

O/0510/23

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATIONS NO. UK3702935 & NO. UK3702794
IN THE NAME OF BERNHARD FROHWITTER
TO REGISTER AS TRADE MARKS**

Fenix Cloud-Services

AND

Fenics

IN CLASSES 9, 37, 42 & 45

AND

**IN THE MATTER OF OPPOSITIONS THERETO
UNDER NUMBERS 431341 & 431344
BY FENICS SOFTWARE, INC.**

BACKGROUND AND PLEADINGS

1. On 28 September 2021, Bernhard Frohwitter (“the applicant”) applied to register trade mark number UK3702935 for the mark **Fenix Cloud-Services**, and UK3702794 for the mark **Fenics**, in the United Kingdom. Both trade mark applications were filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union, based on its respective European Union Trade Mark (“EUTM”), being No 018193854 and No 018193856, accordingly. The EU filing date for each was 07 February 2020.

2. Both the applications were accepted and were published for opposition purposes on 21 January 2022. Both applications were in respect of the following (identical) goods and services:

Class 9: *Virtual server software; Cluster computer system hardware; Computer software for the setup, configuration and management of cluster computer systems, supercomputer systems, operating system software and multiple computers in a networked environment; Cluster computer system software; Supercomputer systems; Computer networks consisting of a number of computers; Computer software in the field of operating and enhancing high performance and high availability computer hardware and computer networks.*

Class 37: *Installation and maintenance of hardware for cluster networks and grid architectures.*

Class 42: *Services for the design of interactive computer software; Services relating to interactive computer networks; Technological services relating to interactive computers; Services for the design of scalable computer software; Services relating to scalable computer networks; Technological services relating to scalable computers; Providing of virtual computer systems by means of cloud computing; Electronic data storage; Online data storage; Computer services concerning electronic data storage; Cloud computing; Consultancy relating to the use of high-performance computers; Design of high performance and high availability computer systems, cluster computer systems,*

supercomputer systems, multiple computer systems and computer networks; Research relating to data processing; Research in the field of information technology; Research in the field of data processing technology.

Class 45: *Generation, acquisition, disposal and evaluation of industrial property rights, in particular patents; Licensing of industrial property rights, Industrial property licensing consultancy; Technology licensing.*

3. The applications are opposed by Fenics Software, Inc. (“the opponent”), and both of the oppositions were filed on 25 February 2022. The opposition against UK3702935 (the “935” mark) is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”); the opposition against UK3702794 (the “794” mark) is based upon Section 5(2)(a) and Section 5(2)(b) of the Act. The oppositions are directed against all of the goods and services in the applications. These oppositions have been consolidated.

4. In each of the cases, the opponent relies upon the following comparable UK marks:

FENICS

UK trade mark registration number 908671133

Filing date: 21 October 2009

Registration date: 10 November 2011

Registered in Classes 9 and 42

Relying on all goods and services, namely:

Class 9: *Computer software; computer software relating to the financial services market and the provision of financial trading information; computer software used to calculate the theoretical fair price of options on foreign exchange contracts and other financial instruments; all of the aforementioned goods only in the financial and investment field and not in the insurance field.*

Class 42 *Computer programming services; design and development of computer software; maintenance of computer software; computer network and support services; pre and post sale technical support services; post sale maintenance services; professional advisory and consultancy services;*

all of the aforesaid services relating to the financial services market and the provision of financial trading information; all of the aforementioned services only in the financial and investment field and not in the insurance field.

(The “133” mark); and

The logo for 'Fenics' is displayed in a bold, black, sans-serif font. The letters are thick and closely spaced, with a slight shadow effect behind the text, giving it a three-dimensional appearance. The background is a light gray rectangle.

UK trade mark registration number 801503423

Filing date: 16 October 2019

Registration date: 22 June 2020

Registered in Classes 9, 36, 38 and 42

Relying on all goods and services, as listed in the table under paragraph 30 of this decision.

(The “423” mark); and

FENICS GO

UK trade mark registration number 801523623

Filing date: 24 October 2019

Registration date: 19 August 2020

Registered in Classes 9, 35, 36, 38 and 42

Relying on all goods and services, as listed in the table under paragraph 30 of this decision.

(The “623” mark).

5. 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

Opposition No. 431341

6. The opponent submits that the opposed application is visually highly similar to the earlier marks, given that the letter X is commonly used to provide a plural to avoid using the letter C in a word, and that the competing marks are aurally identical, with the additional words "Cloud-Services" purely descriptive, the dominant and distinctive component of the contested mark being the word "Fenix". It submits that the competing goods and services are identical or highly similar, and as a result there exists a likelihood of confusion on the part of the public, which includes a likelihood of association, contrary to the provisions of Section 5(2)(b) of the Act.

7. The applicant filed a counterstatement denying the claims. It denies that the marks at issue are highly similar, or that there is a likelihood of confusion, including a likelihood of association, on the part of the public, and accordingly, it requests that the opposition is dismissed and an award of costs in the applicant's favour.

Opposition No. 431344

8. The opponent submits that the opposed application is identical to the earlier mark "FENICS" (the "133" mark) and the stylised mark "Fenics" (the "423" mark) and that the competing goods and services are identical or highly similar, resulting in a likelihood of confusion on the part of the public, which includes a likelihood of association. It submits that registration of the opposed application is therefore contrary to the provisions of Section 5(2)(a) of the Act. In the alternative, the opponent submits that the opposed application is highly similar to the stylised "423" mark

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

“Fenics” and to the “623” mark “FENICS GO”, with a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

9. The applicant filed a counterstatement denying the claims. It denies that the contested mark is identical to either the earlier “133” mark or the “423” mark, pursuant to Section 5(2)(a) of the Act, and it further denies that there is a likelihood of confusion between the application mark and the earlier marks, pursuant to Section 5(2)(b) of the Act. The applicant requests that the opposition is dismissed and an award of costs in its favour.

10. Both parties filed written submissions which will be referred to as and where appropriate during this decision. Only the opponent elected to file evidence. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

11. In these proceedings, the opponent is represented by Bristows LLP and the applicant is represented by Withers & Rogers LLP.

Opponent’s Evidence

12. The opponent’s evidence consists of a witness statement dated 28 September 2022 in the name of Mark Rinaldo. Mr Rinaldo is the Chief Operating Officer of the Fenics businesses operated by BGC Financial LP, an affiliate of and under common control with Fenics Software, Inc. and Fenics Software Limited, a position which he states he has held since January 2017. Mr Rinaldo adduces nine exhibits, labelled **Exhibit MR1** to **Exhibit MR9**. The main purpose of the evidence is to provide background information and history of the mark, and to show “extensive use of FENICS in the United Kingdom and the European Union in connection with the goods and services concerned.”.

13. I note that the applicant submits that the opponent has failed to prove that use by Fenics Software Limited qualifies as evidence of use of the earlier “133” mark by the opponent or with its consent, pursuant to Section 6A(3)(a) of the Act, and that any evidence which shows use of the mark by Fenics Software Limited should be

disregarded.² In its written submissions dated 20 February 2023, the opponent has responded thus:

11. As explained in the WS (paragraph 4) Fenics Software Limited is authorised to use the trade mark FENICS. This is direct evidence that Fenics Software Limited is authorised to use FENICS and does so with the express permission of the Opponent. Therefore any use by Fenics Software Limited is relevant for the assessment of genuine use. Contrary to what the Applicant might submit, there is no requirement in law that a licence/consent/authorization to use a trade mark needs to be recorded in writing. Fenics Software Limited is a registered company in the UK (under Company registration number 03108922). The contact details of Fenics Software Limited are set out at the top of the invoices of Exhibit MR1.

14. In accordance with Rule 64(2) of the Trade Mark Rules 2008, the witness statement given in evidence by the opponent includes a statement of truth. In the absence of evidence to the contrary, I am satisfied that the evidence provided in the name of Fenics Software Limited is acceptable as evidence of use by the opponent or with its consent. I will therefore consider the substance of that evidence accordingly.

15. I have read and considered all of the evidence and I will refer to the relevant parts at the appropriate points in the course of the decision.

DECISION

16. 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.

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

² See paragraphs 9 -12 of the applicant's written submissions dated 17 February 2023.

“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;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B 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;

...”

18. Each of the three trade marks upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As neither the “423” mark nor the “623” mark had completed the registration procedure more than five years before the date the applications were filed, 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.

19. The opponent’s “133” mark completed the registration process more than five years before the application date of the contested marks, and, as a result, it is subject to use provisions. The applicant has required the opponent to provide proof of use of the mark for all the goods and services on which it relies.

Proof of Use

20. Proceedings were started on 25 February 2022, and at that time, the relevant statutory provisions under Section 6A of the Act were as follows³:

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

³ See Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

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

21. As the earlier marks are all comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day —

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

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

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

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

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

22. Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

My approach

23. I note that only the opponent’s “133” mark (**FENICS**) is subject to proof of use and that it has a narrower scope of protection for its goods and services than the other marks on which the opponent relies. I consider it appropriate to approach this decision by first considering whether there is any likelihood of confusion between the applicant’s marks and the opponent’s “423” mark and its “623” mark.

24. In the event that I find there to be a likelihood of confusion between these marks, assessing the “133” mark would not, in my view, improve the opponent’s position. However, if no likelihood of confusion is found, I will reconsider the need to compare the “133” mark, taking into account the evidence provided in relation to genuine use of the mark and the claim of enhanced distinctive character through use.

Section 5(2)(a) and Section 5(2)(b) –

25. Section 5(2)(a) and Section 5(2)(b) of the Act are relied on and read 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, or

(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”.

26. 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.”

27. 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

28. 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.”

29. In making my comparison, 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.

30. The goods and services to be compared are:

Opponent's goods and services for the "423" mark	Opponent's goods and services for the "623" mark	Applicant's goods and services (identical for both the "935" and the "794" marks).
<p><u>Class 9</u></p> <p><i>Downloadable computer software for calculating and analyzing prices of financial instruments; downloadable computer financial software for calculating the theoretical fair price of options on foreign exchange contracts and other financial instruments; downloadable computer software for price discovery of financial instruments; downloadable computer financial software for processing of securities transactions, managing financial data, and creating financial reports; downloadable computer software for use in connection with capital investment services, securities brokerage services, namely, transacting and trading of financial instruments; downloadable computer software for financial trade execution, trade allocation, confirmation, clearing and</i></p>	<p><u>Class 9</u></p> <p><i>Downloadable computer financial software for processing of securities transactions, managing financial data, and creating financial reports; downloadable computer software for use in connection with capital investment services, securities brokerage services, namely, transacting and trading of financial instruments; downloadable computer software for financial trade execution, confirmation, clearing and settlement transactions; downloadable computer software for accessing an electronic marketplace for trading of financial instruments; downloadable computer software for accessing financial information, namely, information in the fields of futures, commodities, securities, currencies, financial instruments, brokerage,</i></p>	<p><u>Class 9</u></p> <p><i>Virtual server software; Cluster computer system hardware; Computer software for the setup, configuration and management of cluster computer systems, supercomputer systems, operating system software and multiple computers in a networked environment; Cluster computer system software; Supercomputer systems; Computer networks consisting of a number of computers; Computer software in the field of operating and enhancing high performance and high availability computer hardware and computer networks.</i></p>

<p>settlement transactions; downloadable computer software for accessing an electronic marketplace for trading of financial instruments; downloadable computer software for accessing financial information, namely, information in the fields of futures, commodities, securities, currencies, financial instruments, brokerage, trading, investments, companies and financial markets and stock pricing and financial indices; downloadable electronic publications, in the nature of electronic newsletters in the fields of business, finance and investing; downloadable computer software for electronically trading securities; customizable application programming interfaces, namely, downloadable software development tools for the creation of client interfaces; downloadable computer software that enables trading in financial instruments, provides trade execution, allocation,</p>	<p>trading, investments, companies, financial markets and stock pricing and indices; downloadable electronic publications, in the nature of electronic newsletters in the fields of business, finance and investing; downloadable computer software for electronically trading securities; customizable application programming interfaces, namely, downloadable software development tools for the creation of client interfaces; downloadable computer software that enables trading in financial instruments, provides trade execution, settlement and confirmation capabilities, and provides access to financial information and financial market information, real time and otherwise; downloadable computer software used to calculate the theoretical fair price of options on foreign exchange contracts and other financial instruments.</p>	
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<p><i>settlement and confirmation capabilities, and provides access to financial information and financial market information, real time and otherwise; downloadable computer software used to calculate the theoretical fair price of options on foreign exchange contracts and other financial instruments.</i></p>		
	<p><u>Class 35</u> <i>Providing an electronic marketplace for trading of financial instruments for buyers and sellers of financial instruments through a global communications network.</i></p>	

<p><u>Class 36</u></p> <p><i>Financial analysis, management and consulting; financial portfolio management; capital investments services; financial securities exchange services; securities brokerage services; financial services, namely, transacting and trading of financial instruments; financial services, namely, aggregation of financial data; providing an electronic marketplace for trading of financial instruments; providing financial information; providing financial information, namely, information in the fields of futures, commodities, securities, currencies, financial instruments, brokerage, trading, investments, companies, financial markets, stock pricing and financial indices; financial services, namely, providing financial market data, financial securities data, and financial pricing data in the nature of financial</i></p>	<p><u>Class 36</u></p> <p><i>Financial analysis, management and consulting; capital investments services; securities brokerage services; financial services, namely, transacting and trading of financial instruments; providing financial information; providing financial information, namely, information in the fields of futures, commodities, securities, currencies, financial instruments, brokerage, trading, investments, companies, financial markets, stock pricing and stock indices; financial, securities and commodities exchange services; financial trade execution, confirmation, clearing and settlement services; investment brokerage; financial analysis and research services; providing information including links to other websites in the field of finance.</i></p>	
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<p><i>instrument price information; financial portfolio management services; financial services in the field of securities analytics, namely, reporting securities prices and indicative prices for use in analyzing and assessing securities portfolios; financial, securities and commodities exchange services; financial trade execution, allocation, confirmation, clearing and settlement services; investment brokerage; financial analysis and research services; analyzing and compiling data for measuring the performance of financial markets; providing information and links to other websites in the field of finance.</i></p>		
		<p><u>Class 37</u> <i>Installation and maintenance of hardware for cluster networks and grid architectures.</i></p>

<p><u>Class 38</u></p> <p><i>Communication of financial information through an online global computer network; electronic transmission for others of securities and financial information via computer linking services, namely, communicating and routing trade information involving orders, entry and execution services, to others via a global computer network; consultancy and provision of information relating to communication of financial information through an online global computer network; leasing of telecommunications equipment.</i></p>	<p><u>Class 38</u></p> <p><i>Electronic transmission of financial information through an online global computer network; consultancy and provision of information relating to electronic transmission of financial information through an online global computer network; leasing of telecommunications equipment.</i></p>	
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<u>Class 42⁴</u>	<u>Class 42</u>	<u>Class 42</u>
<p><i>Research, design and development of computer software; installation and maintenance of computer software; computer software consulting; updating of computer software for others; customization of computer software; providing temporary use of on-line non-downloadable software for accessing a financial exchange; providing temporary use of on-line non-downloadable software for accessing financial information and trading of financial instruments; providing temporary use of on-line non-downloadable software for financial trade allocation, confirmation, clearing and settlement transactions; providing temporary use of on-line non-downloadable software for calculating and analyzing prices of financial instruments and</i></p>	<p><i>Scientific and technological research, design and development of computer hardware and software; installation and maintenance of computer software; computer software consulting; updating of computer software for others; customization of computer software; providing on-line non-downloadable software for accessing financial information and trading of financial instruments; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and diagnosing and repairing of software problems; customized software development services; application service provider featuring customizable application programming interfaces for use in building software applications; computer consulting services in connection with</i></p>	<p><i>Services for the design of interactive computer software; Services relating to interactive computer networks; Technological services relating to interactive computers; Services for the design of scalable computer software; Services relating to scalable computer networks; Technological services relating to scalable computers; Providing of virtual computer systems by means of cloud computing; Electronic data storage; Online data storage; Computer services concerning electronic data storage; Cloud computing; Consultancy relating to the use of high-performance computers; Design of high performance and high availability computer systems, cluster computer systems, supercomputer systems, multiple computer systems and computer networks; Research relating</i></p>

⁴ I note that in paragraph 54 of its written submission dated 17 February 2023, the opponent confirms that some of the services in Class 42 of the “423” mark have been deleted from the home registration of the International Registration (“IR”) on which the UK comparable mark is based. In the comparison table included within the submissions, the opponent has clearly indicated, in red, which of those services have been deleted. To reflect this, I have not included the deleted services in the above comparison table.

<p><i>accessing financial securities pricing data; providing temporary use of on-line non-downloadable computer software for accessing financial securities pricing data; providing temporary use of on-line non-downloadable computer software for managing financial data and creating financial reports; technical support services, namely, troubleshooting of computer software problems; customized software development services; application service provider featuring customizable application programming interfaces for use in building software applications; computer consulting services in connection with software for facilitating interactive communication and information sharing over a global computer network and other networks in the field of finance.</i></p>	<p><i>software for facilitating interactive communication and information sharing over a global computer network and other networks in the field of finance.</i></p>	<p><i>to data processing; Research in the field of information technology; Research in the field of data processing technology.</i></p>
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		<p><u>Class 45</u> <i>Generation, acquisition, disposal and evaluation of industrial property rights, in particular patents; Licensing of industrial property rights, Industrial property licensing consultancy; Technology licensing.</i></p>
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31. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“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”.⁵

32. 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”.⁶

33. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996]

⁵ Paragraph 29

⁶ Paragraph 23

R.P.C. 281 include an assessment of the channels of trade of the respective goods or services.

34. 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, 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”.⁷

35. 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:

“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.”⁸

36. In *Sky v Skykick* [2020] EWHC 990 (Ch), Arnold LJ 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:

⁷ Paragraph 82

⁸ Paragraph 5

(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.”

37. In its written submissions, the opponent submits that the contested goods in Class 9 and the contested services in Class 42 are all considered to be identical and/or highly similar to the earlier goods and services, and that there is similarity between the contested services in Classes 37 and 45 and the earlier goods and services. It has provided examples of where it considers some of the similarities lie. I do not intend to fully reproduce those submissions here, however, I have taken them into consideration in making my own comparisons.

38. In its written submissions, the applicant submits that the opponent's goods in Class 9 can be categorised as computer software for use in the foreign exchange and financial markets, and as such are aimed at a niche relevant public who are a sophisticated end consumer. It submits that in contrast, the applicant's goods in Class 9 are designed to configure a set of computers to work together as a single system, known as a “computer cluster”. As such, it submits that they are aimed at IT engineers and individuals who are responsible for configuring IT systems, as are its computer software services in Class 42 and its installation and maintenance services in Class 37. It further submits that the contested services in Class 45 are dissimilar to the registered goods and services, differing in nature, method of use, intended purpose and relevant public, and that the services are not in competition or

complementary, nor would that be produced by the same undertakings or made available via the same distribution channels.⁹

The applied-for goods in Class 9

Virtual server software; Computer software for the setup, configuration and management of cluster computer systems, supercomputer systems, operating system software and multiple computers in a networked environment; Cluster computer system software; Computer software in the field of operating and enhancing high performance and high availability computer hardware and computer networks.

39. In its written submissions, the opponent submits that while the majority of the earlier marks cover financial based goods and services, the contested goods and services are so broad that they cover any application of the goods and services in the field of finance or the trading of financial instruments. As such, it submits that the applicant's goods such as "*Computer software in the field of operating and enhancing high performance and high availability computer hardware and computer networks*" are identical to its own goods, such as, "*downloadable computer software for use in connection with capital investment services, securities brokerage services, namely, transacting and trading of financial instruments*", which is covered in Class 9 of both the earlier "423" and "623" marks. I acknowledge the principle outlined in *Merit* that goods designated by one mark may be encompassed under a more general category designated by the competing mark. However, I am also mindful of the correct approach to interpreting broad terms as set out in *Skykick*, including the general term 'computer software'. To my mind, all of the above mentioned contested software is specific to the operation and performance of computer systems, while the earlier software is specific to use in the field of finance. While the basic nature of the competing goods is the same inasmuch that they are both software products, their nature and intended purposes are different, which may also extend to the actual method of use. As such, I agree with the applicant that the goods are targeted at different groups of consumer and are likely to be distributed through separate trade channels. The opponent filed no evidence showing that computer software with

⁹ See paragraphs 20 - 33 of the applicant's written submission dated 17 February 2023.

different specific purposes would be provided by the same or connected undertakings. Consequently, I conclude that while there is some similarity between the competing goods, it is to only a low degree.

Cluster computer system hardware; Supercomputer systems; Computer networks consisting of a number of computers.

40. The opponent submits that the contested goods above are identical, or at least highly similar to, the earlier Class 42 services “...*design and development of computer hardware ...*” which I note are covered by the “623” mark. While I acknowledge that services are not the same as goods, nevertheless, I consider computer hardware to be the end result of its design and development, and to that extent there exists a complementary relationship, as without the design and development services there would be no end product in the form of the hardware. However, the method of use and nature of the goods and services will be different. Overall, I consider there to be no more than a medium degree of similarity between the contested goods and the earlier services in Class 42 of the “623” mark, being “...*design and development of computer hardware ...*”.

41. With regard to the goods and services covered by the earlier “423” mark, I consider that while the applicant’s above listed hardware products may be used in conjunction with the opponent’s earlier various software products covered by Class 9 of the earlier mark, I do not, in these circumstances, consider them to be complementary in a trade mark sense, as per *Boston Scientific*. In *Commercy AG v OHIM* Case T-316/07, the Board of Appeal (“BOA”) found that where the respective goods and services are targeted at different consumers, there can be no complementary connection between them.¹⁰ The applicant submits that producers of the registered goods in Class 9 would not usually have the required expert knowledge to produce the contested Class 9 goods. In the absence of evidence to the contrary, I agree that at face value, the competing goods each seem specific to different target markets and as such, I do not consider that they would be directed towards the same user. I consider that the nature, method of use, intended purpose and consumer of

¹⁰ At [49-62].

the respective goods to be different, and consequently that any link between the applicant's "*Cluster computer system hardware; Supercomputer systems; Computer networks consisting of a number of computers*" and the opponent's software is insufficient for a finding of similarity between the goods.

The applied-for services in Class 37

Installation and maintenance of hardware for cluster networks and grid architectures.

42. The opponent submits that fundamentally, the applicant's services in Class 37 relate to the development of computer hardware, and the services are similar to, in particular, the earlier Class 42 services "*...design and development of computer hardware ...*" (which are covered by the "623" mark). To my mind, the above contested services are a stand-alone service, which are different in nature and purpose to the opponent's computer hardware design and development services. However, I acknowledge that there may be an overlap in channels of trade and users, particularly in the case of bespoke hardware. Overall, I consider the respective services to be similar to a low degree.

43. In the absence of evidence to the contrary, while I note that the opponent's services in Class 42 include "*installation and maintenance of computer software*", I find no correlation between the applicant's "*Installation and maintenance of hardware...*" in Class 37 and the opponent's goods and services being provided under classes 9, 36, 38 and 42 of its "423" mark.

The applied-for services in Class 42

Services for the design of interactive computer software; Services for the design of scalable computer software.

44. I consider that the above services are encompassed within the opponent's broad terms "*... design ... of computer software*" (the "423" mark), and its "*... design ... of computer ... software*" (the "623" mark). I therefore find the competing services to be identical as per the principles outlined in *Meric*.

Research in the field of information technology

45. In my view, the broad term “*Research in the field of information technology*” covers “*Research, ... of computer software*” (included in the Class 42 specification of the earlier “423” mark), and “*Scientific and technological research, ... of computer hardware and software*” (the “623” mark), and as such, the opposing terms are identical as per *Meric*.

Design of high performance and high availability computer systems, cluster computer systems, supercomputer systems, multiple computer systems and computer networks.

46. To my understanding, a computer system comprises hardware and its component software.¹¹ I consider that the above services are encompassed within the opponent’s broad term “... *design ... of computer hardware and software*” covered by the Class 42 specification of the “623” mark, and as such, the services are *Meric* identical.

47. However, I consider the applicant’s aforementioned services to be similar to only a low degree to the defined software related goods and services being relied upon by the opponent under its “423” mark.

Services relating to interactive computer networks; Technological services relating to interactive computers; Services relating to scalable computer networks; Technological services relating to scalable computers.

48. While I am mindful that terms used should not be interpreted widely, the above services could feasibly include the opponent’s earlier “*Scientific and technological research, design and development of computer hardware ...*” included under Class 42 of the “623” mark, rendering the competing services identical as per *Meric*. If I am wrong in this, then I consider them to be similar to a high degree.

¹¹ Definition for “computer system” taken from Collins English Dictionary online as “a computer and all its component software and hardware, peripherals, etc”, sourced on 25 May 2023.

49. Once again, I find any link between the above services and the opponent's earlier goods and services under the "423" mark to render them similar to only a low degree.

Consultancy relating to the use of high-performance computers.

50. In the absence of evidence to the contrary, to my mind, the contested services are neither complementary to, or in competition with, the opponent's earlier software related goods and services under its "423" mark. However, I consider consultancy services to be similar in nature and purpose to technical support services, with an overlap in users and channels of trade. As such, I find "*Consultancy relating to the use of high-performance computers*" to be similar to a medium degree to the opponent's "*technical support services, namely, troubleshooting in the nature of diagnosing computer hardware ... problems*" under Class 42 of the earlier "623" mark.

Cloud computing.

51. The opponent submits that the contested services are identical to the term "*cloud computing services, namely cloud hosting in the nature of a scalable computer software for providing access to an electronic exchange*" which it says is covered by the third earlier mark (being the "623" mark). However, this term is not covered by the "623" mark and although it was included in the original Class 42 specification under the "423" mark, it is one of the terms that has since been deleted from the base IR and can therefore no longer be relied upon (see footnote 3). To my understanding, in broad terms, cloud computing refers to the delivery and management of computing services, including software, over the internet. While I acknowledge that services are not the same as goods, nevertheless, there will be an overlap in end users of the above services and the opponent's various software products in Class 9, which may be in competition, with the user electing either to access software via the internet or "cloud", or alternatively choosing to purchase equivalent software as goods. However, the method of use and nature of the goods and services will be different. Consequently, I consider the opponent's various Class 9 software goods under both the "423" and "623" marks to be similar to "*Cloud computing*" to a medium degree.

Providing of virtual computer systems by means of cloud computing.

52. The essential purpose of the contested services is the provision of virtual computer systems, which I consider to be different to the purpose and nature of the defined software goods covered by Class 9 of both the opponent's "423" and "623" marks. However, in my view there is a low degree of similarity between the applicant's "*Providing of virtual computer systems by means of cloud computing*" and the opponent's "... *design and development of computer hardware ...*" covered by the Class 42 specification of the "623" mark, based on the likely overlap in users and channels of trade.

Research relating to data processing; Research in the field of data processing technology.

53. The following definition of the term "data processing" is provided by the Collins online dictionary: "Data processing is the series of operations that are carried out on data, especially by computers, in order to present, interpret, or obtain information."¹² I consider that the above contested services, being research relating to data processing, could be construed as being encompassed by the opponent's "*Research, ... of computer software*" (the "423" mark), and "*Scientific and technological research, ... of computer hardware and software*" (the "623" mark), as the software and the hardware could include products which are specific to data processing. However, I am mindful of the guidance in *Skykick* that in the case of services, the terms used should be confined to the core of the possible meanings attributable to the terms. Consequently, while there is likely to be an overlap in users, as well as nature as far as both services involve research, in my view the competing services are similar to only a low degree.

Electronic data storage; Online data storage; Computer services concerning electronic data storage.

¹² Sourced from collinsdictionary.com on 25 May 2023.

54. The opponent submits that the contested services in Class 42 are similar to the earlier goods in Class 9 as they are often provided by the same businesses and through the same distribution channels, have a similar purpose and are complementary, and coincide in end users and providers. However, it has provided no supporting evidence to demonstrate this in regard to the contested services listed above. I see nothing within the opposing specifications which immediately strikes me as being self-evidently similar, therefore I find the competing goods and services to be dissimilar.

The applied-for services in Class 45

Generation, acquisition, disposal and evaluation of industrial property rights, in particular patents; Licensing of industrial property rights, Industrial property licensing consultancy; Technology licensing.

55. The opponent submits that the contested services in Class 45 are similar to the earlier goods and services and by way of example submits that “*Technology licensing*” could be considered similar to the earlier services in Class 42 for “*Scientific and technological research, design and development of computer hardware and software*” (the “623” mark). I disagree. I consider the contested services to be stand-alone services that bear no similarity in nature, purpose or method of use with the earlier goods and services of either registration and I also consider the consumer and channels of trade to differ. Neither do I consider them to be complementary to, or in competition with the opponent’s goods and services. I therefore find them to be dissimilar.

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

57. In relation to the goods and services which I have found to be dissimilar, as there can be no likelihood of confusion under either section 5(2)(a) or section 5(2)(b), I will take no further account of such goods and services, with the opposition failing to that extent.

58. For the sake of clarity, I summarise my findings on the goods and services comparison in the following table:

Applicant's goods and services	Opponent's "423" Mark comparison	Opponent's "623" Mark comparison
Class 9		
<i>Virtual server software; Computer software for the setup, configuration and management of cluster computer systems, supercomputer systems, operating system software and multiple computers in a networked environment; Cluster computer system software; Computer software in the field of operating and enhancing high performance and high availability computer hardware and computer networks.</i>	Similar to a low degree to "downloadable computer software for use in connection with capital investment services, securities brokerage services, namely, transacting and trading of financial instruments"	Similar to a low degree to "downloadable computer software for use in connection with capital investment services, securities brokerage services, namely, transacting and trading of financial instruments"
<i>Cluster computer system hardware; Supercomputer systems; Computer networks consisting of a number of computers.</i>	Dissimilar to all goods in Class 9	Similar to no more than a medium degree to "...design and development of computer hardware ..." in Class 42
Class 37		
<i>Installation and maintenance of hardware</i>	Dissimilar to all goods and services	Similar to a low degree to "...design and development

<i>for cluster networks and grid architectures.</i>		<i>of computer hardware ...”</i> in Class 42
Class 42		
<i>Services for the design of interactive computer software; Services for the design of scalable computer software.</i>	Identical to “... design ... of computer software”.	Identical to “... design ... of computer ... software”.
<i>Research in the field of information technology.</i>	Identical to “Research, ... of computer software”.	Identical to “Scientific and technological research, ... of computer hardware and software”.
<i>Design of high performance and high availability computer systems, cluster computer systems, supercomputer systems, multiple computer systems and computer networks.</i>	Similar to a low degree to the earlier software related goods and services	Identical to “... design ... of computer hardware ...”
<i>Services relating to interactive computer networks; Technological services relating to interactive computers; Services relating to scalable computer networks; Technological services relating to scalable computers..</i>	Similar to only a low degree to the earlier software related goods and services	Identical to “Scientific and technological research, design and development of computer hardware ...” (or similar to a high degree)

<i>Consultancy relating to the use of high-performance computers.</i>	Dissimilar to all goods and services	Similar to a medium degree to “technical support services, namely, troubleshooting in the nature of diagnosing computer hardware ... problems”
<i>Cloud computing.</i>	Similar to a medium degree to the Class 9 software goods	Similar to a medium degree to the Class 9 software goods
<i>Providing of virtual computer systems by means of cloud computing.</i>	Dissimilar to all goods and services	Similar to a low degree to “...design and development of computer hardware ...”
<i>Research relating to data processing; Research in the field of data processing technology.</i>	Similar to a low degree to “Research, ... of computer software”	Similar to a low degree to “Scientific and technological research, ... of computer hardware and software”
<i>Electronic data storage; Online data storage; Computer services concerning electronic data storage.</i>	Dissimilar to all goods and services	Dissimilar to all goods and services
Class 45		
<i>Generation, acquisition, disposal and evaluation of industrial property rights, in particular patents; Licensing of industrial property rights, Industrial property licensing</i>	Dissimilar to all goods and services	Dissimilar to all goods and services

consultancy; Technology licensing.		
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The average consumer and the nature of the purchasing act

59. 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”.¹³

60. 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.

61. In its written submissions, the opponent submits that the competing goods and services are directed at the professional public with professional knowledge or expertise within the software sector, but that they are not restricted to IT users and/or IT professionals. It submits that visual and aural considerations are likely to dominate the selection process and that awareness of the professional consumer will be high.

62. The applicant submits in its submissions that the opponent’s goods and services are aimed at companies in the financial sector, with the selection process being predominantly online, with the average consumer paying a high degree of attention to the selection of the goods and services. It submits that its own goods and services

¹³ Paragraph 60

are also aimed at a professional public, although in a different sector, and that those consumers would also pay a high degree of attention during the selection process.

63. Given the specific and technical nature of the respective goods and services, I agree with both parties that the average consumer will most likely be a professional in its field, who will pay a high degree of attention to the selection process. I would expect the goods and services to be procured through specialist retailers, be that from bricks and mortar premises, through tele-sales, or via the internet. To my mind, the selection process would be a combination of visual and aural factors: some consumers would seek information from written reviews and recommendations, particularly on the internet, whereas others would receive verbal advice from sales representatives, particularly in the case of tele-sales.

Comparison of marks

64. 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 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

65. 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

¹⁴ Paragraph 34

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

66. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade marks
<p data-bbox="375 546 616 580">The "423" mark</p> 	<p data-bbox="978 546 1219 580">The "935" mark</p> <p data-bbox="826 658 1370 707">Fenix Cloud-Services</p>
<p data-bbox="375 889 616 922">The "623" mark</p> <p data-bbox="347 992 643 1041">FENICS GO</p>	<p data-bbox="978 889 1219 922">The "794" mark</p> <p data-bbox="1007 992 1177 1041">Fenics</p>

67. The opponent submits that the earlier marks have the word "FENICS" as the only or most prominent/dominant and distinctive element, and that the overall impression of its "423" mark is in the word "FENICS", with the stylisation playing a lesser role, being so insignificant that it will go unnoticed by the average consumer. In the alternative, it submits that the contested "794" mark is highly similar to the earlier "423" mark. It further submits that the contested "935" mark is highly similar visually and aurally to the earlier marks.

68. The applicant submits that its "794" mark is visually different to the earlier "423" mark. With regard to the contested "935" mark, it submits that the visual differences between the competing marks would be immediately apparent to the average consumer, and that overall, it is similar to the earlier marks to a medium degree at best.

Overall impression

69. 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 acknowledge that this is not always the case.

70. The opponent's "423" mark consists of the stylised letters "Feni", written in title case in a cursive typeface, conjoined with what is likely to be perceived as the letters "cs", presented in the same typeface. Although some consumers may perceive the "Feni" element as being followed by an arbitrary device element rather than actual letters, given the overall presentation of the mark I consider this would be the case for an insignificant proportion of consumers. To my mind, the overall impression lies in the word "Fenics", however, the stylisation would not go unnoticed.

71. The opponent's "623" mark consists of the words "FENICS GO", presented in capital letters in a standard typeface, although I note that the registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. I do not consider that the combined words "FENICS GO" naturally fit together. In *Whyte and Mackay Ltd v Origin Wine UK Ltd*¹⁵ Arnold J. (as he was then) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. In my view, the average consumer will identify the meaning of the word "GO" within the composite mark, which as per *Medion*, plays an independent, albeit less distinctive role than the (invented) word element "FENICS". Accordingly, it is the word "FENICS" which makes a greater contribution to the overall impression of the contested mark.

72. The applicant's "935" mark consists of the words "Fenix Cloud-Services", presented side by side in title case in a standard typeface. In my view, the average consumer will view the hyphenated words "Cloud-Services" in the contested mark as being either allusive or descriptive of the type of goods and services being provided. I therefore consider that it is the word "Fenix" which will make the greatest contribution

¹⁵ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch).

to the overall impression, although the words “Cloud-Services” will not be entirely overlooked.

73. The applicant’s “794” mark consists of the word “Fenics”, presented in title case in a standard typeface. As the mark contains no other elements, the overall impression rests in the word itself.

The “935” mark

Visual comparison

74. The respective marks all share the same first four letters, being the letters “FENI”, however, this is where the similarity ends. The letters “Feni” in the contested mark are immediately followed by the letter “x”, the whole being presented as the five letter word “Fenix”, which is followed by the additional words “Cloud-Services”. The opponent’s “423” mark comprises a six letter word consisting of the stylised letters “Feni” which are immediately followed by what I considered earlier would be perceived as the letters “cs”, the whole of which would be read as the word “Fenics”, albeit in a stylised, cursive typeface. Given the stylisation of the word overall, and in particular, of the last two letters of the word, the presentation of the mark would not, in my view, go unnoticed by the average consumer. Overall, I consider there to be a medium degree of visual similarity between the marks. Meanwhile, the earlier “623” mark contains the plain word “FENICS” followed by the word “GO”, the second word creating a further visual disparity between it and the applicant’s mark. Considering the marks as a whole, I find there to be a medium degree of visual similarity between the “623” mark and the “935” mark.

Aural comparison

75. The common element in the competing marks are letters F E N I in the words “Fenics” and “Fenix”, the whole of which to my mind are likely to be pronounced identically as two syllables, FEN-ICKS, and is the only element to be voiced in the opponent’s “423” mark. I consider that both word elements in the earlier “623” mark would be articulated, the whole being voiced as three syllables, FEN-ICKS-GOH. In

my view, given the allusive/descriptive qualities of the additional words “Cloud-Services” in the contested mark, there will be a proportion of consumers who will only articulate the “Fenix” element, rendering it aurally identical to the earlier “423” mark, and similar to a medium degree to the earlier “623” mark. There will be other consumers who will voice the contested mark in its entirety, as six syllables, FEN-ICKS-CLOUD-COM-PUTE-ING and in these circumstances, I consider the contested mark to be aurally similar to the earlier marks to a low-medium degree.

76. I also consider that there may be a not-insignificant proportion of consumers for whom the word “FENIX” in the contested mark brings to mind the dictionary defined word “PHOENIX”, and as such, those consumers are likely to pronounce the first word of the mark as two syllables, FEE-NICKS, meaning that the mark is a further step removed from the degree of aural similarity of those consumers who pronounce it as FEN-ICKS.

The “794” mark

Visual comparison

77. The contested mark contains the identical letters “F e n i c s”, presented in the same order as the opponent’s “423” mark, however, due to the stylisation of the earlier mark, as previously described, I do not believe the stylisation to be so insignificant that it would go unnoticed. Consequently, I find the marks overall to be visually similar to a high degree, rather than identical.

78. The contested mark, being the word “Fenics”, is wholly incorporated in the opponent’s “623” mark, “FENICS GO”. Considering the marks as a whole, I find there to be at least a medium degree of visual similarity between them.

Aural comparison

79. The contested mark will be pronounced identically to the earlier “423” mark, both being articulated as two syllables, FEN-ICKS. With no other elements to be voiced in either mark, they are aurally identical.

80. The earlier “623” mark will be voiced in its entirety as three syllables, FEN-ICKS-GOH, compared to two syllables for the contested mark FEN-ICKS. Overall, I consider there to be a medium degree of aural similarity between them.

Conceptual comparison

81. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

“... In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the Larousse dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it.’¹⁶

82. I can find no reference to either the word “fenics” or the word “fenix” in a standard English dictionary, and as such, I consider that a significant proportion of consumers will perceive each to be an invented word with no semantic content, although even where the respective marks are considered to be invented words, this does not exclude the possibility that they are endowed with an allusive meaning.¹⁷ I acknowledge that there may be proportion of consumers who see the word Fenix in the contested “935” mark as alluding to, or a misspelling or alternate spelling of the word Phoenix, which creates a conceptual disparity between the marks. Meanwhile, to those consumers who attach no meaning to either of the marks, the position is neutral with regard to conceptual similarity.

Distinctive character of the earlier marks

¹⁶ Paragraph 8.

¹⁷ By way of example, see *Usinor v OHIM - Corus UK (GALVALLOY)*, Case T-189/05, paragraphs 63-68.

83. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services 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.

84. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

85. 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. The opponent claims that the word FENICS

has no meaning in the English language and that it is highly distinctive for the goods and services at issue, which has been enhanced through use.¹⁸

86. It is the distinctiveness of the common element that is important. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C., sitting as the Appointed Person said:

“39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

87. Earlier in my decision, I found that the “FENICS” element of the opponent’s marks would be perceived as an invented word by a significant proportion of the relevant consumer group. I do not consider it to be allusive of the goods and services for which the marks are registered. Consequently, I find both the earlier marks to be inherently distinctive to a high degree.

88. I note that the evidence filed by the opponent has primarily been provided to demonstrate genuine use of its “133” mark “FENICS” in the United Kingdom and the European Union for which the applicant has required the opponent to provide proof of use. However, having considered the evidence, I also note that much of it shows use of the earlier stylised “423” mark. Even allowing that the evidence demonstrates enhanced distinctive character through use within the relevant period in the UK, being the territory relevant to the assessment of enhanced distinctiveness, given that I have already found the earlier marks to be inherently distinctive to a high degree, it is unlikely that any finding of enhanced distinctiveness greatly improves the opponent’s already strong position on this front. I do not therefore intend to summarise the evidence in relation to the use of its earlier “423” and “623” marks.

¹⁸ See paragraph 36 of the opponent’s written submissions dated 17 February 2023.

Likelihood of confusion

89. 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]).

90. 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).”

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

92. Earlier in this decision, I found that the similarity between the competing goods and services ranged between low to identical, with certain of the contested services being dissimilar to those covered by both earlier marks, as set out in the table under paragraph 58. I agreed with both parties that the average consumer of the goods and services at issue would be a professional in its field paying a high degree of attention to the selection of those goods and services, which would be selected by a combination of visual and aural means. I found the inherent distinctive character of both the earlier marks to be high.

93. In respect of the contested “935” mark, being “Fenix Cloud-Services”, I considered the word “Fenix” to be the distinctive component, making the greatest contribution to the overall impression, although the words “Cloud-Services” would not be entirely overlooked. I found it to be visually similar to a medium degree to both the earlier marks, and aurally, when pronounced as FEN-ICKS, it is identical to the “423” mark where the “Cloud-Services” element is not pronounced, and similar to a medium degree to the “623” mark. Where the contested mark is voiced in its entirety, I found

it to be similar to a low-medium degree to both the earlier marks, however when the “Fenix” element is pronounced as FEE-NICKS, it is aurally a further step removed from the earlier marks. I found that the “Fenics” element of the earlier marks would be seen as an invented word containing no semantic content, creating a conceptual disparity where the contested mark is perceived as alluding to, or as a misspelling of the word “Phoenix”, while to those consumers who attach no meaning to either of the marks, the position is neutral with regard to conceptual similarity.

94. In respect of the contested “794” mark, being “Fenics”, I found it to be visually similar to a high degree to the “423” mark and to at least a medium degree to the “623” mark. Aurally, I considered that it would be pronounced identically to the “423” mark, and that there was a medium degree of aural similarity to the “623” mark. Conceptually, I found that the “Fenics” element of the competing marks would be perceived as an invented word with no semantic content.

The 5(2)(a) ground

95. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the 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 the average consumer.”

96. Earlier in this decision, I found there to be a high degree of visual similarity between the contested “794” mark and the earlier “423” mark, however, I did not consider the marks to be identical. Accordingly, the opposition fails in its entirety under Section 5(2)(a) in respect of the contested UK3702794 application.

97. While I acknowledge that the opponent’s “133” mark is identical to the contested “794” mark, for the reasons given earlier in paragraphs 23 - 24 of this decision, I have based my decision on its “423” and “623” marks only and will now draw my conclusions on the likelihood of confusion under Section 5(2)(b).

OP431341 against UK3702935 for the mark Fenix Cloud-Services

98. 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, I consider it unlikely that they would mistake one mark for the other. I acknowledge the degree of visual and aural similarity between the marks, however, given the high degree of attention paid during the selection of the goods and services, which I have balanced against the identity and similarity between the goods and services at issue, it is my view that even for the services considered to be identical, the average consumer, being reasonably well informed and reasonably circumspect, will notice and recall the differences between the marks. To my mind, realistically, any likelihood of direct confusion between the marks is negligible.

99. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was) in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

100. 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.

101. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive, however, having made a multi-factorial assessment of the various considerations in play, while for some consumers sight of one mark may bring to mind the other mark, I do not see anything which would lead the average consumer into believing that one mark is a variant brand of the other, or assume that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

102. The opposition under Section 5(2)(b) fails.

103. Earlier in my decision under paragraph 24, I explained that should no likelihood of confusion be found, I would reconsider the need to compare the contested mark against the “133” mark, taking into account the evidence provided in relation to genuine use of the mark. In view of the above findings, even accepting that genuine use of the “133” mark is proven for the goods and services relied upon in Classes 9 and 42, given that the “133” mark is identical to the “Fenics” element of the earlier “623” mark, and is aurally identical and visually similar to a high degree to its stylised “423” mark, I consider that the outcome in relation to likelihood of confusion against the mark “Fenix Cloud-Services” would be the same as for its other marks on which this decision is based.

OP431344 against UK3702794 for the mark “Fenics”

104. 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 visual similarity between them, as well as the aural similarity/identity as determined above, all of which play a part. In spite of the high level of attention paid by the average consumer during the purchasing process, bearing in mind the principle of imperfect recollection, I consider the differences between the application mark and both the earlier marks to be insufficient to avoid them being mistakenly recalled as each other, particularly given the high degree of distinctive character enjoyed by the earlier marks. In my view, the average consumer would be likely to recall the word “FENICS”, which I have found to play an independent role in the composite “623” mark,¹⁹ but be less certain about the additional, less distinctive, but independent element “GO” which is present in that mark, or remember the exact presentation of the stylised word in the opponent’s “423” mark. Overall, I find that there is a likelihood of direct confusion between the marks for those goods and services for which I found there to be similarity/identity.

¹⁹ See earlier considerations under paragraph 71 of this decision.

CONCLUSION

105. In relation to OP431341 against UK3702935 for the mark “Fenix Cloud-Services” the opposition has failed in its entirety. Subject to any successful appeal, the application by Bernhard Frohwitter may proceed to registration in respect of all the goods and services.

106. In relation to OP431344 against UK3702794 for the mark “Fenics”, the opposition under section 5(2)(b) succeeds in respect of the following goods and services only:

Class 9

Virtual server software; Cluster computer system hardware; Computer software for the setup, configuration and management of cluster computer systems, supercomputer systems, operating system software and multiple computers in a networked environment; Cluster computer system software; Supercomputer systems; Computer networks consisting of a number of computers; Computer software in the field of operating and enhancing high performance and high availability computer hardware and computer networks.

Class 37

Installation and maintenance of hardware for cluster networks and grid architectures.

Class 42

Services for the design of interactive computer software; Services relating to interactive computer networks; Technological services relating to interactive computers; Services for the design of scalable computer software; Services relating to scalable computer networks; Technological services relating to scalable computers; Providing of virtual computer systems by means of cloud computing; Cloud computing; Consultancy relating to the use of high-performance computers; Design of high performance and high availability computer systems, cluster computer systems, supercomputer systems, multiple computer systems and computer networks;

Research relating to data processing; Research in the field of information technology; Research in the field of data processing technology.

107. Subject to any successful appeal, the application for UK3702794 may proceed to registration in respect of the following services only:

Class 42

Electronic data storage; Online data storage; Computer services concerning electronic data storage.

Class 45

Generation, acquisition, disposal and evaluation of industrial property rights, in particular patents; Licensing of industrial property rights, Industrial property licensing consultancy; Technology licensing.

COSTS

108. In these consolidated proceedings, with regard to OP431341, the applicant has been successful, whereas with regard to OP431344, the opponent has been partially successful. Both parties have enjoyed a share of success, with the greater degree of success on the part of the applicant, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. Taking into account the partial extent of the success, I have made a reduction to the costs to reflect this, and as such, I consider the following to be reasonable:

Considering the two notices of opposition and preparing counterstatements	£300
Filing written submissions:	£400
Total:	£700

109. I therefore order Fenics Software, Inc. to pay Bernhard Frohwitter the sum of £700. 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 1st day of June 2023

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