right".[41] Accordingly, in the case at hand, I found that "Buddy" in both marks is the main distinctive element and that the relevant consumer, when confronted with both marks is likely to pay more attention to the word "Buddy" rather than the less distinctive words "Finance" and "bank" in both marks. It is my view that this finding militates, at least to some extent, against the *El Corté Ingles* principle.[42]

73. Overall, bearing in mind the above considerations and the second earlier mark's stylisation, I find the marks have a below-medium degree of visual similarity.

Aural similarity

74. The Opponent contends that the respective marks are phonetically highly similar,[43] and that, more specifically, "*in spoken use, half of the Earlier Mark resides in the Contested Mark*".[44] The Applicant submits that "*phonetically, the rhythm and cadence differ due to the different words used in conjunction with "Buddy". While*

[40] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.
[41] See decision from the Appointed Person (AP) in BL O/0976/23 at [22].
[42] For a similar conclusion on this point, see the decision from the AP in BL O/0648/24 at [22].
[43] Opponent's statement of grounds dated 31 May 2024 at [10].
[44] Opponent's submissions in lieu dated 12 March 2025 at [18.d]

"Buddy" is common in both, the words "Finance" and "Bank" do not create a phonetic […] similarity that could lead to consumer confusion".[45]

75. In the second earlier mark, the consumers will read the letter "b", although its stylisation, as the English alphabetic letter and read it accordingly (i.e., "bhe"). Consumers will voice the word combination "buddy bank" according to their ordinary English dictionary meaning (i.e., "buh-dee bangk"). The mark also contains the words "Powered by" and "UniCredit". Given the size and position of these latter verbal elements, I find that the relevant consumers are unlikely to read them in the mark. The consumers will not attempt to voice the small circular device placed next to these words.

76. Turning to the Contested Mark, this consists of the word combination "FinanceBuddy". I acknowledge the parties' submissions and albeit I appreciate that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details,[46] they will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for them, suggest a concrete meaning or which resemble words known to them.[47] This may also be the case when a mark contains elements that would encourage such a split, such as irregular capitals. Given the capitalisation of the words "Finance" and "Buddy" and that such words are common English terms, I find that consumers will recognise these two words within the Contested Mark and voice them in line with the common English pronunciation for "Finance" and "Buddy". Differently from the Applicant's submission, I find that the presence of "Finance" in front of "Buddy" does not affect the way consumers will pronounce this latter word.

77. Although the second earlier mark contains more verbal elements than in the Contested Mark (i.e., the letter "b", "Powered by" and "UniCredit") I found the consumers are more likely to pay attention to (and read) mostly (if not exclusively) the letter "b" and the words "buddy bank" with the marks' respective words "buddy" being pronounced identically in both marks. Therefore, I find the marks share a medium degree of aural similarity.

[45] Applicant's counterstatement dated 24 July 2024 at [2].
[46] *Lloyd Schuhfabrik Meyer*, paragraph 25.
[47] Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II 3445*, paragraph 51; Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II 0000, paragraph 57.

Conceptual similarity

78. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

79. The Opponent argues that the respective marks are conceptually highly similar in that the marks share the identical dominant element "BUDDY" which the relevant consumer will likely understand as indicating that "*the goods and services are intended to be of assistance to its user, as a 'buddy' or 'friend' would be*". The Opponent also contends that "*the terms 'BANK' and 'FINANCE' are conceptually highly similar since both imply financial association in the average consumer's mind*". The Opponent did not provide submissions regarding the meaning of the words "Powered by UniCredit". To this regard, I found that the relevant consumers are unlikely to read these words in the mark given their size and position. Therefore, I also find that these verbal elements have a very small impact on the second earlier mark's conceptual meaning. The second earlier mark also contains the letter "b" which it does not convey any meaning apart from that of a letter of the alphabet.

80. The Applicant contends that (original emphasis) "*The terms "Buddybank" and "Finance Buddy" are* ***conceptually different****: "Buddybank" is a* ***single coined term****, clearly referring to a banking service. "Finance Buddy" is a* ***generic phrase****, which could relate to a range of financial services,* ***not just banking***".[48] The Applicant also submits that "*"Finance Buddy" suggests a companion or helper in various financial activities beyond banking, whereas "Buddy Bank" directly references a banking institution*".[49]

81. I have considered the parties' arguments and find that consumers are likely to understand "buddy" in both marks with the same meaning. From their submissions, the parties also seem to agree that "buddy" will be understood as indicating similar meanings (i.e., "companion", "helper" or "friend") and that the respective marks, as

[48] Applicant's written submissions dated 5 February 2025 at [5].
[49] Applicant's counterstatement dated 24 July 2024 at [3].

a whole, allude to the fact that the goods support the users in carrying out financial activities. Therefore, although “buddy” appears in different positions, before “bank” in the second earlier mark and after “Finance” in the Contested Mark, both marks share a clear semantic link. Consumers will perceive “buddy bank” and “FinanceBuddy” as conceptually related. I therefore agree with the Opponent that the marks convey an equivalent meaning through “buddy” and “Finance”/“bank” evoking a connection to financial services, including banking. According to the visual and aural considerations above, the additional letter “b” and the phrase “Powered by UniCredit” do not detract from this conceptual similarity. Overall, I conclude that the marks exhibit an above-medium degree of conceptual similarity.

Distinctive character of the earlier mark

82. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee,* paragraph 51).”

83. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

84. I deal first with the second earlier marks' inherent distinctiveness.

85. As already outlined at paragraph [65] above, the mark features a square black background, with the stylised letter "b" and the words "buddy bank" arranged vertically in white. The mark also contains the phrase "Powered by UniCredit" arranged on two lines with a circular device containing a diagonal slash placed on its left-hand side. As already outlined above in this decision, the letter "b" and the word combination "buddy bank" are the dominant elements in the mark with "buddy bank" being the main distinctive element in the mark. According to my findings at paragraphs [79] and [81], although "buddy bank" does not have a clear semantic correlation to the registered goods, the earlier mark alludes to the fact that the goods for which it is registered support the users in carrying out financial activities (including banking activities). Overall, the second earlier mark has a medium degree of inherent distinctive character.

86. I turn now to consider the position in respect of the Opponent's evidence, to see whether the use the Opponent has made of its earlier mark has enhanced its distinctive character. The Opponent did not file evidence directly concerning the use of the second earlier mark, however, the evidence provided features the words "buddy", the most distinctive element in the second earlier mark, and the stylised letter "b". Therefore, the evidence is relevant for the assessment of the second earlier mark's enhanced distinctiveness (or lack thereof). As discussed at paragraph [41], I found that the Opponent provided limited evidence exclusively targeting the Italian market and in part being dated outside of the relevant period. Likewise, I do not believe that the evidence provided sufficiently shows that the second earlier mark has been used to an extent to justify a finding of enhanced distinctiveness.

Likelihood of confusion

87. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

88. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

89. I found the respective goods to be identical or similar to a very high degree. The level of attention paid the relevant consumer (general public) is medium. The distinctiveness of the second earlier mark is medium. The marks' visual similarity is below medium, the aural similarity is medium, and the conceptual similarity is above medium. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind. The respective marks overlap in the word "buddy" and differ in the words "finance" and "bank" placed, respectively, at the front of the Contested Mark and at the end of the second earlier mark. The earlier mark also contains the stylised letter "b" at the top and clearly visible in the mark. The earlier mark features the phrase "Powered by UniCredit" and a figurative device next to it, although represented in smaller font than the other verbal elements in the mark and placed at the bottom of it. Having considered the arrangement of the words "buddy" an "Finance"/"bank" in both marks as well as taking into consideration the earlier mark's additional elements (both verbal and figurative/stylistic), I find that the marks are unlikely to be mistakenly recalled or misremembered as each other and I do not consider there to be a likelihood of direct confusion.

90. It now falls to me to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

91. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[50] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is

[50] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[51] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[52]

92. Both marks feature the word "buddy", which conveys a friendly, approachable tone. Consumers could perceive this reference in both marks to indicate that both parties offer financial services that are simple to use and approachable. The terms "bank" and "finance" are closely related, both referring to financial activities. Consumers in the finance/banking software market will naturally associate these words with similar functions such as money management, transactions, and financial solutions, reinforcing the impression of a shared commercial origin. This semantic similarity encourages consumers to link both marks with comparable brand values, such as personalised service and accessibility, increasing the likelihood of conceptual overlap.

93. Given the shared use of "buddy" and the related financial terminology, consumers are likely to believe the marks belong to the same brand family or are otherwise commercially connected.

94. The additional letter "b" and the phrase "Powered by UniCredit" act as secondary identifiers and have a reduced impact on the primary brand impression created by "buddy" and its financial reference. Consumers tend to focus on the dominant, distinctive component (i.e., "buddy") which drives brand recall. The conceptual core remains intact because these supporting elements do not alter the friendly, financial connotation.

95. It follows that a significant proportion of the relevant consumers will likely see the Contested Mark as a sub-brand or brand extension deriving from the second earlier mark and will likely believe that both marks originate from the same or economically linked undertakings. As a result, I find that there is a likelihood of indirect confusion.

CONCLUSION

[51] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.
[52] *Liverpool Gin Distillery*.

96. The opposition under section 5(2)(b) has been successful and the application, subject to any appeal, will be refused for all goods.

COSTS

97. The Opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 1/2023. Bearing that scale in mind, I award costs to the Opponent as follows:

Official fee[53]	£100
Preparing the notice of opposition and considering the counterstatement	£250
Preparing evidence	£600
Preparing submissions-in-lieu	£350
Total	**£1,300**

98. I order Finance Buddy Ltd to pay UNICREDIT S.P.A. the sum of **£1,300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of November 2025

Andrea Rossi

For the Registrar

[53] As noted at footnote 1, the original opposition was based on sections 5(2)(b) and 5(4)(a). However, following subsequent amendment of the form TM7 by the Opponent, the section 5(4)(a) was removed. As a result, the opposition proceeded on the basis of section 5(2)(b) alone. Therefore, I have reduced the official fee from £200 to £100.