O/0157/26

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 4006721 BY T.M.L.E. LIMITED TO REGISTER THE TRADE MARK:

GeminAI

IN CLASSES 9, 35, 42 AND 45

AND

THE OPPOSITION THERETO UNDER NO. 446762 BY GOOGLE LLC

BACKGROUND & PLEADINGS

1. T.M.L.E. LIMITED ("the applicant") applied to register the trade mark shown on the front page of this decision in the United Kingdom on 25 January 2024. It was accepted and published in the Trade Marks Journal on 9 February 2024 for the following goods and services:

> **Class 9:** Downloadable mobile applications; Communication, networking and social networking software; Document management software; Database management software; Data processing software; Reporting software; Business management software.
>
> **Class 35:** Business assistance, management and administrative services; Business enquiries and investigations; Data processing services in the field of healthcare; Preparation of expert evaluations and reports relating to business matters; Information and expert opinions relating to companies and business; Database management; Administrative services relating to the management of legal dockets.
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> **Class 42:** Software as a service [SaaS]; Providing temporary use of non-downloadable software applications accessible via a web site; Maintenance of computer records; Electronic storage of medical records; Electronic data storage; Design and development of systems for data input, output, processing, display and storage.
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> **Class 45:** Legal support services; Legal research; Legal information services; Legal document preparation services; Legal consultation services; Providing information about legal services via a website; Expert consultancy relating to legal issues; Preparation of legal reports; Health and safety risk assessment services; Health and safety risk management; Information services relating to health and safety; Consultancy services relating to health and safety.

2. On 9 April 2024, Google LLC ("the opponent") opposed the application on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act")[1]. For the Sections 5(2)(b) and 5(3) grounds the following international registration ("earlier mark") is relied upon:

Trade Mark no.	WO0000001772296
Trade Mark	GEMINI
Services for which the mark is registered	Class 42 (shown in paragraph 26 of this decision)
International registration date	4 October 2023
Designation date	4 October 2023
Date of protection of the international registration in UK	10 April 2024
Priority date	9 May 2023
Priority country	Tonga
TM from which priority claimed	TO/M/2023/04493

3. Under Section 6(1) of the Act, the opponent's international registration clearly qualifies as an earlier trade mark. The earlier mark has not been registered for five years or more before the filing date of the application, and as a result it is not subject to the proof of use requirements as set out in Section 6A of the Act.

4. For the purposes of the claims under Sections 5(2)(b) and 5(3), the opponent relies upon all the terms in its specification.

[1] 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.

5. Under Section 5(2)(b) of the Act, the opponent claims that due to the high degree of similarity between the competing marks and the competing specifications, there exists a likelihood of confusion.

6. Under Section 5(3), the opponent claims that the similarity between the earlier mark and the contested mark is such that the relevant public will believe that they are used by the same undertaking, or that there is an economic connection between the two users. It contends that it has an established reputation in its mark for the respective services, such that the relevant public will be confused that there is a commercial connection between the parties. The opponent also argues that it will be unable to control the quality of the goods and services supplied by the applicant and, if that quality is inferior, the reputation of the earlier mark will be tarnished.

7. It further claims that the applicant would gain an unfair advantage as it would not have to make as much of an investment in promoting and marketing the goods and services sold under the mark, as it could "free ride" on the investment made by the opponent. Such use of the contested mark in relation to the contested goods and services will be detrimental to the earlier mark's distinctive character, and erode its distinctiveness, meaning that it would no longer be capable of arousing an immediate association with the opponent's services making it less likely that consumers will use the opponent's services due to the uncertainty resulting in change in economic behaviour.

8. Under Section 5(4)(a) of the Act, the opponent relies upon the sign "GEMINI" which it claims to have used throughout the UK since 6 December 2023 in relation to the same terms as they appear in Class 42 of the earlier mark. It claims that the opponent has goodwill in its mark and the use of the contested mark would be contrary to the law of passing off.

9. In response, the applicant filed a lengthy counterstatement. Under Section 5(2)(b), the applicant denied similarity in relation to the competing marks, goods and services, and average consumer. Thus, it asserted that there

will be no likelihood of confusion. Under Section 5(3), the applicant denied a link would be made between the marks. It also denied that the use of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character, or the reputation of the earlier mark. Under Section 5(4)(a), the applicant stated that the consumers "*will not connect the Opponent and our offering due to how niche the applications of our offering are, and so there will be no possibility of adverse impact in the Opponent's earlier mark*." I will return to the pertinent points later in this decision.

Papers Filed and Representation

10. Only the opponent filed evidence in these proceedings. This comes in the form of a witness statement from Monique Liburd, who is a Senior Trade Mark Counsel of the opponent in these proceedings. Her witness statement is dated 11 October 2024 and is accompanied by 22 exhibits (ML1-ML22). The purpose of the evidence is to prove enhanced distinctiveness, reputation and goodwill in the earlier mark.[2]

11. Both parties filed written submissions in lieu of a hearing ("final submissions"): the applicant on 4 December 2024 and the opponent on 3 December 2024.

12. I have taken the evidence and submissions into account in reaching my decision and will refer to them below, where necessary.

13. No hearing was requested and so this decision is taken following a careful consideration of the papers.

14. In these proceedings, the applicant is unrepresented and the opponent is represented by Fieldfisher LLP.

[2] The applicant filed comments in response to the opponent's evidence by way of letter dated 1 Nov 2024. However, I do not intend to summarise it as there was nothing of note other than repeating what it said in its counterstatement.

DECISION

Section 5(2)(b)

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

> "A trade mark shall not be registered if because-
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

16. Section 5A states:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

17. 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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

(i) mere association, in the strict sense that the later mark brings 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; and

(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

18. When making the comparison, all relevant factors relating to the goods or services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

> "23. In assessing the similarity of the goods or services concerned […], all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary."

19. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

> "(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."

20. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

21. In *YouView TV Ltd v Total Ltd,* [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'.

> Each involved a straining of the relevant language, which is incorrect. Where words of 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."

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

> "[…] 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."

23. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

> "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."

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

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

25. In *FIL Limited & Anor v Fidelis Underwriting Limited & Ors* [2018] EWHC 1097 (Pat), Arnold J (as he then was) considered how this principle should be applied in the case of services:

> "85. […] terms in specifications of goods and services should be given their ordinary and natural meaning, but this is subject to two overlapping qualifications: first, specifications of services are inherently less precise than specifications of goods, and therefore should be interpreted in a manner which confines them to the core of the ordinary and natural meaning rather than more broadly; and secondly, terms should not be interpreted so liberally that they become unclear and imprecise."

26. The competing goods and services to be compared are shown in the following table:

Earlier Services	Contested Goods & Services
Class 42: Providing online non-downloadable software for use in large language models and artificial intelligence; providing online non-downloadable software using artificial intelligence for the production of human speech and text; providing online non-downloadable software for natural language processing, generation, understanding and analysis; providing online non-downloadable software for artificial intelligence and machine-learning based language and speech processing software; providing online non-downloadable software for creating generative models; providing	**Class 9:** Downloadable mobile applications; Communication, networking and social networking software; Document management software; Database management software; Data processing software; Reporting software; Business management software. **Class 35:** Business assistance, management and administrative services; Business enquiries and investigations; Data processing services in the field of healthcare; Preparation of expert evaluations and reports relating to business matters; Information and expert

online non-downloadable software for processing speech, text, sound, code, videos, images, and sound input; providing online non-downloadable software for generating speech, text, sound, code, videos, images, and sound output; research and development services in the field of artificial intelligence; research, development and evaluation of large language models and data sets; research, design and development of computer programs and software; providing online non-downloadable software for managing data sets and performing safety checks in the field of artificial intelligence; providing online non-downloadable software for multi-modal artificial intelligence and machine-learning based language, text, sound, code, video, image, speech, and sound processing software; providing temporary use of online non-downloadable software for facilitating multi-modal natural language, speech, text, sound, code, videos, images, and sound input; research and development services in the field of multi-modal computer natural language processing, artificial intelligence, and machine learning; providing temporary use of online non-downloadable software for an integrated development environment for large language models; providing online non-downloadable software for use in the fields of artificial intelligence, machine learning, natural language generation, statistical learning, mathematical learning, supervised learning, and unsupervised learning; providing online non-downloadable software for accessing information from searchable indexes and databases of information, including text, music, images, videos, software algorithms, mathematical equations, electronic documents, and databases; application service	opinions relating to companies and business; Database management; Administrative services relating to the management of legal dockets. **Class 42:** Software as a service [SaaS]; Providing temporary use of non-downloadable software applications accessible via a web site; Maintenance of computer records; Electronic storage of medical records; Electronic data storage; Design and development of systems for data input, output, processing, display and storage. **Class 45:** Legal support services; Legal research; Legal information services; Legal document preparation services; Legal consultation services; Providing information about legal services via a website; Expert consultancy relating to legal issues; Preparation of legal reports; Health and safety risk assessment services; Health and safety risk management; Information services relating to health and safety; Consultancy services relating to health and safety.

provider featuring application programming interface (api) software.	

27. In summary, the opponent claims that the contested goods and services are identical or similar. The opponent, within its final submissions, provided a table with highlighted terms, followed by broad submissions on the similarity or identity of the competing goods and services. While some comparisons have been made, the opponent has not provided particularised submissions or explanations as to *why* it considers these competing terms to be similar, nor has it specified which earlier terms are the closest comparators to the specific terms across the entire contested specification (i.e. term-by-term comparison). Taking guidance from Iain Purvis KC, sitting as Appointed Person in the *SmartX*,[3] I note the opponent's submissions and will proceed to make my own comparisons.

28. In addition, the opponent often references EUIPO decisions in various instances to support a finding of similarity between the competing terms. However, it has not provided me with copies of these decisions, and thus I cannot consider them in my assessment. Regardless, I am not bound by decisions of the EUIPO; instead, my decision is to be based on a multifactorial assessment of the relevant factors before me in the present case. Those factors do not include the existence of cases in other jurisdictions.

[3] See BL O/0911/24. He stated: "28. […] it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identicality). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach […] would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent."

29. Within its defence, the applicant denied any similarity between the competing specifications claiming that:

> "[…] beyond the use of 'AI' our goods and services are wholly different.
>
> As outlined above, the goods and services to be covered by the GeminAI mark are the proprietary technology created by T.M.L.E. Ltd to assist lawyers and medical professionals in the completing of expert evidence. This is not a large-language-model, it is not search or query-able and it is not intended to allow users to generate text to their own queries. It is only being used to facilitate the management and production of expert evidence.
>
> The Opponent's mark covers a generalist set of products that are wide-ranging in application but not directed at the same consumer base, for the same purposes as ours.
>
> Our product will be marketed, as discussed, at a very niche section of the public and there will be no confusion between our offering and the Opponent's meaning there would not be any resulting change in economic behaviour. The relevant public, in our submission, would continue to use both products for wholly separate purposes."

30. In addition, the applicant in its final submissions argued that:

> "**Relevant Public:** The intended users of "GeminAI" are a highly specialised group of professionals-medical and legal practitioners involved in medico-legal services. These individuals are well-educated and discerning in their selection of tools, significantly reducing any risk of confusion.
>
> **Distinct Markets and Applications:**
>
> The Opponent's" Gemini" mark applies to large language models (LLMs) and general AI solutions for a broad audience.

By contrast, "GeminAI" is tailored for niche medico-legal use, assisting with the preparation and management of medical evidence. These distinct applications and markets ensure there is no overlap or confusion."

31. I note that the applicant's terms are unlimited and not restricted by a sub-category or its users, such as medical and legal practitioners, as the applicant puts forward. The differences between the market sectors of the respective goods and services, as well as the particular characteristics of the competing terms at issue, are irrelevant, except to the extent that those differences are apparent from each party's specification. Therefore, I must consider the matter based on the terms the parties have registered, and the assessment I will undertake between the competing specifications is notional and objective rather than subjective,[4] and I will say no more.

32. Pursuant to section 60A of the Act, I am mindful of the fact that the goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same Class, nor automatically regarded as dissimilar from each other on the ground that they appear in different Classes.

33. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.[5] Further, where the terms listed are particularly wide or vague, I will endeavour to follow the principles outlined in *Skykick* by comparing what I consider to be the core meaning of the services, without affording them neither a too liberal, nor an artificially narrow, interpretation.

[4] See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraph 22 and *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraphs 78 and 84.

[5] *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

34. I also note that in *Unicorn Studio Inc v Veronese,* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense. Meanwhile, in *RALEIGH INTERNATIONAL* Trade Mark [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.

Class 9

Downloadable mobile applications

35. The contested term is a broad term that would include a wide range of mobile applications across different fields. The opponent claims that the contested goods are highly similar to the earlier services. I consider that the closest term from the earlier specification is "*providing online non-downloadable software for generating speech, text, sound, code, videos, images, and sound output*". The core meaning of the services relates to the provision of online software that enables users to generate output. The use of mobile applications could be integral to and indispensable for the delivery of the services, and the average consumer may think that the goods and services are the responsibility of the same undertaking or economically linked undertakings. Thus, there will be a degree of complementarity between the contested goods and the earlier services. The competing terms may also share the same users (general public), and there will be some overlap in trade channels, as the contested goods would typically be purchased from websites or app stores, and sometimes directly from software developer websites that also offer such services. Goods are intrinsically different in nature to services, and they are used in different ways. Thus, the nature and method of use of the services are different to that of the goods themselves. Overall, I consider the competing goods and services to be similar to a medium degree.

Communication, networking and social networking software

36. My reasoning above also applies here, and I consider that there may be a degree of complementarity between the competing goods and services. They may also overlap in users, trade channels, while differing in nature and method of use. I find them to be similar to a medium degree.

Document management software; Database management software

37. I consider that the closest term from the earlier specification is "*providing online non-downloadable software for accessing information from searchable indexes and databases of information, including text, music, images, videos, software algorithms, mathematical equations, electronic documents, and databases*". In my view, the core function of the earlier services relates to the provision of online software that enables users to search and retrieve electronic documents and databases from searchable indexes and databases. In this respect, although the competing terms differ in nature (goods v services), they overlap in purpose, enabling the handling of documents and databases. There may be a shared method of use as the contested terms are broad terms and may also cover non-downloadable software, which may be accessed by consumers online. It is also possible for the same undertaking to provide both goods and services, and the competing terms may be offered via the same trade channels, such as specialist websites. There will also be an overlap in users (general public). Again, in this case, the use of the contested goods could be integral to the delivery of the services, giving rise to a degree of complementarity with the opponent's services. This is because the average consumer may think that the competing goods and services are the responsibility of the same undertaking or economically linked undertakings. Further, I consider there will be a degree of competition between the goods and services, as users may be faced with the choice of selecting the contested services to use via an online portal or purchasing the appropriate computer programs as goods. Therefore, I consider the

competing goods and services to be similar to between a medium and high degree.

Business management software

38. The contested term is software that enables business users to run and control business operation such as enterprise resource planning, customer relationship management, and HR. In my view, the closest comparable term in the earlier specification is "*application service provider featuring application programming interface (api) software*". I consider that the core meaning of the earlier services relates to the provision of software applications offering programmable interfaces (APIs) that allow interconnectivity and automation between systems. The nature of the competing terms is different, but there is an overlap in purpose as both can support business operations via business-oriented software. Further, the competing terms may overlap in users as they will be offered to business users and professionals. There may also be an overlap in trade channels where the goods and services may be available online in specialist websites. I also consider that there is a complementary relationship between the competing terms as the contested software may be intrinsic to the delivery of the services, playing an important and integral part, which may lead the consumers to believe that they are both offered by the same undertaking. However, I do not consider that they are in competition. I find that the competing terms are similar to a medium degree.

Data processing software

39. I note that the contested term is very broad. It is my view that the closest comparable term from the earlier specification is "*providing online non-downloadable software for multi-modal artificial intelligence and machine-learning based language, text, sound, code, video, image, speech, and sound processing software".* Following the guidance from *Avnet*, it is my understanding that the core meaning of the earlier services is the provision of online software that utilises artificial intelligence and machine learning

to process various data types (e.g. text, sound, code, etc.). For instance, this could involve the online use of AI technologies to extract transcripts from videos. In this regard, the nature and method of use of the competing terms are different, but the end purpose may coincide as the respective goods and services concern the processing of data. In addition, the competing terms may share the same users and trade channels. I do not preclude a degree of complementarity between the contested term and the earlier services. This is in particular due to the potential that the contested goods could be important to the provision of the online processing software. Therefore, the consumers will expect that the respective terms are offered by the same undertaking. In this regard, there may be an overlap in users and potentially trade channels. Further, there is a degree of competition, as users may choose to purchase downloadable software or use online (non-downloadable) services based on their needs. I find that the competing terms are similar to between a medium to high degree.

Reporting software

40. The contested goods relate to the delivery of formatted output, i.e. reports, for user review by extracting or compiling data from various sources. I consider the earlier term "*providing online non-downloadable software for generating speech, text, sound, code, videos, images, and sound output*" to be the closest comparable term. The core meaning of the earlier service is to generate output in various formats, including text, via the web. Following the same approach in the preceding paragraph, although the general nature and the method of use of the competing terms differ, there is an overlap in purpose. They also share the same users and trade channels, and there is a degree of complementarity and competition for the same reasons as provided in the preceding paragraph. Therefore, the competing goods and services are similar to between a medium to high degree.

Class 35

Database management; Data processing services in the field of healthcare

41. I consider there to be a degree of similarity between the contested services and the earlier "*providing online non-downloadable software for managing data sets and performing safety checks in the field of artificial intelligence*". This is because there is a degree of complementarity, as the earlier software services may be important to the delivery of the contested services. Therefore, the consumer may think that the responsibility for the competing services lies with the same undertaking. Also, there will be a degree of overlap in users, as consumers seeking database management and data processing services may well be the users of the earlier non-downloadable software services. Further, there may also be overlap in trade channels, as the competing services may be offered on the same specialist websites. However, the competing services differ in their nature, purpose, and method of use, and they are not in competition. I find that the services are similar to a medium degree.

Administrative services relating to the management of legal dockets

42. Following the same approach in the preceding paragraph, I consider that the earlier term "*providing online non-downloadable software for managing data sets and performing safety checks in the field of artificial intelligence*" is similar to a medium degree to the contested terms for the same reasons advanced above.

Business assistance, management and administrative services; Business enquiries and investigations; Information and expert opinions relating to companies and business; Preparation of expert evaluations and reports relating to business matters

43. The contested terms are all business-related services that pertain to the management and administration of businesses. The opponent submits that "*the Opponent's artificial intelligence and large language model*

software is used in the provision of such services and can directly provide such services". In the absence of evidence, I do not consider that the competing services are similar, as they differ in nature, purpose, method of use, and they are not in competition or complementary. As to the latter, although such services can be used together, I have no particularised submissions from the opponent on this point to explain or support how the services are considered indispensable to one another, not least to an extent that the consumer would believe them to originate from a single undertaking. If I am wrong on this finding, I note that the degree of complementarity would not be sufficiently pronounced in this case,[6] as the consumers would not reasonably conclude that the same undertaking that provides business-related services is also responsible in broad terms for the provision of artificial intelligence and large language model software services, or vice versa. Notably, the earlier services are not offered through the same distribution channels as the contested services. Thus, I do not consider that any complementarity there might be would give rise to a pronounced degree of similarity between the competing services, and there is no rule that 'complementarity' always and necessarily equals 'similarity'.[7] Consequently, I find them to be dissimilar.

Class 42

Software as a service [SaaS]; Providing temporary use of non-downloadable software applications accessible via a web site

44. I consider that the contested services are broad enough to encompass the earlier services "*application service provider featuring application*

[6] Mr Hobbs KC, sitting as the Appointed Person, in *Energy Beverages LLC v Gogu Marin*, BL O/074/19 ruled that: "*A finding of no similarity may legitimately be made, despite the existence of a degree of complementarity, if that complementarity is not sufficiently pronounced for it to be accepted that from the consumer's point of view the goods are similar within the terms of section 5(2)(b).*"

[7] See *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, paragraph 22, in which the Appointed Person quoted: *Assembled Investments (Proprietary) Ltd v. OHIM*, T105/05, paragraphs 30 to 35 (which was upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*, C-398/07P, paragraphs 34, 35).

programming interface (api) software". Therefore, I find them to be identical as per *Meric*.

Design and development of systems for data input, output, processing, display and storage

45. The contested term is a broad term that will readily cover the earlier term "*[…] design and development of computer programs and software*". Therefore, I find that they are identical as per *Meric*.

Maintenance of computer records

46. The contested term concerns the maintenance of computer records, which includes tasks such as organising, updating, securing, and preserving electronic data throughout its lifecycle. I note that this is a broad term that can apply across various areas, including artificial intelligence. Thus, it is my view that the closest comparable term in the earlier specification is "*providing online non-downloadable software for managing data sets and performing safety checks in the field of artificial intelligence*". The competing terms overlap in nature and purpose as they both aim to ensure the preservation, integrity, and reliability of computer data. As the contested services are broad, there is nothing preventing them from being delivered online as the earlier services, and thus I consider that they may share the same method of use. Further, they share the same users (mainly businesses) and trade channels, such as providers' websites and specialised IT procurement marketplaces. There is also a degree of competition, as users may choose to purchase one service over the other. I find that the competing terms are similar to a high degree.

Electronic data storage; Electronic storage of medical records

47. The contested terms relate to the storage of data and medical records. By applying the same approach in the preceding paragraph to the terms in question, I find that the contested terms are highly similar to the earlier

"*providing online non-downloadable software for managing data sets and performing safety checks in the field of artificial intelligence*" for the same reasons.

Class 45

Legal support services; Legal research; Legal document preparation services; Preparation of legal reports; Legal information services; Legal consultation services; Providing information about legal services via a website; Expert consultancy relating to legal issues; Health and safety risk management; Health and safety risk assessment services; Information services relating to health and safety; Consultancy services relating to health and safety

48. There is no obvious similarity between the contested Class 45 services and the earlier Class 42 services. Despite the opponent's broad submissions that "*the Opponent's artificial intelligence and large language model software is used in the provision of such services and can directly provide such services*", I fail to see how this is the case. Even when considering, for example, Exhibit ML21 that contains a news article titled "*AI object! Judges will be able to use ChatGPT in legal rulings in England and Wales - despite the technology being prone to making up bogus cases*", I do not find this exhibit alone to be persuasive in order for me to conclude that there is such a convergence between the competing sectors, namely legal and technological services, to be sufficient for a finding of complementarity. Thus, I do not consider that the respective terms in the competing specifications will be considered as being important or indispensable to each other, leading the consumers to believe that they will be offered by the same undertaking. Although the competing services may share the same users (general public and/or businesses), this alone is not a factor that would warrant similarity. Considering the differences in nature, purpose, trade channels, and method of use, between the competing specifications, I conclude that they are dissimilar. For

completeness, I make the same findings for the services in relation to health and safety for the same reasons.

49. The likelihood of confusion does not arise in relation to the contested services which are dissimilar to the earlier mark's services.[8] **The opposition cannot succeed against dissimilar services and, therefore, is dismissed insofar as it concerns the following terms:**

> **Class 35:** Business assistance, management and administrative services; Business enquiries and investigations; Information and expert opinions relating to companies and business; Preparation of expert evaluations and reports relating to business matters.
>
> **Class 45:** Legal support services; Legal research; Legal document preparation services; Preparation of legal reports; Legal information services; Legal consultation services; Providing information about legal services via a website; Expert consultancy relating to legal issues; Health and safety risk management; Health and safety risk assessment services; Information services relating to health and safety; Consultancy services relating to health and safety.

Average Consumer and the Purchasing Act

50. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ

[8] Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
>
> (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
>
> (e) The average consumer's level of attention varies according to the category of goods or services in question; and
>
> (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind."

51. The parties disagree on the average consumer. The opponent claims that the goods and services will be directed at the general public who will pay a reasonably low level of attention (especially if they are accessing

software for which an unpaid version is available for at least some of the goods and services). I have already addressed the applicant's position regarding the consumers of the competing goods and services in the previous section and will not repeat it here.

52. The average consumer for the goods in Class 9 is likely to be either a member of the general public or business users. Such goods are usually offered for sale in online or app stores, brochures, and catalogues. The consumers will select the goods relying on the images displayed on the relevant web pages or mobile applications. This suggests that the selection of such goods will predominantly be made on a visual basis, though aural considerations cannot be ignored as advice may be sought by the purchaser or offered by a trader. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the products to ensure software/hardware compatibility with other components or systems or that the goods possess the required features. Thus, the average consumer will pay a medium degree of attention when selecting the goods at issue.

53. For the services at issue, the average consumer will primarily be business users or professionals without excluding entirely members of the general public. The consumers will select such services by looking through brochures and websites or signs on a physical property, so the visual element will be important. However, I do not discount the aural element, as word-of-mouth recommendations may also influence consumers' decisions. The cost of the services will be relatively significant, contributing to the selection process of the service provider. Given the more specialist nature of the services in play, especially those selected by business users, I consider that the average consumer will pay a slightly higher than a medium degree of attention in choosing the service provider.

Comparison of Trade Marks

54. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its 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."

55. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

56. The marks to be compared are:

Earlier Mark	Contested Mark
GEMINI	GeminAI

Overall Impression

57. The earlier mark is the word "GEMINI". Registration of a word mark protects the word itself.[9]

58. As to the contested word mark,[10] "GeminAI", both parties agree that the mark will be a portmanteau of the terms "Gemini" and "AI", with the latter being an acronym which will be understood as meaning "Artificial Intelligence". In this context, the mark will be a fusion of these two words that will be obvious to a significant part of consumers. That said, the average consumer will be unable to extract a clear unified concept from the mark as a whole. I also consider that the second component "-AI" could be seen as being suggestive of the respective goods and services in the contested specification. Therefore, the prefix "Gemin-" will dominate the overall impression, and the suffix "-AI", whilst not negligible, will play a lesser role.

Visual Comparison

59. Visually, the earlier mark consists of six letters and the contested seven. I bear in mind that the beginnings of marks tend to have more impact than the ends.[11] While the marks share the same letters, the contested mark contains the additional letter 'A' in position six (GEMINI/GeminAI) which is the only point of visual difference. Taking all this into account, including the overall impression of the marks, I find that the marks are visually similar to a high degree.

Aural Comparison

60. The earlier mark will be verbalised as "JEM-IN-EYE". I consider that a significant proportion of relevant consumers will pronounce the contested

[9] Normal and fair use allows word-only marks to be used in upper and lower case letters. See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

[10] Ibid.

[11] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

mark as “JEM-IN-AY-EYE”. In this respect, the marks will share the first two syllables and the last (in different positions), while they will differ in the presence/absence of the syllable “-AY-”. Thus, I find that the marks are aurally similar to between a medium to high degree.

61. For completeness, I consider the possibility that a small minority of consumers may verbalise the contested mark as “JEM-IN-AY”. Again, in this case, the marks will share the first two syllables. Although the last syllable shares a similar sound, the articulation of the respective vowels will create a difference in the pronunciation. On this basis, I find that the marks are aurally similar to a high degree.

Conceptual Comparison

62. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

63. I bear in mind that in *Usinor SA v OHIM*, Case T-189/05, the GC found that:

> “62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft* (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma* (RESPICUR) [2007] ECR II-0000, paragraph 57).”

64. Even though both parties agree that the contested mark would be understood as a portmanteau of the word “Gemini” and the acronym “AI”, the applicant claims that there is a conceptual difference between the marks introduced by the “-AI” acronym/suffix in the contested mark. Conceptually, although both parties agree that the contested mark consists of the ordinary term “GEMINI”, they appear to provide somewhat similar definitions of the term, albeit slightly different. The applicant argues that the word will be seen as meaning ‘duality’ or ‘twins’, whereas the opponent provides the definitions from the Cambridge Dictionary, which describe it as the constellation symbolising twins or the zodiac sign. Given that both parties’ definitions overlap in that the term conveys the notion of “twins”, the average consumer is likely to form the same concept of that word when it appears in the other mark. The contested mark also gives rise to the concept of ‘artificial intelligence’ due to the presence of the “-AI” acronym, which the average consumer will likely interpret as suggestive of the respective goods and services in the contested specification.[12] For completeness, as mentioned above, I do not consider that the average consumer will conceptualise the contested mark as a whole conveying a new meaning. Consequently, notwithstanding the added concept of the acronym “-AI” in the contested mark, the competing marks will be conceptually similar to a medium to high degree based on the shared concept of the common word “Gemini” being the dominant word/component in the competing marks.

Distinctive Character of the Earlier Trade Mark

65. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> “In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must

[12] While I appreciate that, as per the case of *EMILIANA* (Case BL O/054/22), conceptual comparisons are usually done without reference to the goods or services at issue. However, in the present case, I am of the view that the AI acronym gives context to the mark which will likely be viewed by consumers as being a company that provides goods and services powered by AI.

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).

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)."

66. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

67. The opponent in its final submissions puts forward that the earlier mark is inherently distinctive to a "*normal*" degree.

68. As outlined in the previous section, the opponent's word mark consists of the word "GEMINI". The word will be understood in the way defined earlier in this decision, having no suggestive or descriptive relevance to the registered services. I find the mark to be inherently distinctive to a medium

degree. I will now proceed to the assessment of enhanced distinctiveness of the earlier mark.

Enhanced Distinctiveness

69. The opponent made lengthy submissions claiming that the earlier mark has acquired an enhanced distinctive character "*as a result of its intensive use internationally and in the United Kingdom*."[13] However, the applicant in its counterstatement did not deny enhanced distinctiveness of the earlier mark.[14] Further, in its final submissions, the applicant submitted the following:

> "**3. Recognition of Enhanced Reputation (Section 5(3))**
>
> We acknowledge the Opponent's claim of enhanced distinctiveness for "Gemini". However, under UKIPO's guidance, enhanced reputation alone does not automatically preclude coexistence. […]"

The need for pleadings to be fully particularised was emphasised by Professor Phillip Johnson, sitting as the Appointed Person, in *SkyClub* Trade Mark, BL O/044/21, paragraphs 23-28. He quoted Lord Hoffmann's statement in *Barclays Bank Plc v Boulter* [1999] 1 WLR 1919 at [1923]: "*The purpose of the pleadings is to define the issues and give the other party fair notice of the case which he has to meet*."[15] In addition, Professor Johnson explained that, while it would be possible to file an adequately particularised notice of opposition by completing the boxes on Form TM7, the same could not be said for the defence and Form TM8. Consequently, it would be wrong for me to proceed as if the claim that the distinctive

[13] Paragraph 31 of the final submissions.
[14] Tribunal Practice Notice ("TPN") No. 4/2000 contains the following guidance on the content of counterstatements: "19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove. 20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counter-statement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided."
[15] Quoted by the Appointed Person at paragraph 26 of his decision.

character of the mark has been enhanced is denied. That said, I will consider below to what extent the earlier mark has been enhanced as a result of the use made of it.

70. While global evidence is helpful in painting a picture of the opponent's success, I note that the earlier mark is an international registration (designating the UK), and it is the position in the UK that must be considered because the question is whether the average consumer in the UK will be confused.

71. Having reviewed the evidence, I note that in her witness statement, Ms Liburd provides the background of the opponent in the following terms:

> "The Opponent is a US headquartered, multinational corporation specialising in Internet-related services and products including search engines, online advertising technologies, artificial intelligence technologies, cloud computing, and mobile operating system software."

The opponent's evidence is focusing on the worldwide[16] and UK[17] advertising and promotional materials, including press coverage, YouTube videos, and social media posts. In more detail, extensive media coverage is provided in the form of press articles from various UK-wide media outlets such as BBC News, Mail Online, The Guardian, London Evening Standard, The Daily Telegraph, The Independent, and The Times (London),[18] the majority of which are dated between 6 December 2023 and January 2024. In summary, most of these pieces serve as press releases and online articles that cover the launch of the opponent's "Gemini", which is described as "*the most powerful AI ever*".[19] The evidence details that Gemini is a multimodal AI foundation model,[20] with capabilities in

[16] Exhibits ML7-9, ML11, ML13-14, ML16-19.
[17] Exhibits ML15, ML16 at page 121, ML20-22.
[18] ibid.
[19] See Exhibit ML20 page 161.
[20] According to the evidence, Gemini powers Google's chatbot Bard which is the generative AI platform.

advanced reasoning, planning, and processing text, images, audio, video, and coding with three tiers, namely “Nano”, “Pro”, and “Ultra”. As provided in the evidence, Gemini Nano and Pro are models that are specifically designed to operate on smartphones, such as Google’s Pixel 8 series[21], offering users a range of AI features and tools, such as live translation, AI photo tools, “circle to search” function, smart reply, and summarising notes and audio recordings.[22] In addition, one article within the relevant date also stipulates that the opponent teamed up with Samsung integrating Gemini into Samsung Galaxy S24 series, which was available to pre-order on 17 January 2024 (prior to the relevant date) with a release date on 31 January 2024. Gemini Ultra is portrayed as the unreleased “top” version designed for highly complex tasks,[23] offering a new code-writing tool for computer programmers.[24] At this point, based on the evidence, I highlight that although Gemini was initially launched on 6 December 2023 in the US,[25] due to regulatory constraints, it became available in the UK on 19 December 2023.[26] I also note that a YouTube video from 7 December 2023 demonstrates that BBC News covered the launch of Gemini on its news programme.[27]

72. Further, the total number of downloads and reviews for the Gemini app and the Google app (which reportedly incorporates Gemini) from the UK Google Play Store and the iOS App Store, respectively, are provided with the evidence.[28] For example, it is indicated that the Gemini app was downloaded 10M times in Google Play Store, and received a significant number of user reviews.[29] However, these exhibits are dated with a computer date, namely 10 and 11 October 2024, falling outside the relevant date. I also take into account the witness statement and Exhibit ML5 which comprises a printout of an article from the opponent’s website

[21] Exhibits ML20 at pages 164-166, and ML21 at pages 197-200, and page 209.
[22] Ibid.
[23] Exhibit ML20 at page 165.
[24] Exhibit ML21 at page 207.
[25] Exhibit ML20 at pages 154, 168-169, and Exhibit ML21 page 202.
[26] Exhibit ML21 page 186.
[27] Exhibit ML16 at page 121.
[28] Exhibit ML8-9.
[29] Exhibit ML8.

titled "*Bard becomes Gemini: Try Ultra 1.0 and a new mobile app today*" dated 8 February 2024. Specifically, the article states that "*We've heard that you want an easier way to access Gemini on your phone. So today we're starting to roll out a new mobile experience for Gemini and Gemini Advanced with a new app on Android and in the Google app on iOS*." In addition, Exhibit ML21 features a printout of the article titled "*Google asks the public how it should improve its Bard AI*" dated 2 January 2024. This article outlines that Google crowdsourced feedback from Reddit users on its Bard chatbot, which according to the article it is running on Gemini Pro. Notably, one of the features requested by Reddit users was a standalone app. Taking all the above into account, it can be inferred that the downloads and reviews likely began after the apps' rollout on 8 February 2024, post-dating the relevant date. At this point, I remind myself that evidence outside the relevant period can be used to explain or substantiate evidence of use dating from within the relevant period. Thus, I can infer from the evidence that the extensive press coverage prior to the Gemini's app release may have played a role in raising awareness and educating the public with regard to the opponent's services offered under the Gemini brand, thereby creating a desire for accessing these services via a standalone mobile app.

73. The evidence also covers the research and development activities in AI of the opponent in the UK.[30] Notably, a printout dated 12 January 2024 from *standard.co.uk*, titled "*What next for the AI revolution? Inside Google DeepMind, the world's biggest AI company*" offers an in-depth account on Google's AI research hub in the UK, namely Google DeepMind, which has been "*at the forefront of an AI revolution*" over the past 15 years and built Gemini.[31] The article highlights Gemini as DeepMind's flagship multimodal model, detailing how its development "*feeds back to Google and Alphabet*" to enhance their products and services. It also stresses that Gemini has already been "*seeded*" into Google products including "Search", illustrating how UK R&D translates directly into consumer solutions. In addition, the

[30] See Exhibits ML20 at pages 161-167 and ML21 at pages 177-180
[31] See Exhibit ML21 at pages 177-180.

article refers to the Ofcom's report that reveals that by late November 2023, 79% of UK teens (13–17) were using tools such as ChatGPT or Bard to help with work and studies. The article also mentions that, in early December, Google DeepMind announced a new era for Gemini, emphasising its improved capabilities to draw information from images as well as text data.

74. In the witness statement it is stated that the opponent first used publicly the GEMINI mark on 10 May 2023, during its annual developer conference 'Google I/O', which was held in the US and livestreamed online globally. In this regard, the opponent refers me to Exhibit ML3 which contains a screenshot from a YouTube video titled "*Google Keynote (Google I/O '23)*" that was streamed live on the above date and accumulated over 2M views. However, I note that the opponent in its submissions and witness statement does not expressly states whether the conference targeted the UK consumers, and without any corroborating evidence, it is not possible to determine whether the UK audience interacted with the above livestreamed event where the registered mark was used. Thus, even if non-US users could indeed have livestreamed the event, an inference of global targeting is inappropriate in this case,[32] especially given that different regulatory frameworks in relation to the use of AI technologies exist in different parts in the world. This is so, as it is clear from the evidence that the launch of Gemini faced delays in the UK by virtue of regulatory constraints,[33] which strongly suggests against an inference of global targeting being relevant here. For completeness, the same reasoning equally applies to the evidence concerning the opponent's global YouTube account[34] and third-party social media posts[35].

[32] See BL O/0984/25 paragraph 34.
[33] I also note that various articles discuss that the opponent was in discussions with the UK government about the AI Safety Institute carrying out tests on Gemini's AI models building safeguards to help head off the mounting risks from AI.
[34] Exhibit ML14.
[35] Exhibits ML16-19.

75. In terms of the opponent's UK YouTube account, I note that the Exhibit ML15 is dated 10 October 2024 and the listed videos relating to Gemini appear to be posted a month prior to that date, post-dating the relevant period. Thus, the evidential value of the exhibit is very limited.

76. Further, I note that Exhibits ML6, ML10, and ML12-13 are of little or no evidential value as they are either dated after the relevant date, or they target an audience outside the UK. I will deal with each in turn briefly. Exhibit ML6 contains a Wikipedia article on "Gemini (chatbot)", with a print date of 10 October 2024. This date falls outside the relevant period, and since Wikipedia is a community-based encyclopaedia that any user can contribute to at any time, the content may be unverified. Therefore, the evidential value of this exhibit is dubious. As to Exhibits ML10, ML12-13, I note that the market share reports in relation to mobile operating systems, smartphones, and generative AI chatbots, respectively, are all from *.com* domains, and explicitly concern either the US or the global market, rather than the relevant market within the UK generally, or the opponent's position within it. I have discounted those parts of the evidence and will make no further reference to them.

Conclusions on Enhanced Distinctiveness

77. The factors which are relevant to the assessment of enhanced distinctiveness are the same as those against which reputation is measured, namely 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 class of persons who, because of the mark, identify services as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. I note that the evidence does not contain any evidence of sales or narrative evidence of turnover figures or marketing expenditure but rather it primarily pertains to the advertising and promotion of the services under the registered mark. However, I remind myself that

the applicant has not denied the opponent's claim to enhanced distinctiveness of the mark and, for the reasons given above, I am proceeding on the basis that it has been enhanced to some degree. Having considered the evidence before me, including the extensive coverage on UK media outlets within a short period (December 2023 - January 2024), I consider that the distinctiveness of the mark was enhanced through use to a significant proportion of the relevant consumer marginally or slightly above the medium degree of inherent distinctiveness for all the services in the specification.

Likelihood of Confusion

78. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.[36] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[37]

79. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

[36] See *Canon Kabushiki Kaisha*, paragraph 17.

[37] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

80. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Iain Purvis QC, sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

81. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the

distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

82. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

> "18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
>
> 20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is

qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER)."

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

83. Earlier in this decision I have concluded that:

- the competing goods and services at issue are identical and similar to various degrees;
- the average consumer of the goods will be a member of the general public and businesses. The selection process is predominantly visual without discounting aural considerations. The degree of attention will be medium for the respective goods, and slightly higher than a medium degree for the respective services;
- the competing marks are visually highly similar, aurally similar to between a medium to high degree for the significant proportion of consumers, and conceptually similar to between a medium and high degree;
- the earlier mark has a medium degree of inherent distinctive character, and it was enhanced further marginally or slightly above that degree.

84. Taking all of the above into consideration, the factors persuade me that there is a likelihood of direct confusion for identical services. The identical services in play are selected mainly via visual means, which is a point in the opponent's favour. Even with an increased level of attention of the average consumer during the selection process for the services, this will not be sufficient to counteract the visual, aural and conceptual similarities between the marks as well as militate against imperfect recollection. As

detailed earlier in this decision, the contested mark will be seen as a portmanteau of the terms “GEMINI” and “AI”, and the common and more dominant element “GEMINI”, which the average consumer will recognise in the contested mark, will create a semantic bridge between the competing marks. Thus, given that consumers rarely have a chance to compare marks side by side, I am satisfied that as a result of the identical beginnings of the marks and the differences arising between them at the end, they will be imperfectly recalled. In light of the principle of imperfect recollection, the consumers may be directly confused and mistake the applicant’s mark for the opponent’s or vice versa. The same finding extends to the goods and services that I found to be similar at any degree based on the principle of interdependency wherein a high degree of visual similarity between the marks will counter a lower degree of similarity between the goods and services.

85. For completeness, I would have arrived at the same finding even when considering the marks as a whole. I note that the marks as a whole diverge by one letter, which is placed at the end of the contested mark, i.e. GEMINI/GeminAI. Again, in this case, I consider that consumers tend to focus on the beginnings of marks, and due to the position of the divergent letter being in a less impactful position, they may overlook the difference and likely mistake one mark for the other.

Final remark

86. I note that the applicant submitted that it took steps so that the competing marks could coexist in the UK. In this regard, I bear in mind the decision BL O/0662/25 of Mr Phillip Johnson, sitting as the AP, where he stated that:

> “29. To establish co-existence it is necessary for there to be evidence that both the earlier and later mark are used in the same marketplace at the same time in a way which would (in the absence of evidence) be seen as giving rise to a likelihood of confusion.

30. Accordingly, it is not possible to establish peaceful co-existence with an earlier mark which has not been used (ie where it is less than 5 years old; and so attracts no requirement to prove use)."

Based on the above rationale and given that the earlier mark is not subject to proof of use requirements, such a defence does not assist or put the applicant in any better position, and I will say no more.

87. The opposition under this ground succeeds in part.

Section 5(3) of the Act

88. Section 5(3) of the Act states:

"(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

[…]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

89. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived

by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

90. The conditions of Section 5(3) are cumulative. First, the opponent must show that the marks are similar. Second, the opponent must show that the earlier mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Third, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, Section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of Section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under Section 5(3) is the filing date of the contested application, namely 25 January 2024.

Similarity between the marks

91. The opponent relies on the same mark and services here as it did under its Section 5(2)(b) ground. I have already assessed the similarity between the marks for the purposes of the opposition. I adopt those findings[38] as they apply equally here.

Reputation

92. In *General Motors*, Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

93. I note that the applicant made various references to the opponent's reputation in its counterstatement without denying it. I also note that the

[38] See paragraphs 57-64.

applicant did not deny reputation of the earlier mark with its final submissions, while stating the following:

> "**3. <u>Recognition of Enhanced Reputation (Section 5(3))</u>**
>
> We acknowledge the Opponent's claim of enhanced distinctiveness for "Gemini". However, under UKIPO's guidance, enhanced reputation alone does not automatically preclude coexistence. "GeminAI" does not exploit or dilute the "Gemini" mark for the following reasons:
>
> **Market Segmentation:** "GeminAI" is exclusively aimed at the medico-legal sector, a niche segment with no overlap with the Opponent's generalist AI audience.
>
> **Goodwill and Efforts to Avoid Confusion:** To address any concerns of overlap, we have offered to restrict the mark's use to its target market of medical and legal professionals. This is a clear demonstration of our good faith and commitment to minimising any potential risk of confusion. Unfortunately, this proposal has not been accepted by the Opponent."

Bearing in mind the comments of Professor Phillip Johnson in *SkyClub*, it is my view that the applicant does not deny that the opponent holds a reputation in the mark for the services relied upon. Thus, I will proceed to identify the strength of the earlier mark's reputation.

94. Earlier in this decision, I found that the earlier mark enjoys some degree of enhanced distinctiveness. Whilst enhanced distinctiveness and reputation are different,[39] the factors relevant to both assessments are the same. I also keep in mind that the list of factors, as set out in *General Motors*, are examples, as all relevant evidence must be taken into consideration,[40] and

[39] *Enterprise Holdings Inc. v Europcar Group UK Ltd* [2015] EWHC 17 (Ch), Arnold J (as he then was).
[40] See *Farmeco AE Dermokallyntika v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-131/09.

that reputation is a knowledge threshold.[41] Despite the absence of turnover and marketing figures, this is not in itself fatal to a finding of reputation. For the same reasons given earlier in this decision, and due to the applicant's lack of denial and the unchallenged evidence, I consider that the opponent had a modest reputation in the UK at the relevant date, known for its state-of-the-art[42] services for all of the terms relied upon.

Link and Damage

95. In its counterstatement, the applicant denied that there would be a link and damage under Section 5(3), concluding that:

> "**2. No Economic Connection or Reputation Exploitation:** Given the distinctiveness and the niche market of our product which GeminAI is intended to cover, there is no basis to then assume that the relevant public will believe there is an economic connection or that our mark will exploit the reputation of the Opponent's mark.
>
> **3. Reputation and Market Differentiation:** Our product is marketed within a highly specialised sector (being legal and healthcare professionals operating in the medical malpractice market), distinguishing it from the broader applications of the Opponent's mark. This differentiation mitigates any potential for reputational harm or economic detriment to the Opponent.
>
> **4. No Tarnishment or Erosion of Distinctiveness:** The niche application of our product and the clear market segmentation ensure that there is no risk of tarnishing the Opponent's reputation or eroding the distinctiveness of their mark."

96. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified

[41] See *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at paragraph 69; and T-277/04 *Vitakraft-Werke Wührmann v OHIM* [2006] ECR II-2211 at [34].
[42] See for example Exhibits ML20-21 in pages 152, 199-200, 206.

by the CJEU in *Intel* at paragraph 42 of its judgment. As to the assessment of damage, in *L'Oréal*,[43] the CJEU said:

> "The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

Earlier in the same decision, the CJEU also said:

> "41. As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation."

97. I will first consider the goods and services for which I already found that there is a likelihood of confusion under Section 5(2)(b), before assessing whether a link can be established for the dissimilar services in Classes 35 and 45.

98. A link means that the earlier mark will be brought to mind by the contested mark. One of the considerations in deciding whether a link will be made between the competing marks is whether there is a likelihood of confusion.

[43] *L'Oréal SA & Ors v Bellure & Ors*, Case C-487/07, paragraph 50.

If there is a likelihood of confusion, there must be a link, because confusion means that there must be more than a bringing to mind. Given my findings above about the similarity of the marks, the identity and similarity (at any degree) of the competing goods and services, the distinctiveness of the earlier mark and the likelihood of confusion, I find that a significant proportion of the relevant public would call in mind the earlier mark "GEMINI" upon being confronted with the contested mark "GeminAI". The relevant public will believe that the marks are used by the same undertaking or will believe that there is an economic connection between the undertakings leading to a link being made. Thus, this will result in an unfair advantage for the opponent through consumers believing that the contested goods and services come from the opponent, and the applicant gaining a commercial advantage from that belief and/or from the transfer of the image of the earlier mark to the contested mark. As I have found for the opponent under the first head of damage, I do not consider it necessary to go on to consider the remaining heads of damage pleaded.

99. My finding of no likelihood of confusion under Section 5(2)(b) in relation to the dissimilar terms in Classes 35 and 45[44] does not in itself mean that there will be no link in the mind of the public.[45] That said, I do not consider that a link would be made in the mind of the relevant public. This is because the distance between the services is simply too great, and would offset the similarity between the marks, notwithstanding the strength of the opponent's reputation. In any event, even if I am wrong regarding the absence of a link, I am unable to identify how any damage would arise. It is difficult to see how there would be any image transfer or leg-up for the applicant, given the distance between the services. It does not seem to me that the opponent's reputation for its earlier services would easily transfer to the dissimilar services. In this case, the opponent's claim regarding damage to reputation appears to be entirely hypothetical and, therefore, incapable of succeeding. In the absence of evidence, I see no reason why use of the contested mark in relation to such distant services would

[44] See paragraph 49 of this decision.
[45] See *Lazard & Co., Holdings Ltd v Lazard Consulting Ltd,* BL O/359/15, paragraph 55.

compromise the capacity of the earlier mark to distinguish the services of one particular undertaking.

100. The opposition based upon Section 5(3) succeeds in part.

Section 5(4)(a)

101. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> (aa) […]
>
> (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

102. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

103. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

104. 'Halsbury's Laws of England Vol. 97A' (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant date

105. The contested mark was applied for on 25 January 2024, and that filing date is the relevant date. However, if the applicant had used its trade mark prior to this date, then this use must also be taken into account.[46] The applicant states in its submissions that:

"[The applicant] over the course of a decade has been independently developing and cultivating its reputation as a tech-focussed and AI driven force in the medico-legal field providing solutions to this marks relevant public. The "GeminAI" branding, coming out of TM.L.E. Ltd, therefore is not reliant on, nor does it attempt to leverage, the reputation of the Opponent's mark."

[46] See *Advanced Perimeter Systems v Keycorp Limited* (MULTISYS), BL O-410-11, paragraph 43.

106. However, the applicant has not filed any evidence in this regard. Therefore, I am unable to infer whether the applicant was actually trading at the time of the application for the contested mark, and, if so, for how long. Consequently, the opponent must show that it had goodwill in a business at the application date, that is on 25 January 2024, and that the sign relied upon is associated with, or distinctive of, that business.

Goodwill

107. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, at paragraph [224]:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

108. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (as he then was), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> "... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able

to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

109. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J stated:

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s. 11 of the 1938 Act (see *Smith Hayden & Co Ltd's Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

110. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

> "[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand

Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

111. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

> "62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

112. The case law above makes it clear that goodwill must be more than trivial in extent, but that a business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill may be small.

Assessment

113. The opponent claims to have used the sign for all the services shown in the specification of the earlier mark since 6 December 2023 throughout the UK. With its submissions, the opponent draws my attention to the following cases: *Global Projects Management Ltd v Citigroup Inc* [2006] F.S.R. 39, *Glaxo plc v Glaxowellcome Ltd* [1996] F.S.R. 388, *Reed Consumer Books Ltd v Pomaco Ltd (MINERVA TM)* [2000] F.S.R. 734, which I have taken into consideration. The opponent argues that these decisions lay down that "*goodwill can be established in the United Kingdom within a short timeframe and even prior to the sale of any goods or services where there is sufficient publicity*".[47] I will return to this point later in this decision.

114. On the other hand, the applicant has challenged the opponent's evidence, stating the following:

> "**4. No Misrepresentation or Unfair Advantage (Section 5(4(a))**
>
> The UKIPO framework for evaluating passing-off claims requires evidence of misrepresentation, goodwill damage, or tarnishment. These elements are absent here:
>
> - **No Misrepresentation:** The relevant public, comprising sophisticated legal and medical professionals, would not mistakenly associate "GeminAI" with "Gemini." The distinct visual and conceptual differences, coupled with the specialised use case, make such confusion highly improbable.
>
> - **Independent Reputation:** T.M.L.E. Ltd over the course of a decade has been independently developing and cultivating its reputation as a tech-focussed and AI driven force in the medico-legal field providing solutions to this marks relevant public. The "GeminAI" branding, coming out of T.M.L.E. Ltd, therefore is not

[47] See paragraphs 70-72 of the opponent's final submissions.

reliant on, nor does it attempt to leverage, the reputation of the Opponent's mark."

115. The test for the existence of goodwill is far less onerous than the ones conducted above for enhanced distinctiveness and reputation. In *Mercis BV v Bunnyjuice* Inc, BL O/0064/24, Dr Brian Whitehead, sitting as the Appointed Person, said:

> "57. […] In trade mark law, the analysis of proof of use, reputation and enhanced distinctive character needs to be performed on a granular basis, looking at each of the individual goods and services in turn. […] In passing off law, however, goodwill attaches to a business, rather than to isolated individual goods and services. Of course, when assessing goodwill, it is necessary to ask, 'What is the nature of the business?', but it is not appropriate to break the business down at the same level of granularity as is done for assessing trade mark use etc."

116. I note Lord Neuberger's comments (with whom the rest of Supreme Court agreed) in *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, where he left open whether advertising on its own is enough to create a protectable goodwill without any actual sales to UK customers. Further, pre-launch publicity appears to have been accepted as sufficient to create an actionable goodwill in the cases of *Allen v Brown Watson* [1965] RPC 191 and *BBC v Talbot* [1981] FSR 228. This was also endorsed by Jacob J (as he then was) in *Reed Consumer Books Ltd v Pomaco Ltd* [2000] FSR 734, which is one of the decisions the opponent refers me to. However, I note that the plaintiffs in those cases already had established businesses and goodwill in the UK, and the real issue was whether their new marks had become distinctive of those businesses to their UK customers through advertising alone.[48] That said, until the law is clarified, it is therefore doubtful whether a business

[48] See 3-156 of Wadlow on the Law of Passing Off, 6th Ed.

with no sales to UK customers can establish a passing off right based solely on advertising.

117. While bearing in mind the above caselaw, it is all the facts and circumstances of the evidence before me that I must assess. The evidence before me, as summarised earlier in this decision, paints a picture of a multinational business that launched its latest AI-related software services under the GEMINI sign in the UK on 19 December 2023 (prior to the relevant date).[49] Where the period of time is relatively short, evidence of promotion and advertising becomes even more important. In the instant case, the evidence shows extensive media coverage in the UK within a short period and use of the relevant sign specifically directed towards the UK market and its consumers. It is my view that such evidence is capable of being considered pre-launch publicity, attracting widespread viewership. In addition, I note from the evidence that the services associated with the sign, for example, were immediately incorporated into the opponent's smartphones, such as Google's Pixel 8 series, alongside other Google products, such as Google Search.[50] Further, the evidence indicates that the release of Samsung's Galaxy S24 series, integrating Gemini, was imminent in the UK with pre-orders (in GBP) being available from 17 January 2024 (prior to the relevant date), ahead of the official release on 31 January 2024.[51] Lastly, I note that the evidence highlights the importance of Google DeepMind (Google's AI research hub), headquartered in London, in developing and making available the services offered under the sign to the public.

118. Sufficient goodwill does not necessarily mean that the level must be large. Although the evidence has shortcomings, I consider that, over a short period, a small but more than trivial goodwill has been built up and generated among the general public in the UK for services under the sign by means of the extension of the opponent's activities. Finally, I am

[49] See Exhibit ML21 at page 186.
[50] See Exhibit ML20 at page 164, and Exhibit ML21 at page 178 and 197.
[51] See Exhibit ML21 at pages 175-176.

satisfied that the sign used on promotion and advertising, such as press articles and YouTube videos, was distinctive of that goodwill at the relevant date.

119. Having found that the opponent has the requisite goodwill for the purposes of its Section 5(4)(a) ground, I must consider whether use of the contested mark will lead to misrepresentation and damage.

Misrepresentation

120. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is:
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.

And later in the same judgment:

> […] for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November

1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

121. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

> "64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

122. The opponent submitted that the consumer encountering the contested mark for the contested goods and services would expect them to come from the opponent. I agree that there will be misrepresentation in relation to those goods and services for which I found a likelihood of confusion under Section 5(2)(b) earlier in this decision. In making this finding, I acknowledge that the test for misrepresentation is different from that for the likelihood of confusion in that it entails "*deception of a substantial number of members of the public*" rather than "*confusion of the average consumer*". However, it is unlikely, in the light of the Court of Appeal's decision in *Comic Enterprises Ltd v Twentieth-Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here.

123. Further, I am of the view that there will also be misrepresentation if the contested mark were to be used for the dissimilar services in Classes 35 and 45. The respective services under the contested mark may share the same consumers as the earlier sign, who may purchase the respective types of services. Whilst I note that the opponent has only a small but protectable goodwill, I consider this, combined with the high similarity between the contested mark and the sign to result in a substantial number of members of the relevant public being misled into purchasing contested services in the mistaken belief that they are provided by the opponent.

Damage

124. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett LJ described the requirements for damage in passing off cases at [715]:

> "In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

125. I consider that there is a real likelihood of damage through substitution, with consumers choosing the applicant's goods and services instead of those of the opponent, as well as the risk of damage to the opponent's goodwill if the opponent's customers purchase goods and services from the applicant, are dissatisfied with them, and mistakenly believe they are the responsibility of the opponent. Such a loss of custom is an obvious damage to the opponent's business.

126. The opposition based upon section 5(4)(a) is, therefore, successful.

OUTCOME

127. The opposition succeeds in part under Section 5(2)(b) and Section 5(3), and in full under Section 5(4)(a), and, subject to any successful appeal against this decision, the application will be refused in its entirety.

COSTS

128. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs as follows:

Official fee	**£200**
Preparing a statement and considering the other side's statement	**£250**
Preparing evidence and considering and commenting on the other side's evidence	**£600**
Filing final submissions	**£350**
Total	**£1,400**

129. I, therefore, order T.M.L.E. LIMITED to pay to Google LLC the sum of £1,400. The above sum should be paid within twenty-one days of the

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

Dated this 26th day of February 2026

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General