

O/0325/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3703871
IN THE NAME OF CYLUS CYBER SECURITY LTD.
TO REGISTER AS A TRADE MARK**

CYLUS

IN CLASSES 9, 42 and 45

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 431659
BY CYLANCE INC.**

BACKGROUND AND PLEADINGS

1. On 29 September 2021, Cylus Cyber Security Ltd. (“the applicant”) applied to register trade mark number UK3703871 for the mark “CYLUS” in the United Kingdom. This case was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union, based on its European Union Trade Mark (“EUTM”) No 017801952. The EU filing date was 13 February 2018, which claimed priority from Israeli TM No. 302659, with a priority date of 08 February 2018.
2. The application was accepted and published for opposition purposes on 07 January 2022, in respect of the following goods and services:

Class 9: *Data processing equipment; downloadable software for the cyber security of rail and metro companies.*

Class 42: *Software as a service for cyber security in rail and metro companies; computer services, including but not limited to: risk assessment, vulnerability assessment, penetration testing, system and code review, incident planning and response, technological consultation regarding effective cybersecurity requirements in tenders for rail and metro goods and services, including but not limited to: risk assessment, vulnerability assessment, penetration testing, system and code review, incident planning and response; Security services for cyber security for rail and metro companies, including but not limited to risk assessment, vulnerability assessment, penetration testing, system and code review, incident planning and response; scientific and technological services, as well as research and design services in these areas; design and development of software and computer equipment.*

Class 45: *Consulting services for tenders in the field of security services; security consultancy for protection of rails and metros; security inspection services for others; security monitoring services.*

3. The application is opposed by Cylance Inc. (“the opponent”). The opposition was filed on 07 March 2022 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application. The opponent relies upon the following comparable UK marks:

CYLANCE

UK trade mark registration number 914887707

Filing date: 07 December 2015

Registration date: 12 April 2016

Registered in Classes 9 and 42

Relying on all goods and services, namely:

Class 9: *Downloadable software for use in preventing unauthorized access to computers and electronics systems that is accessible via a web interface; downloadable Internet security software.*

Class 42: *Providing online non-downloadable Internet security software; consulting services for others in connection with computer forensics; consulting services for others in connection with Internet security hardware and software; computer security consulting services for others in connection with preventing unauthorized access to computers and electronics systems.*

(Mark 1); and

CYLANCE

UK trade mark registration number 911338662

Filing date: 12 November 2012

Registration date: 16 February 2014

Registered in Classes 9 and 42

Relying on all goods and services, namely:

Class 9: *Internet security software; software for preventing unauthorized access to computers and electronics systems; computer hardware for preventing unauthorized access to computers and electronics systems.*

Class 42: *Providing online Internet security software and software for preventing unauthorized access to computers and electronics systems; consulting services in the field of Internet security software; consulting services in the fields of the design, development, and implementation of computer hardware and software for preventing unauthorized access to computers and electronics systems.*

(Mark 2).

4. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Trade Mark designating the EU. As a result, the opponent's marks were each converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.¹

5. The opponent submits that the overlapping letters "CYL" at the beginning of the competing marks, which it contends is a relatively uncommon beginning in the English language, leads to an above average level of visual similarity. It submits that the marks are aurally highly similar, and that overall, the marks are confusingly similar. The opponent submits that as a result of the similarity between the marks and the identity/similarity between the respective goods and services, there is a likelihood of confusion on the part of the public.

6. The applicant filed a counterstatement denying the claims and submits that the competing marks bear significant visual, aural and conceptual differences. It submits that its own goods and services are directed towards a highly specialised public which would pay a very high degree of attention, meaning that they are much more likely to distinguish between the marks. Accordingly, it submits that there is no likelihood of confusion.

¹ See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

7. Both parties filed written submissions which will be referred to as and where appropriate during this decision. Both parties elected to file evidence. I have read and considered all of the evidence and I will refer to the relevant parts at the appropriate points in the decision, which I will summarise to the extent I consider necessary. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

8. In these proceedings, the opponent is represented by Kilburn & Strode LLP and the applicant is represented by Simmons & Simmons LLP.

Preliminary Issues

9. In its Counterstatement, the applicant refers to the related opposition proceedings between the applicant and the opponent in connection with the applicant's EU application No. 017801952, and the opponent's EUTM 11338662 on which its comparable Mark 2 in the proceedings before me is based. Following the decision of the Opposition Division of the European Union Intellectual Property Office ("EUIPO"), which found in favour of the applicant in its entirety, the decision was appealed by the opponent. In the subsequent appeal decision, the EUIPO Fourth Board of Appeal, partially annulled the EUIPO decision, leading to a further appeal to the General Court ("GC") on the part of the applicant. The appeal to the GC remains ongoing.

10. The applicant further references the decision of the Israeli Registrar of Patents, Designs, Industrial Designs and Trademarks of the related opposition proceedings filed by the opponent against the applicant's Israeli trade mark application, which concerned the same marks and goods and services at issue as in the matter before me. It states that the same conclusions were drawn by the Israeli Registrar as those drawn by the EUIPO, i.e. that no confusing similarity existed between the competing marks, resulting in the Israeli opposition being rejected in its entirety.

11. Whilst I have considered the impact of these decisions, I am not bound by the findings of other jurisdictions, and I draw my own conclusions based on the evidence before me.

EVIDENCE

Opponent's Evidence

12. The opponent's evidence consists of a witness statement in the name of Nora Fowler, of the opponent's representatives Kilburn & Strode LLP, which is dated 8 August 2022, and to which there are attached five exhibits, accordingly labelled **Exhibit NXF1 to Exhibit NXF5**.

13. Ms Fowler purports that the main purpose of the evidence is to refute the applicant's submissions that the "CY" element of the competing marks is descriptive and has no distinctive character for the relevant goods and services; and to show that taking into account its extensive use and recognition, the distinctiveness of the earlier marks must be regarded as enhanced.

Applicant's Evidence

14. The applicant's evidence consists of the witness statement dated 10 October 2022 of Darren Meale of Simmons & Simmons LLP, being the applicant's representatives.

15. Alongside the witness statement are four exhibits, labelled **Exhibit DM1 to Exhibit DM4**. Mr Meale explains that the purpose of the evidence is:

- a) to update the UKIPO on the related proceedings before the GC, which I note is still ongoing, and to communicate the decision by the District Court in Tel-Aviv-Yafo, sitting as Court of Appeal in the Israeli opposition proceedings, to uphold the original decision of the Israeli Registrar;
- b) to explain how Mr Meale's understanding of the abbreviation "CY" differs to the that of the opponent, as evidenced in the witness statement of Ms Fowler;
- c) to confirm on behalf of the applicant that it is unaware of any instances of actual confusion between marks at issue; and

d) to comment on the acquisition of Cylance by BlackBerry Limited in February 2019.

16. As I have already addressed the submissions regarding the related opposition proceedings at paragraphs 9 - 11 of this decision, I make no further comment in this regard. With regards to the issue of actual confusion in the marketplace, I acknowledge the evidence submitted by the applicant to support its claim, however, absence of evidence of confusion does not necessarily mean an absence of actual confusion².

DECISION

17. Although the UK has left the European Union, 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. Therefore, this decision contains references to the trade mark case-law of the European courts.

Section 5(2)(b)

18. Section 5(2)(b) reads as follows:

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

...

(a) 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”.

² See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 at [80].

19. 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.”

20. 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 or international trade mark (UK) 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

... “

21. Each of the trade marks upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As neither of the trade marks had been registered for more than five years before the priority date claimed for the contested application, they are not subject to the use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon them in relation to all of the goods and services indicated without having to prove that genuine use has been made of them.

22. I am guided by the following principles which 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 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 to mind the earlier mark, 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 will wrongly 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

23. Section 60A of the Act provides:

“(1) For the purposes 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 1979.”

24. The goods and services to be compared are:

Opponent’s goods and services	Applicant’s goods and services ³
<p><u>Class 9</u></p> <p><u>Mark 1</u></p> <p><i>Downloadable software for use in preventing unauthorized access to computers and electronics systems that is accessible via a web interface; downloadable Internet security software.</i></p> <p><u>Mark 2</u></p> <p><i>Internet security software; software for preventing unauthorized access to computers and electronics systems; computer hardware for preventing unauthorized access to computers and electronics systems.</i></p>	<p><u>Class 9</u></p> <p><i>Data processing equipment for the cyber security of rail and metro companies; downloadable software for the cyber security of rail and metro companies.</i></p>
<p><u>Class 42</u></p> <p><u>Mark 1</u></p> <p><i>Providing online non-downloadable Internet security software; consulting services for others in connection with computer forensics; consulting services for others in connection with Internet security hardware and software; computer</i></p>	<p><u>Class 42</u></p> <p><i>Software as a service for cyber security in rail and metro companies; computer services for the cyber security of rail and metro companies, including but not limited to: risk assessment, vulnerability assessment, penetration testing, system and code review, incident planning and</i></p>

³ I note that following receipt of Form TM21B on 10 October 2022, the applicant’s goods and services in Classes 9 and 42 were amended from the original specification as filed (as shown under paragraph 2 of this decision) to the goods and services listed in this table. The opponent confirmed in a letter dated 30 November 2022 that while it noted the amendments, the opposition was maintained.

<p><i>security consulting services for others in connection with preventing unauthorized access to computers and electronics systems.</i></p> <p><u>Mark 2</u></p> <p><i>Providing online Internet security software and software for preventing unauthorized access to computers and electronics systems; consulting services in the field of Internet security software; consulting services in the fields of the design, development, and implementation of computer hardware and software for preventing unauthorized access to computers and electronics systems.</i></p>	<p><i>response, technological consultation regarding effective cybersecurity requirements in tenders for rail and metro goods and services, including but not limited to: risk assessment, vulnerability assessment, penetration testing, system and code review, incident planning and response; Security services for cyber security for rail and metro companies, including but not limited to risk assessment, vulnerability assessment, penetration testing, system and code review, incident planning and response; scientific and technological services, as well as research and design services in these areas all for the cyber security of rail and metro companies; design and development of software and computer equipment for the cyber security of rail and metro companies.</i></p>
	<p><u>Class 45</u></p> <p><i>Consulting services for tenders in the field of security services; security consultancy for protection of rails and metros; security inspection services for others; security monitoring services.</i></p>

25. In *Gérard Meric v OHIM*, Case T-133/05, the GC stated that:

“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”.⁴

26. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“In assessing the similarity of the goods or services concerned, ... 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”.⁵

27. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 include an assessment of the channels of trade of the respective goods or services.

28. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. 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”.⁶

29. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

⁴ Paragraph 29

⁵ Paragraph 23

⁶ Paragraph 82

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁷

30. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... 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.”⁸

31. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

32. In its Statement of Grounds, and as referred to in its final written submissions, the opponent submits that the goods under Class 9 and the services under Class 42 of the opposing marks are either identical or highly similar, while the services in Class 45 for which the applicant seeks protection are similar to the earlier goods and services in Classes 9 and 42 as all relate to security, are similar in nature, and are

⁷ Paragraph 5

⁸ Paragraph 12

aimed at the same consumers. It further submits that the broad security software and Software as a Service of the opponent's specifications can apply to and be used by rail and metro companies, and therefore the applicant's goods and services fall within the broader scope of the applicant's goods and services.

33. The applicant submits that its own goods and services in Classes 9 and 42 are directed solely to the very specific rail and metro industry, and as such, "it is a stretch to argue that these terms are of any significant level of similarity".⁹

34. I am mindful of the fact that the appearance of respective goods and services in the same class is not sufficient in itself to find similarity between those goods and services, and that likewise, neither are goods and services to be automatically found to be dissimilar simply because they fall in a different class.

Class 9

Downloadable software for the cyber security of rail and metro companies.

35. I consider that the applicant's goods are encompassed within the opponent's broader terms "*downloadable Internet security software*" (Mark 1) and "*Internet security software*" (Mark 2). I agree with the opponent that while there is no limitation to the target market for its internet security software, the competing goods are identical as per the principle outlined in *Meric*.

Data processing equipment for the cyber security of rail and metro companies.

36. I consider the applicant's data processing equipment to be computer hardware used in the storage and management of data. Although the nature and purpose of these goods are different to the opponent's "*downloadable Internet security software*" (Mark 1) and "*Internet security software*" (Mark 2), the competing goods are qualified as being in relation to cyber/internet security. I also consider it likely that the applicant's data processing equipment will utilise related computer software in order to function. While I note that the applicant's goods are targeted specifically towards

⁹ See paragraph 47 of the applicant's written submissions dated 9 January 2023.

the rail/metro industry, I see no reason why the opponent's software could not be utilised by consumers in the same industry, resulting in an overlap in users of the respective software and hardware, with the opposing goods sharing the same channels of trade. Overall, I find the applicant's "*Data processing equipment for the cyber security of rail and metro companies*" to be similar to the opponent's "*downloadable Internet security software*" and "*Internet security software*" to a medium degree.

Class 42

Security services for cyber security for rail and metro companies, including but not limited to risk assessment, vulnerability assessment, penetration testing, system and code review, incident planning and response;

37. I consider the applicant's "*Security services for cyber security for rail and metro companies, including but not limited to ...*" to be a broad term which could reasonably encompass the opponent's earlier services, and in particular its "*computer security consulting services for others in connection with preventing unauthorized access to computers and electronics systems*" (Mark 1), and "*consulting services in the fields of the design, development, and implementation of computer hardware and software for preventing unauthorized access to computers and electronics systems*" (Mark 2). Accordingly, I consider the competing services to be *Merici* identical.

Computer services for the cyber security of rail and metro companies, including but not limited to: risk assessment, vulnerability assessment, penetration testing, system and code review, incident planning and response, technological consultation regarding effective cybersecurity requirements in tenders for rail and metro goods and services, including but not limited to: risk assessment, vulnerability assessment, penetration testing, system and code review, incident planning and response.

38. I consider the applicant's "*Computer services for the cyber security of rail and metro companies, ...*" to be suitably vague, particularly as the qualifier "*including but not limited to: ...*" only gives examples of what may be encompassed by the preceding wider term, rather than limiting the services in any way. As such, I consider it feasible that the applicant's services could also cover any, if not all, of the opponent's services under Class 42 of both its earlier marks. I therefore consider the services to be

identical, as per the principle outlined in *Meric*. If I am found to be wrong in interpreting the services as being identical, then I consider them to be highly similar, with an overlap in users, nature and channels of trade.

Software as a service for cyber security in rail and metro companies.

39. To my understanding, in broad terms, the above services refer to the delivery and management of software over the internet, with the provider hosting the software, which does not need to be downloaded to be accessed. It therefore shares the same nature and purpose as the opponent's "*Providing online non-downloadable Internet security software*" (Mark 1) and its "*Providing online Internet security software and software for preventing unauthorized access to computers and electronics systems*" (Mark 2), with both services providing the software on a temporary basis. The opposing services are both in relation to internet security, albeit that the applicant's services are specifically targeted towards rail and metro companies, which may or not be the same for the opponent's services. Overall, I consider "*Software as a service for cyber security in rail and metro companies*" to be similar to a high degree to "*Providing online non-downloadable Internet security software*" and "*Providing online Internet security software and software for preventing unauthorized access to computers and electronics systems*".

Design and development of software and computer equipment for the cyber security of rail and metro companies.

40. Under its Mark 2, the opponent relies upon its "*consulting services in the fields of the design, development, and implementation of computer hardware and software for preventing unauthorized access to computers and electronics systems*". While I do not consider a consultancy service to be identical to the design and development service itself, the consultancy services at issue are in relation to the design, development and implementation of security hardware and software. As such, they are the likely first step in identifying the customer's requirements, and there is a clear complementary relationship between the competing services to an extent that it would be reasonable for consumers to expect them to be provided by the same or economically linked undertakings. Both parties' services are in relation to computer (cyber) security, with an overlap in users and general purpose. Overall, I regard the services as being similar to at least a medium degree.

41. With regard to the opponent's earlier Mark 1, I consider computer software to be the end result of its design and development, and as such there exists a complementary relationship between the applicant's "*Design and development of software and computer equipment for the cyber security of rail and metro companies*" and the opponent's "*Providing online non-downloadable Internet security software*" in Class 42, as well as its "*downloadable Internet security software*" in Class 9. This is because without the design and development services, there would be no end product in the form of the software. In my view, while the goods and services relate to software in the field of cyber/internet, the nature, purpose and method of use is different, with different users, although there may be an element of competition, with the consumer selecting either bespoke software from the designer, or choosing specific software already on the market. Overall I consider the competing goods and services to be similar to a low to medium degree.

Scientific and technological services, as well as research and design services in these areas all for the cyber security of rail and metro companies.

42. I am mindful of the guidance given in *Avnet* that specifications for services should not be given a wide construction covering a vast range of activities. However, at the core of the applicant's above services is the provision that they are "*all for the cyber security of rail and metro companies*". I consider that the aforementioned services are likely to include an element of consultancy and as such, there is an overlap with the opponent's "*computer security consulting services for others in connection with preventing unauthorized access to computers and electronics systems*" (Mark 1) and "*consulting services in the fields of the design, development, and implementation of computer hardware and software for preventing unauthorized access to computers and electronics systems*" (Mark 2), resulting in a low to medium degree of similarity between the respective services.

Class 45

43. The opponent submits that the contested Class 45 services are similar to the opponent's Class 9 goods and Class 42 services as they share the same purpose

(security and prevention of attacks), and share the same end users and are compatible.¹⁰

Consulting services for tenders in the field of security services; security consultancy for protection of rails and metros.

44. I consider that the applicant's aforementioned consulting services in Class 45 would involve the provision of expert advice to the consumer in relation to physical security, although they may also utilise computer software in the provision of those services. However, in *Commercy AG v OHIM* Case T-316/07, the Board of Appeal ("BOA") found that just because goods are used by an undertaking in order to provide its services, the respective goods and services are targeted at different consumers, and as such, there can be no complementary connection between them.¹¹ As per *Commercy*, although the opponent's "downloadable Internet security software" (Class 9, Mark 1) and "Internet security software" (Class 9, Mark 2) may support the provision of the applicant's "Consulting services for tenders in the field of security services; security consultancy for protection of rails and metros", they are different in nature, method of use, intended purpose and target user. The same can be said for the earlier online internet security software covered under the opponent's services in Class 42. Consequently, I consider the respective goods and services to be dissimilar.

Security inspection services for others; Security monitoring services.

45. As per the criteria outlined earlier in *Boston Scientific*, I do not consider the applicant's above listed services to be complementary in a trade mark sense to any of the opponent's goods and services. For the same reasons as given above under paragraph 44, I consider the applicant's "Security inspection services for others; Security monitoring services" to be dissimilar to all of the opponent's earlier goods and services.

¹⁰ See paragraph 34 of the opponent's final written submissions filed on 09 January 2023.

¹¹ At [49-62].

46. A degree of similarity between the goods and services is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

47. In relation to the services which I have found to be dissimilar, being Class 45 in its entirety, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such services, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

48. 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 was then) described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.¹²

49. 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.

50. The opponent submits that the average consumer of both its own, as well as the applicant's, goods and services include the public at large and the specialised consumer.

51. The applicant submits that the average consumer of its own goods and services will be specific to rail and metro companies, who will pay a very high degree of

¹² Paragraph 60

attention to what it considers to be an important purchasing decision, in an area where poor choices could put public safety at risk. I note the applicant's submissions that , the average consumer who is a specialised member of the professional public "is bound to recognise that the "CY" element of both "CYLUS" and "CYLANCE" is a descriptive reference to "cyber" in the context of cyber security such that these two marks sit alongside other cyber security businesses on the market" and it gives examples such as, inter alia, CYGENTA; CYGENTISE; CYJAX; CYRISK; CYBOURN; CYFOR;; CYNAM; and CYPAW. While I do not have evidence to show that these examples are all registered trade marks, even if that were the case, it would have no bearing on my assessment. Just because a number of trade marks relating to the goods and services at issue begin with the letters "CY", this is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned: *Case T-400/06, Zero Industry Srl v OHIM*.¹³

52. As found earlier in my decision, the goods and services in common for the competing marks are in relation to internet security, and while the target market of the opponent's goods and services are unspecified, and could therefore include the general public, the overlapping terms of the applicant's specifications are specifically in relation to rail and metro companies, which are encompassed by the opponent's broader terms.

53. As such, the average consumer for the competing goods and services will be professionals within the rail and metro industry, and those goods and services are likely to be sourced from specialist providers, by both visual and aural means. Given the nature of the goods and services, and their importance to the target consumer as a matter of security, I would expect the level of attention paid during the selection and purchasing process to be very high.

Comparison of marks

54. 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

¹³ At [73].

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 in *Bimbo SA v OHIM* Case C-591/12P, 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.”¹⁴

55. 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.

56. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p><u>Mark 1</u></p> <p>CYLANCE</p>	<p>CYLUS</p>
<p><u>Mark 2</u></p> <p>CYLANCE</p>	

¹⁴ Paragraph 34

57. The opponent denies the applicant's submissions that the prefix "CY" is an abbreviation of the word "CYBER" and that it is descriptive and has no distinctive character for the relevant goods and service. It submits that the common elements CY or CYL in the respective marks do not form obvious independent elements within the marks, but form part of the marks as a whole and have a significant (if not the most significant) impact on the overall impression of the marks, which due to its positioning at the start of the mark will not be ignored by the consumer. It submits that the competing marks are visually similar to an above average degree, and aurally similar to a very high degree.¹⁵

58. In its counterstatement, and as referred to again in its written submissions, the applicant submits that the competing marks are all visually, aurally and conceptually different, with further obvious visual differences between the contested mark and the opponent's earlier Mark 1. It submits that conceptually, the "LANCE" element of the earlier marks may be considered to indicate that the opponent's goods and services are a weapon to assist with cyber security (a lance being a type of sword), and that no such concept is present in its own mark.¹⁶

Overall impression

59. The opponent's Mark 1 consists of the stylised word "CYLANCE", presented in capital letters. Notwithstanding that the letter "A" is replaced by what resembles an inverted letter "V", in my view, the presentation of the word as a whole is not particularly striking. However, while the stylisation is unlikely to go completely unnoticed, it plays a lesser role in the overall impression of the mark, which I consider to be dominated by the word itself.

60. The opponent's Mark 2 consists of the single word "CYLANCE", presented in a standard typeface in capital letters. As the mark contains no other elements, the overall impression rests in the word itself.

¹⁵ See, in particular, paragraphs 12–24 of the opponent's written submissions filed on 08 August 2022.

¹⁶ See paragraphs 20-21 of the Counterstatement, and paragraphs 49-50 of the written submissions dated 9 January 2023.

61. The applicant's mark consists of the single word "CYLUS", presented in a standard typeface in capital letters. The mark contains no other elements, and therefore the overall impression rests in the word itself.

Visual comparison

62. To my mind, in spite of the low degree of stylisation of the opponent's Mark 1, there is greater visual similarity between the contested mark and the opponent's word Mark 2. However, apart from the presentation of Mark 1, as described above, the opponent's marks each comprise the same seven letter word "CYLANCE".

63. The applicant's mark consists of five letters "CYLUS", and as such the competing marks share the same first three letters, appearing in the same order, "CYL". The letters in common in the opponent's earlier marks are followed by four letters, "ANCE", while in the applicant's mark they are followed by only two letters, "US", creating a point of differentiation between the opposing marks. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. Considering the marks as a whole, I find there to be a relatively low degree of visual similarity between the Opponent's Mark 1 and the contested mark, and no more than a medium degree of visual similarity between the applicant's mark and the Opponent's Mark 2.

Aural comparison

64. As the stylisation of the opponent's Mark 1 would not affect its pronunciation, both the earlier marks would be pronounced equally, as two syllables SI-LANSS, which as suggested by the applicant, may also be voiced by some consumers as the English word "silence" (SI-LUNSS). The contested mark would also be pronounced as two syllables, SI-LUSS. The common element is therefore in the first syllable SI (CY). To my mind, the applicant's submission that the earlier mark would be articulated as "silence" brings it one step closer to the pronunciation of its own mark, with the only difference being the articulation of the letter "N". However, the alternative pronunciation SI-LANSS is slightly further removed, due to the differing vowel sound

in the second syllable. Overall, I consider the competing marks to be aurally similar to a very high degree where the earlier marks are pronounced as SI-LUNSS, and to a high degree where voiced as SI-LANSS.

Conceptual comparison

65. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]¹⁷.

66. In considering the conceptual message relayed by the competing marks, I have taken into account the evidence of both parties in relation to the meaning of the letters “CY”. The opponent has provided printouts from acronymfinder.com (Exhibit NXF1), Wikipedia (Exhibit NXF2) and dictionary.com (Exhibit NXF3), which all show results for a search of the letters “CY”, and each giving various definitions, none of which provide that the letters refer to the word “CYBER” alone, although I note that the first exhibit gives “Cyberspace” as one of its possible meanings in relation to Information Technology. Conversely, in the witness statement of Darren Meale, the applicant has also provided an extract from acronymfinder.com which shows that “CY stands for Cyber”, as well as an extract from abbreviationfinder.org showing the same.

67. Although case law directs me to bear in mind the dominant and distinctive elements of the marks, the average consumer views the mark as a whole and is not in the habit of unnaturally dissecting words in order to find an underlying conceptual meaning. Neither of the words which make up the competing marks have a defined meaning in British English. However, earlier in this decision I found that the consumer of the competing goods and services would be a professional consumer and therefore, within the English speaking UK market, it is highly likely that such consumers will notice the letters in common “CY” at the start of each of the marks and assume that they allude to the word “cyber”, with this element of the marks being suggestive of the type of goods and services offered, i.e. those “involving, using, or relating to computers,

¹⁷ Paragraph 56.

especially the internet”.¹⁸ While I acknowledge that there may be a minority of professional consumers who would see the marks purely as invented words, and as such would not make the connection between the letters “CY” and the type of goods and services being provided, I consider the likelihood to be negligible. Taking everything into account, I consider that due to the shared letters “CY” at the start of each of the competing marks, the marks overall are conceptually similar to no more than a medium degree.

Distinctive character of the earlier marks

68. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

69. 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

¹⁸ Definition of “cyber” taken from the Cambridge Dictionary online, sourced on 22 March 2023.

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).”

70. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up 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 made of it.

71. Earlier in this decision, I found that the professional consumer would be most likely to perceive the “CY” element of the earlier marks as being allusive of the goods and services being provided, i.e. those which relate to computers, especially the internet. Overall, I consider the earlier Mark 2 to be inherently distinctive to no more than a medium degree, and given that the stylisation of the earlier Mark 1 is not particularly striking, it does little to elevate the mark beyond the degree of inherent distinctiveness of Mark 2.

72. I now turn to the matter of enhanced distinctiveness. The opponent has filed evidence in support of the earlier marks relied upon. The territory relevant to the assessment of enhanced distinctiveness is the United Kingdom. I must now assess if that evidence demonstrates whether, at the priority date claimed for the contested application, the earlier marks enjoyed an enhanced degree of distinctive character by virtue of the use made of them in relation to the UK market. I note the applicant’s submissions that the evidence provided by the opponent falls short in this respect. In particular, the applicant submits that Exhibit NXF4 relates to the opponent’s activities outside of the UK.

73. In her witness statement, Ms Fowler explains that Exhibit NXF4 comprises articles and website printouts relating to recognition, rankings and awards of Cylance in the industry, and she further explains that Exhibit NXF5 provides information on the cybersecurity field and Cylance’s positioning in that market.

74. The first five pages of Exhibit NXF4 comprise printouts from WIKIPEDIA which provide background to the company Cylance Inc.as an American software firm based in Irvine, California, which was founded in 2012 and acquired by BlackBerry Limited in February 2019. The revenue for the company is shown in the article as \$100.1 million in 2019, however, there is nothing to show what percentage of this relates to the UK market:

Cylance Inc.

	
Type	Private ^[1]
Industry	<u>Computer security</u>
Founded	2012
Founder	Stuart McClure, Ryan Permech
Headquarters	Irvine, California, United States
Services	Anti-virus, anti- malware
Revenue	▲ \$100.1 Million(2019) ^[2]
Number of employees	760 ^[3]
Parent	<u>BlackBerry Limited</u>
Website	<u>Cylance.com</u> (http://www.cylance.com)

75. While the Wikipedia article makes reference to various honours and awards, as do other articles within the exhibit, I find no mention of use of the marks at issue in relation to the UK market. Ms Fowler states that the company Cylance were ranked at no. 23 of the Forbes Cloud list in 2016, and I note the “businesswire” article at page 67 of Exhibit NXF4 shows that they were ranked in the top 100 private cloud-based

companies in the world for the third consecutive year in 2018, however, once again, this evidence does not show the performance of either the company or its trade marks within the UK.

76. The LinkedIn article included at pages 21 – 25 of the exhibit, which places Cylance at no. 24 of top companies start-ups in 2017, is cited as among the top 50 startups in the U.S., rather than the UK:

To be eligible for Top Companies | Startups, companies must be 10 years old or younger, have at least 100 employees, remain independent and privately held and have at least one round of venture-backed funding. LinkedIn worked with **CB Insights** to pull a global list of nearly 25,000 eligible venture-backed companies.

Share the list and join the conversation using #LinkedInTopCompanies.

Here are this year's top 50 startups in the U.S.

77. With regards to the remaining articles, I agree with the applicant that Exhibit NXF4 does not relate directly to the opponent's activities in the UK, although there are references to its worldwide success. Further, all financial references within the articles are quoted in either US or Canadian dollars. Neither have I found any references within Exhibit NXF5, being "The BlackBerry Cylance 202 Threat Report", which evidence trade mark use of the signs at issue in relation to the goods and services within the UK market.

78. While I appreciate that the "CYLANCE" trade mark belongs to the company Cylance Inc., the references within the evidence to "CYLANCE" do not explicitly show use of the mark. The majority of the references seem to imply the actions of the company and as such do not differentiate between the company name and the trade mark. Even where the articles mention particular products which include the house mark "CYLANCE", such as "CylancePROTECT" and "CylanceOPTICS" I see no

specific evidence to demonstrate “CYLANCE” being used as a trade mark in the UK in direct relation to the goods and services for which it is registered.

79. Given that I have no evidence to show “CYLANCE” being used as a trade mark in the UK, and in the absence of any turnover, advertising or market share figures in relation to the mark being used in UK market, or any information as to how or where potential customers were able to access the goods and services under the mark in the UK during the relevant period, I do not consider the evidence sufficient to establish that the distinctive character of the mark has been enhanced through use.

Likelihood of confusion

80. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

81. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that

the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

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

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

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

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

82. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

83. Earlier in this decision, I found identity/similarity between the opponent's goods and services and the applicant's goods and services in classes 9 and 42, although I found the contested services in Class 45 to be dissimilar to the earlier goods and services. I considered the average consumer of the goods and services in common to be professionals within the rail and metro industry, where the level of attention paid during the selection process would be very high. I found the competing marks to be

visually similar to a relatively low degree for the earlier Mark 1 and to no more than a medium degree for Mark 2; aurally, I considered the marks to be similar to a very high degree where the earlier marks are pronounced as “SI-LUNSS”, and to a high degree when voiced as “SI-LANSS”. In my conceptual comparison of the marks, I considered that the professional UK consumer would assume that the letters in common “CY” allude to the word “cyber”, being suggestive of the type of goods and services at issue, and as such, I found the marks as a whole to be conceptually similar to no more than a medium degree. Overall, I considered the earlier Mark 2 to be inherently distinctive to no more than a medium degree, and that the stylisation of Mark 1 did little to elevate it beyond the degree of distinctiveness of Mark 2. I found no evidence of enhanced distinctiveness through use in the UK.

84. I have weighed up each of the competing factors in my decision, not least the differences as well as the similarities between the competing marks, including the degree of aural and visual similarity between them, as identified above, both of which play a part. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, in my view, given the very high level of attention paid by the average consumer to the purchasing process of the goods and services, and the niche target market, I consider it unlikely that they would mistake one mark for the other. Overall, I do not consider there to be any likelihood of direct confusion.

85. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

86. I acknowledge that the categories listed by Mr Iain Purvis Q.C. are not exhaustive, but having made a multi-factorial assessment of the various considerations in play, although the marks share the first three letters “CYL”, and for some consumers, sight of one mark may bring to mind the other mark, given the allusive qualities of the letters “CY” to the goods and services at issue, which lessens the inherent distinctive character of the earlier marks as a whole, realistically, I do not consider that the

average consumer would mistakenly assume an economic connection between the marks at issue and I therefore find there to be no likelihood of indirect confusion for the goods and services in common.

87. The opposition under section 5(2)(b) fails in its entirety.

CONCLUSION

88. The applicant has been successful. Subject to any successful appeal, the application by Cylus Cyber Security Ltd. may proceed to registration.

COSTS

89. The applicant has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. Applying the guidance in that TPN, I award the applicant the sum of £1200, which is calculated as follows:

Considering the notice of opposition and preparing a counterstatement:	£300
Preparing evidence and considering the other party’s evidence:	£600
Preparing written submissions in lieu of a hearing:	£300
Total:	£1200

90. I therefore order Cylance Inc. to pay Cylus Cyber Security Ltd. the sum of £1200. 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 3rd day of April 2023

**Suzanne Hitchings
For the Registrar,
the Comptroller-General**