

o/1001/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3514148

BY HEADSPRING, LLC

TO REGISTER THE TRADE MARK:



IN CLASSES 9, 35 & 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001540

BY Headspring Ltd

Background and pleadings

1. On 21 July 2020, Headspring, LLC (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 4 September 2020. The goods and services applied for are as follows:

Class 9: Computer hardware, firmware and software; computer software and hardware relating to computer aided design, computer aided manufacture and computer aided engineering; computer software and hardware relating to open source software, mobile and web application development, software security, messaging tools and messaging platforms, cloud migration, predictive analytics (Artificial Intelligence); graphics computer software and hardware; computer software and hardware relating to geospatial analysis; computer software and hardware relating to computer virtualisation; computer peripherals; computer printers; data processing equipment; computer apparatus and telecommunications apparatus; computer apparatus for the storage of data; computer data storage apparatus; computer installations for the storage of data; computer memory storage apparatus; computer networks for the storage of data; computer storage apparatus; security devices for computer hardware and software; mobile telephone software, software to enable the viewing of website content via personal and handheld computers and mobile devices; downloadable software in the nature of a mobile application; downloadable mobile application software; downloadable software for use in wireless telecommunication devices; computer software; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other network (including websites); downloadable software in the nature of a mobile application and downloadable mobile application software relating to financial services, financial advice and financial analysis; predictive analytics software; data analysis software; electronic publications; information stored on electronic, magnetic and/or optical means; components, parts and fittings for all the aforesaid goods.

Class 35: Business and commercial data analysis services; preparing statistics and reports for businesses regarding computer software and technology; business consulting services in the fields of technology, namely, cloud computing, cloud migration, computer software, predictive analytics (Artificial intelligence), global broadband penetration, and technology-enabled systems integration featuring collaboration tools to facilitate development and maintenance of a remote work infrastructure and business infrastructure ; business consulting services in the field of technology, application development and management, cloud architecture and infrastructure set up, cloud app assessment, cloud app re-platform, cloud security and co-production; business consulting services in the field of remote business processes and business transformation; advisory, information and consultancy services relating to all of the aforesaid.

Class 42: Design, development, maintenance and updating of computer software; design, development, maintenance and updating of open source software, mobile and web applications, software security programmes and applications, messaging tools and messaging platforms, cloud migration, predictive analytics (Artificial Intelligence); computer programming services; computer network services; development and maintenance of computer networks; consultancy services relating to computer security; provision of information and preparation of reports relating to computer software, computer hardware and computer firmware; computer services, namely, cloud computing, global broadband penetration, and technology-enabled systems integration featuring collaboration tools to facilitate development and maintenance of a remote work infrastructure; computer services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; design and development of computer software in the field of mobile applications; Internet-based application service provider, namely, hosting, managing, developing, analyzing and maintaining the code, applications, and software for others; Information technology consulting services; Installation, implementation, maintenance, and repair services with respect to computer software; Technical support services, namely, remote infrastructure management services for the

monitoring, administration and management of public and private cloud computing IT and application systems; Quality assurance services relating to the development of computer security systems and contingency planning for information systems; Business services, namely, developing and managing cloud architecture, mobile applications and data security solutions; outsource service provider in the field of information technology; provision of an IT helpdesk for third party companies and businesses; services for software development, software updating, design, installation, maintenance and rental of software; computer software design and development services; design and development of mobile application software; application service provider (ASP) services; providing temporary use of non-downloadable software; providing temporary use of non-downloadable software to enable the viewing of website content via personal and handheld computers and mobile devices; provision of non-downloadable software applications through a website, virtual community, social networking site, shared use of text, images and audio-visual content; rental and maintenance of memory space for others (hosting), software development services; providing temporary use of non-downloadable software; providing temporary use of non-downloadable software to enable the viewing of website content via personal and handheld computers and mobile devices; provision of IT support to third parties online or offline; creation and maintenance of the aforesaid; advisory, consultancy and information services relating to all of the aforesaid .

2. The application was opposed by Headspring Ltd (“the opponent”) on 3 December 2020. The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. The opponent relies on the following trade mark:

UK3332883

HEADSPRING

Filing date: 20 August 2018

Registration date: 23 November 2018

Relying upon all goods and services for which the earlier mark is protected, namely:

Class 9: Software applications delivered online through a web-browser; software applications delivered as a downloadable application; software applications delivered to any computing device including desktop, laptop, wearable computer peripheral, tablet computer and/or mobile device; computer software for teaching, instructional and educational purposes; teaching apparatus and/or instruments; instructional apparatus and/or instruments; downloadable MP3 files; recorded content; digital media; electronic publications; downloadable electronic publications; downloadable electronic publications in the nature of newspapers, magazines, periodicals, leaflets, catalogues, newsletters, directories and books; articles, columns or written/published articles contained and/or supplied in or by electronic media; published material in digital format; e-books; downloadable ebooks; publications in electronic form, supplied on-line from databases or from facilities provided on the Internet; electronic publications delivered online as a downloadable application or application delivered to any computing device including desktop, laptop, wearable computer peripheral, tablet computer and/or mobile device; optical, electronic and magnetic data storage devices bearing recorded information; DVDs; CDs; hard disks; pre-recorded audio and/or video cassettes; compact discs; floppy discs; podcasts; vodcasts; blogs; electronic databases; information stored in electronic, digital and/or magnetic form; educational apparatus and/or instruments; electronic devices for providing access to the Internet or viewing information on global computer networks; speech recognition equipment for use in education; computer software for the collection and the distribution of visual images, data, video, audio material, audio visual material and information; computer software for processing images, graphics, audio, video, and/or text; computer software for transmission and display of digital content, audio works, visual works, audiovisual works, electronic publications, books, movies, and music; computer software for browsing and accessing digital content, audio works, visual works, audiovisual works, electronic publications, books, movies and/or music;

computer software for collecting, editing, modifying, organizing, synchronizing, integrating, monitoring, transmitting, storage and sharing of data and/or information; computer software; computer software for cloud computing; computer software for use in cloud infrastructure management; computer software for running cloud computing based applications; computer software development tools; interfaces for digital content management of wired and wireless electronic devices for accessing, storing, transmitting, and/or sharing of data, information, text, images, audio, video, and/or multimedia content.

Class 16: Printed matter; printed publications; books; newspapers, periodicals, journals, textbooks, catalogues, magazines, leaflets, newsletters, posters, charts, directories and calendars; articles, columns and written/published articles contained and/or supplied in or by print media; instructional and teaching materials; paper and cardboard; educational course certificates; educational or training award certificates; diplomas; course notes; study guides; pamphlets; journals; newsletters; prospectuses; catalogues; handbooks; stationery; pictures; note books; note pads; forms; calendars; writing instruments; pens; pencils; pencil cases; pencil sharpeners; erasers; rulers; writing materials; book marks; pennants; badges made of paper and cardboard; maps; address books; prints; posters; wall charts; postcards; labels; adhesive stickers; greeting cards, diaries; photographs; graphic prints.

Class 35: Business advisory services; business assistance; business appraisals; business information; marketing and promotional services; business development services; arranging and conducting business conferences and events, commercial exhibitions and trade show exhibitions; business introductory and meetings services and business networking services; provision and dissemination of information relating to business introductory services and business networking services; consultancy, advisory and information services for all the above services.

Class 41: Education services; training services; examination services; design and provision of educational and training programmes; design and provision of courses and examinations; providing education accreditation; certification of

education training and awards; education services relating to business and/or business services; planning, arranging and conducting educational events; provision of training; conducting correspondence courses; providing training and/or education events; providing exhibitions, conferences, seminars, workshops and networking events; teaching, research, instruction and education by means of a computer database; providing access to video and audio materials for education; providing feedback for teachers on pupils' progress; training of teachers; computer assisted teaching services; online education for the assessment and improvement of student learning or teacher training; provision of distance learning for adult education; publishing services; publishing of electronic publications; electronic publishing services; provision of online-electronic publications; publishing services provided by means of the Internet and world-wide web; provision of teaching materials online; distribution of printed or electronic materials relating to education; development and dissemination of teaching material; provision of digital handbooks, instructional handbooks, and educational materials in the field of education; organization of competitions, awards, quizzes, games and recreational activities; organizing and arranging of cultural and entertainment events; production, presentation, provision and distribution of films, blogs, webinars, podcasts, vodcasts and news feeds; consultancy, advisory and information services relating to the above services.

Class 42: Application hosting services for digital networks; platform as a service (PAAS); software as a service (SAAS); software as a service for use in providing education services; providing non-downloadable software applications; provision of temporary use of non-downloadable computer software for use in the creation and publication of online education materials; providing temporary use of on-line non-downloadable software for publishing and sharing digital media and information via global computer and communication networks online; hosting of digital content on the internet; application service provider featuring application programming interface (API) software for accessing and searching for content and data in electronic publications and on online databases; application hosting; software development in the field of mobile applications; application service provider,

namely, hosting, managing, developing, and maintaining applications, software, and web sites; cloud computing services; leasing, hire and rental of computer hardware, computer software and computer programmes; electronic data storage; creating, managing, developing, designing, maintaining and/or hosting of websites; installation, maintenance, upgrading and repair of computer software; designing, managing and monitoring online forums for discussion; online services, namely, providing secure online data storage; providing temporary use of on-line non-downloadable cloud computing software for use in electronic storage of data; cloud hosting of electronic databases; advisory, information, management, consultancy and technical support relating to all the above services.

5. The opponent claims that the marks are identical save for the device element in the applicant's mark which they suggest will go unnoticed by the average consumer. In the alternative, it argues that the marks are visually highly similar and phonetically and conceptually identical. The opponent also claims that the applicant's goods and services are either identical or highly similar to their own services. It concludes that in the opinion of the opponent, the identity or high degree of similarities mean that there is a likelihood of confusion which is increased by the distinctive character of the earlier mark.

6. The applicant filed a counterstatement denying the claims made. It claims that its mark is figurative, coloured and features the yellow device and is therefore visually strikingly different. It also argues that these differences make the marks conceptually different.

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file any evidence in respect of these proceedings.

9. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; however, the opponent did file written submissions in lieu. This decision is taken following a careful perusal of the papers.

10. The applicant is represented by HGF Limited and the opponent is represented by Sipara Limited.

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

12. Section 5(1) of the Act is as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

13. Section 5(2)(a) of the Act is also being relied upon and is as follows:

“5(2) A trade mark shall not be registered if because-

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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”.

14. Section 5(2)(b) is also being relied upon and is 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”.

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6. (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

16. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2, above, which qualifies as an earlier trade mark under the above

provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

Sections 5(1) and 5(2)(a)

17. Sections 5(1) and 5(2)(a) require the marks to be identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

18. I note that the opponent’s mark is a word mark and that the applicant mark is a figurative mark. I bear in mind the following from Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14 found that:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

19. However, the applicant mark has the addition of a device element, which I will address further later in this decision. I do not agree with the opponent that this device will go unnoticed by the average consumer. For the purposes of sections 5(1) and 5(2)(a), it is enough to distinguish the marks from being identical and therefore, the opposition fails under sections 5(1) and 5(2)(a). I will therefore go on to compare the marks under section 5(2)(b).

Section 5(2)(b)

Case law

20. The following principles are gleaned from the decisions of the EU courts 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:

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

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

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

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

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

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

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

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

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

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

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

Comparison of Goods and Services

21. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

22. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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".

23. 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.

24. In *Gérard Meric v OHIM* ('Meric'), Case T-133/05, the General Court ("the 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".

25. For the purposes of considering the issue of similarity of goods, 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 (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

26. In *Boston Scientific Ltd v 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".

27. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

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

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

29. The goods and services to be compared are shown in the table below:

Applicant Goods & Services	Opponent Goods & Services
<p>Class 9: Computer hardware, firmware and software; computer software and hardware relating to computer aided design, computer aided manufacture and computer aided engineering; computer software and hardware relating to open source software, mobile and web application development, software security, messaging tools and messaging platforms, cloud migration, predictive analytics (Artificial Intelligence); graphics computer software and hardware; computer software and hardware relating to geospatial analysis; computer software and hardware relating to computer virtualisation; computer peripherals; computer printers; data processing equipment; computer apparatus and telecommunications apparatus; computer apparatus for the storage of data; computer data storage apparatus; computer installations for the storage of data; computer memory storage apparatus; computer networks for the storage of data; computer storage apparatus; security devices for computer hardware and software; mobile telephone software, software to enable the viewing of website content via personal and handheld computers and mobile devices; downloadable software in the nature of a mobile application; downloadable mobile application software; downloadable software for use in wireless telecommunication devices; computer software; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other network (including websites); downloadable software in the nature of a mobile application and downloadable mobile application software relating to financial services, financial advice and financial analysis; predictive analytics software; data analysis software; electronic publications; information stored on electronic, magnetic and/or</p>	<p>Class 9: Software applications delivered online through a web-browser; software applications delivered as a downloadable application; software applications delivered to any computing device including desktop, laptop, wearable computer peripheral, tablet computer and/or mobile device; computer software for teaching, instructional and educational purposes; teaching apparatus and/or instruments; instructional apparatus and/or instruments; downloadable MP3 files; recorded content; digital media; electronic publications; downloadable electronic publications; downloadable electronic publications in the nature of newspapers, magazines, periodicals, leaflets, catalogues, newsletters, directories and books; articles, columns or written/published articles contained and/or supplied in or by electronic media; published material in digital format; e-books; downloadable ebooks; publications in electronic form, supplied on-line from databases or from facilities provided on the Internet; electronic publications delivered online as a downloadable application or application delivered to any computing device including desktop, laptop, wearable computer peripheral, tablet computer and/or mobile device; optical, electronic and magnetic data storage devices bearing recorded information; DVDs; CDs; hard disks; pre-recorded audio and/or video cassettes; compact discs; floppy discs; podcasts; vodcasts; blogs; electronic databases; information stored in electronic, digital and/or magnetic form; educational apparatus and/or instruments; electronic devices for providing access to the Internet or viewing information on global computer networks; speech recognition equipment for use in education; computer software for the collection and the distribution of visual images, data, video, audio material, audio visual</p>

optical means; components, parts and fittings for all the aforesaid goods.

Class 35: Business and commercial data analysis services; preparing statistics and reports for businesses regarding computer software and technology; business consulting services in the fields of technology, namely, cloud computing, cloud migration, computer software, predictive analytics (Artificial intelligence), global broadband penetration, and technology-enabled systems integration featuring collaboration tools to facilitate development and maintenance of a remote work infrastructure and business infrastructure ; business consulting services in the field of technology, application development and management, cloud architecture and infrastructure set up, cloud app assessment, cloud app re-platform, cloud security and co-production; business consulting services in the field of remote business processes and business transformation; advisory, information and consultancy services relating to all of the aforesaid.

Class 42: Design, development, maintenance and updating of computer software; design, development, maintenance and updating of open source software, mobile and web applications, software security programmes and applications, messaging tools and messaging platforms, cloud migration, predictive analytics (Artificial Intelligence); computer programming services; computer network services; development and maintenance of computer networks; consultancy services relating to computer security; provision of information and preparation of reports relating to computer software, computer hardware and computer firmware; computer services, namely, cloud computing, global broadband

material and information; computer software for processing images, graphics, audio, video, and/or text; computer software for transmission and display of digital content, audio works, visual works, audiovisual works, electronic publications, books, movies, and music; computer software for browsing and accessing digital content, audio works, visual works, audiovisual works, electronic publications, books, movies and/or music; computer software for collecting, editing, modifying, organizing, synchronizing, integrating, monitoring, transmitting, storage and sharing of data and/or information; computer software; computer software for cloud computing; computer software for use in cloud infrastructure management; computer software for running cloud computing based applications; computer software development tools; interfaces for digital content management of wired and wireless electronic devices for accessing, storing, transmitting, and/or sharing of data, information, text, images, audio, video, and/or multimedia content.

Class 16: Printed matter; printed publications; books; newspapers, periodicals, journals, textbooks, catalogues, magazines, leaflets, newsletters, posters, charts, directories and calendars; articles, columns and written/published articles contained and/or supplied in or by print media; instructional and teaching materials; paper and cardboard; educational course certificates; educational or training award certificates; diplomas; course notes; study guides; pamphlets; journals; newsletters; prospectuses; catalogues; handbooks; stationery; pictures; note books; note pads; forms; calendars; writing instruments; pens; pencils; pencil cases; pencil sharpeners; erasers; rulers; writing materials; book marks; pennants;

<p>penetration, and technology-enabled systems integration featuring collaboration tools to facilitate development and maintenance of a remote work infrastructure; computer services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; design and development of computer software in the field of mobile applications; Internet-based application service provider, namely, hosting, managing, developing, analyzing and maintaining the code, applications, and software for others; Information technology consulting services; Installation, implementation, maintenance, and repair services with respect to computer software; Technical support services, namely, remote infrastructure management services for the monitoring, administration and management of public and private cloud computing IT and application systems; Quality assurance services relating to the development of computer security systems and contingency planning for information systems; Business services, namely, developing and managing cloud architecture, mobile applications and data security solutions; outsource service provider in the field of information technology; provision of an IT helpdesk for third party companies and businesses; services for software development, software updating, design, installation, maintenance and rental of software; computer software design and development services; design and development of mobile application software; application service provider (ASP) services; providing temporary use of non-downloadable software; providing temporary use of non-downloadable software to enable the viewing of website content via personal and handheld computers and mobile devices; provision of non-downloadable software applications</p>	<p>badges made of paper and cardboard; maps; address books; prints; posters; wall charts; postcards; labels; adhesive stickers; greeting cards, diaries; photographs; graphic prints.</p> <p>Class 35: Business advisory services; business assistance; business appraisals; business information; marketing and promotional services; business development services; arranging and conducting business conferences and events, commercial exhibitions and trade show exhibitions; business introductory and meetings services and business networking services; provision and dissemination of information relating to business introductory services and business networking services; consultancy, advisory and information services for all the above services.</p> <p>Class 41: Education services; training services; examination services; design and provision of educational and training programmes; design and provision of courses and examinations; providing education accreditation; certification of education training and awards; education services relating to business and/or business services; planning, arranging and conducting educational events; provision of training; conducting correspondence courses; providing training and/or education events; providing exhibitions, conferences, seminars, workshops and networking events; teaching, research, instruction and education by means of a computer database; providing access to video and audio materials for education; providing feedback for teachers on pupils' progress; training of teachers; computer assisted teaching services; online education for the assessment and improvement of student learning or teacher training; provision of distance learning for adult education; publishing services; publishing of electronic</p>
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through a website, virtual community, social networking site, shared use of text, images and audio-visual content; rental and maintenance of memory space for others (hosting), software development services; providing temporary use of non-downloadable software; providing temporary use of non-downloadable software to enable the viewing of website content via personal and handheld computers and mobile devices; provision of IT support to third parties online or offline; creation and maintenance of the aforesaid; advisory, consultancy and information services relating to all of the aforesaid .

publications; electronic publishing services; provision of online-electronic publications; publishing services provided by means of the Internet and world-wide web; provision of teaching materials online; distribution of printed or electronic materials relating to education; development and dissemination of teaching material; provision of digital handbooks, instructional handbooks, and educational materials in the field of education; organization of competitions, awards, quizzes, games and recreational activities; organizing and arranging of cultural and entertainment events; production, presentation, provision and distribution of films, blogs, webinars, podcasts, vodcasts and news feeds; consultancy, advisory and information services relating to the above services.

Class 42: Application hosting services for digital networks; platform as a service (PAAS); software as a service (SAAS); software as a service for use in providing education services; providing non-downloadable software applications; provision of temporary use of non-downloadable computer software for use in the creation and publication of online education materials; providing temporary use of on-line non-downloadable software for publishing and sharing digital media and information via global computer and communication networks online; hosting of digital content on the internet; application service provider featuring application programming interface (API) software for accessing and searching for content and data in electronic publications and on online databases; application hosting; software development in the field of mobile applications; application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites;

	<p>cloud computing services; leasing, hire and rental of computer hardware, computer software and computer programmes; electronic data storage; creating, managing, developing, designing, maintaining and/or hosting of websites; installation, maintenance, upgrading and repair of computer software; designing, managing and monitoring online forums for discussion; online services, namely, providing secure online data storage; providing temporary use of on-line non-downloadable cloud computing software for use in electronic storage of data; cloud hosting of electronic databases; advisory, information, management, consultancy and technical support relating to all the above services.</p>
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Class 9

Computer software; electronic publications.

30. I find that the above goods can be found identically between both specifications.

Publications in electric form supplied on-line from a database or from facilities provided on the Internet or other network (including websites)

31. I consider that the above goods to fall in the wider category of the opponent's 'electronic publications' and therefore these goods are identical under the *Meric* principles.

Predictive analytics software; data analysis software; computer... firmware and software; computer software relating to computer aided design, computer aided manufacture and computer aided engineering; computer software relating to open source software, mobile and web application development, software security, messaging tools and messaging platforms, cloud migration, predictive analytics (Artificial Intelligence); graphics computer software; computer software relating to geospatial analysis; computer software relating to computer virtualisation

32. I consider that the above goods to fall in the wider category of the opponent's 'computer software'. Therefore, I find that the goods are identical under the *Meric* principles.

Mobile telephone software, software to enable the viewing of website content via personal and handheld computers and mobile devices; downloadable software in the nature of a mobile application; downloadable mobile application software; downloadable software for use in wireless telecommunication devices; downloadable software in the nature of a mobile application and downloadable mobile application software relating to financial services, financial advice and financial analysis

33. I believe that the above goods to fall in the wider category of the opponent's 'Software applications delivered to any computing device including desktop, laptop, wearable computer peripheral, tablet computer and/or mobile device' and therefore find them to be identical under the *Meric* principles.

Computer apparatus for the storage of data; computer data storage apparatus; computer installations for the storage of data; computer memory storage apparatus; computer storage apparatus; computer hardware

34. For the above goods, I consider them to be broader categories that include the opponent's 'hard disks' which I find covers both internal and external hard disks for computers which are used to store data and therefore find them to be identical under the *Meric* principles.

Computer hardware relating to computer aided design, computer aided manufacture and computer aided engineering; computer hardware relating to open source software, mobile and web application development, software security, messaging tools and messaging platforms, cloud migration, predictive analytics (Artificial Intelligence); graphics computer hardware; computer hardware relating to geospatial analysis; computer hardware relating to computer virtualisation; computer peripherals; computer apparatus

35. The above goods from the applicant's specification are all types of computer hardware and I consider that 'computer peripherals' would mean things such as the monitor, keyboard and mouse which would also be considered as computer hardware items. I believe there to be an overlap in user, and in trade channels with the

opponent's 'leasing, hire and rental of computer hardware, computer software and computer programmes' as a company selling the applicant's goods could possibly also offer rental contracts. To my mind, there could also be an element of competition between the applicant's goods and the opponent's services as a consumer would have the choice between buying the computer hardware or renting it. Further, there could be an element of complementarity between the goods and services as computer hardware is essential for the delivery of the opponent's service. I note that the applicant's goods are limited to specific types of hardware rather than hardware more generally; however, the opponent's services would involve the leasing, hire and rental of the specific types of hardware found in the applicant's specification. The average consumer may assume that the same entity is responsible for both the rental and the goods themselves. I do recognise that the method of use, purpose and the nature of the services will differ slightly from those of the goods. I therefore find the applicant's goods to be similar to a low degree to the opponent's services.

Information stored on electronic, magnetic and/or optical means

36. For the above goods, I believe these to be identical to the opponent's 'information stored in electronic, digital and/or magnetic form' as optical data storage is a form of digital data storage (such as a CD-ROM).

Data processing equipment

37. As the parties have not provided me with any evidence as to what these goods include, I interpret them (as per the case law above) to mean any equipment that accumulates, processes and stores data and that would overlap in purpose and use with the opponent's 'computer software for collecting, integrating, monitoring, transmitting, storage and sharing of data and/or information'. The nature will differ as the applicant goods are hardware and the opponent's are software. The goods could be in competition as the consumer would perhaps need to choose between using hardware and software to process and store their data. They are not complementary. I therefore find the goods to be similar to no more than a medium degree.

Computer networks for the storage of data

38. I consider that there would be some overlap of use and purpose between the above goods and the opponent's 'electronic data storage' in Class 42 as both are related to the storage of information in the form of data. The users are likely to be the same as they will be companies and other organisations who want to store data may and would choose either to do it in-house with the applicant's goods or pay a third party to supply the opponent's services. Given the applicant's networks are a good and the opponent's storage is a service, there may be differences in the trade channels and the nature of the goods and services. They could be complementarity as the service of storing the data depends on the goods that provide the storage themselves. The average consumer may assume that the same entity is responsible for both. There could be competition between them also as the consumer could have to choose between the purchase of the good to have on site or whether they purchase the service for someone else to manage the storage of data on their behalf. I therefore find these goods and services are similar to a medium degree.

Computer printers

39. The contested goods are peripheral devices, connected to a computer or video camera, controlled by specific printing software such as drivers and software that manages the printing queues for job scheduling. Nowadays, most printers work in close combination with printing software in order to achieve their intended purpose. The opponent's 'computer software' goods may be essential for the use of the contested goods and, therefore, these goods are complementary. Indeed, software might be required to connect the printing devices to a computer or network. Therefore, the contested goods are similar to at least a low degree to the opponent's software as they are complementary, target the same end users and are distributed through the same channels.

Telecommunications apparatus

40. The applicant's goods could include phones (and the additional hardware) that have access to the internet. The opponent's 'electronic devices for providing access to the Internet or viewing information on global computer networks' could include smartphones as they are an electronic device with access to the internet and potentially the ability to view information on global computer networks. Therefore, I

find the applicant's goods to fall within the wider category of the opponent's goods and they will be identical under the *Meric* principles.

Security devices for computer hardware and software

41. I find that the above goods would have an overlap in purpose with the opponent's 'computer software' as this will include security software for the hardware and other software. The nature will differ as one will be an actual device like hardware whereas the other is software. The trade channels could slightly overlap as well as the user as it would be someone looking to protect their hardware/software from outside hacking or theft. I do not believe them to be in competition. I also believe the computer software is going to be integral to the working of security devices and that would mean the average consumer is likely to believe them to come from the same undertaking. I therefore find the goods to be similar to a low degree.

Components, parts and fittings for all the aforesaid goods

42. It would seem to me that the nature of the goods in their component parts would differ from the finished product. The use and user would also therefore differ. Where the underlying goods have been found to be identical or similar above, the average consumer is likely to consider these parts to come from the same manufacturer and therefore they would be complementary. It is also likely that they will share channels of trade. I therefore find the goods to be similar to a low degree.

Class 35

Business and commercial data analysis services; preparing statistics and reports for businesses regarding computer software and technology; business consulting services in the fields of technology, namely, cloud computing, cloud migration, computer software, predictive analytics (Artificial intelligence), global broadband penetration, and technology-enabled systems integration featuring collaboration tools to facilitate development and maintenance of a remote work infrastructure and business infrastructure; business consulting services in the field of technology, application development and management, cloud architecture and infrastructure set up, cloud app assessment, cloud app re-platform, cloud security and co-production; business consulting services in the field of remote business processes and business

transformation; advisory, information and consultancy services relating to all of the aforesaid.

43. Regarding the applicant's class 35 services, I believe that these will fall within the wider category of the opponent's 'business assistance; consultancy, advisory and information services for all of the above services' as this is a very wide category of services which would include all the types of consultancy and assistance in matters for businesses mentioned in the applicant's above services. I therefore find these services to be identical under the *Meric* principles.

Class 42

Installation, implementation, maintenance and repair services with respect to computer software

44. I consider that the services overlap with the opponent's 'installation, maintenance, upgrading and repair of computer software' with the only differences being that the applicant's service includes 'implementation' which I suggest largely overlaps with the installation of the software and the inclusion of 'upgrading' within the opponent's service. I consider the users and use of these services would largely be the same - consumers who require software to be provided by a third party and the continuing maintenance of such software. The opponent's service simply provides the upgrading of the software in addition. As there is a large overlap in the services provided, the nature, trade channels and purpose will also overlap. I therefore find the services to be similar to a high degree.

Design, development...of computer software; Services for software development; software...design; Computer software design and development service; software development services

45. I find that the above services will encompass the opponent's 'software development in the field of mobile applications' as a wider category and therefore find them to be identical under the *Meric* principles.

Maintenance and updating of computer software; software updating, installation, maintenance

46. I find that the above services will be included in the wider category of the opponent's 'installation, maintenance, upgrading and repair of computer software' and are therefore identical under the *Meric* principles.

Design and development of computer software in the field of mobile applications; Business services, namely, developing and managing ... mobile applications

47. Next, I find that the above service is a wider category encompassing the opponent's 'software development in the field of mobile applications' falls and therefore, the services are identical under the *Meric* principles.

Design, development, maintenance and updating of open source software, mobile and web applications, software security programmes and applications, messaging tools and messaging platforms, cloud migration, predictive analytics (Artificial Intelligence)

48. I believe that there will be an overlap of purpose of the above services with the opponent's 'software development in the field of mobile applications' as they are both related to the development of varying types of software, including applications for mobile phones. There may be an overlap in user and use as it could be used by consumers who wish to have application software created for them; however, the applicant's services go on to continue with maintenance and updating the software as well so there could be an ongoing contract situation in those instances. I believe there could be an overlap in trade channels also. The services might be in competition with each other but they are not complementary. I therefore find the services to be similar to a medium degree.

Computer programming services

49. Computer programs are a type of software and therefore this would be a wider category encompassing the opponent's 'software development in the field of mobile applications' as developing the software would be one of the services covered in programming. I therefore find these services identical under the *Meric* principles.

Computer network services; development and maintenance of computer networks

50. The cloud is 'the network of remote servers that is used in cloud computing'.¹ I therefore find that there is likely to be an overlap in nature and use of the applicant's

¹ <https://www.collinsdictionary.com/dictionary/english/cloud>

services and the opponent's 'cloud computing services' as they both involve services relating to computer networks. I consider that the nature may differ where the applicant's services cover the development and maintenance of physical networks as opposed to the provision of services via the cloud. There is an overlap in purpose as they both involve services relating to connections between computers (or other hardware connected to the network). The trade channels may differ given the differing natures of how the networks are set up. The services may be in competition as a consumer might decide whether to have a physical network set up and managed or whether they would prefer to have access to the cloud and the services related to managing this connection. The services are not complementary. I therefore find these services to be similar to no more than a medium degree.

Consultancy services relating to computer security

51. With regard to the applicant's services I consider that there could be some overlap in nature and use with the opponent's 'advisory, information, management, consultancy and technical support relating to all the above services where those services are Online services, namely, providing secure online data storage' as they both include services related to securing data. The purpose would be providing consultancy support to the consumer in relation to security of their devices and data. There could be an overlap in trade channels and user also. I find these services to be similar to at least a medium (but not the highest) degree.

Computer services, namely, cloud computing, global broadband penetration, and technology-enabled systems integration featuring collaboration tools to facilitate development and maintenance of a remote work infrastructure; computer services in the field of public and private cloud computing solutions; Business services, namely, developing and managing cloud architecture

52. For the opponent's 'cloud computing services' I believe that this falls within the wider category of the above services of the applicant's and I therefore find them to be identical under the *Meric* principles.

Computer services in the field of datacenter architecture

53. In the absence of any evidence to the contrary, I believe that the applicant's services will relate to looking after a data center which supports a network and

provides storage and applications and therefore I believe it will have some overlap with the opponent's advisory, information, management, consultancy and technical support relating to electronic data storage as both will feature the management of data and the storage thereof. The users may overlap but the nature might differ simply due to the set up of how it is managed. There may be a slight overlap in trade channel and the services could be in competition as the consumer might choose between offsite data storage compared to onsite. However, they are not complementary. I therefore find these services to be similar to no more than a medium degree.

Computer services in the field of evaluation and implementation of internet technology and services

54. I consider that the above services have an overlap in nature with the opposition's 'application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites; cloud computing services; advisory, information, management, consultancy and technical support relating to all the above services' as they all involve the provision of internet technology although the applicant's services may be slightly wider. The user will overlap slightly as the consumer will be looking for someone else to start off and review the technology. There may also be a slight overlap in trade channels. I do not consider them to be in competition, nor are they complementary. I consider them to be similar to a medium degree.

Provision of information and preparation of reports relating to computer software, computer hardware and computer firmware

55. The above services from the applicant's specification are encompassed by the opponent's 'information... relating to all the above services' in class 42 and I therefore find them to be identical under the *Meric* principles

Internet-based application service provider, namely, hosting, managing, developing, analyzing and maintaining the code, applications, and software for others

56. The applicant's services will overlap in purpose and nature with the opponent's 'application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites' as they would both be acting as a service provider for software applications with the applicant's specifically being internet based. Both services include the parties hosting, managing and developing such applications

for the benefit of the users. The applicant's services further include analyzing and maintaining the code which are not included within the opponent's services. There may be an overlap in users who are seeking to use the applications and the connected services provided by each party and they could therefore be in competition with one another. Their services could also overlap in trade channels. Therefore, I find these services to be similar to a high degree.

Information technology consulting services

57. The above services encompass the opponent's 'consultancy...relating to all of the above services' and so I find them to be identical under the *Meric* principles.

Technical support services, namely, remote infrastructure management services for the monitoring, administration and management of public and private cloud computing IT and application systems

58. The above services from the applicant's specification encompassed by the opponent's '....technical support relating to cloud computing services' and I therefore find them to be identical under the *Meric* principles.

Quality assurance services relating to the development of computer security systems and contingency planning for information systems;

59. I believe that the above services would involve checking the robustness and quality of the computer security services a consumer has in place. I find there to be a slight overlap in nature with the opponent's 'advisory [services] ... relating to all the above services', where these services are 'Online services, namely, providing secure online data storage' as they focus on the security of the consumer's systems and data. They differ in nature where the applicant's services are focusing on providing the security to the consumer's systems whereas the opponent's services are about advising on a secure online place to store data. There may be an overlap in user - consumers looking for security in relation to their data and systems and therefore also a slight overlap in trade channel. They could be in competition as the consumer would be deciding whether to have security systems installed on their own hardware and networks and having those checked out and advised on by the provider or whether to seek advice about off site or third party storage which is secure. They are not complementary. I therefore find these services to be similar to no more than a medium degree.

Business services, namely, developing and managing ... data security solutions

60. I consider that the above services fall within the wider category of 'online services, namely providing secure online data storage' and therefore find them to be identical under the *Meric* principles. If I am wrong in this, I find that they are highly similar, given that there is an overlap in purpose and the consumer would, in my view, expect secure online data storage to require data security solutions.

Business services, namely, developing and managing ... mobile applications

61. For the applicant's above services I find that it wholly encompasses the opponent's 'software development in the field of mobile applications' and I therefore find these services to be identical under the *Meric* principles.

Outsource service provider in the field of information technology

62. I find the above term from the applicant's specification to be very broad and it could therefore cover any number of the opponent's services. For example, 'installation, maintenance, upgrading and repair of computer software' could indeed be outsourced and therefore, I find these services to be identical under the *Meric* principles.

Provision of an IT helpdesk for third party companies and businesses; provision of IT support to third parties online or offline

63. I consider the applicant's services is a more generic term for providing ongoing IT services from outside of the consumer entity and therefore this would encompass the opponent's 'technical support relating to all of the above services' for most of the class 42 services. I therefore find them to be identical under the *Meric* principles.

Services for ... Rental of software

64. I believe this falls within the wider category of the opponent's 'leasing, hire and rental of computer hardware, computer software and computer programmes' and therefore, the services are identical under the *Meric* principles.

Design and development of mobile application software

65. I consider that the above services wholly encompass the opponent's 'software development in the field of mobile applications' and therefore the services are identical under the *Meric* principles.

Providing temporary use of non-downloadable software; providing temporary use of non-downloadable software to enable the viewing of website content via personal and handheld computers and mobile devices; provision of non-downloadable software applications through a website, virtual community, social networking site, shared use of text, images and audio-visual content

66. I consider that the opponent's 'providing non-downloadable software applications' is a wider category that covers the above services and therefore I find these services to be identical under the *Meric* principles.

Application service provider (ASP) services

67. I consider that these services are a wider category which includes the opponent's 'application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites' and therefore the services are identical under the *Meric* principles.

Rental and maintenance of memory space for others (hosting)

68. For the above services I find that they fall within the wider category of the opponent's 'electronic data storage and therefore, the services are identical under the *Meric* principles.

Average consumer and the purchasing act

69. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

70. 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. (as he then was) 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.”

71. I consider that the average consumer of the Class 9 goods save for ‘Computer hardware, firmware and software; computer peripherals; computer printers; computer apparatus and telecommunications apparatus; computer software; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other network (including websites); downloadable software in the nature of a mobile application and downloadable mobile application software relating to financial services, financial advice and financial analysis; electronic publications’ will be a business or a professional. The costs of these goods are likely to vary and I believe could range between medium and high cost. I would consider that these goods will be purchased relatively infrequently. The average consumer will need to take into consideration the cost and suitability of these goods in accordance with their needs. I therefore consider that the average consumer would pay a higher than average level of attention during the purchasing process. ‘Computer hardware, firmware and software; computer peripherals; computer printers; computer apparatus and telecommunications apparatus; computer software’ would be purchased by the public or businesses. These goods range in cost and overall I consider the average consumer would pay at least a medium degree of attention in their purchase. The average consumer will see the mark used on any packaging or descriptions on websites. They may also use reviews in the media or online, and so I consider that the visual element will be most important. However, I do not discount the aural element, as word-of-mouth recommendations may also be influential.

72. ‘Publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other network (including websites); downloadable software in the nature of a mobile application and downloadable mobile application software relating to financial services, financial advice and financial analysis; electronic publications’ are likely to be purchased by the public although I do not discount the possibility that they could be purchased by businesses also. I believe the costs to be

relatively low; however, I do not discount the possibility that certain items could attract a higher purchase price. I consider the average consumer would pay at least a medium degree of attention in its purchase. The average consumer will see the mark used on any packaging or descriptions on websites. They may also use reviews in the media or online, and so I consider that the visual element will be most important. However, I do not discount the aural element, as word-of-mouth recommendations may also be influential.

73. The services at issue in Class 35 comprise a range of business consultancy, and assistance services. I find that the average consumer for these services would most likely be a professional or business. The selection of such services is most likely to be a visual process, either online, via websites or printed marketing material, with the possibility of aural conversations with salespersons and other advisors and word of mouth recommendations.

74. All of the class 35 services at issue are likely to be a fairly regular consideration for a professional consumer or business, but I feel such selections will generally invite a higher level of attention than casual purchases, due to the higher cost of such services and their impact on the health and profitability of the business. I therefore consider the average consumer will pay a higher than average level of attention in the selection and purchase of these services.

75. In relation to the class 42 services, I believe that the majority of consumers will be businesses. They are mainly ongoing services in relation to IT, cloud services and data storage. The services may also provide ongoing maintenance/upgrade provisions. They would probably involve ongoing contracts and would be more than a casual inexpensive purchase which is not likely to be frequent. I consider it likely that the services will be selected by the consumer perusing websites and marketing materials. Again, the aural element will come into consideration as advice may also be given by sales people. I therefore find that a higher than average level degree of attention will be paid.

Comparison of the marks

76. 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 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.”

77. It would be wrong, therefore, to artificially dissect the trade marks, 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.

78. The respective trade marks are shown below:

Earlier mark	Contested mark
HEADSPRING	

79. The earlier mark is a plain word mark which consist of one word. The overall impression lies in the word itself.

80. The contested mark is a figurative mark which features the word 'Headspring' in a white simple font on a navy blue background. The mark also includes a yellow device that made up of yellow dots forming a triangular shape with the dots becoming more concentrated the closer they are to the word element. The word takes up most of the blue rectangle it occupies. In *Migros-Genossenschafts-Bund v European Union Intellectual Property Office (EUIPO)*, T-68/17 the GC stated that:

“...in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements...”²

81. I find that 'Headspring' is the dominant and distinctive element of the mark. The device seems to be purely decorative in nature and does not add any meaningful concept to the mark. Therefore, I find that it will carry much less weight in the overall impression of the mark.

82. I will now consider the visual comparison of the marks. The applicant submitted in its counterstatement that it uses a stylised mark with the addition of the device element and hence the marks are visually different. As the Appointed Person said in *Groupements Des Cartes Bancaires*, the opponent's mark may be presented in any font, size, or combination of upper and lower-case fonts and in an identical colour scheme to the applicant's mark.

83. The earlier mark comprises a single word containing ten letters. The contested mark contains the same word together with the yellow triangular device element. Given the identical word within both marks and only the addition of a simplistic non-

² Paragraph 52

distinctive device element, I find that the marks are visually similar to a very high degree.

84. Turning to the aural comparison between the marks, I consider that the word element of the contested mark will likely be pronounced with two syllables and the words 'Head' and 'Spring' will be given their ordinary dictionary pronunciations. The same will occur for the earlier mark and therefore, the marks are aurally identical.

85. Conceptually, I note the definition provided by the opponent in their submissions that a 'Headspring' is defined as '(1) a spring that is the source of a stream, (2) a spring using the head as a lever from a position lying on the ground, (3) a source'. I also consider that even with the dictionary definition provided by the opponent, there could be a group of relevant consumers who do not assign those meanings to the word 'Headspring' and would potentially see it as a portmanteau of the words 'Head' and 'Spring' and give those their ordinary dictionary meanings. In any of the above meanings however, it is clear to me that the average consumer would assign the same meaning to both marks and therefore, they are conceptually identical. I consider that the concept of the applicant's mark is not altered by the addition of the device as the average consumer will consider this to be a decorative element and will not necessarily assign it any concept or meaning given its simplistic nature.

Distinctive Character of the Earlier Marks

86. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

87. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of its earlier mark. I will therefore consider the position based solely on its inherent distinctiveness.

88. The marks are comprised of one word which could be a portmanteau of two ordinary dictionary words or, alternatively, could be viewed as one of the three dictionary definitions mentioned above. For the consumers who see the mark as a portmanteau, it will be distinctive to an above average, although not the highest, degree. For the consumers who see the marks as their ordinary definition, I find that the marks are inherently distinctive to an average degree.

Likelihood of Confusion

89. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

90. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, 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 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.”

91. I have come to the conclusions above that the marks at issue are visually similar to a very high degree; aurally and conceptually identical, and the average consumer would pay a higher than average or medium degree of attention. The remaining goods at issue have been found to be between identical or similar to a low degree. The earlier marks are inherently distinctive to an above average degree. I found the overall impression of both series of marks was in the words themselves.

92. Given the highly similar visual representation of the marks (and the possibility of the opponent’s word mark being represented in a similar colour scheme and font to the applicant mark) together with the aural and conceptual identity, even where the degree of attention being paid by the average consumer is higher than average I consider that there will be a likelihood of direct confusion where the goods and services are similar, even to a low degree.

Conclusion

93. The opposition under section 5(2)(b) succeeds in its entirety.

Costs

94. The opponent has successful and is entitled to a contribution towards its costs. Award of costs in Fast Track proceedings are based upon the scale as set out in Tribunal Practice Notice 2 of 2015. The award of costs is calculated as follows:

Filing fee	£100
Preparing the Notice of Opposition and preparing Counter Statement	£100
Preparing the Opponent's written submissions in lieu	£200
Total	£400

95. I therefore order Headspring, LLC to pay Headspring Ltd the sum of £400. 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 15th day of November 2022

L Nicholas
For the Registrar