

O/0001/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF:

INTERNATIONAL REGISTRATION WO0000001514927 DESIGNATING THE UK

AND

TRADE MARK REGISTRATION UK00801514927

IN THE NAME OF GIOTTO.AI SA

AND

RESPECTIVE APPLICATIONS 506717 AND 506718

BY ALMAVIVA S.P.A.

FOR DECLARATIONS THAT THE AFORESAID REGISTRATIONS ARE INVALID

Background and Pleadings

1. The following registered rights ('the Contested Marks') stand in the name of Giotto.ai SA, the Registered Proprietor ('the RP'):

i) International registration: **WO0000001514927**

Date of protection of the International Registration in the UK: 29 April 2020

Designation date: 18 November 2019

International registration date: 18 November 2019

Priority date: 11 October 2019

Priority country: Switzerland

TM from which priority claimed: 737483

ii) UK trade mark registration: **UK00801514927***

Filing date: 18 November 2019

Date of entry in register: 17 August 2020

Priority date: 11 October 2019

Priority country: Switzerland

TM from which priority claimed: 737483

*This is a comparable mark pursuant to Article 56 of the Withdrawal Agreement,¹ based on an IR designating the EU.

Both marks are registered in the following form:



Both marks are registered for the same goods and services, namely:

¹ 'Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01)', also known as the 'Withdrawal Agreement'.

Class 9:

Software; artificial intelligence and machine learning software; open-source software (OSS); calculating devices; computers and computer peripheral devices; computer software for encryption; computer software for database management; computer operating software; artificial intelligence software for healthcare; life saving devices; computer software applications, downloadable; computer software for business purposes; computer shareware; computer application software for cellular phones; electronic publications; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media.



Class 42:

Computer system analysis; data encryption services; cloud computing; software as a service (SaaS); computer software design; computer system design; development of computer platforms; installation of computer software; rental of computer software; maintenance of computer software; updating of computer software; providing search engines for the Internet; computer programming; technological research; off-site data backup; rental of web servers; electronic data storage; monitoring of computer systems by remote access; hosting computer software applications for others; hosting multimedia and interactive applications; hosting computer databases; hosting platforms on the Internet; server hosting; hosting memory space on the Internet; hosting on-line web facilities for others; information technology [IT] consultancy; computer software consultancy; computer technology consultancy; conversion of data or documents from physical to electronic media; conversion of computer programs and data, other than physical conversion; design and development of medical diagnostic apparatus; design and development of computer software for use with medical technology; computer programming for the medical sector; computer-aided diagnostic testing services; design and development of medical technology.

Class 45:

Licensing of intellectual property; licensing of databases; licensing of computer software; licensing of technology; online social networking services.

2. On 21 November 2023, ALMAVIVA S.P.A., the Cancellation Applicant ('the CA'), applied to invalidate RP's registrations, pursuant to sections 47(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The applications for invalidation (CA506717 and CA506718, respectively) are directed against all of the goods/services for which the Contested Marks are registered. The CA relies upon the following five earlier rights for both invalidation actions, and to the same extent:

a) UK00918106947	
	<p>Filing date: 13 August 2019 Date of entry in register: 18 December 2019</p>
b) UK00918106945	
	<p>Filing date: 13 August 2019 Date of entry in register: 18 December 2019</p>
c) UK00918106944	

	<p>Filing date: 13 August 2019</p> <p>Date of entry in register: 18 December 2019</p>
<p>d) UK00918107362</p>	
	<p>Filing date: 12 August 2019</p> <p>Date of entry in register: 18 December 2019</p>
<p>e) UK00918106910</p>	
	<p>Filing date: 12 August 2019</p> <p>Date of entry in register: 18 December 2019</p>

All five earlier rights are:

i) Comparable marks pursuant to Article 54 of the Withdrawal Agreement,² based on EUTMs which were registered prior to the withdrawal of the UK from the European Union;

and

ii) registered for the following goods and services, all of which are relied upon for each of the two invalidation actions:

Class 9:

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Computer software; Electronic diaries; Intercommunication apparatus; Precision measuring apparatus; Vehicles (Navigation apparatus for -) [on-board computers]; Satellite navigational apparatus; Naval signalling apparatus; Nautical apparatus and instruments; Commutation (Electric apparatus for -); Regulating apparatus, electric; Measuring devices, electric; Monitoring apparatus, electric; Electro-dynamic apparatus for the remote control of railway points; Electro-dynamic apparatus for the remote control of signals; Blueprint apparatus; Cameras; Global Positioning System [GPS] apparatus; Apparatus for programming data; Audiovisual teaching apparatus; Diagnostic apparatus, not for medical purposes; Phototelegraphy apparatus; Speed measuring apparatus [photography]; Sound recording apparatus; Time recording apparatus; Distance recording apparatus; Sound reproduction apparatus; Railway traffic safety appliances; Sound transmitting apparatus; Distance measuring apparatus; Radios; Radios for vehicles; Telephones; Distribution boxes [electricity]; Encoded identification bracelets, magnetic; Calculators; Juke boxes for computers; Identity

² 'Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01)', also known as the 'Withdrawal Agreement'.

cards, magnetic; Integrated circuit cards [smart cards]; Couplers [data processing equipment]; Floppy discs; Circular slide rules; Disks, magnetic; Optical discs; Ignition (Electric apparatus for remote -); Computers; Transmitting sets [telecommunication]; Interfaces for computers; Circuit closers; Disk drives for computers; Readers [data processing equipment]; Computer memory devices; Microprocessors; Measuring apparatus; Modems; Monitors [computer programs]; Computer programs [downloadable software]; Computer operating programs, recorded; Recorded computer programs; Electronic publications, downloadable; Scanners [data processing equipment]; Computer software, recorded; Navigational instruments; Magnetic data media; Encoded magnetic cards; Magnetic tape units for computers; Peripherals adapted for use with computers; Computers; Voting machines.

Class 42:

Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Computer rental; Updating of computer software; Computer system analysis; Consultancy in the field of energy-saving; Computer software consultancy; Consultancy in the design and development of computer hardware; Web site design consultancy; Quality control; Conversion of computer programs and data, other than physical conversion; Conversion of data or documents from physical to electronic media; Creating and maintaining web sites for others; Digitization of documents [scanning]; Duplicating computer programs; Computer software design; Provision of scientific information, advice and consultancy in relation to carbon offsetting; Providing search engines for the internet; Engineering services; Installation of software; Rental of software; Maintenance of software; Monitoring of computer systems by remote access; Rental of web servers; Hosting computer sites; Computer system design; Computer programming; Recovery of computer data; Research and development for others; Research in the field of environmental protection; Mechanical research; Scientific research; Technical research; Server hosting; Meteorological information; Information technology [IT] consultancy; Laboratory (Scientific -) services; Computer virus protection services; Software as a service [SaaS]; Conducting technical project studies; Energy auditing.

Class 45:

Licensing of computer software [legal services]; Physical security consultancy; Intellectual property consultancy; Mediation; Monitoring intellectual property rights for legal advisory purposes; Security services for the protection of property and individuals; Licensing of intellectual property; Copyright management; Litigation services.

3. The CA's pleading is essentially the same for each invalidation action: that the parties' respective marks are similar and registered for identical/highly similar goods and services, leading to a likelihood of confusion.
4. The RP filed Defences and Counterstatements for each of the invalidations. The pleading is essentially the same for each:³
 - It is denied that the parties' marks are similar;
 - It is admitted that '[s]ome of the goods and services are self-evidently identical [...];
 - It is claimed that where goods/services are not self-evidently identical, they are dissimilar;
 - and
 - It is denied that there is a likelihood of confusion.
5. The CA is represented by Stevens, Hewlett & Perkins. The RP is represented by Lewis Silkin LLP.
6. Neither party filed evidence. A hearing was neither requested nor considered necessary. Neither party filed written submissions in lieu of a hearing. The following decision has been made after careful consideration of the papers available to me.

RELEVANCE OF EU LAW

³ The RP's Counterstatements, [4].

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

DECISION

The relevant legislation

8. Section 47 of the Act states as follows:

'47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) ...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.'

9. Section 5(2)(b) of the Act states:

'5(2) A trade mark shall not be registered if because –

(a) ...

(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.'

Earlier mark

10. In accordance with section 6 of the Act, all five of the CA's marks are earlier marks by virtue of their filing dates, which fell before the priority dates of the contested registrations.

A note on the matter of proof of use

11. In the instant case, none of the earlier marks had been registered for more than five years before the dates of the applications for invalidity. The proof of use provisions in section 47(2A) of the Act are, therefore, not engaged.

Section 5(2)(b) case law

12. The following principles are derived from the decisions of the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG*, Case C-251/95; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98; *Matratzen Concord GmbH v OHIM*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

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

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

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

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

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

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

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

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

Comparison of goods and services

13. Section 60A of the Act provides:

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

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

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

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

14. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties' goods and services must be taken into account:

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

15. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.⁴ In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ('GC') described "complementary" in the following terms: "[...] 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".⁵ 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.

⁴ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

⁵ Paragraph 82.

16. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281⁶, identified the following factors for assessing similarity of the respective goods and services:

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

17. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

‘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.’

18. Case law establishes that ‘... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise’ but “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

⁶ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

language unnaturally so as to produce a narrow meaning which does not cover the goods in question.⁷

19. The goods and services to be compared are set out at Annexe 1 to this decision.

20. The CA has identified three terms present in both parties' specifications: *Software* (class 9), *software as a service (SaaS)* (Class 42) and *Licensing of computer software (legal services)* (class 45). No further points of overlap or similarity have been specified.⁸

Class 9

21. I find the following contested terms to be identical with those under the earlier marks; whether frankly identical, synonymous or identical based on the principle outlined in *Meric*. I set out the points of identity in the following table:

Earlier Marks:	Contested Marks:
<i>Computer software</i>	<i>Software</i>
<i>Computer software</i>	<i>artificial intelligence and machine learning software; open-source software (OSS); computer software for encryption; computer software for database management; computer operating software; artificial intelligence software for healthcare; computer software applications, downloadable; computer software for business purposes; computer shareware;⁹ computer application software for cellular phones; recorded</i>

⁷ *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch).

⁸ Penultimate unnumbered paragraph of the CA's statements.

⁹ It is my understanding that computer 'shareware' is a type of computer software.

	<i>and downloadable [...] computer software</i>
<i>calculating machines</i>	<i>calculating devices</i>
<i>computers</i>	<i>Computers</i>
<i>Peripherals adapted for use with computers</i>	<i>computer peripheral devices</i>
<i>Electronic publications, downloadable</i>	<i>electronic publications</i>
<i>life-saving [...] apparatus and instruments</i>	<i>life saving devices</i>
<i>Apparatus for recording, transmission or reproduction of sound or images</i>	<i>apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data</i>
<i>Electronic publications, downloadable</i>	<i>[...] downloadable media [...]</i>
<i>Compact discs, DVDs and other digital recording media</i>	<i>[...] blank digital or analogue recording and storage media.</i>

22. I now consider the remaining Class 9 term, *recorded [...] media [...]*. I do not find it to be 'self-evidently' identical to any of the Opponent's terms. I will compare it to the CA's term *Compact discs, DVDs and other digital recording media*, which appears to be the most appropriate comparator. Whilst 'recorded' media will encompass compact discs, DVDs and material recorded in other formats, it is my view that the CA's 'recording' media most likely encompasses blank compact discs etc, upon which material has yet to be recorded. Users will overlap to the broad extent that a consumer might be a user of both blank and recorded compact discs or DVDs, for example. Trade channels may overlap somewhat; e.g. the same outlet might sell both CDs and DVDs with content recorded on them (e.g. music, film) as well as blank CDs/DVDs. The respective goods are not in competitive relationship, neither good being substitutable for the other. I do not find complementarity, either; whilst it is obvious that blank CDs are crucial to a *business* selling CDs on which material is recorded, neither good is useful or necessary for the other from the standpoint of the average *consumer*. The parties' goods will have the same physical nature, with the only difference being the presence or absence of recorded content. The methods of use will coincide in some respects: i.e. ultimately, both will

be 'played' or 'run' in order to listen to or view material recorded on them. On the other hand, the specific method of use will diverge: blank media are for recording on, whereas recorded media contain ready-to-access content. All things considered, I find a medium level of similarity between the parties' goods.

Class 42

23. I set out the points of identity as follows:

Earlier Marks:	Contested Marks:
<i>Computer system analysis</i>	<i>Computer system analysis</i>
<i>Software as a service [SaaS]</i>	<i>software as a service (SaaS)</i>
<i>Software as a service [SaaS]</i>	<i>cloud computing</i>
<i>Computer software design</i>	<i>computer software design</i>
<i>Computer system design</i>	<i>computer system design</i>
<i>Maintenance of software</i>	<i>maintenance of computer software</i>
<i>Updating of computer software</i>	<i>updating of computer software</i>
<i>Providing search engines for the internet</i>	<i>providing search engines for the Internet</i>
<i>Computer programming</i>	<i>computer programming</i>
<i>Computer programming</i>	<i>computer programming for the medical sector</i>
<i>[...] technological services and research</i>	<i>technological research</i>
<i>Design and development of computer hardware and software</i>	<i>development of computer platforms (Meric)</i>
<i>Conversion of computer programs and data, other than physical conversion</i>	<i>data encryption services (Meric)</i>
<i>Rental of software</i>	<i>rental of computer software</i>
<i>Rental of web servers</i>	<i>rental of web servers</i>
<i>Design and development of computer hardware and software</i>	<i>design and development of computer software for use with medical technology</i>

	(Meric)
<i>Information technology [IT] consultancy</i>	<i>information technology [IT] consultancy</i>
<i>Computer software consultancy</i>	<i>computer software consultancy</i>
<i>Installation of software</i>	<i>installation of computer software</i>
<i>Server hosting</i>	<i>server hosting</i>
<i>Computer software consultancy; Consultancy in the design and development of computer hardware</i>	<i>computer technology consultancy</i> (Meric)
<i>Research and development for others; [...] technological services and research and design relating thereto</i>	<i>design and development of medical technology</i>
<i>Research and development for others; [...] technological services and research and design relating thereto</i>	<i>design and development of medical diagnostic apparatus</i>
<i>Conversion of data or documents from physical to electronic media</i>	<i>conversion of data or documents from physical to electronic media</i>
<i>Conversion of computer programs and data, other than physical conversion</i>	<i>conversion of computer programs and data, other than physical conversion</i>
<i>Monitoring of computer systems by remote access</i>	<i>monitoring of computer systems by remote access</i>
<i>Hosting computer sites</i>	<i>hosting on-line web facilities for others</i>

24. The following contested terms, addressed at [25] to [28], have not been included in the above table because, to my mind, it is not self-evident that they are identical to the CA's terms. It is, therefore, appropriate to consider them more closely.

Contested term: *off-site data backup*

25. It is my understanding that 'off-site data back-up' involves data being held remotely (e.g. by a server) as opposed to on the user's own computer drive or some other data storage device (e.g. a USB stick). The CA's specification includes the very broad term '*[...] technological services [...]*'. I consider the provision of 'off-site data

back-up' to be a technological service and, therefore, encompassed by the CA's broad term. The parties' services are, therefore, identical based on the principle in *Meric*.

Contested term: *electronic data storage*

26. I consider 'electronic data storage' to be another example of a technological service and, therefore, encompassed by the CA's term '[...] *technological services* [...]'. The services are identical based on the principle in *Meric*.

Contested term: *computer-aided diagnostic testing services*

27. I find that the above service would typically be performed in a laboratory setting. I find that it will be encompassed by the CA's broader term *Laboratory (Scientific -) services*. The parties' services are, therefore, identical based on the principle in *Meric*.

Contested terms: *hosting computer software applications for others; hosting multimedia and interactive applications; hosting computer databases; hosting platforms on the Internet; hosting memory space on the Internet*

28. I compare the contested terms to the CA's *Hosting computer sites*. Both parties' offerings entail the hosting of some sort of infrastructure within the online 'realm'. Whilst both parties' offerings will involve the service-provider having ultimate control over certain websites, strictly speaking, the hosting of websites is not the same as the hosting of applications/databases/platforms/memory space. Users and trade channels will overlap. The parties' services will share a broad purpose of providing the user with access to and use of online facilities hosted by the service-provider. However, their specific purposes will differ according to the facility hosted. Depending on the website being hosted, the parties' offerings may be substituted for one another. The respective services will, therefore, be competitive in certain instances. I also find complementarity: the RP's hosted facilities may also

involve website hosting as part and parcel of the same offering. All things considered, I find the parties' services to be highly similar.

Class 45

29. I set out the points of identity as follows:

Earlier Marks:	Contested Marks:
<i>Licensing of intellectual property</i>	<i>Licensing of intellectual property</i>
<i>Licensing of computer software [legal services]</i>	<i>licensing of computer software</i>

30. I do not consider the remaining contested terms, addressed below at [31] to [33], to be identical to the CA's terms. They, therefore, deserve closer scrutiny.

Contested term: *licensing of databases*

31. It is my understanding that the licensing of databases will likely entail the drawing up of legal agreements defining the respective rights of the licensee and licensor concerning use of the database in question. I compare this term to the CA's *Licensing of computer software [legal services]*. At the core of each service is a concern with the rights and obligations that constitute the licensor-licensee relationship. The purposes of the respective services diverge as to the subject matter of the licences: databases versus computer software. Users may overlap in so far as the same undertaking might own both databases and software that it wishes to make available to third parties whilst retaining certain proprietary rights. Trade channels will likely overlap; the same undertaking may provide both services. I do not consider the services to be in a competitive relationship, neither being substitutable for the other. However, I do find the services to be complementary in some instances. It is conceivable that the licensing of a particular database could necessitate the licensing of the software according to which the database operates, as part and parcel of the same offering. The average consumer of the licensing services would presume the same undertaking to provide licensing

of software as well as databases. All things considered, I find the services to be highly similar.

Contested term: *licensing of technology*

32. It is my understanding that the licensing of technology is encompassed by the CA's broader term *Licensing of intellectual property*. The licensing of intellectual property will include the licensing of patents, which concern rights in technologies. The parties' services are, therefore, identical based on the principle in *Meric*.

Contested term: *online social networking services*

33. The contested term, as its wording suggests, entails facilitating connections between individuals or businesses within the digital realm. A well-known example is 'LinkedIn', which aims to connect people based on occupational or business interests. Neither party has identified which of the CA's terms might be an appropriate comparator. I will, therefore, compare the contested services to the CA's broad term *Software as a service [SaaS]* in Class 42. The CA's software service may relate specifically to social networking. Users and trade channels will inevitably overlap; both being offered by the same undertaking, with both engaged by users hoping to connect with others. I find the services to be complementary given that both offerings could be part and parcel of the same package of services. I find a medium to high level of similarity between the parties' services.

Average consumer and the purchasing act

34. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word "average" denotes that the person is typical. 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*.

Class 9

35. I will address the 'software' terms, first. The specification includes both specialised software (for example, *artificial intelligence software for healthcare*) as well as a number of broad 'general' software terms which will cover any field and any level of expertise. The more specialised software goods will likely be purchased predominantly by the professional public, whereas the more 'general' software will be purchased by both the general consumer as well as professionals. For either type of consumer, I consider that the purchasing act will be primarily visual. Prospective consumers will likely encounter the goods online, by way of advertisements in printed matter or via radio or television. Specialist software goods may be featured in trade publications or directories. I acknowledge that there may also be an aural aspect to the purchasing process (e.g. by recommendation or word-of-mouth), particularly with more specialist purchases. For example, where software for a business is concerned, a transaction might follow after discussion with the seller of the goods. I find that the attention level of the average consumer will vary according to the particular goods purchased. For example, an ordinary member of the public downloading a generative AI 'App' to a smartphone might pay no more than a medium level of attention. On the other hand, a business considering whether to purchase a *computer software for database management*, might pay a fairly high level of attention. Factors likely to influence such a purchase might include, *inter alia*, whether the software is compatible with the purchaser's existing systems. I, therefore, find that the 'software' goods will likely be purchased with a level of attention ranging from medium to high.

36. I find that the remaining goods (i.e. the 'device/apparatus' goods, peripherals and recording and storage media) will be purchased by both general consumers and professionals. My comments above at [35] on the visual and aural aspect of the purchasing process also apply here. I will simply add that the goods here are physical offerings and will, in many cases, be available for the prospective purchaser to view and/or purchase from a physical retail store. I find that the level of attention will vary depending on the particular good purchased. Factors influencing the purchasing decision might include, *inter alia*: compatibility with existing systems or devices. For example, a professional sourcing a highly

sophisticated scientific computer or calculating machine will likely command a high level of attention. On the other hand, a computer peripheral (e.g. a scanner, speakers or a computer mouse) sought by an ordinary member of the public might be purchased with a medium level of attention. I, therefore, find that the goods will likely be purchased with a level of attention ranging from medium to high.

Class 42

37. The relevant services in class 42 comprise mainly software and computer-related services, some of which are highly specialised and aimed at professionals (e.g. *computer programming for the medical sector*) whereas others are more 'general' (e.g. *electronic data storage* or *software as a service*) and will be purchased by both the general and professional public. My comments at [35] on the visual and aural aspects of the purchasing process apply equally here. I find that the more specialised services, engaged by professionals, will likely be purchased with a high level of attention. The more 'general' services will likely be purchased with at least a medium level of attention.

38. The scientific/technical services (i.e. *computer-aided diagnostic testing services; design and development of medical technology*) will be purchased exclusively by professionals. I find that the purchasing process will be primarily visual, with the services being encountered online or in printed matter aimed at professionals in the field. There will likely be an aural component to the purchasing process in relation to these services; with prospective purchasers likely to engage in discussion with the service-provider before committing to a transaction. I find that a high level of attention will be paid, given the high stakes involved in the medical field.

Class 45

39. Broadly speaking, the relevant class 45 services concern the licensing of software or intellectual property. The average consumer of these services will be professionals who are looking to commercialise their intellectual property or software/databases whilst maintaining their rights in that property. The purchasing

act will most often be primarily visual. The services will likely be encountered online or in printed matter particular to Intellectual Property in general and/or to the fields in which the purchasers operate. There will likely be an aural aspect to the purchasing process in the manner already described. I find that these services would likely be engaged with a fairly high level of attention, given that the purchaser's rights are at stake.

Comparison of the marks

40. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

'...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.

41. The marks to be compared are:

Earlier marks:



Overall impressions of the marks

The CA's marks:

42. The CA has addressed the overall impressions of its marks by way of overarching comments that apply to all five marks.¹⁰ In short, it argues that, for each earlier mark:

- The dominant and distinctive element is the word ‘GIOTTO’;
- The circular device common to the marks is subservient to the word ‘GIOTTO’;
- The word ‘GIOTTO’ retains the greatest trade mark significance;
- The remaining verbal elements of the marks, being of smaller relative size, do nothing to disturb the dominance/trade mark significance of the ‘GIOTTO’ element.

43. The RP’s comments can be summarised as follows:¹¹

- That the ‘GIOTTO’ element of the CA’s marks is heavily stylised such that the ‘t’ resembles the letter ‘l’.
- That the presence in the CA’s marks of the wording accompanying ‘GIOTTO’ is as prominent as the word ‘GIOTTO’; except in the GIOTTO ‘Mesh’ mark (earlier mark (c), where ‘MESH’ is more prominent than ‘GIOTTO’.

44. The CA’s five earlier marks are composite marks sharing a similar general structure: a geometric shape resembling a stylised star/sun, with an upper case ‘G’ at its centre; the word element ‘GIOTTO’; and various additional wording underneath ‘GIOTTO’. I disagree with the RP’s suggestion that the ‘t’ characters within the word GIOTTO will be seen as ‘l’ characters. To my eye, the presence of the horizontal ‘bar’ characteristic of a lower case ‘t’ makes this unlikely. The star/sun device occupies roughly 50% of the surface area of the mark. The device outline is coloured purple/dark-blue and its central circle has touches of yellow shading which create the impression of a glow radiating from within. In each mark, ‘GIOTTO’ is positioned as the first or ‘top’ word element, in a slightly stylised

¹⁰ Form TM26(l), Continuation sheet, at Q.9 (both invalidations).

¹¹ RP’s counterstatement, [9] to [10] (both invalidations).

typeface, its font in a hue darker than that of the additional wording beneath it. The 'additional' wording, in each mark, is presented in a plain typeface, in upper case. I will consider the overall impression of each of the five marks individually.

a) I find that the device and the word 'GIOTTO' contribute most to the overall impression of the mark, given their positioning and size relative to the wording 'ALMAVIVA ENTERPRISE DIGITAL PLATFORM'. This latter wording is in a much smaller font, rendered in a plain typeface, positioned at the bottom of the mark. I agree with the CA's argument that the word 'GIOTTO' is the dominant and distinctive element of the mark. Whilst the device nevertheless has an appreciable visual impact in the mark, I bear in mind that it is generally the case that the words 'speak louder' than devices.¹² In the CA's mark, my view is that the average consumer will likely accord more trade mark significance to the word 'GIOTTO' than the device. The presence of the 'G' within the device, to my mind, reinforces this, because it will likely be seen as the initial for 'GIOTTO'. As to the wording 'ALMAVIVA ENTERPRISE DIGITAL PLATFORM', I find that the average consumer would see this as the lesser distinctive element of the mark, by virtue of its much smaller font size and less prominent positioning than the other elements. Although many average consumers will unlikely understand the meaning of 'ALMAVIVA', the words that follow would be seen as informative (i.e. alluding to/ describing the offering in some way) rather than an indication of trade origin.

b) For the reasons that follow, the most distinctive element of this earlier mark will also be the word 'GIOTTO'. My comment on the role of the device within the earlier mark a) also applies here. I note that the word 'CONNECT' is in a similarly large font to the word 'GIOTTO' above it, albeit presented in the paler hue of yellow. The smaller wording 'ALMAVIVA API & INTEGRATION PLATFORM' will be seen as the least distinctive element, by virtue of its size and positioning, which accord it less prominence within the mark. The reference to 'API & INTEGRATION PLATFORM' will likely be seen as informative rather than an indication of trade origin. I find that the words 'GIOTTO' and 'CONNECT' will play the greater role within the mark, albeit the 'CONNECT' element will likely be seen as the lesser

¹² *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, [37].

distinctive of the two. As I have observed in earlier mark a), I consider the central presence of the 'G' within the device to be seen as reinforcing the distinctiveness of 'GIOTTO'.

c) My earlier comments on the impact of the device element within the mark also apply here. I note that the word 'MESH' is presented in a slightly larger font than 'GIOTTO'. The wording 'ALMAVIVA DIGITAL EXPERIENCE' will likely play a lesser role owing to its less prominent positioning and much smaller size relative to the other elements of the mark. The words 'DIGITAL EXPERIENCE' will be seen as informative rather than an indicator of trade origin. I find that the words 'GIOTTO MESH' play the greatest role within the mark, owing to their relative size and positioning. To my mind, the pairing 'GIOTTO MESH' is the most distinctive part of the mark, with neither constituent word dominating the other.

d) My earlier comments on the impact of the device element within the mark also apply here. I find the word 'GIOTTO' to be the dominant and distinctive element of the mark. The word 'SERVICES' will be seen as descriptive and, therefore, non-distinctive. I find the wording 'ALMAVIVA IOT CONSULTING SERVICES' to be the lesser distinctive part of the mark, owing to its less prominent positioning, much smaller font size and the presence of the wording 'IOT CONSULTING SERVICES' which will be perceived as merely informative rather than an indicator of trade origin.

e) My earlier comments on the impact of the device element within the other marks also apply here. I find the words 'GIOTTO ONCHAIN' to play the greatest visual role within the mark, albeit 'ONCHAIN' will likely be seen as the lesser distinctive word given its allusion to 'blockchain'. I find the wording 'ALMAVIVA BLOCKCHAIN INTEROPERABILITY' to be the lesser distinctive element within the mark owing to its positioning and the fact that 'BLOCKCHAIN INTEROPERABILITY' will be seen as informative rather than having trade mark significance.

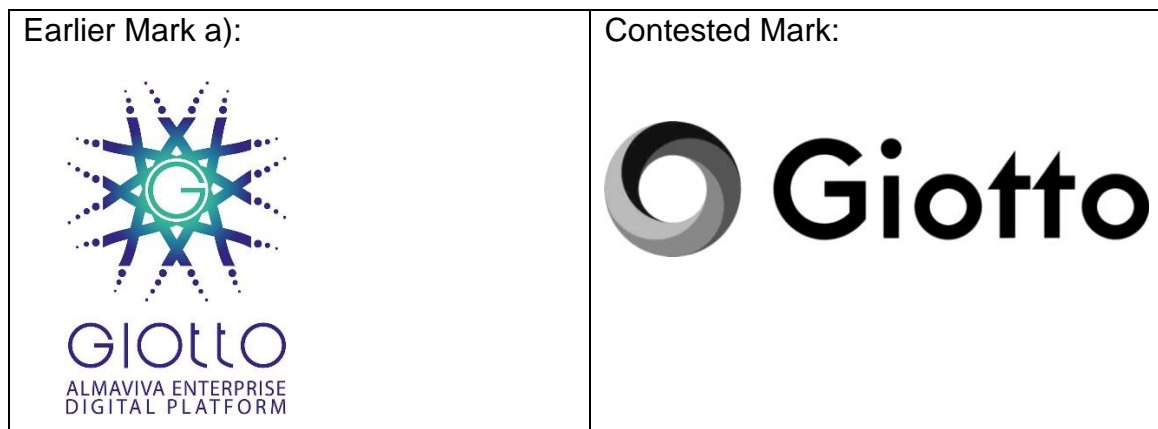
The RP's mark:¹³

¹³ I will refer collectively to the RP's Contested Marks in the singular, given that they are identical.

45. The RP's mark comprises a word element and a device. The word 'GIOTTO' is presented in a slightly stylised typeface, heavily emboldened. In front of the word element, is a ring-shaped device whose grayscale shading might be described as 'swirled'. In my view, the dominant and distinctive element of the RP's mark is 'GIOTTO'. The device will likely be noticed, given its size, although it will play a lesser role within the overall mark.

My approach to the comparison of the parties' marks

46. Having set out the overall impressions of the marks, it is my view that earlier mark a) appears to be the closest comparator to the Contested Mark. Given that all five earlier marks are registered for the same specification, I consider it unnecessary to make a comparison against all five of them at this stage. I will, therefore, proceed to compare the Contested Mark to earlier mark a). I reproduce the competing marks again here for ease of reference:



Visual comparison

47. Both marks feature the word element 'GIOTTO', presented in a slightly stylised typeface. Although this stylisation is different in each mark, the typefaces remain fairly plain. I do not consider this visual difference to make a great impact. The main points of visual difference are:

- The presence of the star-like device in the CA's mark versus the presence of the ring-like device in the RP's mark;

and

- The presence of the text 'ALMAVIVA ENTERPRISE DIGITAL PLATFORM' in the CA's mark, which has no counterpart within the RP's mark.

48. As to the 'G' character at the centre of the device within the CA's mark, my view is that a number of average consumers might either overlook this detail, or notice it after seeing the word 'GIOTTO'.

49. All things considered, I find the parties' marks to be visually similar to a medium degree.

Aural comparison

50. I find that the word 'GIOTTO', in either party's mark, will likely be articulated as 'JEE-O-TOE' (with a 'soft' 'G') or 'GEE-O-TOE' (with a 'hard' 'G'). I do not consider the device elements of either mark to lend themselves to articulation. In my view, a significant number of average consumers may neglect to articulate the wording 'ALMAVIVA ENTERPRISE DIGITAL PLATFORM' present in the CA's mark. For this proportion of average consumers, I find that the parties' marks will be aurally identical.

51. To my mind, the number of average consumers who will articulate all of the text present in the CA's mark, will likely be small. In this instance, the mark will be articulated as: 'JEE/GEE-O-TOE AL-MA-VEE-VA [the remaining English words articulated in the usual way]. The beginnings of the marks will be aurally identical. The significantly longer length of the CA's mark will be very obvious, aurally speaking. For this group of average consumers, the marks will have a low level of aural similarity.

Conceptual comparison

52. The CA has stated that 'GIOTTO' is a name of Italian origin, although it will have no immediate meaning or connotation to the average UK consumer.¹⁴ The CA argues that, for the relevant public, GIOTTO should be treated as an invented word.¹⁵

53. The RP has claimed that 'GIOTTO' 'will be widely recognised by the average consumer as the surname of Giotto di Bondone, the Italian painter and architect thought to be the father of the Renaissance era'.¹⁶

54. I prefer the CA's argument. Whilst I recognise that a number of UK consumers will likely recognise 'GIOTTO' to be the name of an Italian painter, it is my view that there will be a significant proportion of average consumers who will not appreciate this reference. I find that many average consumers will perceive 'GIOTTO' as either an invented word or an Italianate word whose meaning is unknown to them.

55. It is convenient to address the RP's mark first. I find that, for a significant proportion of average consumers, the mark will be understood as either an invented word with no particular meaning, or as a word that is Italianate in origin, whose meaning is unknown. The circular device will contribute very little to the mark in terms of concept and will likely be seen merely as a ring-shaped form rather than denoting anything in particular.

56. I now consider the conceptual aspect of the CA's mark. I find that the 'GIOTTO' element will be understood in the manner already described at [54]. As to the wording 'ALMAVIVA ENTERPRISE DIGITAL PLATFORM', a significant proportion of average consumers will likely see the first word, 'almaviva', as an invented or Italianate word to which no meaning will readily attach. The words 'enterprise', 'digital' and 'platform' are words with which the average consumer will be familiar. 'Enterprise' will be understood as denoting a business venture or some sort of project or undertaking. 'Digital' will likely be understood as relating to computer technology or the online 'realm'. I find that 'platform' will most likely be understood

¹⁴ Form TM26(l), Continuation sheet, at Q.9 (both invalidations).

¹⁵ As above.

¹⁶ RP's counterstatement, [7] (both invalidations).

in the technological sense, i.e. the online infrastructure to support certain activities/tasks. It is my view that the wording 'ALMAVIVA ENTERPRISE DIGITAL PLATFORM', will most likely be seen as playing an informative role in relation to the goods/services. Within this wording, 'Almaviva Enterprise' may be seen as some sort of reference to the undertaking itself.

57. As to the device within the CA's mark, I find that it will contribute little in terms of the overall conceptual message. The device will likely be perceived as a mere geometric sun or star-like form. For the consumer who notices the central 'G' character, this will likely be seen as the initial for 'GIOTTO'. To my mind, the device element of the mark does not readily conjure any particular meaning capable of immediate grasp by the average consumer.

58. I find that the conceptual message that would be understood from the CA's mark is that of a brand named 'GIOTTO' whose goods or services relate to the online 'realm', with a focus on online platforms.

59. Strictly speaking, the marks can be said to be conceptually different. However, it is important to note that the conceptual message conveyed by the CA's mark does not originate from the dominant and distinctive element of the mark, but from the 'informative' wording which plays a secondary visual role. In the instant case, therefore, I do not consider the conceptual difference between the parties' marks to be distinctive or determinative.

Distinctive character of the earlier mark

60. 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)'.¹⁷

61. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

62. Given that no evidence has been filed, I have only the inherent position to consider. I have found the dominant and distinctive element of the CA's mark to be the word 'GIOTTO', which will be perceived by a significant proportion of average consumers as an invented word, or, perhaps, an Italianate word whose meaning is unknown. 'GIOTTO' neither describes nor alludes to the relevant goods/services in respect of which the mark is registered. The 'GIOTTO' element, therefore, will have a high level of inherent distinctive character. Whilst the additional elements within the mark might add to its overall impression, it is the distinctiveness of the shared element that is key when making the assessment of the likelihood of confusion between the marks.¹⁷

¹⁷ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, per Mr Iain Purvis Q.C. (as he then was), [38] – [39].

63. I have found that the wording 'ALMAVIVA ENTERPRISE DIGITAL PLATFORM' will play a lesser role within the mark, in part owing to its less prominent placement and much smaller font size. Whilst 'Almaviva' will also be seen as an invented or Italianate word, I consider that its inclusion within a form of words which plays a secondary role within the mark plays down any potential distinctive character that such a word might otherwise enjoy. Bearing in mind the goods and services that relate to computer technology and/or focus on the online 'realm', I find that the wording 'digital platform' will be seen as somewhat descriptive and/or allusive of those offerings. Where the service concerned is not directly related to technology or digital matters (e.g. 'licensing of intellectual property') this will be less so.

64. Bearing in mind the presence of the highly distinctive element 'GIOTTO' and the less distinctive wording 'ALMAVIVA ENTERPRISE DIGITAL PLATFORM', I find that the CA's mark overall enjoys a level of inherent distinctive character somewhere within the upper range of medium.

Likelihood of confusion

65. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹⁸. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹⁹, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can, therefore, occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or an economically linked undertaking.

¹⁸ Case BL O/375/10 at [16].

¹⁹ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

66. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [12]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

67. I have found all of the contested terms to be either identical or similar (ranging from medium to highly similar degrees) to those of the CA. I have found the Contested Mark to be visually similar to the CA’s earlier mark a) to a medium degree. Aurally speaking, the dominant and distinctive elements of the respective marks are identical. Although the average consumer will register the presence of the additional wording ‘ALMAVIVA ENTERPRISE DIGITAL PLATFORM’, I consider that a significant proportion of average consumers would neglect to articulate this text owing to the lesser role that it plays within the composite mark. Whilst some consumers might articulate all of the text elements within the CA’s mark, they will unlikely comprise a significant proportion. Both marks feature a device, which will be noticed by the average consumer. As noted above at [59], the conceptual difference between the marks leaves the common element, also the dominant and distinctive element, shared by the parties’ marks, undisturbed. This dominant and distinctive element enjoys a high level of inherent distinctive character by virtue of being seen as an invented or non-English word.

68. My view is that the net effect of the differences that I have identified is sufficient to prevent one party’s mark being mistaken or mis-remembered as that of the other, even where the goods/services are identical. The presence of the additional text within the CA’s mark, and the differing device elements, in my view, will not escape the attention of the average consumer. Even the lowest level of attention paid during the purchasing act will be medium. In the light of the foregoing, I find that there is no likelihood of direct confusion.

69. I do not consider that an analysis based upon any of the remaining four earlier marks would result in a finding of a likelihood of direct confusion, either.

70. However, for the reasons that follow, I do find a likelihood of indirect confusion with respect to the CA's earlier mark a).

71. In the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said the following at [16]:

'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'.

72. Arnold LJ emphasised that 'there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion'.²⁰

73. In *L.A. Sugar Limited v Back Beat Inc*²¹ Mr Iain Purvis Q. C. (as he then was), as the Appointed Person, explained that:

(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

²⁰ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

²¹ Case BL O/375/10.

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).

74. I remind myself that a finding of a likelihood of indirect confusion should not be made merely because the competing marks share a common element.²² I also bear in mind that the above-mentioned categories are not intended to be exhaustive.

75. I consider that the instant case most closely aligns with the first of Mr Purvis' categories. The common element 'GIOTTO' is highly distinctive, and the additional wording, 'ALMAVIVA ENTERPRISE DIGITAL PLATFORM', present in the CA's mark would most likely be seen as informative rather than indicating trade origin. The average consumer might see the different devices within the marks as simply stylistic differences between related marks belonging to the same or economically-related undertakings. For example, the variations might be seen as denoting different lines of goods or packages of services. The 'informative' wording within the CA's mark might be seen as an element which may, or may not, appear within either party's mark from time to time. I find that there is a likelihood of indirect confusion between the parties' marks. I find this to be the case for all of the CA's goods and services.

Conclusion

76. Both invalidation actions CA506717 and CA506718 have succeeded in their entirety. Subject to a successful appeal, both International Registration

²² Case BL O/547/17, [81.4].

WO0000001514927 and UK trade mark registration UK00801514927 will be declared invalid in their entireties.

Costs

77. The CA is the successful party and is, therefore, entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 1/2023, calculated as follows:

Official filing fees for invalidations x2:	£400
Preparing statements and considering the other side's statements x2 (£300 and £100, respectively):	£400
Total:	£800

78. I have awarded a sum of £400 for the preparation of the CA's statements and consideration of the RP's statements (which is below the minimum threshold of £250 per claim) to reflect the fact that the pleadings for CA506717 and CA506718 were almost identical.

79. I, therefore, order Giotto.ai SA to pay to ALMAVIVA S.P.A. the sum of £800. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of January 2026

N. R. Morris

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

Annexe 1

The goods and services to be compared:

Earlier Marks:	Contested Marks:
<p>Class 9: <i>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Computer software; Electronic diaries; Intercommunication apparatus; Precision measuring apparatus; Vehicles (Navigation apparatus for -) [on-board computers]; Satellite navigational apparatus; Naval signalling apparatus; Nautical apparatus and instruments; Commutation (Electric apparatus for -); Regulating apparatus, electric; Measuring devices, electric; Monitoring apparatus, electric; Electro-dynamic apparatus for the remote</i></p>	<p>Class 9: <i>Software; artificial intelligence and machine learning software; open-source software (OSS); calculating devices; computers and computer peripheral devices; computer software for encryption; computer software for database management; computer operating software; artificial intelligence software for healthcare; life saving devices; computer software applications, downloadable; computer software for business purposes; computer shareware; computer application software for cellular phones; electronic publications; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media.</i></p>

control of railway points; Electro-dynamic apparatus for the remote control of signals; Blueprint apparatus; Cameras; Global Positioning System [GPS] apparatus; Apparatus for programming data; Audiovisual teaching apparatus; Diagnostic apparatus, not for medical purposes; Phototelegraphy apparatus; Speed measuring apparatus [photography]; Sound recording apparatus; Time recording apparatus; Distance recording apparatus; Sound reproduction apparatus; Railway traffic safety appliances; Sound transmitting apparatus; Distance measuring apparatus; Radios; Radios for vehicles; Telephones; Distribution boxes [electricity]; Encoded identification bracelets, magnetic; Calculators; Juke boxes for computers; Identity cards, magnetic; Integrated circuit cards [smart cards]; Couplers [data processing equipment]; Floppy discs; Circular slide rules; Disks, magnetic; Optical discs; Ignition (Electric apparatus for remote -); Computers; Transmitting sets [telecommunication]; Interfaces for computers; Circuit closers; Disk drives for computers; Readers [data processing equipment]; Computer memory devices; Microprocessors; Measuring apparatus; Modems; Monitors [computer programs]; Computer programs [downloadable

<p>software]; Computer operating programs, recorded; Recorded computer programs; Electronic publications, downloadable; Scanners [data processing equipment]; Computer software, recorded; Navigational instruments; Magnetic data media; Encoded magnetic cards; Magnetic tape units for computers; Peripherals adapted for use with computers; Computers; Voting machines.</p>	
<p>Class 42: <i>Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Computer rental; Updating of computer software; Computer system analysis; Consultancy in the field of energy-saving; Computer software consultancy; Consultancy in the design and development of computer hardware; Web site design consultancy; Quality control; Conversion of computer programs and data, other than physical conversion; Conversion of data or documents from physical to electronic media; Creating and maintaining web sites for others; Digitization of documents [scanning]; Duplicating computer programs; Computer software design; Provision of scientific</i></p>	<p>Class 42: <i>Computer system analysis; data encryption services; cloud computing; software as a service (SaaS); computer software design; computer system design; development of computer platforms; installation of computer software; rental of computer software; maintenance of computer software; updating of computer software; providing search engines for the Internet; computer programming; technological research; off-site data backup; rental of web servers; electronic data storage; monitoring of computer systems by remote access; hosting computer software applications for others; hosting multimedia and interactive applications; hosting computer databases; hosting platforms on the Internet; server hosting; hosting memory space on the Internet; hosting on-line web facilities for others;</i></p>

<p><i>information, advice and consultancy in relation to carbon offsetting; Providing search engines for the internet; Engineering services; Installation of software; Rental of software; Maintenance of software; Monitoring of computer systems by remote access; Rental of web servers; Hosting computer sites; Computer system design; Computer programming; Recovery of computer data; Research and development for others; Research in the field of environmental protection; Mechanical research; Scientific research; Technical research; Server hosting; Meteorological information; Information technology [IT] consultancy; Laboratory (Scientific -) services; Computer virus protection services; Software as a service [SaaS]; Conducting technical project studies; Energy auditing.</i></p>	<p><i>information technology [IT] consultancy; computer software consultancy; computer technology consultancy; conversion of data or documents from physical to electronic media; conversion of computer programs and data, other than physical conversion; design and development of medical diagnostic apparatus; design and development of computer software for use with medical technology; computer programming for the medical sector; computer-aided diagnostic testing services; design and development of medical technology.</i></p>
<p><i>Class 45: Licensing of computer software [legal services]; Physical security consultancy; Intellectual property consultancy; Mediation; Monitoring intellectual property rights for legal advisory purposes; Security services for the protection of property and individuals; Licensing of intellectual property; Copyright management; Litigation services.</i></p>	<p><i>Class 45: Licensing of intellectual property; licensing of databases; licensing of computer software; licensing of technology; online social networking services.</i></p>

