

O/0146/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004168736
IN THE NAME OF EBIQUITY PLC
TO REGISTER THE FOLLOWING TRADE MARK:

ERA

IN CLASS 35

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP600003717
BY MICO HOLDING LTD

Background and pleadings

1. On 04 March 2025, Ebiquity Plc (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 04 April 2025. Protection is sought in respect of the following services:¹

Class 35: Advertising and promotional services; advertising, media and marketing consultancy; analysis of advertising response and market research; compiling indexes of information for commercial or advertising purposes; media auditing; modelling for advertising or sales promotion; none of the aforesaid services being in relation to strategic cost services, organisations/business cost reduction services, cost analysis services, cost management services, business to business process improvement services or procurement services.

2. On 04 July 2025, MICO Holding Ltd (“the Opponent”) opposed the application under the fast track opposition procedure, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent relies upon the following UK trade marks (“UKTM”):

era GROUP (1 of 2 in series)

ERA GROUP (2 of 2 in series)

UKTM no. UK00003851953 (series of 2 marks)

Filing date: 22 November 2022

Registration date: 17 November 2023

Relying upon the following services:

¹ This is the final specification following the Applicant’s Form TM21b application to limit the original specification on 21 July 2025.

Class 35: Business consultancy; business management assistance; business management consultancy; business organisation consultancy; accounting consultancy; compilation and provision of business analysis, business information or business reports; business analysis and consultancy relating to cost; business analysis and consultancy relating to purchasing; cost-containment consultancy; cost-containment analysis; cost savings analysis services; cost savings consultancy; all of the aforesaid in relation to strategic consulting services, namely, strategic cost services, organisations/businesses cost reduction services, cost analysis services, cost management services, business to business process improvement services, procurement services; none of the aforesaid in relation to real estate and real estate franchising.

3. By virtue of its earlier filing date, the Opponent's mark constitutes an earlier mark within the meaning of section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to the use provisions contained in section 6A of the Act. The Opponent can, therefore, rely upon all of the services it has identified without having to demonstrate use.
4. The Opponent pleads that the services at issue are identical or similar and that the marks are similar.
5. The Applicant filed a counterstatement denying the claims made by the Opponent.
6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

is to require the parties to seek leave in order to file evidence in fast track oppositions.

However, neither party requested permission to file evidence.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; however, the Applicant filed written submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers.
8. The Applicant is represented by Withers & Rogers LLP; the Opponent is represented by Ezra's iP.²
9. 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

Section 5(2)(b)

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

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

...

² As of 2 January 2026, prior to this the Opponent was represented by Alpha & Omega.

(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”.

11. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(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 services

12. The services for comparison are as follows:

Opponent's services	Applicant's services
Class 35: Business consultancy; business management assistance; business management consultancy; business organisation consultancy; accounting	Class 35: Advertising and promotional services; advertising, media and marketing consultancy; analysis of advertising response and market research;

<p>consultancy; compilation and provision of business analysis, business information or business reports; business analysis and consultancy relating to cost; business analysis and consultancy relating to purchasing; cost-containment consultancy; cost-containment analysis; cost savings analysis services; cost savings consultancy; all of the aforesaid in relation to strategic consulting services, namely, strategic cost services, organisations/businesses cost reduction services, cost analysis services, cost management services, business to business process improvement services, procurement services; none of the aforesaid in relation to real estate and real estate franchising.</p>	<p>compiling indexes of information for commercial or advertising purposes; media auditing; modelling for advertising or sales promotion; none of the aforesaid services being in relation to strategic cost services, organisations/business cost reduction services, cost analysis services, cost management services, business to business process improvement services or procurement services.</p>
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13. 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”.³

14. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice

³ Paragraph 29

of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

15. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- “(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.”

16. For the purposes of considering the issue of similarity of the services, it is permissible to consider groups of terms collectively where appropriate: *Separode* Trade Mark, BL O-399-10.

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

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

"12. ... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

19. 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: *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, at [365].

20. Before I conduct the services comparison, I note that the Opponent has not provided any submissions identifying precisely which of its earlier services it believes are similar to the Applicant’s exact services, furthermore, it has failed to give precise reasons why the competing services would be similar to one another. Consequently, whilst conducting the services comparison, I shall keep the principles of *Smart X*,⁴ in mind and proceed to compare terms on the basis of obvious similarity (or lack thereof) only.

⁴ BL O/0911/24

21. As for the Applicant, it challenges any alleged similarity between the services and submits the following in relation to the competing services:

*“The general purpose of business management and consultancy is to assist companies with improving performance or achieving organisational objectives. The general purpose of advertising and marketing services is to assist companies with the promotion of their products/services. The respective services may share the same end users, but they serve a different purpose and are provided by different entities. They are neither in competition, nor are they complementary”.*⁵

22. Whilst I note these submissions, I observe that the earlier services are not general business management and consultancy services but are restricted further to business and consultancy services for strategic costs, costs analysis, cost management and procurement services (amongst others), which the Applicant goes on to deal with saying:

*“The distinction between the respective services is all the more obvious when it is borne in mind that the Opponent’s services are all specifically related to strategic cost services, cost reduction/analysis/management services, process improvement and/or procurement, whereas the Applicant’s services all specifically exclude strategic cost services, cost reduction/analysis/management services, process improvement and/or procurement. Thus, not only are the fundamental services themselves different, but the specific areas to which they relate are also distinct.”*⁶

23. For clarity, when making my comparisons below, I will take into account each parties’ limitation within its specification which have the effect of creating a further layer of difference between the respective services.

24. Furthermore, I acknowledge the Applicant has referred to several cases within its submissions,⁷ helpfully providing full decisions and citing specific paragraphs at

⁵ Applicant’s submissions, paragraph 14

⁶ Applicant’s submissions, paragraph 15

⁷ BL O/656/22, BL O/435/19, BL O/736/18, BL O/330/16, BL O/327/16, BL O/280/13.

paragraph 12 of its submissions. The purpose of its reliance on these cases is to show what other Hearing Officers have found when analysing similar services. I keep in mind that I am not bound by previous decisions of my colleagues, and moreover, the competing services that I must consider are not exactly the same as those that have been considered by other Hearing Officers. That said, I acknowledge the considerations and analysis made in these decisions, and bear these in mind when making my own decision.

Advertising and promotional services; advertising, media and marketing consultancy; none of the aforesaid services being in relation to strategic cost services, organisations/business cost reduction services, cost analysis services, cost management services, business to business process improvement services or procurement services.

25. The above services are all advertising and marketing services or consultancy for such. In contrast, the Opponent's services are all business consultancy services specifically related to cost services, such as assessing operational efficiency with the aim of reducing costs for organisations. As mentioned above, the presence of the limitation creates a further point of difference as the Applicant looks to limit the exact services that the Opponent's specification is restricted to. The Opponent's services differ in nature, method of use and intended purpose to the applied for services. The applicant's services are for the purpose of promoting a business' reputation amongst consumers, unlike the earlier services which focus on the cost management of the overall business operations. The trade channels do not appear to coincide as there is no reason why a company offering advertising and marketing services would also offer business services specifically related to cost management and cost reduction for businesses, or procurement. The services are not competitive as one cannot carry out the function of the other, neither are the services complementary as advertising and marketing services are not needed for the use of business services related to costs etc. and vice versa. Even though businesses may use both services, this is not sufficient for a finding of similarity. Consequently, I find that the competing services are dissimilar.

Analysis of advertising response and market research; compiling indexes of information for commercial or advertising purposes; none of the aforesaid services being in relation to strategic cost services, organisations/business cost reduction services, cost analysis services, cost management services, business to business process improvement services or procurement services.

26. In my view, the best comparator is the Opponent's term "*compilation and provision of business analysis, business information or business reports; all of the aforesaid in relation to strategic consulting services, namely, strategic cost services, organisations/businesses cost reduction services, cost analysis services, cost management services, business to business process improvement services, procurement services*" which are services for compiling and producing business reports and analysis in relation to costs and cost management/reduction. Whilst there is a slight overlap in nature, as both services involve analysis and compilation of information, this is very general and not enough for a finding of similarity. The applied for services are in relation to advertising and marketing, in contrast, the Opponent's services are focused on business strategic consultancy services specifically for various types of cost services. These services have different methods of use and core purposes; one is to analyse and compile information for the purpose of gaging the response to advertising, the other is to analyse and compile information to see where in the business, costs can be optimised or reduced. Furthermore, there is no apparent overlap in trade channels as one will be provided by an advertising and marketing specialist, whilst the other will be provided by business consultants specialising in cost management and reduction or procurement. The services are not competitive as they cannot fulfil the role of the other, neither is there any obvious complementarity as the services are not important to the use of the other, and even if they were, consumers would not reasonably expect the same company to offer the competing services. Although business users may use both services, this is not enough to engage similarity as use is far too generalised. Absent of any submissions to the contrary explaining exactly how these services are similar, I see no overlap in the respective services and ultimately find that the services are dissimilar.

Media auditing; none of the aforesaid services being in relation to strategic cost services, organisations/business cost reduction services, cost analysis services, cost management services, business to business process improvement services or procurement services.

27. I understand media auditing to be a service that analyses how successful advertising has been and whether it has successfully reached the intended target audience. Further, I note that the limitation means that these services are not in relation to strategic cost, costs management and cost analysis such as the Opponent's. Therefore, given the limitation the applied for services would not include services relating to media spend, but instead include verifying media advertising compliance, and checking the reach and frequency of these placements. As such, the nature, method of use and intended purpose differ to the Opponent's business services which are specifically related to costs, i.e. strategic cost reduction and optimisation of procurement processes. Without evidence to the contrary, there appears to be no overlap in trade channels as the applied for services would be offered by marketing or media specialists, whilst the earlier services would be offered by business consultants or costs specialists. The services are not competitive as they cannot perform the role of the other. Neither are the services complementary, as the applied for media auditing services are not important or essential for the use of the Opponent's business services for costs, or vice versa, and further consumers would not reasonably expect the same undertaking to be responsible for both the competing services. Whilst businesses may use both of the respective services, this is too broad for a finding of similarity. Overall, I consider the competing services are dissimilar.

Modelling for advertising or sales promotion; none of the aforesaid services being in relation to strategic cost services, organisations/business cost reduction services, cost analysis services, cost management services, business to business process improvement services or procurement services.

28. It is not evident why modelling services for the advertisement of sales promotion would be similar to the Opponent's earlier services which are all

business services relating to costs. There is no apparent overlap in nature, method of use, intended purpose, trade channels or users. Neither are the services competitive or complementary. As such, the services are dissimilar.

29. Consequently, as a level of similarity is required between the competing services in order for there to be a likelihood of confusion under section 5(2)(b) of the Act,⁸ the opposition would fail irrespective of whether the competing marks were found to be identical or similar.

Conclusion

30. The opposition under section 5(2)(b) of the Act has not succeeded. Subject to any successful appeal against my decision, the application may proceed to registration.

COSTS

31. The Applicant has been successful and is entitled to a contribution towards its costs. Therefore, considering the guidance in Tribunal Practice Notice 1/2023, set out under '*scale adaptations for trade mark fast track opposition proceedings*', I award the Applicant costs on the following basis:

Preparing a notice of opposition and considering the counterstatement:	£150
Preparing written submissions in lieu of a hearing:	£300
Total:	£450

32. I therefore order MICO Holding Ltd to pay Ebiquity Plc the sum of **£450**. The above sum should be paid within twenty-one days of the expiry of the appeal period or,

⁸ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 23rd day of February 2026

**Sarah Wallace
For the Registrar**