O/0993/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4028595

BY LEVYT LIMITED

TO REGISTER THE TRADE MARK:

IN CLASS 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 448614

BY DRIVETIME SALES AND FINANCE COMPANY, LLC

BACKGROUND AND PLEADINGS

1. On 20th March 2024, Levyt Limited ("the applicant") applied to register the trade mark shown on the cover of this decision in the United Kingdom. The application was accepted and published in the Trade Marks Journal on 19th April 2024, in respect of the following service:

   Class 42: *Software as a Service (SaaS) offering software for comprehensive car history checks.*

2. On 15th July 2024, Drivetime Sales and Finance Company, LLC ("the opponent") opposed the application based on Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the services in the application. The opponent relies upon the earlier mark, an International Registration, ("IR") shown below:

   WO0000001622232
   CARFI

   Registered on 15th September 2021 and protected in the UK on 5th May 2022, with a US priority date of 18th March 2021.

   Relying upon the following services:

   Class 35: *Automobile dealership services*

   Class 36: *Automobile financing services*.

   Class 42: *Software as a service (SAAS) services featuring software for online financing in the field of automobiles; software as a service (SAAS) featuring software for lending optimization in the field of automobiles.*

3. The opponent's IR qualifies as an "earlier trade mark" in accordance with Section 6 of the Act, as its priority date is earlier than the filing date of the applicant's mark. Since the opponent's earlier mark had been protected for less than five

years at the filing date of the applicant's mark, it is not subject to the use provisions specified in Section 6A of the Act.

4. Under Section 5(2)(b), the opponent claims that the marks are visually similar and aurally and conceptually identical. It goes on to claim that its IR enjoys a heightened level of distinctiveness due to it being an invented word with no meaning. In terms of the services, it deems the applicant's services are highly similar in all three classes. Therefore, that there exists a likelihood of confusion on the part of the public between the two marks which includes likelihood of association.[1]

5. The applicant counters in its witness statement (attached to its defence and counterstatement) that the opponent's mark is not an invented word but instead an abbreviation of "car finance", and therefore descriptive of its products and services.[2] It claims there is no aural or conceptual similarity between the two marks. It also asserts its services are "not remotely similar" to those protected by the opponent's IR and that its "service offering is sufficiently distinct to not cause confusion or competition".[3]

6. In these proceedings, the opponent is represented by Brabners LLP and the applicant by its technical director and shareholder, Kambiz Karimi.

PRELIMINARY ISSUES

7. Some important points are apparent from the submissions which I intend to address before going any further into the merits of this opposition.

Representation of the earlier mark

8. The applicant's witness statement states there are "clear and obvious differences in our brands, both in respect of the mark we have applied for and the wider features of our branding, like our mascot" which "distinguish" and "eliminate any

[1] Paragraphs 11, 12, 13 and 18 of statement of grounds dated 15th July 2024.
[2] Paragraph 6 of witness statement dated 4th October 2024.
[3] Ibid., paragraphs 13 and 24.

possibility of confusion".[4] It is unclear what wider branding or mascot the applicant is referring to. Nevertheless, this is immaterial as my assessment in this decision must take into account only the applied for mark and any potential conflict with the opponent's earlier mark.

9. In its submissions the opponent refers to, what it deems, false claims by the applicant regarding its mark. My understanding here is that the opponent is referencing the applicant's use of formatted text (bold orange typeface) within the body of the text in the witness statement submitted by Mr Karimi. For example, at paragraph 11. I do not agree with the opponent's suggestion that this was "disingenuous" behaviour by the applicant or an attempt at falsely claiming the mark as something other than that as filed.[5] However, for the avoidance of any doubt, I reiterate here that the basis of my assessment is made on the trade mark as applied for (regardless of any other marketing/use) and the visual representation of the mark as it appears on the UK trade mark register, as shown on the cover of this decision.

Specification of the earlier mark and the services applied for

10. The applicant admits that "while our application concerns software as a service, we conclude that we do not actually supply software to our users", and instead sells a "physical and downloadable report on a vehicles *[sic]* history*".*[6] The applicant continues that "it may be reasonably argued that our services more appropriately fall under the description of 'industrial analysis and research services'…still a category that falls under class 42" and which it still deems as different to the opponent's services.[7] In response to these arguments, I am mindful that any differences between the actual services provided by the parties are not relevant unless those differences are apparent from the applied for and protected marks. Thus, if the applicant has applied for a class which does not accurately reflect its business (which appears to be the suggestion here), I am unable to take this into account, and it would be incorrect for me to do so.

[4] Paragraph 41 of witness statement.
[5] Paragraph 20 of written submissions dated 5th December 2024.
[6] Paragraph 14 of witness statement
[7] Ibid., paragraph 15.

Grounds for opposition

11. Within its submissions, the opponent invites me to find that the applicant's mark was filed in bad faith.[8] I note that no grounds for opposition have been pleaded based upon Section 3 of the Act, and no application has been made to add Section 3(6) as a ground of opposition; therefore, I will not comment on this further.

12. Similarly, the applicant quotes various law within the conclusion of the witness statement provided by Mr Karimi which is not relevant to the opposition at hand. At paragraph 42, the applicant references section 10(3)(b) of the UK Trademark *[sic]* Act. This sub-section of the legislation has been repealed and is therefore of no relevance to this opposition, which is being made under Section 5(2)(b).[9]

13. A paragraph 43, the applicant quotes it is the earliest user of the mark in the UK and "protected by the common law". However, there is no application for invalidation of the opponent's earlier mark and thus no assessment to be made on this: see Tribunal Practice Notice 4/2009 at paragraphs 4 and 5.

EVIDENCE AND SUBMISSIONS

14. Both sides filed evidence. The applicant filed its evidence at the pleadings stage, in the form of a witness statement dated 4th October 2024 and accompanied by 15 exhibits. It denies any aural or conceptual similarity between the two marks. Further, it asserts that the opponent's 'CARFI' mark is not a made-up word but instead descriptive of their services in relation to car finance. A large proportion of the evidence comprises of screenshots from the internet (e.g. online search engines and financial websites) to demonstrate the applicant's view that the use of 'FI' is "common worldwide" and "widely recognized as shorthand for finance…in company or brand names to indicate a financial connection".[10] The remainder of the applicant's evidence touches upon the opponent's operations and also its marketing in the US.

[8] Paragraphs 25 and 26.
[9] Further, Section 10 of the Act relates to infringement which is a matter for the courts.
[10] Paragraphs 7 and 8 of witness statement.

15. The opponent filed written submissions and evidence consisting of a witness statement (dated 5th December 2024 by Hayley Morgan), with 10 accompanying exhibits. A proportion of the opponent's submissions covers considerations I have already dealt with as preliminary issues above (paragraphs 8-9) so I will not reiterate them below. The exhibits focus on car dealerships, car history checks and car financing on dealership websites, and news articles/websites to support the prominence of the two dealerships quoted.

16. No hearing was requested, therefore this decision is taken following careful consideration of all the papers before me. I have not summarised the evidence and the submissions in full, but they will be referenced within this decision to the extent that is necessary.

DECISION

Section 5(2)(b)

17. Section 5(2)(b) of the Act is as follows:

> "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."

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."

18. In considering the opposition under this section, I am guided by the following principles which are taken from the decisions of the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM"),* Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:[11]

The principles

(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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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

[11] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

(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 SERVICES

19. It is settled case law that I must make my comparison of the services on the basis of all relevant factors. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. Additionally, in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court of the European Union (“GC”) stated that:

> “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 für 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."

21. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, 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."

22. The services to be compared are as follows:

The applicant's services	**The opponent's services**
Class 42: *Software as a Service (SaaS) offering software for comprehensive car history checks.*	**Class 35**: *Automobile dealership services.* **Class 36**: *Automobile financing services*. **Class 42**: *Software as a service (SAAS) services featuring software for online financing in the field of automobiles; software as a service (SAAS) featuring software for lending optimization in the field of automobiles.*

23. The opponent claims that the applicant's services are highly similar to all three of the classes protected under its IR. In his witness statement for the applicant, Mr

Karimi states that the applicant's service offerings are "not remotely similar" to the opponent's IR because the applicant is:

- "not at all involved in automobile dealing"
- "not at all involved in automobile financing"
- "not at all involved in software as a service to optimise automobile financing".[12]

With respect class 42, the opponent states the services between the applicant and opponent have the same uses, users and identical trade channels.[13]

24. Neither side has provided an explanation of the term Software as a Service (SaaS). My understanding is that this refers to cloud-based software applications available to users via the internet. The opponent's services relate to online financing and lending optimisation, whereas the applicant's focusses upon car history checks. The opponent uses this as the basis for its claim that the respective services have "the same uses, namely checking/analysis relating to cars/automobiles with a view to purchase".[14]

25. I note the difference highlighted by the applicant that its services relate to checking and analysis of the *vehicle* prior to purchase, whereas the opponent's services may also relate to checking and analysis of the *purchaser* of the vehicle, specifically in relation to securing finance[15]. The applicant suggests this is a sufficient basis to find that the customers or products would not conflict with each other. However, I disagree. The users of these services would often still be the same, such as those seeking to purchase a vehicle or a business consumer, such as a car dealership, accessing these services for their customer. The trade channels would also be the same. This is supported by the opponent's Exhibits HM2 and HM3 which show car financing and car history services being offered on the same Auto Trader website. Exhibit HM2 (page 5) invites customers to "shop for your next car on Auto Trader and use the calculator on our adverts to quickly work out your monthly payments". Exhibit HM3 (page 3) details the option

[12] Paragraph 13.
[13] See paragraph 61 of written submissions.
[14] Paragraph 61 of written submissions.
[15] Paragraph 24 of witness statement.

of a “full vehicle check from Auto Trader” which includes information on the car’s history such as “any outstanding finance”, “number of previous owners” and “date of first registration”. While this exhibit does not specifically reference this being delivered via SaaS, the offering appears to correspond with the nature of the applicant’s services and supports the finding that the users and trade channels are the same.

26. I recognise that the services are not wholly dependent upon each other and are not in competition. There are circumstances where the applicant’s services may be utilised but the opponent’s not, i.e. when an individual intends to purchase a vehicle (and carries out a car history check) but is a cash buyer and therefore does not require a finance or lending package. The opponent’s written submissions deem that “it is inherently necessary to conduct history checks” on the subject vehicle of a finance agreement, that “financing services…are not provided without conducting car history checks” and “it is impossible for a consumer to obtain a vehicle financing plan without one entity, usually the automobile dealership, conducting history checks”.[16] I cannot find anything in the opponent’s evidence to support the notion that a car history check is a compulsory step in securing finance on a vehicle but I do agree that it appears highly recommended (and standard) practice.[17] The opponent’s evidence at Exhibit HM3 includes information from the Auto Trader website detailing how all cars listed have a free “five-point background check” and that “it’s important to get a vehicle check done”. Therefore, for those purchasing a car using finance, I consider that the services are complementary, with a car history check featuring as part of the standard purchasing process and to the extent that the relevant consumer could think that the same provider offers both. Indeed, that can be the case, as found through Exhibits HM2 and HM3 discussed at paragraph 25 above.

27. The applicant makes the point that the opponent’s services in class 42 “must necessarily target other authorised lenders for the provision of software, who are not our intended market audience”, therefore claiming that their target consumers

[16] Paragraphs 74 and 75.

[17] I note Exhibit HM10 details that “Approved used cars often come with added benefits like…a detailed history report” which supports the notion that they are beneficial, but not compulsory.

are distinct.[18] Regarding the "intended market audience," I am mindful that my assessment must be made on what is notionally covered by the services in each party's specification.[19] This is a recurring issue within the applicant's submissions, therefore I cover this in more detail at paragraph 51 below.

28. It is not clear to me why the applicant considers the users of its service as the public at large (i.e. individuals buying a vehicle) whereas that the same cannot apply to the opponent's services. This appears to be based on the fact that the opponent also has "*automobile financing services*" protected under class 36 and a suggestion by the applicant that this leads to some kind of interrelationship between the opponent's class 36 and class 42 services which (it deems) would require authorisation by the Financial Conduct Authority.

29. Regardless of whether particular authorisation is required in order to *provide* a particular service, I cannot find anything in the applicant's evidence to support the claim that the opponent's services must be *accessed* only by users with particular authorisation. I consider it entirely feasible that a prospective car buyer could access a cloud-based software application for a car history check, then utilise a similar application to research which finance offerings (optimised to their particular circumstances) may be available to them in order to purchase that car, or vice versa. Even if there were circumstances where the opponent's SaaS cannot be used by the public at large, I still consider that the respective services would share common commercial users. For example, where a car dealer or broker would utilise SaaS to provide both car history and financial analysis (such as lending optimisation) to its customers. The opponent alludes to this in paragraph 62 of its written submissions. The applicant also addresses this possibility in paragraphs 26 and 27 of Mr Karimi's witness statement, albeit disputing the order in which a customer may access the respective services. I do not find the ordering of the two actions an issue, since this line of argument supports the finding that the services may be utilised by the same customers, via the same trade channels, and are complementary to each other, regardless of

[18] Paragraph 21 of witness statement.

[19] In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* Case C-533/06, at paragraph 66, the CJEU stated that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

the sequencing.

30. Taking all of the above into account, I consider the services in class 42 similar to a medium degree. I consider that the applicant's services would also be similar to the opponent's "a*utomobile financing services"* in class 36 to a medium degree, for the same rationale as outlined above. They share the same users in relation to purchasing a vehicle, with the same trade channels and are complementary. Finally, in relation to the opponent's "*automobile dealership services"* in class 35, these only overlap in users insofar as members of the general public. For this group, the trade channels would be similar and the services would be complementary, therefore I consider the opponent's class 35 services and the applicant's class 42 services similar to a low to medium degree.

The average consumer and the nature of the purchasing act

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

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

32. The opponent has not made specific submissions regarding the average consumer or purchasing act. In his witness statement on behalf of the applicant, Mr Karimi has commented on "the average diligent consumer" and accessing its

services as “an act of diligence”.[20]

33. I have already made some comments about the average consumer as part of the comparison above. For the class 42 services, the average consumer would be a member of the general public seeking to purchase a vehicle, or a business consumer such as a car dealership (who may also be acting as a broker) accessing these services on behalf of their customer. The same would apply for the opponent’s class 36 “a*utomobile finance services*”, whereby these are accessed by the car purchaser directly, or a dealership/broker acting as an intermediary. Regarding the class 35 “a*utomobile dealership services”* the average consumer would only be members of the general public.

34. On the nature of the purchasing act, it is expected this would be an infrequent but well considered transaction. A high level of attention would be expected from consumers, in relation to choosing an automobile dealership (the opponent’s class 35) and the applicant’s class 42 software services, to ensure the vehicle being purchased was suitable and fit for purpose. Arguably, the level of attention may be slightly higher for the opponent’s services in class 42 and 36 due to the financial agreement being entered into and customers comparing lending products for their suitability.

Comparison of the marks

35. 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 Case C-591/12P, *Bimbo SA v OHIM*, 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

[20] Paragraph 37.

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."

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

37. The respective marks are shown below:

Applicant's contested mark	Opponent's earlier mark
carfie	**CARFI**

Overall Impression

38. Both marks comprise of a single word in which the overall impression resides. The opponent's mark, 'CARFI' is in upper case and standard black typeface, whereas the applicant's 'carfie' mark is in lower case with a subtly stylised typeface and an orange/red colour[21]. This stylisation plays only a small role overall. Further, the fact that the earlier mark is protected in plain, upper case, whereas the contested mark is sought to be registered in the stylised orange/red lower case is immaterial. In paragraph 39 *of LA Superquimica v European Union Intellectual Property Office,* Case T-24/17, the GC held that such plain word marks protected the word contained in the mark in whatever form, colour or typeface used.

[21] I note that the applicant and opponent differ in their assessment of the colour, perceiving them as orange and red respectively but the case does not turn on this point.

Visual similarity

39. The opponent submits that there is a high degree of visual similarity whereas the applicant denies similarity. The marks both consist of the same first five letters 'CARFI', with the applicant's mark featuring an additional "E" at the end. Thus, the opponent's mark is found within the applicant's mark in its entirety and in a position to which the average consumer usually pays more attention; i.e. the beginning of the mark.[22] I find that the applicant's mark is visually similar to the opponent's mark to a high degree.

Aural similarity

40. The opponent highlights that, as invented words, there is no accepted pronunciation for either of the marks. Both sides agree that the first syllable of both marks would be articulated as 'CAR'. In terms of pronunciation, the applicant suggests this would be 'CAR-FEE' for its mark, versus 'and 'CAR-FYE' for the opponent's mark.[23] The opponent does not provide a view on the full pronunciation of the marks, beyond the opinion that they would be, or would be very likely to be, pronounced identically.[24]

41. In terms of my own assessment, I believe that the both marks would be readily pronounced as 'CAR-FEE' in which case they would be aurally identical. Or alternatively, both identically as 'CAR-FYE'. I agree a proportion of the relevant consumer may pronounce the ending of the marks slightly differently, i.e. 'CAR-FEE' versus 'CAR-FYE'. In these instances, then the marks would be aurally similar to a high degree.

Conceptual similarity

42. The opponent claims that the marks are conceptually identical. The applicant claims that its mark is "completely invented", whereas the opponent's mark is not, is instead an abbreviation of "car finance" and descriptive of its products and

[22] El Corte *Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[23] Paragraphs 10 and 11 of witness statement.
[24] Paragraphs 49 and 50 of written submissions.

services.[25] The applicant claims its evidence provides examples where two descriptive terms are combined to convey the services offered. It seeks to argue that 'FI' is "widely recognized as shorthand for finance…is commonly used in company or brand names to indicate a financial connection" and "appears both as a prefix and suffix globally".[26] Some of the examples provided include:

- A Wikipedia definition of decentralized finance, also stylised as "DeFi" and use of this term on the website "fidelity.com" (within Exhibit KK1).
- A Google definition of "TradFi" which refers to traditional finance (within Exhibit KK2).
- Use of the terms "DEFI" and "TRADFI" on the International Monetary Fund's website (within Exhibit KK2).
- The website of a personal loan company "SoFi" (within exhibit KK5).
- The UK based website for recruitment company "FiSearch" (within exhibit KK9).[27]

43. I do not consider that the evidence provided demonstrates widely recognised or common use of the term "FI", especially in relation to the average consumer as identified at paragraph 33. Many of the exhibits are undated and appear to concern the definition of financial terms aimed at specialist or technical audiences, such as those who are finance professionals. For those examples which do appear to be targeted at the general public, they do not clearly relate to the UK market (which must be the relevant market for this assessment) or are unclear regarding the use of "Fi" as an abbreviation for finance.[28] The only example which expressly relates to the UK is "FiSearch" (Exhibit KK9), which relates to finance recruitment and is therefore targeted at a different relevant consumer.

[25] Paragraphs 5, 6 and 11 of witness statement.
[26] Ibid., paragraph 7.
[27] This is a selection of examples found within in the exhibits, not an exhaustive list. I confirm I have reviewed and considered all the evidence provided.
[28] For example, "SeedFi" (Exhibit KK4) , "SoFi" (Exhibit KK5) and "Lemfi" (Exhibit KK7) which are all '.com' websites. The "SeedFi" and "SoFi" sites use Americanisms such as US spelling and dollar signs in their content. I note the "Lemfi" site utilises the Union flag, though this serves only as a means to select English as the display language, rather than indicating the site relates to the UK. Fiserv.com (Exhibit KK6) references the United Kingdom but only insofar as a separate link to be redirected to that "local" site.

44. The opponent does not comment on whether its mark is indeed an amalgamation of “car” and “finance”. On considering this point I am mindful that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz-Picasso & Others* v *OHIM.*[29] Even if ‘FI’ was readily understood by the consumer as an abbreviation of “finance” (though I do not believe this to be the case, as outlined above), I consider that the identification of the ‘CAR’ and ‘FI’ elements to refer to car finance would involve an extra step of analysis by the average consumer, and I remind myself that the mark must be assessed by reference to the overall impressions created by the marks. Consequently, I am satisfied on both of these fronts that the average consumer will see “CARFI” as an invented word.

45. Therefore, I consider that both marks are invented words. Conceptually, both begin with the dictionary word “Car” relating to the mode of transport which may be allusive to their services in relation to these vehicles. Taking these considerations this into account, I consider that neither mark is likely to convey any specific meaning to the average consumer beyond a potential affiliation with cars. For those consumers who see the marks as invented words, the marks are conceptually neutral. For those consumers who perceive a link to cars, they are conceptually similar to a high degree.

Distinctive character of the earlier mark

46. Distinctive character is a measure of how strongly the earlier mark identifies the services for which it is protected (and on which it may rely), determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identifies the services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

> “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

[29] Case C-361/04 P

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).

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

48. The opponent has not filed evidence about the use it has made of its mark. Consequently, I have only the inherent position to consider. It does claim that its IR enjoys a heightened level of distinctiveness due to it being an invented word with no meaning. In light of the assessment at paragraph 45 that the earlier mark is an invented word but which may, for some consumers, be allusive to its services in relation to cars, I consider it to have a higher than average (but not the highest) level of inherent distinctiveness.

GLOBAL ASSESSMENT – conclusions on likelihood of confusion

49. 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 services down to the responsible undertaking being the same or related.

50. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to

be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing act. In doing so, I must take into account the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

51. As referenced above, the applicant's arguments also bring into play differences between their respective services and elements of the opponent's operations. This includes claims relating to authorisation by the Financial Conduct Authority, the opponent's outsourcing of services, its use of alternative brand names in US marketing and a lack of presence/reputation in the UK market. This is not relevant to the comparison which must be made on the basis of the 'notional' coverage of the terms in the specification. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd (*[2004] RPC 41) like this:

> "22. […] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

52. Any associated authorisation by the Financial Conduct Authority or marketing by the opponent in other jurisdictions is immaterial to this. Further, the opponent's mark has not been protected for five years at the date on which the application was filed. Therefore, the proof of use provisions do not apply and the opponent is not required to prove use for any of the services for which its mark is protected.

53. To summarise my global assessment so far, I have identified the average consumer to be a member of the general public (purchasing a car) or a business such as a vehicle dealership. They will select the services through visual means, word-of-mouth recommendations and discussions with salespersons (and thus aural considerations) may also play a part. The services will be purchased infrequently and the degree of attention paid will be high. I have found the parties' services to have a medium/medium-low similarity and concluded the parties' marks are visually and aurally similar to (at least) a high degree. They are conceptually neutral or similar to a high degree, depending on their interpretation by the average consumer. Finally, I have found the earlier mark to have a slightly higher than normal degree of inherent distinctive character.

54. Taking all of this into account, I consider it likely that the marks will be mistakenly recalled or misremembered as each other, especially as there is no conceptual hook to separate the two from each other. In my view, there is a likelihood of direct confusion, even allowing for the high attention to detail associated with purchasing decisions for these services.

CONCLUSION

55. The opposition under section 5(2)(b) succeeds.

COSTS

56. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. Despite claims from the opponent regarding failings by the applicant leading to "disproportionately increased" costs, I have found no evidence of unreasonable

behaviour by the applicant to warrant an award to be made off the scale.[30] I have factored in the consideration of the evidence attached to the counterstatement in the evidence award. In the circumstances, I award the opponent the sum of £950.00, calculated as follows:

Fee for opposition form	£100
Preparing a statement and considering the other side's statement	£250
Preparing evidence and considering the others side's evidence	£600
Total	**£950**

57. I therefore order Levyt Limited to pay Drivetime Sales and Finance Company, LLC the sum of **£950.00**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of October 2025

C IRELAND

For the Registrar

[30] Paragraphs 18 and 19 of witness statement.