O/0781/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4007426
IN THE NAME OF THE SCOTCH HOUSE ALBA LIMITED
TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS:

AND

IN CLASSES 9, 35 AND 36
AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000447909
BY LUFTHANSA AIRPLUS SERVICEKARTEN GMBH

Background and pleadings

1. THE SCOTCH HOUSE ALBA LIMITED ("the applicant") applied to register the series of two trade marks shown on the front cover of this decision in the UK on 26 January 2024, under number 4007426. As the two marks only differ as to their colour, I shall focus my assessment on the first grey mark in the series only and refer to it as "the applicant's mark", unless it becomes necessary for me to differentiate between them. The applicant's mark was accepted and published in the Trade Marks Journal on 8 March 2024 in respect of the following goods and services:

> <u>Class 9:</u> *Consumer credit cards; magnetic consumer cards; encoded consumer cards; consumer chip cards; consumer smart cards; magnetic data carriers; card readers for credit cards; credit card terminals; applications for consumer banking, consumer payments and consumer credit services. computer programs and software for consumer banking, consumer payments and consumer credit services. consumer credit bureau software; consumer credit consultancy software; consumer database management software; databases, data sets and software relating to consumer account management (including consumer credit accounts); databases, data sets and software relating to consumer bank accounts; databases, data sets and software relating to consumer bank account sort codes; databases, data sets and software relating to consumer billing; databases, data sets and software relating to individual biometric data; databases, data sets and software relating to individual candidate verification; databases, data sets and software relating to consumer credit application processing; databases, data sets and software relating to consumer credit assessment and consumer credit screening; databases, data sets and software relating to consumer credit scorecards; databases, data sets and software relating to consumer credit strategy management; databases, data sets and software relating to consumer customer profiling; databases, data sets and software relating to consumer financial information; databases, data sets and software relating to individual identity documents; databases, data sets and software relating to individual identity verification and authentication; databases, data sets and software relating to names of individuals; databases, data sets and software relating to public record information about individuals.*

None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

<u>Class 35:</u> Consumer credit card registration services, provision of consumer credit card rewards based programs; preparation of monthly statements of account for consumer services; provision of monthly statements for consumer services. None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

<u>Class 36:</u> Consumer banking; consumer e-wallet payment services; consumer financial management; consumer financing services; instalment loans for consumers; issuance of consumer credit cards; issuance of consumer credit; issuance of prepaid gift cards to consumers; consumer loans [financing]; mobile consumer banking services; online consumer banking; online consumer banking services rendered in virtual environments; processing of consumer credit card payments; processing of consumer debit card payments; providing consumer financial information; providing consumer financial information via a website; savings bank services; issuance of credit cards, credit lines and loans to consumers; management of consumer credit card accounts, credit accounts and loans for consumers; Consumer credit history services; consumer credit account management services; consumer credit agency services; consumer credit assessment services; consumer credit bureau services; consumer credit consultancy services; consumer credit evaluation services; consumer credit information services; consumer credit rating services; consumer credit risk assessment services; consumer credit risk information services; consumer credit scoring and credit scorecard services; consumer credit screening services; consumer credit strategy management services; consumer debt collection services; consumer financial database services; fraudulent consumer credit application detection services; preparation of consumer credit reports; consumer credit application processing services; consumer financial services; consumer monetary affairs; consumer banking credit care services; consumer credit services; consumer credit card services; consumer debit card services; magnetic card services for consumers; chip card services for consumers; smart card services for consumers; electronic funds

transfer services for consumer services; issuance of credit, debit and magnetic cards to consumers; consumer credit card payment processing; consumer lending services; advisory, consultancy and information services related to all of the aforesaid. None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

2. On 10 June 2024, Lufthansa AirPlus Servicekarten GmbH ("the opponent") opposed the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at all the goods and services in the application. The opponent relies upon the following trade marks and the following goods and services for which they are registered:

(i) AirPlus International

UK registration no. 902335693

Filing date: 9 August 2001

Registration date: 26 September 2002

Goods and services for which the mark is registered (all of which are relied upon for opposition purposes):

<u>*Class 9*</u>*: Computer programs recorded on data carriers, in particular for invoice and payment processing and for travel planning and travel costs processing.*

<u>*Class 35*</u>*: Professional business and organisational consultancy; business advice; business marketing services, in particular the conducting of advertising initiatives, for others, mail advertising, including mailing and compiling of mailing lists; processing of organisational procedures for others, in the fields of business and marketing; conducting and setting up billing systems for others, in particular billing systems for travel.*

<u>*Class 36*</u>*: Financial services, including credit card company services, in particular the issuing of credit and service cards; concluding monetary transactions with credit cards; financial consultancy; processing of organisational procedures for others in the field of finance; invoicing and payments processing, in particular*

card billing for the services of others, including the gathering and evaluation of data on such.

<u>*Class 42*</u>*: Data/message processing for others.*

("the '693 mark")

(ii)

AirPlus
INTERNATIONAL

UK registration no. 902335057

Filing date: 9 August 2001

Registration date: 24 August 2007

Goods and services for which the mark is registered (all of which are relied upon for opposition purposes):

<u>*Class 9*</u>*: Computer programs recorded on data carriers, in particular for invoice and payment processing and for travel planning and travel costs processing.*

<u>*Class 35*</u>*: Professional business and organisational consultancy; professional business consultancy; marketing, in particular the conducting of advertising initiatives, for others, mail advertising, including mailing and compiling of mailing lists; processing of organisationsal procedures for others, in the fields of business and marketing; conducting and setting up billing systems for others, in particular billing systems for travelling expenses.*

<u>*Class 36*</u>*: Financial services, including credit card company services, in particular the issuing of credit and service cards; concluding monetary transactions with credit cards; financial consultancy; processing of organisational procedures for others in the field of finance; invoicing and payments processing, in particular card*

billing for the services of others, including the gathering and evaluation of data on such services.

<u>Class 42</u>: Data/message processing for others.

("the '057 mark")

(iii) AirPlus Connect

UK registration no. 917475864

Filing date: 14 November 2017

Registration date: 15 March 2018

Goods and services which the opponent relies upon for opposition purposes[1]):

<u>Class 9</u>: Data processing apparatus and computers; Computer software and hardware; Computer programs recorded on data carriers, in particular for invoice and payment processing and for travel planning and travel costs processing; Software products for e-commerce, home banking, card billing systems and the Internet; Online computer systems comprising data processing equipment and computers; Database software; Card readers and apparatus for recording, transmission or reproduction of sound, images and computer data; Mobile apps; Encoded cards for use in point of sale transactions; Electronic and magnetic ID cards for use in connection with payment for services; Software; Software and applications for mobile devices; Software for tablet computers; Software for facilitating secure credit card transactions; Software related to handheld digital electronic devices; Magnetic payment cards.

<u>Class 35</u>: Billing for others; Professional business and organisational consultancy; Professional business project management in the fields of claims management, warnings

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[1] The '864 mark is also registered for a range of services in class 38, but the opponent's letter dated 2 July 2024 clarified that it only wished to rely upon the goods and services in classes 9, 35, and 36.

and general book-keeping and account management; Business management, business administration and office functions; Electronic commerce provider services on the Internet, namely order placement, delivery and invoice management within the framework of e-commerce, and arranging of contracts for others for the purchase and sale of goods; Arranging and concluding commercial transactions, for others, via electronic ordering platforms; Professional business project management for the development of bonus, service and credit card programmes; Presentation of goods and services, bonus, service and credit card programmes as part of advertising and marketing measures and events; Organisational and professional business monitoring of bonus, service and credit card programmes; Invoice management, in particular cashless and cash-based billing, including collating and statistical evaluation of data on the aforesaid invoice management; Compilation, updating, maintenance, organisation and systemisation of information into computer databases; Providing of information on the Internet in the field of business management; Invoicing and drafting of invoices for others, including via the internet, accounting; Services relating to book-keepting and business administration for monitoring and conducting claims management; Including all the aforesaid services provided online and via the Internet, via databases; Preparation of accounts.

<u>Class 36</u>*: Finance services, Including financial services of credit card companies; Issuing of credit, service and bonus cards with payment functions; Financial services for running credit, service and bonus card programmes; Financial consultancy relating to the running and management of credit, service and bonus card programmes; Debt recovery in the framework of claims*

management; Providing of information via the Internet in the field of financial services; Financial services for conducting payment and billing transactions and for financial brokerage; Including all the aforesaid services provided online and/or via the Internet, via databases; Rental of automatic cash dispensers, bank statement printers and money counting apparatus, in particular for use with credit, service and bonus cards, included in class 36; Payment processing; Electronic payment services; Contactless payment services; Electronic processing of payments; Financial payment services; Financial transfers and transactions, and payment services; Money ordering services; Electronic wallet services (payment services), Financial sales transaction management; Rental of card payment apparatus, in particular for use with credit, service and bonus cards.

("the '864 mark")

(iv)

AirPlus

UK registration no. 1287497

Filing date: 8 October 1986

Registration date: 10 August 1990

Goods and services for which the mark is registered (all of which are relied upon for opposition purposes):

Class 16: Credit cards, cheques, bankers cards, printed matter relating to the issuance, promotion, and advertising of credit cards and bankers cards, all included in Cl ass 16.

Class 36: Banking services; credit brokerage and credit card services; financing services for the security of funds for others; all included in Class 36.

("the '497 mark")

3. As the filing dates of the opponent's marks are earlier than the filing date of the applicant's mark, the opponent's marks constitute earlier marks in accordance with section 6 of the Act. The earlier marks had been registered for more than five years at the filing date of the applicant's mark and are, therefore, subject to the use requirements in section 6A of the Act. The Opponent has made a statement of use, and the applicant has put the opponent to proof of use for all the goods and services relied upon in these proceedings.

4. In its statement of grounds, the opponent argues that the competing marks are highly similar, and that the parties' goods and services are identical or similar. On this basis, the opponent submits that there is a likelihood of confusion.

5. The applicant filed a counterstatement denying the ground of opposition.

6. The opponent is professionally represented by KUNZE Rechtsanwälte & Solicitor (England & Wales) PartG mbB, whereas the applicant is not professionally represented. During the evidence rounds, both parties filed submissions and evidence, and the opponent filed further submissions in response to the applicant's evidence. No hearing was requested, but both parties filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

Evidence

7. The opponent's evidence consists of a witness statement provided by Sahra Ewings (dated 11 April 2025). She states that she is the Director of Marketing of the opponent in these proceedings. She has filed Exhibits 1 to 21.5 to show use of the opponent's mark. Exhibit 5a also contains a witness statement provided by Robert Kunze. He states that he is the founding partner of Kunze Rechtsanwaite – Solicitor (England & Wales) PartG mbB. He provides an English translation of Exhibit 5a.

8. The applicant's evidence consists of a witness statement provided by Sion O'Connor (dated 14 July 2025). He states that he is an experienced Brand, Marketing and Product Director, and has previously represented the applicant in these proceedings in meetings with the Financial Conduct Authority. He has filed Exhibits SOC 001 to 009.

9. I have taken all the evidence into account in reaching my decision and will refer to it below where necessary.

Preliminary issue

10. In its submissions filed within the evidence rounds, the applicant contends that "the Opponent does not hold the required regulatory permissions to offer consumer credit cards, neither in Germany… nor the UK". In support of this, he has filed several exhibits (Exhibit SOC1, SOC2, SOC4-7). In its submissions filed within the evidence rounds, the applicant also alleges that the opponent's marks have been filed in bad faith on account of "a pattern of overbroad and implausible specifications covering hundreds or even thousands of goods and services".

11. I must clarify that it is not a matter for the Tribunal as to whether the opponent has complied with any regulatory requirements, and it is not material to the question of genuine use. Furthermore, whether or not the earlier marks were filed in bad faith is not relevant to the opposition as the applicant has not filed any invalidity proceedings against the earlier marks. Whilst I recognise that, in its submissions in lieu, the applicant has explained that it has made these submissions for contextual reasons as it believes the opponent "claims rights far beyond its actual commercial activities", my assessment is based only on what the evidence of use demonstrates and how this relates to the marks' specifications.

Relevance of EU law

12. 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[2] 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.

Decision

13. Section 6A of the Act reads as follows:

[2] As amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023

"(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."

14. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

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

…

(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(3) and (4) to the United Kingdom include the European Union."

15. Pursuant to the above provisions, the relevant period for assessing whether there has been genuine use of the opponent's marks is the five-year period ending with the filing date of the applicant's mark, i.e. 27 January 2019 to 26 January 2024. Within this period, the relevant territory is the EU for the period up to 31 December 2020 and the UK thereafter.

16. In *easyGroup Ltd v Nuclei Ltd & Ors*,[3] 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*

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[3] [2023] EWCA Civ 1247

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 V*erein 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 sub-category of goods or services, the principles may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37];

Verein at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

17. Moreover, section 100 of the Act states that:

> “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.”

<u>Introduction</u>

18. On page 1 of her witness statement, Ms Ewings states that AirPlus International GmbH was founded in 1989, and is “one of the leading international providers of corporate payment solutions”. She says that that this includes “services such as corporate credit cards and virtual payment solutions to assist companies to manage their business expenses efficiently”.

<u>Forms of the mark</u>

19. In Exhibit 9 (dated 2023), the opponent has used a very lightly stylised form of the words “AirPlus” along with the tagline “Smarter payment, Better business” (as shown below). I shall refer to it as “the white and blue variant”:

AirPlus
Smarter payment. Better business.

The ‘693 mark

20. In *LA Superquimica v European Union Intellectual Property Office (EUIPO),*[4] the General Court (“GC”) held at [39] that word-only marks protect the word or words contained in the mark in whatever case, colour or typeface. As the opponent’s ‘mark is a word-only mark, it is protected in any form. I find that the use of the mark in dark blue in a reasonably basic typeface would be covered by notional and fair use of the mark. However, the ‘693 mark as registered has the word “International” and does not feature the tagline. In *Hyphen GmbH v EU IPO,*[5] the GC held the following:

[4] Case T-24/17
[5] Case T-146/15

“28. ..a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, ATLAS TRANSPORT, T 482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, Maestro de Oliva, T 4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA), T 381/12, not published, EU:T:2014:119, paragraph 30).

29. For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, Klement v OHIM — Bullerjan (Form of an oven), T 317/14, not published, EU:T:2015:689, paragraph 33).

30. It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA), T 46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31. It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, Fruit of the Loom v OHIM — Blueshore Management (FRUIT), T 514/10, not published, EU:T:2012:316, paragraph 38).

> 32. It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009."

21. As paragraph 31 demonstrates, any additions or omissions to a registered mark must not alter the distinctive character of the mark in the form in which it was registered. It is my view that the word "International" denotes that the goods and services are offered internationally, and is therefore non-distinctive. I am fortified in this finding by the applicant's submissions filed during the evidence rounds, in which the applicant states that the opponent's marks consist of the word 'Air' along "with "Plus" and/or additional descriptors". It is therefore my view that the applicant accepts that "Plus", "International", and "Connect" are "additional descriptors", and therefore as "descriptors" they are descriptive and non-distinctive in nature.

22. The tagline is non-distinctive, as it is my view that consumers will view it as alluding to the financial goods and services on offer. I therefore find that the omission of the word "International" and the addition of the tagline do not alter the distinctive character of the marks. On this basis, I find that the use of the white and blue variant is an acceptable variant of the opponent's '693 mark.

The '057 mark

23. The '057 mark consists of the word "AirPlus" written in white on blue rectangular shapes, along with the word "International" written underneath. As stated in relation to the '693 mark, I find the omission of the word "International" and the addition of the tagline to be acceptable as they do not alter the '057 mark's distinctive character. Whilst the text has a minor degree of further stylisation in the white and blue variant, and background colours are reversed in the white and blue variant, I find that this also does not affect the mark's distinctive character, and therefore I find the white and blue variant to be an acceptable form of the '057 mark.

The ‘864 mark

24. The ‘864 mark is a word-only mark comprising the words “AirPlus Connect”. For the same reasons given above in relation to the ‘693 mark, I find this to be an acceptable variant of the ‘864 mark.

The ‘497 mark

25. Whilst the text has a minor degree of further stylisation in the white and blue variant (as well as the use of the blue colour), I find that this does not alter the distinctive character of the ‘497 mark. Furthermore, for the reasons outlined above, I find that the addition of the tagline also does not affect the distinctive character. I therefore find the white and blue variant is acceptable for showing use of the opponent’s ‘497 mark.

26. In Exhibit 14 (in use since 2023) the opponent has used the mark set out below. I shall refer to it as “the purple variant”:

AirPlus
Smarter payment. Better business.

27. I find that the purple variant is an acceptable form of all four of the opponent’s marks. Whilst the use of colour is different, this does not alter my findings above and, for the same reasons, I find it to be acceptable variant use of all four of the opponent’s marks.

28. In Exhibit 8 the opponent has used the following mark:

AirPlus
Smarter payment. Better business.

29. As this variant only differs from the purple variant as to the colour of the background and dot above the ‘i’ (which does not alter the four marks’ distinctive character), it follows that it is also an acceptable variant of the four earlier marks.

30. Ms Ewings states that the opponent has used the mark set out below in the UK "since the beginning of 2024" (which theoretically includes the end of the relevant period), which I shall refer to as "the green variant":

AirPlus

31. I find that this is an acceptable variant of the registered marks. Whilst it contains a green background with blue text, it is my view that the use of colour does not affect the four marks' distinctive character. For the same reasons given above, I find that the green variant is acceptable for showing use in relation to all four earlier marks.

32. The opponent has also used the words "AirPlus" with different coloured backgrounds, such as shown in Exhibit 14.8 (dated in the witness statement as in use "since 2023"):

AirPlus

33. It is my view that the use of different coloured backgrounds (such as shown here) is acceptable for showing use of the registered marks, as the omission of non-distinctive verbal elements (such as "Connect" and "International") and the use of colour/slightly different fonts does not affect the four earlier marks' distinctive character.

34. The following mark has used in the UK since 2019:

AirPlus
INTERNATIONAL

35. This is the '057 mark as filed. However, it is also acceptable for showing use of the '693 mark, as it contains the same verbal elements which are protected regardless of their typeface or colour. It is also an acceptable variant of the '864 mark. This is on account of the same reasoning outlined above, i.e. the omission of the word "Connect" and the inclusion of the word "International" do not affect the '864 mark's distinctive character. It is also an acceptable variant of the '497 mark, as the use of the different

colours, or the addition of the blue rectangle shapes or the word “International” do not affect the mark’s distinctive character.

Relevant territory

36. As stated previously, within the relevant period, the relevant territory is the EU for 27 January 2019 to 31 December 2020 and the UK for 1 January 2021 to 26 January 2024. I note that some of the exhibits within the evidence relate only to the UK during the period when the EU was the relevant territory. However, I remind myself that sales in one Member State may be sufficient for showing use during the period in which the EU is the relevant territory.[6] This applies even where there are no special factors, such as the market for the goods and/or services being limited to that area of the Union.

Marketing activities

37. Ms Ewings files Exhibit 16 as an example of a digital campaign conducted in the UK during 2022 and 2023. In her witness statement, Ms Ewings gives the following figures for the number of digital campaigns that have been conducted under the AirPlus trade marks:

All countries	Year:	2024	2023	2022	2021	2020	2019	TOTAL
	Number of digital campaigns	48	41	41	9	34	7	180
	Number of sessions	1.521.317	1.992.531	967.788	1.180.850	1.662.421	1.787.433	9112340
	Number of marketing contacts	5.609	2.484	1.855	1.828	2.555	934	15265
	Number of deliverd marketing mails	8.523	9.066	12.450	19.428	37.433	14.036	100936
UK only								
	Number of digital campaigns	4	5	4	2	3	0	18
	Number of sessions	134.379	98.518	101.906	112.828	99.026	131.908	678565
	Number of marketing contacts	407	68	121	54	86	18	754
	Number of deliverd marketing mails	747	224	654	604	521	159	2909

38. As the relevant period spans 27 January 2019 to 26 January 2024, I am mindful that the figures given for the years 2019 and 2024 may include campaigns conducted before and after the relevant period started and finished. Although I cannot be sure of what proportion of the figures given for 2019 and 2024 ought to be discounted, I am mindful that the figures for 2019 and 2024 are likely to be lower than what is shown in the table above.

39. On page 19 of her witness statement, Ms Ewings also gives the following expenditure figures for marketing activities, which she states on page 18 were “spent

[6] For example, *Leno Merken BV v Hagelkruis Beheer BV* Case C-149/11 and *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited* [2016] EWHC 52

on promoting the services offered by my company under its house trademarks “AirPlus” and “AirPlus International” and other trademarks containing “AirPlus””. These figures are as follows:

Year	Global expenditure	UK expenditure
2019	3,943 Mio[7] EUR	300,000 EUR
2020	1,509 Mio EUR	302,000 EUR
2021	1,844 Mio EUR	165,000 EUR
2022	3,607 Mio EUR	177,930 EUR
2023	4,488 Mio EUR	170,000 EUR
2024	4,139 Mio EUR	170,000 EUR

40. There is no data to accompany these figures to demonstrate the number of people who had viewed the marketing activities, so it is not possible to understand the impact that these marketing activities would have had on EU or UK consumers within the relevant period. Also, as above, although I cannot be sure of what proportion of the figures given for 2019 and 2024 ought to be discounted, I am mindful that the figures for expenditure for 2019 and 2024 are likely to be lower for the part of the year that falls within the relevant period than what is shown in the table above.

41. Exhibit 12 shows a press release, which Ms Ewings states in her witness statement was released in September 2022. Exhibit 13 shows an article dated 22 June 2022 which discusses the integration between AirPlus and Apple Pay. There are a number of documents such as Exhibits 14.1 to 14.35 which Ms Ewings states in her witness statement are “marketing collaterals” which have been used “since the year 2023”. She also refers to Exhibits 14.45 to 14.53 which she states have been in use “in the UK since 2002”. It is my view that it is reasonable to infer that the fact that the opponent has continued to update marketing materials from as early as 2002 suggests that they are being circulated in some way. However, there is no data in relation to

[7] It is my understanding that ‘mio’ is a common replacement in Europe for ‘million’

these documents to show the number of consumers who read them, so it is not possible to understand how many consumers within the relevant territories would have been exposed to these press coverage and marketing documents.

42. In pages 13 and 14 of her witness statement, Ms Ewings also refers to other marketing materials such as a series of podcasts made between April 2023 and November 2023. However, there are no further details as to the number of downloads or streams, so it is unclear how many consumers these reached.

Sales figures

43. On page 7 of her witness statement, Ms Ewings gives the following purchase volume figure generated by the opponent, "with the following number of contracts and with credit and debit cards in the UK" as follows:[8]

Year	Purchase volume	Customer contracts	Number of cards
2019	1,074,487,712 €	1,269	43,467
2020	363,730,022 €	1,226	75,308
2021	394,051,368 €	1,314	33,466
2022	863,930,808 €	1,308	35,679
2023	1,115,664,589 €	1,201	38,597

44. Ms Ewings attributes the decline in the number of credit and debit cards issued by the opponent "due to the fact that many cards have been replaced by so-called "virtual card"".

45. Ms Ewings also gives the turnover for the UK subsidiary of the company as £16.6 million in 2022, which she says was for business conducted under the AirPlus trade marks. These figures are supported by a very small selection of invoices (Exhibits 21.1 to 21.5). However, of the five invoices submitted, three (Exhibits 21.3 to 21.5) were dated after the relevant period finished in 2024. Exhibit 21.1 shows an address in

[8] I have not included the year 2024 as it is a forecast rather than an actual number.

London and Exhibit 21.2 shows an address with an SL1 post code (which, to the best of my knowledge, is a Slough address).

<u>Sufficient use</u>

46. The evidence has its limitations. The information in relation to the services offered by the opponent in Exhibits 3 and 4 is undated. Whilst there is a copyright notice stating 2024, it is not clear whether this falls within the section of 2024 that is in the relevant period. Although Exhibit 3 gives a year-by-year breakdown of when the opponent's services were made available, I cannot be sure whether the information in Exhibit 4 falls within the relevant period. Exhibits 5a and 5b are also dated outside of the relevant period. Exhibit 11 gives details of the opponent's stand at a trade fair in June 2024. However, it falls outside of the relevant period, which ends on 26 January 2024. The virtual e-books in Exhibit 17.2 list "2024" as the date, so I cannot ascertain whether or not it falls within the relevant period. The first newsletter in Exhibit 18 is dated 2005 and therefore falls outside of the relevant period. Although the second newsletter in the exhibit is dated "2024", it does not specify when, so it is unclear if it was within the relevant period or not. Exhibit 19 contains screenshots of the opponent's LinkedIn account. However, none of the screenshots are dated and the witness statement only refers to them being made "during the year 2024" so I cannot be sure that the posts were made in the relevant period. Furthermore, it is not clear how many UK consumers viewed these posts, so it is not possible to assess their impact. In addition to this, the invoices do not demonstrate that sales have been widespread across the UK territory.

47. However, an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole.[9] The opponent's evidence demonstrates a reasonably high expenditure on marketing the goods and services bearing its marks. Whilst there were only two sales invoices submitted that fell within the relevant period, the purchase volume figures shown by Ms Ewings in the witness statement show that the sales figures for the UK were reasonably high. Several exhibits show use in relation to the opponent's software app under the name "AirPlus" in the Apple App store. For example, in her witness statement, Ms Ewings shows an example of the app interface on page 16. On pages 16 to 17, she states that there have been more than 7,000

[9] *New Yorker SHK Jeans GmbH & Co. KG v OHIM,* Case T-415/09

downloads of the app in the UK since it was made available in 2021. This is supported by a dated graph on page 17 showing that the majority of these downloads were made within the relevant period. On the face of it, the download figures seem reasonably modest in the context of the UK market for applications and software, which I understand to be very large. However, as the authorities cited above show, use does not need to be quantitatively significant for it to be considered genuine. Taking the evidential picture as a whole, I am satisfied that there has been genuine use of the opponent's mark in relation to **credit and debit cards** (as demonstrated by the figures given on page 7 of Ms Ewings' witness statement, the examples of the goods on pages 3 to 6, the marketing materials such as Exhibits 14.45 and 14.48). It also shows use of the marks in relation to **virtual cards** (such as in the marketing materials shown in Exhibits 8 and 16 and the narrative evidence that credit/debit card numbers have declined in recent years in favour of these goods). The evidence also shows use of the marks in relation to **software applications for managing credit accounts** (such as in pages 16 to 17 of the witness statement). It also shows use of the marks in relation to **payment services** (Exhibit 4 showing a "settlement account" for employers to use for business travel expenses using the 'AirPlus Portal', and the marketing materials in Exhibit 9). Although the witness statement refers to the use of the mark in relation to other services (such as support services, on page 18 of the witness statement), the scale of use in relation to these more peripheral services is not clear from the evidence.

48. I will now consider how these findings apply to the specification of the marks relied upon for opposition purposes.

<u>Fair specification</u>

49. In determining a fair specification for the opponent's marks, I consider *Merck KGaA v Merck Sharp & Dohme Corp & Ors*[10] in which the Court of Appeal set out the proper approach to partial revocation (which applies equally to the framing of a fair specification) as follows:

[10] [2017] EWCA Civ 1834

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

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

50. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1),*[11] subject to the proviso that it must be seen in light of more recent guidance by the Court of Justice of the European Union ("CJEU") that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU*[12] at paragraphs 36-53).

The '693 mark and the '057 mark

<u>Class 9:</u> *Computer programs recorded on data carriers, in particular for invoice and payment processing and for travel planning and travel costs processing.*

51. Based on my understanding, the virtual card described by the opponent (such as in Exhibit 8) functions like a physical card but is a type of software-based payment tool which is linked to the user's bank account. However, this term specifies that it relates specifically to programs which are recorded on data carriers. It is my understanding that data carriers are items such as USB sticks or memory cards. As I am unable to see evidence of computer programs on data carriers, I therefore find that the opponent cannot rely on this term.

<u>*Class 35 [for the '693 mark]*</u>*: Professional business and organisational consultancy; business advice; business marketing services, in particular the conducting of advertising initiatives, for others, mail advertising, including mailing and compiling of mailing lists; processing of organisational procedures for others, in the fields of business and marketing; conducting and setting up billing systems for others, in particular billing systems for travel.*

<u>*Class 35 [for the '057 mark]*</u>*: Professional business and organisational consultancy; professional business consultancy; marketing, in particular the conducting of advertising initiatives, for others, mail advertising, including mailing and compiling of mailing lists; processing of organisational procedures for others, in the fields of business and marketing; conducting and setting up billing systems for others, in particular billing systems for travelling expenses.*

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[11] [2024] UKSC 36
[12] (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106

52. It is my view that the opponent's evidence demonstrates services which relate to setting up billing systems. For example, page 163 of Exhibit 14.52 is a "marketing collateral" which refers to the opponent's services being used "from implementation to reporting". It also states that "the implementation plan will provide a seamless transition to you and your card users", which implies that the consumers will use the services to set up billing systems for others. Exhibit 9 explains the services in relation to managing accounts, their virtual card services, and procurement. Furthermore, the opponent also refers to having "dedicated account managers [which] are here to help you build your card program and guide you through the roll-out process". However, there is no evidence that demonstrates the scale of use in relation to these services. I therefore find that the opponent cannot rely on *professional business consultancy; conducting and setting up billing systems for others, in particular billing systems for travel, conducting and setting up billing systems for others, in particular billing systems for travelling expenses, professional business and organisational consultancy, business advice*, and *processing of organisational procedures for others, in the fields of business […]* as the evidence does not clearly show the scale of use of these services.

53. In addition to this, I cannot see specific evidence which shows the use of the mark for the other services in class 35, such as those relating to organisational services or marketing/advertising initiatives. Whilst I appreciate that the opponent has submitted many documents demonstrating its own marketing materials (such as Exhibits 14.1 to 14.35), I cannot see that the evidence shows use of the mark on the provision of these types of services for others. I therefore find that the opponent cannot rely on *marketing, in particular the conducting of advertising initiatives, for others, mail advertising, including mailing and compiling of mailing lists, business marketing services, in particular the conducting of advertising initiatives, for others, mail advertising, including mailing and compiling of mailing lists* or *professional business and organisational consultancy, business advice*, and *processing of organisational procedures for others, in the fields of […] marketing.*

<u>*Class 36*</u>*: Financial services, including credit card company services, in particular the issuing of credit and service cards; concluding monetary transactions with credit cards; financial consultancy; processing of organisational procedures for others in the field of*

finance; invoicing and payments processing, in particular card billing for the services of others, including the gathering and evaluation of data on such.

54. The evidence shows many exhibits demonstrating financial services. For example, the brochure in Exhibit 8 (which Ms Ewings describes in her witness statement as being circulated electronically since 2021) shows the use of the mark on virtual cards offered to business customers by the opponent. It shows an example of a statement and billing information. Exhibit 9 (dated 2023) shows a press release detailing the financial services available under the AirPlus mark. These include generating virtual credit cards to use for individual transactions, a financial portal, data analysis, and card procurement. These are also supported by a number of similar brochures and marketing materials included in Exhibits 14.1 to 14.35. It is my view that these documents primarily relate to the functionality and benefits of their financial services. In her witness statement, Ms Ewings states that these have been in use in the UK "since 2023". Exhibits 14.47 to 14.53 shows brochures (which Ms Ewings states has been in use since 2003 in her witness statement) which outline further information in relation to financial services, such as the information manager and the corporate cards available.

55. It is my view that the evidence shows use specifically in relation to *financial services, including credit card company services, **namely** the issuing of credit cards* and *concluding monetary transactions with credit cards,* and *[…] payments processing, in particular card billing for the services of others, including the gathering and evaluation of data on such.* However, I am of the view that the evidence does not show genuine use in relation to invoicing, processing of organisational procedures, or consultancy, and therefore the opponent may not rely upon *processing of organisational procedures for others in the field of finance*, *invoicing […]* or *financial consultancy.*

<u>Class 42</u>*: Data/message processing for others.*

56. Whilst the opponent's financial services may use data and messaging functionality, I cannot see any specific evidence of genuine use in relation to this service. I therefore find that the opponent cannot rely on this term in class 42.

The ‘864 mark

<u>*Class 9*</u>*:*

Computer software […]; Computer programs recorded on data carriers, in particular for invoice and payment processing and for travel planning and travel costs processing; Software products for e-commerce, home banking, card billing systems and the Internet; Database software; Mobile apps; Software; Software and applications for mobile devices; Software for tablet computers; Software for facilitating secure credit card transactions; Software related to handheld digital electronic devices.

57. As stated previously above for the ‘693 mark, it is my view that the opponent has not shown use in relation to *Computer programs recorded on data carriers, in particular for invoice and payment processing and for travel planning and travel costs processing.* I also cannot see that the opponent has shown use in relation to *database software* and therefore it also cannot rely on these goods.

58. As stated previously, the opponent has shown use of its mark in relation to specific payment software, such as the virtual card and its mobile app. It can therefore rely on *software for facilitating secure credit card transactions.*

59. However, the evidence does not show use in relation to software, apps, or computer programs at large. I therefore find that the opponent can only rely on *Computer software […]; Mobile apps; Software; Software and applications for mobile devices; Software for tablet computers; Software related to handheld digital electronic device* and *Software products for e-commerce, home banking, card billing systems […].* with the limitation *to all the aforementioned in relation to payments and banking.*

Data processing apparatus and computers; Computer […] hardware; Online computer systems comprising data processing equipment and computers; Card readers and apparatus for recording, transmission or reproduction of sound, images and computer data.

60. I cannot see any evidence in relation to these hardware goods. I therefore find that the opponent cannot rely on them.

Encoded cards for use in point of sale transactions; Electronic and magnetic ID cards for use in connection with payment for services; Magnetic payment cards.

61. Pages 3 and 4 on Ms Ewings' witness statement show various samples of cards bearing the opponent's marks which are dated within the relevant period. These are supported by the figures given on page 7 of Ms Ewings' witness statement, the examples of the goods on pages 3 to 6, the marketing materials such as Exhibits 14.45 and 14.48. However, it is my view that the evidence shows use in relation to debit and credit cards, rather than other types of cards. I therefore find that it can rely on *encoded debit and credit cards for use in point of sale transactions* and *magnetic debit and credit payment cards*.

62. It is my view that the evidence does not specifically show any forms of ID cards. I therefore find that the opponent cannot rely on *electronic and magnetic ID cards for use in connection with payment for services.*

<u>*Class 35*</u>*: Billing for others; Professional business and organisational consultancy; Business management, business administration and office functions; Electronic commerce provider services on the Internet, namely order placement, delivery and invoice management within the framework of e-commerce, and arranging of contracts for others for the purchase and sale of goods; Arranging and concluding commercial transactions, for others, via electronic ordering platforms*; *Organisational and professional business monitoring of bonus, service and credit card programmes; Invoice management, in particular cashless and cash-based billing, including collating and statistical evaluation of data on the aforesaid invoice management; Compilation, updating, maintenance, organisation and systemisation of information into computer databases; Providing of information on the Internet in the field of business management; Invoicing and drafting of invoices for others, including via the internet, accounting; Services relating to book-keeping and business administration for monitoring and conducting claims management; Including all the aforesaid services provided online and via the Internet, via databases; Preparation of accounts.*

63. It is my view that, for the same reasons cited above in relation to the '693 mark, the opponent has not demonstrated the scale of use in relation to its billing or organisational services. Furthermore, I do not consider that the evidence

demonstrates the opponent's marks being used in relation to book-keeping, or ordering. I also do not find that the evidence shows use in relation to computer databases, or administrative services. I therefore find that the evidence does not show use of the marks on any of the opponent's class 35 services, and therefore it cannot rely on them.

Professional business project management for the development of bonus, service and credit card programmes; Professional business project management in the fields of claims management, warnings and general book-keeping and account management; Presentation of goods and services, bonus, service and credit card programmes as part of advertising and marketing measures and events.

64. It is my view that the opponent's evidence does not specifically show that it offers project management services for others. I also cannot see any evidence which shows the provision of services relating to the presentation of goods and services for marketing purposes. I therefore find that it cannot rely on these services.

<u>Class 36</u>:

Finance services, Including financial services of credit card companies.

65. The term *finance services, including financial services of credit card companies* merely states that it includes this sub-category of services, rather than is limited to this. Therefore, to allow the opponent to rely on this term would effectively allow it to rely upon *finance services* at large. As it is my view that the opponent's services relate to payment services, I therefore find that it can only rely on *finance services, namely financial services of credit card companies.*

Issuing of credit, service and bonus cards with payment functions; Financial services for running credit, service and bonus card programmes; Financial consultancy relating to the running and management of credit, service and bonus card programmes.

66. I am unable to find use in relation to *bonus cards*, so I find use only in relation to *Issuing of credit and service […] cards with payment functions* and *Financial services for running credit and service […] card programmes; Financial consultancy relating to the running and management of credit and service […] card programmes.*

Debt recovery in the framework of claims management.

67. It is my view that the financial services described in the exhibits did not specifically address debt recovery services. I therefore find that the opponent cannot rely on these services.

Providing of information via the Internet in the field of financial services; Financial services for conducting payment and billing transactions and for financial brokerage; Including all the aforesaid services provided online and/or via the Internet, via databases.

68. It is my view that, as financial services is a very wide category of services, the evidence (such as in relation to the portal and in relation to the payment services) only shows use of *providing of information via the Internet in the field of payment services.* I also cannot see sufficient evidence to show use of financial brokerage, and therefore I only find use in relation to *financial services for conducting payment and billing transactions […].* It is also my view that the opponent has not demonstrated use in relation to databases, and therefore the limitation *Including all the aforesaid services provided online and/or via the Internet, via databases* should be limited to *Including all the aforesaid services provided online and/or via the Internet* instead.

Payment processing; Electronic payment services; Contactless payment services; Electronic processing of payments; Financial payment services; Financial transfers and transactions, and payment services; Money ordering services; Electronic wallet services (payment services), Financial sales transaction management.

69. In line with my reasoning for the '693 mark, it is my view that the evidence (such as the exhibits showing the brochures describing the opponent's financial services) demonstrates use of the opponent's mark in relation the financial service connected with credit cards, debit cards, and payments. I therefore find that it can rely upon *Payment processing; Electronic payment services; Contactless payment services; Electronic processing of payments; Financial payment services; Financial transfers and transactions, and payment services; Money ordering services; Electronic wallet services (payment services), Financial sales transaction management.*

Rental of card payment apparatus, in particular for use with credit, service and bonus cards; Rental of automatic cash dispensers, bank statement printers and money counting apparatus, in particular for use with credit, service and bonus cards, included in class 36.

70. I cannot see any information which refers to the rental of these types of hardware. I therefore find that the opponent cannot rely on these services.

The ‘497 mark

Class 16*: Credit cards, cheques, bankers cards, printed matter relating to the issuance, promotion, and advertising of credit cards and bankers cards, all included in Class 16.*

71. As stated above, the exhibits show a number of different goods relating to cards. I find that they are sufficient for showing use of the mark in relation to *credit cards.* As the opponent has shown use in relation to debit cards, it is my view that this includes *bankers* cards. However, I am unable to see any evidence relating to *cheques* and therefore I find that the opponent cannot rely on them. Although I acknowledge that the opponent may use printed matter as a means of advertising, I cannot see evidence which specifically shows the provision of *printed matter relating to the issuance, promotion, and advertising of credit cards and bankers cards.* I therefore find that it cannot rely on these goods either.

Class 36: *Banking services; credit brokerage and credit card services; financing services for the security of funds for others; all included in Class 36.*

72. It is my view that the evidence demonstrates examples of the use of the opponent’s mark in relation to *credit card services* and *banking services.* However, it is my view that *financing services for the security of funds for others* would primarily relate to money protection services. As it is my view that the opponent has not demonstrated use of these services or of *credit brokerage* in the evidence, so I therefore find that it cannot rely on them.

73. In reaching these conclusions, I have borne in mind the applicant’s submissions filed in the evidence rounds, also in which it argues that the opponent’s goods and services “are consistently described as corporate, commercial, or business solutions”,

and that the opponent has not "presented any goods or services marketed or sold to consumers, nor of any attempt to operate in the consumer finance sector". On page 2 of his witness statement, Mr O'Connor explains that the goods and services "are aimed at corporate travel managers, procurement officers, and B2B customers".

74. In response to the applicant's submissions, the opponent filed further submissions during the evidence rounds. The opponent argues that "even where a payment card is issued or sponsored by a corporate entity, the ultimate users are individuals (employees and cardholders) who function as consumers in their day-to-day transactions". Moreover, it highlights that "the relevant public for the purposes of trademark law includes not only contracting parties but also those who perceive, encounter, or are affected by the services", and therefore argues that "an employee using a corporate-issued card perceives the mark in his or her capacity as an end-consumer". It submits that the applicant's evidence "demonstrates that the distinction between B2B and B2C is blurred, particularly where corporate cards are used by individuals in ordinary retail transactions".

75. In *ACTC GmbH v Taiga AB,*[13] the CJEU held that it was not relevant that the goods were aimed at different publics and sold through different trade channels. Therefore, although the applicant asserts that its "consumer base and channels of trade are entirely distinct from those of the opponent",[14] I do not find that the opponent's terms should be limited in this way. Taking into account the parties' submissions on the matter, it is my view that the purpose and intended use (as identified in *ACTC GmbH v Taiga AB* as the "essential criterion" for identifying a subcategory) of the goods and services does not substantially differ whether or not they are provided on a B2B basis or a B2C basis. Moreover, the Court of Appeal in *Merck* (cited above) stated the following:

> "247. … it is not possible for a proprietor to use the mark in relation to all possible variants of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved,

[13] Case C-714/18 P
[14] Page 2 of Mr O'Connor's witness statement

are not in essence different from them and cannot be distinguished from them other than in an arbitrary way."

76. It is therefore clear that a proprietor does not necessarily need to show use of a mark in relation to every possible variant of that service. It is therefore my view that the opponent's goods and services should not be limited solely to corporate-related goods and services.

77. It is my view that the software goods in class 9 and credit card goods in class 16 would not differ in their purpose or their intended use (which is to provide computer hardware with digital instructions in order to generate information and undertake tasks), regardless of whether the end user is a corporate customer or a member of the public. I therefore do not find that there is a clear difference in the intended use of the goods according to whether they are used in the field of corporate finance or consumer finance. The other goods in class 9 relate to physical payment cards. I am also of the view that these goods would not differ in their purpose or intended use (which is for the user to complete financial transactions), depending on whether they were being used within the corporate sector or consumer sector. It is also my view that the financial services also do not substantially differ in their intended purpose (which is to help the user complete financial tasks), regardless of the end user. It is my view that the services' core purpose remains the same whether they are offered to corporate clients or the public consumers.

78. I therefore find that the opponent's goods and services should not be limited in the way suggested by the applicant, as it is my view that the average consumer would not view the intended purpose of the different goods and services as being substantially different whether they were offered purely on a B2B level or to public consumers. Whilst I acknowledge that the opponent's evidence shows that its products and services are primarily marketing towards B2B consumers, it is my view that limiting the opponent's goods and services to being solely B2B-related goods and services would amount to it being stripped of protection for goods and services "which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way" (*Merck*, cited above).

79. In summary, I therefore find that the opponent may rely upon the following goods and services:

Mark	Goods
The ‘693 mark	<u>Class 36</u>: *Financial services, including credit card company services, namely the issuing of credit and service cards; Concluding monetary transactions with credit cards; […] payments processing, in particular card billing for the services of others, including the gathering and evaluation of data on such.*
The ‘057 mark	<u>Class 36</u>: *Financial services, including credit card company services, namely the issuing of credit and service cards; concluding monetary transactions with credit cards; […] payments processing, in particular card billing for the services of others, including the gathering and evaluation of data on such.*
The ‘864 mark	<u>Class 9</u>: *Computer software […]; Mobile apps; Software; Software and applications for mobile devices; Software for tablet computers; Software related to handheld digital electronic devices; Software products for e-commerce, home banking, card billing systems […]; all the aforementioned in relation to payments and banking;* Software *for facilitating secure credit card transactions; Encoded debit and credit cards for use in point of sale transactions; Magnetic debit and credit payment cards.* <u>Class 36</u>: *Finance services, namely financial services of credit card companies; Issuing of credit and service […] cards with payment functions; Financial services for running credit and service […] card programmes; Financial consultancy relating to the running and management of credit and service […] card programmes; providing of information via the Internet in the*

	field of payment services; financial services for conducting payment and billing transactions […]; Including all the aforesaid services provided online and/or via the Internet; Payment processing; Electronic payment services; Contactless payment services; Electronic processing of payments; Financial payment services; Financial transfers and transactions, and payment services; Money ordering services; Electronic wallet services (payment services), Financial sales transaction management.
The '497 mark	<u>*Class 16*</u>*: Credit cards; Bankers cards.* <u>*Class 36*</u>*: Banking services; Credit card services.*

Section 5(2)(b)

80. Section 5(2)(b) of the Act reads as follows:

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

81. Section 5A states: […] "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."

82. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor:*[15]

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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;

[15] [2025] UKSC 25

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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

83. In *Canon*[16], the CJEU stated, at paragraph 23 of its judgment, that when considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. The CJEU stated that those factors include their nature, intended purpose, method of use and whether they are in competition with each other or are complementary.

84. The relevant factors identified by Jacob J. (as he then was) in *Treat*[17] 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;

[16] Case C-39/97
[17] [1996] R.P.C. 281

(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.

85. In *Kurt Hesse v OHIM,*[18] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),*[19] the 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."

86. In *Gérard Meric v OHIM,*[20] the GC confirmed that even if goods and services 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."

87. The goods and services to be compared are as follows:

[18] Case C-50/15 P
[19] Case T-325/06
[20] Case T- 133/05

The opponent's goods and services (as per the fair specification findings)	The applicant's goods and services
<u>The '693 mark</u> <u>*Class 36*</u>*: Financial services, including credit card company services, namely the issuing of credit and service cards; concluding monetary transactions with credit cards; […] payments processing, in particular card billing for the services of others, including the gathering and evaluation of data on such.* <u>The '057 mark</u> <u>*Class 36*</u>*: Financial services, including credit card company services, namely the issuing of credit and service cards; concluding monetary transactions with credit cards; […] payments processing, in particular card billing for the services of others, including the gathering and evaluation of data on such.* <u>The '864 mark</u> <u>*Class 9*</u>*: Computer software […]; Mobile apps; Software; Software and applications for mobile devices; Software for tablet computers; Software related to handheld digital electronic devices; Software products for e-commerce, home banking, card billing systems […]; all the aforementioned in*	<u>*Class 9:*</u> *Consumer credit cards; magnetic consumer cards; encoded consumer cards; consumer chip cards; consumer smart cards; magnetic data carriers; card readers for credit cards; credit card terminals; applications for consumer banking, consumer payments and consumer credit services. computer programs and software for consumer banking, consumer payments and consumer credit services. consumer credit bureau software; consumer credit consultancy software; consumer database management software; databases, data sets and software relating to consumer account management (including consumer credit accounts); databases, data sets and software relating to consumer bank accounts; databases, data sets and software relating to consumer bank account sort codes; databases, data sets and software relating to consumer billing; databases, data sets and software relating to individual biometric data; databases, data sets and software relating to individual candidate verification; databases, data sets and software relating to consumer credit application processing; databases, data*

relation to payments and banking; Software for facilitating secure credit card transactions; Encoded debit and credit cards for use in point of sale transactions; Magnetic debit and credit payment cards. *<u>Class 36</u>: Finance services, namely financial services of credit card companies; Issuing of credit and service […] cards with payment functions; Financial services for running credit and service […] card programmes; Financial consultancy relating to the running and management of credit and service […] card programmes; providing of information via the Internet in the field of payment services; financial services for conducting payment and billing transactions […]; Including all the aforesaid services provided online and/or via the Internet; Payment processing; Electronic payment services; Contactless payment services; Electronic processing of payments; Financial payment services; Financial transfers and transactions, and payment services; Money ordering services; Electronic wallet services (payment services), Financial sales transaction management.* <u>The '497 mark</u>	*sets and software relating to consumer credit assessment and consumer credit screening; databases, data sets and software relating to consumer credit scorecards; databases, data sets and software relating to consumer credit strategy management; databases, data sets and software relating to consumer customer profiling; databases, data sets and software relating to consumer financial information; databases, data sets and software relating to individual identity documents; databases, data sets and software relating to individual identity verification and authentication; databases, data sets and software relating to names of individuals; databases, data sets and software relating to public record information about individuals. None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.* *<u>Class 35:</u> Consumer credit card registration services, provision of consumer credit card rewards based programs; preparation of monthly statements of account for consumer services; provision of monthly statements for consumer services. None of the aforementioned in relation to Corporate Payments,*

<u>Class 16</u>: Credit cards; Bankers cards. *<u>Class 36</u>: Banking services; Credit card services.*	*Business Travel, Procurement or Travel Trade.* *<u>Class 36:</u> Consumer banking; consumer e-wallet payment services; consumer financial management; consumer financing services; instalment loans for consumers; issuance of consumer credit cards; issuance of consumer credit; issuance of prepaid gift cards to consumers; consumer loans [financing]; mobile consumer banking services; online consumer banking; online consumer banking services rendered in virtual environments; processing of consumer credit card payments; processing of consumer debit card payments; providing consumer financial information; providing consumer financial information via a website; savings bank services; issuance of credit cards, credit lines and loans to consumers; management of consumer credit card accounts, credit accounts and loans for consumers; Consumer credit history services; consumer credit account management services; consumer credit agency services; consumer credit assessment services; consumer credit bureau services; consumer credit consultancy services; consumer credit evaluation services; consumer credit information services;*

	consumer credit rating services; consumer credit risk assessment services; consumer credit risk information services; consumer credit scoring and credit scorecard services; consumer credit screening services; consumer credit strategy management services; consumer debt collection services; consumer financial database services; fraudulent consumer credit application detection services; preparation of consumer credit reports; consumer credit application processing services; consumer financial services; consumer monetary affairs; consumer banking credit care services; consumer credit services; consumer credit card services; consumer debit card services; magnetic card services for consumers; chip card services for consumers; smart card services for consumers; electronic funds transfer services for consumer services; issuance of credit, debit and magnetic cards to consumers; consumer credit card payment processing; consumer lending services; advisory, consultancy and information services related to all of the aforesaid. None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

88. In its submission in lieu, the opponent does not offer any specific comparators between the parties' goods and services. It submits that the competing parties' goods

and services “are highly similar to each other, if not identical”. It also argues it is “irrelevant” that the applicant has added a limitation to its specification on the basis that for the average consumer it would be “difficult, if not impossible, to distinguish between ‘corporate payments, business travel, procurement or travel trade’ and ‘other purposes’ when using the goods and services in question”.

89. In its submission in lieu, the applicant does not offer any specific comparators between the parties’ goods and services. It submits that there is “no similarity of goods/services due to the Applicant’s explicit exclusions”. It argues the parties operate in entirely different markets and have distinctive relevant publics as its services “are intended for individual customers” whereas the opponent “exclusively serves corporate clients, with solution targeted at business travel, corporate expenses, and procurement”. It also submits that the channels of trade do not overlap, stating that the consumer finance sector uses “price comparison websites, credit comparison platforms, consumer-facing apps, [and] direct advertising to retail individuals”. It argues that the opponent “is entirely absent from these channels”, operating instead through “corporate procurement tools, corporate travel management systems, [and] B2B integrations…”.

90. For the purposes of comparing goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.[21] I have therefore assessed the applicant’s goods and services by dividing the terms into groups as per below.

<u>Class 9:</u>

Consumer credit cards; magnetic consumer cards; encoded consumer cards; consumer chip cards; consumer smart cards; Magnetic data carriers; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

91. It is my view that the applicant’s *consumer credit cards, magnetic consumer cards, encoded consumer cards,* and *consumer chip cards* fall within the opponent’s *encoded*

[21] *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38

debit and credit cards for use in point of sale transactions, electronic and magnetic ID cards for use in connection with payment for services, and *magnetic debit and credit payment cards* (for its '864 mark). I have included *magnetic data carriers* within these, as it is my understanding that these include magnetic payment cards. It is also my understanding that *consumer smart cards* are used to make payments but do not have a magnetic element within them. However, it is my view that they fall within the opponent's term *encoded cards for use in point of sale transactions.* As such, the competing parties' goods are identical under the principle within *Meric.*

Card readers for credit cards; credit card terminals; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

92. These goods are types of hardware relating to cards. Their nature and purpose overlaps with the opponent's *encoded debit and credit cards for use in point of sale transactions* in that they are both financial transaction goods, although the core purpose of an encoded card is to transmit the user's details to the retailer to make a payment, whereas the hardware's core purpose is to obtain this information and receive payment. The users overlap as both will be used by trade customers, but they differ as *encoded debit and credit cards for use in point of sale transactions* will be used widely by the general public too. However, their trade channels may also differ given that cards are widely available through banking organisations, whereas the hardware goods will not be. It is my view that they are unlikely to be viewed as complementary, as consumers are unlikely to believe that the responsibility for both lies with the same undertaking. Given the difference in the goods' core purpose, I am of the view that they are not in competition with one another. Taking all these factors into account, I find that there is a low to medium degree of similarity between the goods.

Applications for consumer banking, consumer payments and consumer credit services; computer programs and software for consumer banking, consumer payments and consumer credit services; consumer credit bureau software; consumer credit consultancy software; […] software relating to consumer account management (including consumer credit accounts); […] software relating to consumer bank accounts; […] software relating to consumer bank account sort codes; […] software relating to consumer billing; […] software relating to consumer credit application *processing; […] software relating to consumer credit assessment and consumer credit screening; […] software relating to consumer credit scorecards; […] software relating to consumer credit strategy management; […] software relating to consumer customer profiling; […] software relating to consumer financial information; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.*

93. The opponent's '864 mark is registered for *software in relation to payments and banking*. As the applicant's goods above are all narrower types of payment or banking software, they are included in the opponent's wider term. I therefore find that the goods are therefore identical under the principle outlined in *Meric.*

Consumer database management software.

94. It is my view that there is a degree of similarity between the applicant's goods and the opponent's *software in relation to payments and banking*. Although the parties' goods are both software, their core purpose differs. This is because the opponent's goods are used in relation to financial tasks, whereas the opponent's goods are used to manage consumer databases. The users of both goods include trade customers, but *software in relation to payments and banking* will be used widely by the general public too. The goods may share software-related trade channels. However, given the difference in core purpose, it is likely that the goods will appear in different areas within those trade channels. The goods are unlikely to be complementary as it is my view that one is not essential to the other. Given the difference in core purpose, the goods are also unlikely to be in competition with each other. Taking all these factors into account, I find a low degree of similarity between the goods.

[…] software relating to individual biometric data; […] software relating to individual candidate verification; […] software relating to individual identity documents; […] software relating to individual identity verification and authentication; […] software relating to names of individuals; […] software relating to public record information about individuals; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

95. It is my view that the applicant's software goods above are similar to the opponent's *software in relation to payments and banking*. The nature of the parties'

goods broadly overlaps as they are all types of software used with sensitive data. The opponent's goods are specifically used in financial contexts. Whilst this may be true of the applicant's goods too, they will also be used in wider contexts too where verification is needed. The core purpose of the goods is also different, given that the opponent's goods are used to manage finance, whereas the applicant's goods are used in relation to data and/or identity verification. There may be an overlap in trade channels where both goods are aimed at professionals. However, given the difference in core purpose, the goods are likely to appear in different areas within these trade channels. The goods are unlikely to be complementary as it is my view that one is not essential to the other. Given the difference in core purpose, the goods are also unlikely to be in competition with each other. Taking all these factors into account, I find a low degree of similarity between the goods.

Databases, data sets […] relating to consumer account management (including consumer credit accounts); databases, data sets […] relating to consumer bank accounts; databases, data sets […] relating to consumer bank account sort codes; databases, data sets […] relating to consumer billing; databases, data sets […] relating to consumer credit application processing; databases, data sets […] relating to consumer credit assessment and consumer credit screening; databases, data sets […] relating to consumer credit scorecards; databases, data sets […] relating to consumer credit strategy management; databases, data sets […] relating to consumer financial information; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

96. It is my view that the applicant's various database and data set-related goods above are similar to the opponent's *software in relation to payments and banking* (for its '864 mark). The opponent's goods are programs which instruct devices to carry out financial tasks. Cambridge Dictionary defines "database" as "a large amount of information stored in a computer in such a way that it can be easily looked at or changed". Although it does not offer a definition for "data set", it is my understanding this is essentially a group of information similar to a database. The applicant's goods are therefore bodies of data in relation to financial information. Whilst the competing goods' nature and purpose broadly overlap in the sense that they are digital products all used within a financial context, they differ as the opponent's software performs

financial tasks or functions, whereas the applicant's database goods store financial information. The users of the parties' goods overlap as both will be used by trade consumers. However, the users differ in that *software in relation to payments and banking* will be used widely by the general public too. There may be an overlap in trade channels where both goods are aimed at professionals. However, given the difference in core nature and purpose, the goods are likely to appear in different areas within these trade channels. There may be a degree of complementarity as financial databases may be essential to the operation of financial software, and financial software may be needed to access or manage the financial database. Moreover, given the specialised financial aspect of the goods and the overlap in the digital nature of the goods, consumers may expect the responsibility to lie with the same undertaking. However, given the difference in core purpose, it is my view that the goods are not in competition with each other. Taking all these factors into account, I find a medium degree of similarity between the goods.

Databases, data sets […] relating to individual biometric data; databases, data sets […] relating to individual candidate verification; databases, data sets […] relating to consumer customer profiling; databases, data sets […] relating to individual identity documents; databases, data sets […] relating to individual identity verification and authentication; databases, data sets […] relating to names of individuals; databases, data sets […] relating to public record information about individuals; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

97. It is my view that the applicant's various database and data set-related goods above are dissimilar to the opponent's class 9 goods, such as *software in relation to payments and banking*. The nature and purpose of the parties' goods differ in that the applicant's goods are bodies of data used in relation to identification, whereas the opponent's goods are software products used in relation to finance. The goods are likely to be sold through different trade channels, given the difference in purpose and nature. The goods are not complementary as consumers are unlikely to believe that the responsibility for both lies with the same undertaking. The goods are also not in competition with each other. Taking these factors into account, it is my view that the goods are dissimilar. I have considered the opponent's other goods and services for

its four earlier marks, but none of the other goods and services put the opponent in a more favourable position.

<u>Class 35:</u>

Consumer credit card registration services, provision of consumer credit card rewards based programs; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

98. It is my view that these services are similar to the opponent's *finance services of credit card companies provided online and/or via the Internet […]* in class 36 (registered for the '864 mark). The services' users will overlap, as both will be used by those seeking services relating to credit cards. The services' nature and purpose broadly overlap as they are all services relating to credit cards, although they will differ slightly in that the applicant's services are specifically for registration or reward programs and will therefore be primarily administrative, whereas the opponent's services are financial. Given that the parties' services are all used within the credit card industry, it is my view that their trade channels may overlap. There may be a degree of complementarity, given that *finance services of credit card companies provided online and/or via the Internet […]* are necessary for credit card registration and reward programs to exist. Furthermore, consumers are likely to believe that the responsibility for both lies with the same undertaking, given that they both operate in the credit card industry. They are not in competition with each other, as one service would not substitute the other. Taking these factors into account, I find a medium degree of similarity between the services.

Preparation of monthly statements of account for consumer services; provision of monthly statements for consumer services; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

99. The services above relate to preparing statements for consumer services. Neither party has clarified the meaning of these terms, but it is my understanding that these services are wide enough to include a variety of statement preparation services, include the issuing of credit statements that record a consumer's spending. It is also my view that the opponent's *finance services of credit card companies provided online*

and/or via the Internet […] will incorporate these types of services. It is therefore considered that the services are identical under the principle in *Meric.*

<u>Class 36:</u>

Consumer banking; consumer financial management; consumer financing services; consumer financial database services; fraudulent consumer credit application detection services; preparation of consumer credit reports; consumer credit application processing services; consumer financial services; consumer monetary affairs; consumer banking credit care services; consumer credit services; consumer credit card services; magnetic card services for consumers; chip card services for consumers; smart card services for consumers; electronic funds transfer services for consumer services; consumer credit card payment processing; consumer lending services; advisory, consultancy and information services related to all of the aforesaid; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

100. It is my view that these services can either be included in the opponent's term *finance services, including financial services of credit card companies.* This is because it is considered that all of the above would reasonably be expected to fall within the financial services conducted by credit card companies. It is my view that such companies would undertake tasks relating to credit cards, banking, financial management, and credit services. I therefore find them identical to the opponent's *finance services, including financial services of credit card companies* under the principle set out in *Meric.*

Issuance of consumer credit; issuance of prepaid gift cards to consumers; issuance of consumer credit cards; issuance of credit, debit and magnetic cards to consumers; issuance of credit cards and credit lines […] to consumers; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

101. It is my view that the above services can be included in the opponent's *issuing of credit and service […] cards with payment functions.* They are therefore identical under the principle in *Meric.*

Issuance of […] loans to consumers; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

Based on my understanding, loans are a standalone financial product compared to credit card services. However, it is my view that the applicant's loan-issuing services are similar to the opponent's term *issuing of credit and service […] cards with payment functions.* The services' nature overlaps, as both relate to issuing financial products related to lending. However, their core nature differs slightly in that the applicant's services relate specifically to loans whereas the opponent's services relate to credit card finance. The purpose and users will likely overlap in that both will be used by consumers who need access to additional finance. It is my view that the services' trade channels will overlap. It is considered that the services are not complementary as one is not essential to the other. However, it is likely that the services will be in competition with each other, as users will select between different financing options. Taking these factors into account, it is my view that there is a medium to high degree of similarity between the parties' services.

Processing of consumer credit card payments; consumer e-wallet payment services; processing of consumer debit card payments; consumer debit card services; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

102. I am of the view that the terms above can all be included in the opponent's terms *payment processing; Electronic payment services; Contactless payment services; Electronic processing of payments; Financial payment services; Financial transfers and transactions, and payment services.* They are therefore identical under the principle set out in *Meric.*

Savings bank services; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

103. It is my understanding that these services will incorporate a variety of services relating to savings, including transfer and transaction-related services. It is therefore my view that the applicant's services will include the opponent's *financial transfers and transactions […] services.* They are therefore identical under the principle set out in *Meric.*

Providing consumer financial information; providing consumer financial information via a website; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

104. It is considered that these services can be included in the opponent's *providing of information via the Internet in the field of financial services,* and therefore the parties' terms are identical under the principle in *Meric.*

<u>Comparison of goods and services summary</u>

105. Some similarity between goods and services is essential for engaging the test of the likelihood of confusion under section 5(2). In *eSure Insurance v Direct Line Insurance,*[22] Lady Justice Arden stated that:

> "49. ...If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

106. As I have found no similarity for the following goods, the opposition under section 5(2)(b) fails in relation to them:

> <u>Class 9:</u> *Databases, data sets […] relating to individual biometric data; databases, data sets […] relating to individual candidate verification; databases, data sets […] relating to consumer customer profiling; databases, data sets […] relating to individual identity documents; databases, data sets […] relating to individual identity verification and authentication; databases, data sets […] relating to names of individuals; databases, data sets […] relating to public record information about individuals; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.*

107. I will now go on to consider whether there exists a likelihood of confusion under section 5(2)(b) for the class 9 goods, the remaining class 35 services, and the class 36 services which I have found to be either identical or similar (even if only to a low degree) to the opponent's goods and services.

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[22] [2008] ETMR 77 CA

My approach

108. Following my findings in relation to the parties' goods and services, I consider the opponent's '864 mark to be its strongest case due to the greatest similarity or identity of the goods and services. In the event that the opposition fails on the basis of the '864 mark, the other three marks will not improve the opponent's position. As such, I will determine the opponent's claim on the basis of the '864 mark only, referring to it as "the opponent's mark" from this point onwards.

Average consumer and the purchasing act

109. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*,[23] the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)*,[24] where he pointed out that*:*

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling

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[23] [2025] UKSC 25
[24] [2024] EWCA Civ 262

courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

110. The average consumer for the class 9 goods will be professional and business customers, as well as the general public. The cost of purchase is likely to vary, with goods such as credit cards for instance at one end of the spectrum and sophisticated software products at the other. Overall, the goods are likely to be purchased on a fairly infrequent basis. Several factors may influence the average consumer when purchasing software-related goods, such as the effect of the useability, technical function, and the compatibility of the software with existing systems. Several factors may also influence the average consumer when purchasing the card-related goods, such as the compatibility with the intended financial product. Several factors may also influence the average consumer when purchasing the card hardware goods, such as useability, technical function, and the compatibility of the hardware with existing systems. Taking these factors, I find that the average consumer is likely to pay a medium degree of attention when purchasing the goods, although this will be higher for trade and professional customers. I bear in mind that in relation to the assessment of the likelihood of confusion, it is the group of consumers with the lowest level of attention which must be taken into consideration.[25] The goods will be selected from specialist retailers or online, or may be obtained from financial institutions via app stores or websites. The customer will self-select the goods from the display shelves, or by selecting the image of their desired product if purchasing online. The visual component will therefore dominate the purchasing process, but I do not discount aural considerations, such as word-of-mouth recommendations, or placing telephone orders.

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[25] See Case T-247/12, *Argo Group International Holdings Ltd. v OHIM* and *Idem* T -356/14 [25]-[26]

111. The average consumer for the class 35 and 36 services will primarily be the general public, as well as professional and business customers. The cost of purchase is likely to vary greatly, depending on the expertise of the provider and the extent of the services offered. Several factors may influence consumers, such as the expertise and reputation of the organisation providing the services, the availability of the provider, and the suitability for their needs. Taking into account all of these factors, it is my view that the average consumer is likely to pay a medium to high degree of attention, with professional users at the higher end of the scale.[26] The consumer will choose the services after seeing the mark on signage or on the premises. They may also select the services after seeing advertisements or reviews in printed publications or online via websites. The visual component is therefore likely to dominate the selection process, but I also do not discount the role that aural selection may play, especially when receiving word-of-mouth recommendations and when discussing the services with others via the telephone.

Comparison of marks

112. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*[27] 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 relative 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."

113. 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 marks

[26] See *Argo* cited above
[27] Case C-591/12P

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

114. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
AirPlus Connect	AIR

115. In its submissions in lieu, the opponent submits that the overall impression of the opponent's mark "rests solely in the single word AIR", and the applicant's mark is also dominated by the word AIR due to it consisting of the single word AIR. In its submissions filed within the evidence rounds, the applicant submits that "[t]he presence of the suffix "Plus" is a dominant and integral component of the Opponent's marks".

116. The opponent's mark is a word-only mark consisting of the conjoined words "Air" and "Plus" along with a separate word "Connect" (all of which are written in title case). The Cambridge Dictionary defines "Air" as "the mixture of gases that surround the earth and that we breathe" and "the space above the ground". As an ordinary, everyday word, it is my view that this is how at least a significant proportion of consumers will understand the word. The word does not describe or allude to the goods and services, and the term therefore is arbitrary and distinctive in relation to them. It is my view that the word "Plus" will be viewed by the average consumer as a non-distinctive reference to an additional/enhanced service, or an add-on. The word "Connect" is defined in the Cambridge as meaning "to join together two things, or to be joined together". It is my view that the average consumer will understanding this as relating to the concept of the idea of connecting people through the goods and services. Furthermore, as explained previously, the applicant has referred to the word "Plus" and the subsequent word (such as "Connect") in the opponent's mark as being "additional descriptors", so it accepts the descriptive and non-distinctive nature of these words. As the arbitrary word "Air" is distinctive in relation to the goods and services, it is my view that it

dominates the opponent's mark. The words "Connect" and "Plus" still contribute to the opponent's mark's overall impression, but to a lesser degree.

117. The applicant's mark is a figurative mark consisting of the verbal element "AIR" written in upper case in a stylised typeface with a grey rectangle as its background. Due to the principle that the eye is naturally drawn to elements of marks which can be read,[28] it is considered that the distinctive word "AIR" dominates the overall impression of the applicant's mark.

<u>Visual comparison</u>

118. In its submissions in lieu, the opponent submits that the competing marks share a "medium degree of visual similarity" due to the shared use of the word "AIR". In its submissions filed during the evidence rounds, the applicant submits that the competing marks differ as they have "different visual structures".

119. The competing marks are visually similar as they both contain the word "Air"/"AIR". Whilst the opponent's mark is written in title case whereas the applicant's mark is written in upper case in a stylised typeface, the difference does not create a significant visual difference. This is because word marks are protected regardless of the case type, as shown in *LA Superquimica v European Union Intellectual Property Office (EUIPO)*[29], in which the GC held at [39] that word-only marks protect the word or words contained in the mark in whatever case, colour or typeface. The difference in capitalisation and stylisation between "Air" and "AIR" is therefore not significant.

120. The competing marks differ visually as the opponent's mark also contains the words "Plus" and "Connect". The beginnings of marks tend to have more visual and aural impact than the ends,[30] which results in the visual difference created by the additional words at the end of the opponent's mark being less significant. Bearing in mind my analysis of the marks' overall impressions, I am of the view that the competing marks are visually similar to a low to medium degree.

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[28] See paragraph 37 of *Wassen International Ltd v OHIM (SELENIUM-ACE),* Case T-312/03
[29] Case T-24/17
[30] See paragraph 81 of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Aural comparison

121. In its submissions in lieu, the opponent submits that the marks are similar as they "coincide in respect of the single syllable word AIR" and that "the presence of the word 'PLUS' as well as…. 'Connect" in the opponent's mark does not create a notable point of aural contrast". In its submissions filed during the evidence rounds, the applicant submits that "[t]he respective marks differ …aurally".

122. The competing marks are aurally similar as they both contain the same word "AIR", which occurs at the beginning of the opponent's mark. The beginnings of words tend to have more visual and aural impact than the ends,[31] which increases the marks' aural similarity. The competing marks differ aurally as the opponent's mark also contains the words "Plus" and "Connect". Bearing in mind my analysis of the marks' overall impressions, I am of the view that the marks are aurally similar to a low to medium degree.

Conceptual comparison

123. In its submissions in lieu, the opponent does not refer to the degree of similarity but refers to the conceptual meaning of the word "Air" as "neither descriptive nor allusive". In its submissions in lieu, the applicant also argues that the opponent's marks are "unitary composite terms", and that the parties' marks are "conceptually distinct".

124. Although the applicant has argued that the mark consists of a unitary composite term, I do not agree. The phrase "AirPlus Connect" is meaningless when taken in totality, as it is composed of three abstract dictionary words which do not mean anything when presented together. On this basis, it is therefore my view that the average consumer will not understand the three words "Air", "Plus" and "Connect" as conveying a unitary meaning. Instead, I am of the view that the average consumer will understand the words "Air", "Plus", and "Connect" based on their individual dictionary definitions (as cited above), and will view the concepts as being independent of each other. Whilst I acknowledge that the words "Air" and "Plus" are conjoined, it is my view that consumers will readily extrapolate the words' individual meanings on the basis that they are common dictionary words and see them as a random pairing of two

[31] See paragraph 81 of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

separate words, rather than seeing the word “AirPlus” in totality as being a neologism coined by the opponent.

125. The competing marks are therefore conceptually similar as they both contain the same word “Air”/”AIR” which will be interpreted by the average consumer in the same manner.

126. The competing marks differ conceptually as the opponent’s mark also contains the words “Plus” and “Connect”, which have their own conceptual meanings, and which are absent from the applicant’s mark. Bearing in mind my analysis of the marks’ overall impressions, I am of the view that the marks are conceptually similar to a low to medium degree.

Distinctive character of the earlier mark

127. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,*[32] 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

[32] Case C-342/97

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

128. Registered trade marks possess various degrees of inherent distinctive character; marks which are suggestive or allusive of a characteristic of the goods and services tend to be at the lower end of the scale, whereas invented words with no allusive qualities tend to be at the higher end of the scale. A range of marks will fall in between, such as dictionary words with no obvious connection to the goods and services.

129. In its submissions in lieu, the opponent argues that its mark has "a normal degree of inherent distinctiveness". Whilst it acknowledges that the word 'AIR' is "a normal veerday[33] word which the average consumer will be very familiar", it also submits that "it is neither descriptive nor allusive" to its goods and services. In its submissions filed during the evidence rounds, the applicant refers to "the commonplace nature of the word "AIR" and its frequent use across a wide range of industries".

130. As stated previously, the word "Air" in the opponent's mark will be understood based on its dictionary definition. I agree with the opponent that it is not descriptive, non-distinctive or allusive in the context of the goods and services. The words "Plus" will be understood as a non-distinctive reference to an additional element, and "Connect" will be perceive as relating to the connection aspect of the goods and services. Furthermore, as explained earlier, in the applicant's submissions filed during the evidence rounds, the applicant states that the opponent's mark consists of the word 'Air' along "with "Plus" and/or additional descriptors". It is therefore my view that the applicant accepts that "Plus" and "Connect" are "additional descriptors", and therefore as "descriptors" they are descriptive and non-distinctive in nature. However, taking the opponent's mark in totality, I find therefore that it has a medium level of inherent distinctive character due to the inclusion of the distinctive word "Air".

131. Although the opponent has filed evidence of use, I do not consider this evidence to be sufficient for the purposes of demonstrating that the opponent's mark had an enhanced degree of distinctive character at the relevant date of 26 January 2024. Whilst I acknowledge that the evidence demonstrates genuine use of the opponent's

[33] I have interpreted this as a typographical mistake, with the intended meaning "everyday".

marks and sales under these marks in the UK, the evidence does not show what share of the relevant market was held by goods and services sold under the opponent's marks and therefore I am unable to ascertain how significant those sales were. Furthermore, although the evidence contains screenshots of press coverage and newsletters, as well as yearly expenditure on advertising activities, it is my view that this is not sufficient to demonstrate the extent to which the average consumer of the goods within the relevant jurisdiction has been exposed to the opponent's mark. Taking all of these factors into account, I find that the opponent has not demonstrated an enhancement to the distinctiveness of the earlier mark.

Global assessment – conclusions on likelihood of confusion

132. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no set formula for establishing a likelihood of confusion between marks; it is a global assessment where a number of factors need to be borne in mind.

133. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the applicant's mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful 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 that they have retained in their mind.

134. In its submissions in lieu, the opponent submits that there exists a likelihood of confusion between the parties' marks, given the "identity for most of the goods and services to be compared and a high similarity between the remaining foods as well as services and the high similarity of the marks at issue".

135. In its submissions filed during the evidence rounds, the applicant denies that there is a likelihood confusion which would connect the parties' marks, as it submits

that "[t]he Applicant's mark consists solely of the word "AIR" rendered in a distinctive stylised format, with no reference to the word "Plus" or any composite construction that might imply a connection". It states that there is "no basis upon which the average consumer would perceive the Applicant's "AIR" as an offshoot or variant of "AirPlus"".

136. Earlier in this decision I found that the applicant's goods and services range from being identical to having a low degree of similarity to the opponent's goods and services. The average consumer of the goods and services will be professional and business customers, as well as the general public. The average consumer is likely to pay a medium degree of attention when selecting the goods, although this will be higher for professional users. The average consumer of the services will pay a medium to high degree of attention when selecting the goods, with professional users on the higher end of the scale. The goods and services will primarily be selected through visual means, although I do not discount an aural element to the selection process. I have found the marks to be visually similar to a low to medium degree, aurally similar to a low to medium degree, and conceptually similar to a low to medium degree. The earlier mark has a medium level of inherent distinctive character due to the inclusion of the word "Air".

137. It is my view that, even when accounting for imperfect recollection, I consider that the marks' differences are enough to prevent the average consumer to mistake the parties' marks for each other. Whilst the words "Plus" and "Connect" are non-distinctive, they are not negligible in the opponent's mark. They constitute clear differences between the competing marks, and it is unlikely that the average consumer would overlook these additional elements. It is my view that these differences are likely to be sufficient to prevent the average consumer for mistaking the opponent's mark for the applicant's mark (and vice versa). I find this even in respect of goods and services which are identical. Consequently, I find that there is no likelihood of direct confusion.

138. I now go on to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*[34], Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "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

[34] BL O/375/10

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)."

139. I bear in mind that these categories are not intended to be an exhaustive list. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*[35], Arnold LJ approved Mr Purvis's formulation but added:

[35] [2021] EWCA Civ 1207

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

140. It is not sufficient that a mark merely calls to mind another mark (as per *Duebros Limited v Heirler Cenovis GmbH*[36]). This is mere association not indirect confusion. A finding of indirect confusion should not be made merely due to a shared element within marks. As per *L.A. Sugar Limited v By Back Beat Inc*[37] (set out above), indirect confusion should be identified in cases where the average consumer is likely to notice the differences between the competing marks but assume an economic link between the two undertakings based on their similarities.

141. It is my view that, even if consumers recognise the competing marks' differences, these are consistent with a brand extension or brand variant. The word "AIR" is the most distinctive element in the competing parties' marks. I am of the view that consumers will view the removal of the non-distinctive words "Plus" and "Connect" in the applicant's mark as being a brand extension of the opponent's mark. Whilst the applicant's mark also contains stylisation to the word "AIR", this is in line with a brand variant. Consequently, I am of the view that the average consumer, even when paying higher degree of attention, may believe the mark "AIR" to indicate a commercial connection between the respective undertakings due to the identity of the marks' shared element "AIR". On this basis, I find that there is a likelihood of indirect confusion, notwithstanding the differences between the competing marks.

142. However, taking into account the interdependency principle, I do not find this to be the case in respect of the applicant's goods which are only similar to the opponent's goods to a low degree. For these goods, it is my view would be that a significant proportion of consumers would view the marks' similarity as a coincidence rather than

[36] BL O/547/17
[37] BL O/375/10

a shared economic undertaking. This is on the basis that, notwithstanding the common dominant words, the marks are not sufficiently similar and the earlier mark not sufficiently distinctive to result in indirect confusion where there is only a low level of similarity between the goods. The opposition therefore fails in respect of the following goods:

> Class 9: *Consumer database management software; […] software relating to individual biometric data; […] software relating to individual candidate verification; […] software relating to individual identity documents; […] software relating to individual identity verification and authentication; […] software relating to names of individuals; […] software relating to public record information about individuals; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.*

143. It also fails for the goods which I found to be dissimilar to the opponent's goods:

> Class 9: *Databases, data sets […] relating to individual biometric data; databases, data sets […] relating to individual candidate verification; databases, data sets […] relating to consumer customer profiling; databases, data sets […] relating to individual identity documents; databases, data sets […] relating to individual identity verification and authentication; databases, data sets […] relating to names of individuals; databases, data sets […] relating to public record information about individuals; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.*

Conclusion

144. The opposition under section 5(2)(b) has been partially successful. Subject to any successful appeal, the application will be refused registration for the following good and services:

> Class 9: *Consumer credit cards; magnetic consumer cards; encoded consumer cards; consumer chip cards; consumer smart cards; Magnetic data carriers; Card readers for credit cards; credit card terminals; Applications for consumer banking, consumer payments and consumer credit services; computer programs and software for consumer banking, consumer payments and*

consumer credit services; consumer credit bureau software; consumer credit consultancy software; […] software relating to consumer account management (including consumer credit accounts); […] software relating to consumer bank accounts; […] software relating to consumer bank account sort codes; […] software relating to consumer billing; […] software relating to consumer credit application processing; […] software relating to consumer credit assessment and consumer credit screening; […] software relating to consumer credit scorecards; […] software relating to consumer credit strategy management; […] software relating to consumer customer profiling; […] software relating to consumer financial information; Databases, data sets […] relating to consumer account management (including consumer credit accounts); databases, data sets […] relating to consumer bank accounts; databases, data sets […] relating to consumer bank account sort codes; databases, data sets […] relating to consumer billing; databases, data sets […] relating to consumer credit application processing; databases, data sets […] relating to consumer credit assessment and consumer credit screening; databases, data sets […] relating to consumer credit scorecards; databases, data sets […] relating to consumer credit strategy management; databases, data sets […] relating to consumer financial information; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

Class 35: Consumer credit card registration services, provision of consumer credit card rewards based programs; Preparation of monthly statements of account for consumer services; provision of monthly statements for consumer services; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.

Class 36: Consumer banking; consumer financial management; consumer financing services; consumer financial database services; fraudulent consumer credit application detection services; preparation of consumer credit reports; consumer credit application processing services; consumer financial services; consumer monetary affairs; consumer banking credit care services; consumer credit services; consumer credit card services; magnetic card services for consumers; chip card services for consumers; smart card services *for consumers; electronic funds transfer services for consumer services; consumer credit card payment processing; consumer lending services; advisory, consultancy and information services related to all of the aforesaid; Issuance of consumer credit; issuance of prepaid gift cards to consumers; issuance of consumer credit cards; issuance of credit, debit and magnetic cards to consumers; issuance of credit cards and credit lines […] to consumers; Issuance of […] loans to consumers; Processing of consumer credit card payments; consumer e-wallet payment services; processing of consumer debit card payments; consumer debit card services; Savings bank services; Providing consumer financial information; providing consumer financial information via a website; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.*

145. It will proceed to registration for the following goods and services:

<u>*Class 9*</u>*: Consumer database management software; […] software relating to individual biometric data; […] software relating to individual candidate verification; […] software relating to individual identity documents; […] software relating to individual identity verification and authentication; […] software relating to names of individuals; […] software relating to public record information about individuals; databases, data sets […] relating to individual biometric data; databases, data sets […] relating to individual candidate verification; databases, data sets […] relating to consumer customer profiling; databases, data sets […] relating to individual identity documents; databases, data sets […] relating to individual identity verification and authentication; databases, data sets […] relating to names of individuals; databases, data sets […] relating to public record information about individuals; None of the aforementioned in relation to Corporate Payments, Business Travel, Procurement or Travel Trade.*

Costs

146. The opponent has enjoyed the greater degree of success and is entitled to a contribution towards its costs. I note that the opponent submitted a costs proforma on 25 November 2025. However, costs proformas are intended to be completed by

unpresented parties, as all costs for professional representatives are based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances I award the opponent the sum of £1,430 as a contribution towards the cost of the proceedings. I have made a slight reduction[38] in the award to reflect the fact that the opposition was only partially successful. The sum is calculated as follows:

Official fees: £100

Preparing a statement: £220

Preparing evidence £800

Preparing submissions in lieu £310

147. I therefore order THE SCOTCH HOUSE ALBA LIMITED to pay Lufthansa AirPlus Servicekarten GmbH the sum of £1,430. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of August 2026

K SERRAVALLE

For the Registrar

[38] Official fees are not subject to a reduction for partial success