

**O/0257/26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003956657**

**BY PC SPECIALIST LTD**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**Luna Series**

**IN CLASSES 9, 35, 37, 40 AND 42**

**AND IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 444940**

**BY UNIVERSAL AUDIO, INC.**

## BACKGROUND AND PLEADINGS

1. On 14 September 2023, **PC Specialist Ltd** (“the Applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 29 September 2023 and registration is sought for the following goods and services:

Class 9      Data processing equipment, computers; computer hardware; custom built computers; communications servers [computer hardware]; computer software; smart phones; tablet computers; laptop computers; data processors; parts and fittings for all the aforesaid goods.

Class 35      Retail services connected with the sale of data processing equipment, computers, computer hardware, custom built computers, communications servers [computer hardware], computer software, smart phones, tablet computers, laptop computers, data processors and parts and fittings for all the aforesaid goods; information, advice and consultancy in relation to all the aforesaid services.

Class 37      Installation, maintenance and repair of computers, data processing equipment and computer hardware; information, advice and consultancy in relation to all the aforesaid services.

Class 40      Custom manufacture of computers and computer hardware for others; custom manufacture and assembly of information technology products; digital printing; printing of documents from digital media; information, advice and consultancy in relation to all the aforesaid services; custom construction of computers, data processing equipment and computer hardware.

Class 42 Customization of computer hardware and software; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer and information technology support and consultancy services; configuration of computer hardware, firmware, software, systems and networks; rental of web servers; information, advice and consultancy in relation to all the aforesaid services.

2. On 27 December 2023, the application was opposed by **Universal Audio, Inc.** (“the Opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent relies upon UKTM no. 3459427 for the mark LUNA, which was filed on 20 January 2020 and registered on 9 August 2020. The earlier mark claims a priority date of 29 October 2019 (US). The Opponent relies upon all goods for which the earlier mark is registered, namely:

Class 9 Audio production equipment; computer hardware and computer software programs for audio and music production; computer software for digital audio production, processing, and editing; multimedia computer hardware and software for the integration of music, text, audio, graphics, still images and moving pictures and for interconnectivity between personal computers, networked audio hardware, and electronic musical instruments.

3. The Opponent claims that the marks are similar and the goods and services are similar, with the result that there is a likelihood of confusion.

4. The Applicant filed a counterstatement denying the grounds of opposition.

5. Neither party requested a hearing. This decision is taken following a careful consideration of all of the papers on file.

## **REPRESENTATION**

6. The Applicant is represented by Trade Mark Direct.

7. The Opponent is represented by Marks & Clerk LLP.

## **EVIDENCE AND SUBMISSIONS**

8. The Opponent filed evidence in the form of the witness statement of Erik Hanson dated 7 May 2024, which is accompanied by 10 exhibits (EH1 to EH10). Mr Hanson is the Vice President of Brand Marketing and Communications of the Opponent. He has held this position since June 2020.

9. The Applicant filed evidence in the form of the witness statement of Daniel Martin Williams dated 3 July 2024, which is accompanied by 4 exhibits (DMW1 to DMW4). Mr Williams is a director of the Applicant.

10. The Opponent filed evidence in reply in the form of the witness statement of Julie Canet dated 4 September 2024, which is accompanied by 4 exhibits (JC1 to JC4). Ms Canet is a Chartered Trade Mark Attorney acting on behalf of the Opponent in these proceedings.

11. The Applicant filed written submissions in lieu dated 4 November 2024.

12. The Opponent filed written submissions in lieu dated 6 November 2024.

## **RELEVANCE OF EU LAW**

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

## **DECISION**

### **Section 5(2)(b)**

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

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

15. Section 5A of the Act is as follows:

“5A 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.”

16. Given the earlier priority date, the trade mark relied upon by the Opponent qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to the use provisions in section 6A of the Act. The Opponent can, therefore, rely upon all of the goods identified.

### **Relevant law**

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. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

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

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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 *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated that:

“29. 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.”

21. Further, in *Kurt Hesse v OHIM*,<sup>1</sup> the CJEU stated that complementarity is autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,<sup>2</sup> the GC stated that “complementary” means:

“...there is 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.”

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<sup>1</sup> Case C-50/15 P

<sup>2</sup> Case T-325/06

22. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted as the Appointed Person (‘AP’) in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

23. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] 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 or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

24. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded."

25. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

"[...] definitions of services ... are inherently less precise than specifications of goods. [...] 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."

26. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:<sup>3</sup>

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

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<sup>3</sup> BL O/399/10

27. In its submissions in lieu, the Opponent has put forward specific combinations of some terms to compare, whereas for others, the Opponent has generally compared the Applicant's classes on the basis that they fall into broader aspects of 'hardware and software' in the Opponent's specification, rather than explicitly going through the *Canon* and *Treat* factors and without referring to any specific terms. I remind myself of paragraph 28 of the appeal to the Appointed Person in *SMARTX* BL O/0911/24 which states that:

"... it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends 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."

28. I will therefore proceed on the basis that I will only consider similarities which have been highlighted by the Opponent.

### **Parties' comments on goods and services similarity**

29. In its Counterstatement, the Applicant submits that 'the goods and services in Classes 9, 35, 37, 40 and 42 of the Application have low similarity to those covered by the Opponent's Mark, and will be perceived as such by consumers'.<sup>4</sup> In paragraph 3 the Applicant's submissions in lieu, it appears to change its position to state that the goods and services are similar to a low degree in respect of classes 9 and 35, but that there is no similarity in respect of classes 37, 40 and 42.<sup>5</sup> I will proceed on the basis

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<sup>4</sup> TM8 Counterstatement

<sup>5</sup> I note that Mr Williams in his witness statement expresses his opinion that the goods and services are dissimilar, but I must make my own assessment of the similarity based upon the relevant legal principles.

that the Applicant has conceded a low degree of similarity, as this represents the Opponent's best case.

### **Class 9**

#### **Data processing equipment, computers; computer hardware; data processors.**

30. The contested terms are physical computer hardware goods for data processing (and parts and fittings for those goods).

31. I consider that the earlier term "computer hardware (and computer software programs for) audio and music production" in the specifications of the earlier mark are also physical hardware goods for audio and music production. Whilst I note that the Opponent's goods are specifically for audio production, such goods can (and often are) still used for data processing in some respect. In my view, these goods are all identical on the principle outlined in ***Meric***.

32. However, even where there is not identity, the trade channels would overlap as these hardware goods are all likely to be sold through specialist computer hardware suppliers. The user is also likely to overlap as the goods are both likely to be purchased by members of the general public or business users. There will also be a degree of overlap in nature by virtue of the fact that the goods are electronic hardware goods. I consider these goods to be similar to at least a **medium** degree.

#### **Parts and fittings for all the aforesaid goods**

33. With regard to the above terms in this class, to the extent that the contested goods relate to goods where I have found similarity then there will be a degree of similarity here. I consider the level of similarity to be slightly lower than between the goods themselves.

#### **Communications servers [computer hardware].**

34. A server, in this context, is a computer which transfers data to other computers, via a network. In my view, the Opponent's "*multimedia computer hardware and*

*software for the integration of music, text, audio, graphics, still images and moving pictures and for interconnectivity between personal computers, networked audio hardware, and electronic musical instruments”* share the same nature as they are both types of specialised computer hardware that transfer computer data.

35. Although I take into account that the Opponent’s goods may also be sold in specialist audio/graphics suppliers, I do not discount that the Opponent’s hardware may also be sold through the same trade channels to the same users. I do not consider them complimentary in the sense that they are not important or indispensable for the other, nor are they in competition as they are not interchangeable. In my view, the goods are similar to between a **low** and **medium** degree.

*Parts and fittings for all the aforesaid goods*

36. With regard to the above terms in this class, to the extent that the contested goods relate to goods where I have found similarity then there will be a degree of similarity here. I consider the level of similarity to be slightly lower than between the goods themselves.

*Tablet computers; laptop computers; custom built computers.*

37. These terms are all types of computer hardware, and their parts and fittings (which would include computer hardware for audio and music production) and, consequently, they are identical on the principle outlined in ***Meric*** to “*computer hardware and computer software programs for audio and music production*” in the earlier Mark.

*Parts and fittings for all the aforesaid goods*

38. With regard to the above terms in this class, to the extent that the contested goods relate to goods where I have found similarity then there will be a degree of similarity here. I consider the level of similarity to be slightly lower than between the goods themselves.

*Smart phones.*

39. I compare the Applicant’s “*smart phones; parts and fittings for all the aforesaid goods*” against the Opponent’s “*multimedia computer hardware and software for the*

*integration of music, text, audio, graphics, still images and moving pictures and for interconnectivity between personal computers, networked audio hardware, and electronic musical instruments*". Smartphones are mobile telephones which have additional functions including, *inter alia*, internet access, camera and video and the ability to play music. Although their methods of use will differ in that a smart phone is a digital mobile device and the Opponent's hardware goods enables technology for multimedia and device interconnection, there is commonality in that both are items of electronic hardware which have a multimedia function.

40. The goods will overlap in nature by virtue of both being electronic hardware which has a multimedia function (with smartphones often having functionality for videos, photographs, music etc.). The trade channels will overlap as they will both be sold through computer hardware stores, as will the user. There will also be an overlap in purpose to the extent that both have a multimedia functionality. In my view, the goods are similar to at least a **medium** degree.

#### *Parts and fittings for all the aforesaid goods*

41. With regard to the above terms in this class, to the extent that the contested goods relate to goods where I have found similarity then there will be a degree of similarity here. I consider the level of similarity to be slightly lower than between the goods themselves.

#### *Computer software.*

42. This is a broad term which would encompass software in the audio and music production sector.

43. In accordance with ***Meric***, I find the Applicant's "*computer software*" identical to the Opponent's "*computer software programs for audio and music production*" in earlier rights on the basis that the contested terms encompass the earlier terms.

Parts and fittings for all the aforesaid goods

44. The term “parts and fittings” appears to me to relate to physical items. It is not clear to me what would be meant by the term “parts and fittings” in relation to the aforesaid computer software; in my view, such a term would be nonsensical. In accordance with *Skykick*, as the term cannot be interpreted, I will disregard it.

**Class 35**

Retail services connected with the sale of data processing equipment, computers, computer hardware, custom built computers, communications servers [computer hardware], computer software, smart phones, tablet computers, laptop computers, data processors and parts and fittings for all the aforesaid goods; information, advice and consultancy in relation to all the aforesaid services.

45. The Opponent submits that the Applicant’s Class 35 services are “*highly similar to the Opponent’s Class 9 goods as the services are provided in relation to identical or similar goods*”.<sup>6</sup>

46. In relation to Class 35, the Applicant claims that any rights “*they (“the Opponent”) may have through their registration in class 9 can extend only to Audio production equipment and computer hardware specific to audio production*”.<sup>7</sup>

47. To that extent, the above service covers the retail of a range of goods which include “*computer hardware and computer software programs for audio and music production*”. As these services relate to the same goods that I have found to be similar above, I find that they would overlap in trade channels and user. Where the goods of the Opponent are specified as being sold through the Applicant’s retail services, there will also be complementarity.<sup>8</sup> However, even if that is not the case, there will still be between a **low** to **medium** degree of similarity.

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<sup>6</sup> Opponent submissions in lieu para 24

<sup>7</sup> TM8 Counterstatement

<sup>8</sup> *Oakley, Inc v OHIM*, Case T-116/06

Information, advice and consultancy in relation to all the aforesaid services.

48. With regard to the above services in this class, to the extent that the information and consultancy relates to services where I have found similarity then there will be a degree of similarity here also as it would be fair to expect a person providing a service will be able to give information or advice in relation to it. I consider the level of similarity to be slightly lower than between the goods and services themselves.

**Class 37**

Installation, maintenance and repair of computers, data processing equipment and computer hardware; information, advice and consultancy in relation to all the aforesaid services

49. The Opponent submits that the above services in Class 42 are “*similar to the goods for which the earlier mark is protected as these are all IT services and are closely linked with the Opponent’s computer hardware and computer software*”.<sup>9</sup>

50. The purpose of the Applicant’s Class 37 services is to provide technical support and consultancy in relation to software and/or hardware. In comparing the above to the Opponent’s “*computer hardware and computer software programs for audio and music production*”, I will first say that there is clearly no overlap in purpose. In addition, I am of the view that the nature and method of use for these goods and services are plainly different. That being said, I agree that the user and trade channels overlap. This is on the basis that those who seek computer hardware for audio and music production are also likely to seek the installation, maintenance and repair of the same. Further, I accept that it is common in the trade for such services to be provided by the producer of the computer hardware themselves. Lastly, the goods and services are not competitive in nature, but I accept that there is a degree of complementarity between them on the basis that the Opponent’s computer hardware is important to the installation, maintenance and repair of the same. Taking all of this into account, I find that these goods and services are similar to a **medium** degree.

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<sup>9</sup> Opponent submissions in lie para 33

Information, advice and consultancy in relation to all the aforesaid services.

51. With regard to the above services in this class, to the extent that the information and consultancy relates to services where I have found similarity then there will be a degree of similarity here also as it would be fair to expect a person providing a service will be able to give information or advice in relation to it. I consider the level of similarity to be slightly lower than between the goods and services themselves.

#### **Class 40**

Custom manufacture of computers and computer hardware for others; custom manufacture and assembly of information technology products; custom construction of computers, data processing equipment and computer hardware.

52. I interpret the above to encompass the customer manufacture of computer components and parts, as well as various other information technology products. These services could include the manufacture of computers and other goods for audio production, as well as their peripherals. Consequently, I consider there to be an overlap in trade channels and user with “*computer hardware and computer software programs for audio and music production*” in the earlier mark.

53. Bearing in mind that the comparison here is between goods and services, I am of the view that the nature and purpose of these will differ. Further the method of use differs. There is some level of complementarity as custom computer-manufacture services could produce machines designed to run or host the opponent’s audio-production software. Alternatively, there may be competition, as a user may either purchase the Opponent’s ready-made hardware or engage the services of the Applicant to create a bespoke product. In my view, the goods and services are similar to at least between a **low** to **medium** degree.

Digital printing; printing of documents from digital media.

54. To my knowledge, these are services usually offered by specialist printing service providers. In the absence of any evidence or submission from the Opponent to assist me, I can see no point of overlap in nature, method of use, purpose or trade channels

with the Opponent's goods. There is no competition or complementarity. Whilst the user might overlap, this is not enough on its own for a finding of similarity. I consider the goods and services to be **dissimilar**.

55. However, for the reasons set out above, I will proceed on the basis that the Applicant has conceded similarity to a **low** degree.

*Information, advice and consultancy in relation to all the aforesaid services.*

56. With regard to the above terms in this class, to the extent that "*Digital printing; printing of documents from digital media*" relates to goods where I have found similarity then there will be a degree of similarity, as I have found the above services to be dissimilar to the goods, I also find dissimilarity in relation to all the above services.

**Class 42**

*Customization of computer hardware and software; design and development of computer hardware and software.*

57. In my view, these services share a purpose with the Opponent's computer hardware and software goods, as the end result of the Applicant's services is to provide software/hardware to the user. There will be an overlap in user. There may also be competition as one might choose to buy the Opponent's software/hardware or engage the services of the Applicant to design/develop or add additional customization to meet the same requirements. In my view, the goods and services are similar to a **medium** degree.

*Computer programming.*

58. In its Submissions the Opponent makes reference to the "*Customization of computer hardware and software*" but maintains that the "*remainder of the Applicant's services' to the Applicant's goods in Class 9 as they are 'all IT services and are closely linked to the Opponent's computer hardware and software*".<sup>10</sup> I note this to be a broad

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<sup>10</sup> Opponent submissions in lieu

comparison on the basis that they fall in broader aspects of the Opponent's specification.

59. The above term covers the service of programming computers via their software by creating codes that enables a computer to function. In the absence of any evidence or submission from the Opponent to assist me other than the submissions above, I can see no point of overlap in nature, method of use, purpose or trade channels with the Opponent's goods. There is no competition or complementarity. Whilst the user might overlap in some instances with the Opponent's goods, this is not enough on its own for a finding of similarity. I consider the goods and services to be **dissimilar**.

60. However, as explained above, I will proceed on the basis that the Applicant has conceded a **low** degree of similarity.

*Configuration of computer hardware, firmware, software, systems and networks.*

61. The above services in the Applicant's class 42 specification are services relating to the configuring of computer hardware, firmware, software, systems and networks. To my mind this involves installation, integrating, adjusting and optimising the above to create a working, functioning system including coding and creating controls that allow software and hardware devices to communicate via networks.

62. Whilst the contested services are not the same as the goods, the provision of a configuration service is likely to be linked as an after-sales service to the Opponent's computer hardware and software goods as the goods may require set-up and customisation to perform its function or communicate via networks. Furthermore, I find this service shares a degree of similarity with the Opponent's computer hardware and software in Class 9 on the basis that in the IT field, manufacturers of hardware and software are also likely to render software-related services (as a means of keeping systems updated, etc.). Therefore, I consider that both the average consumer and the usual producers and providers for the goods and services at issue may coincide. Overall, I consider there to be between a **low** to **medium** degree of similarity between the above services and the Opponent's "*computer hardware and computer software programs for audio and music production*" in Class 9.

*Installation, maintenance and repair of computer software; computer and information technology support and consultancy services.*

63. These are all services that relate to the ongoing maintenance of computer software. I compare this to “*computer software for digital audio production, processing, and editing*”. I consider it likely that the same businesses that sell computer software are also likely to offer these services to their customers. It is not uncommon, for example, for software businesses to provide updates (which include maintenance, such as fixing bugs and technical support). Consequently, I consider there to be an overlap in user and trade channels. There is also complementarity. The goods and services are therefore similar to a **medium** degree.

*Rental of web servers.*

64. I understand the above contested term to refer to a service whereby a consumer can hire web servers in order to run websites, apps or store data from a hosting provider. I acknowledge that web servers can be either hardware such as the physical or virtual machine on which the server software runs or software as programs that serve web content, and to that extent they are software.

65. I can see no point of overlap in nature, method of use, purpose or trade channels with the Opponent’s goods. There is no competition or complementarity. Whilst the user might overlap in some instances with the Opponent’s goods, this is not enough on its own for a finding of similarity. I consider the goods and services to be **dissimilar**.

66. However, for the reasons given above, I will proceed on the basis that there is a **low** degree of similarity between the goods and services.

*Information, advice and consultancy in relation to all the aforesaid services.*

67. With regard to the above term in this class, to the extent that information, advice and consultancy relates to services where I have found similarity then there will be a degree of similarity here also as it would be fair to expect a person providing a service

will be able to give information or advice in relation to it. I consider the level of similarity to be slightly lower than between the goods and services themselves.

### **Average consumer and the purchasing act**

68. 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.

69. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ 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.

70. Both parties provided submissions regarding the average consumer, with the Opponent arguing that the average consumer of the Opponent's goods would include specialised users, 'both professional and amateurs within the audio and sound recording industry.'<sup>11</sup> They state that the average consumer of the Applicant's goods and services will include members of the public at large paying varied levels of attention. The Applicant's arguments are that the average consumer can be expected to pay a high level of attention during the purchasing process in both the contested and relied upon goods and services.

71. With all of the above in mind, I consider the average consumer of the goods and services at issue is likely to comprise of members of the general public, professional and specialist consumers. I bear in mind that this would include, but is not limited to, a subset of individuals who have an interest in music and audio production. I keep in mind that some of the services, in particular, will primarily target the professional consumer.

72. The costs of the various goods and services at issue is likely to vary fairly significantly from relatively inexpensive (some software items) to significantly expensive (custom made computers and services). The frequency of the associated purchase will also vary significantly. However, even where the cost is relatively low, factors such as useability, specifications and performance are likely to be taken into

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<sup>11</sup> Opponent submissions in lieu para 73

account. For the services, factors such as reputation of service provider and qualifications are likely to be considered. I find that the level of attention will vary from medium to higher than medium. The goods and services are likely to be selected following perusal of signage on websites, physical premises and advertisements. Consequently, visual considerations will dominate the purchasing process. However, I do not discount an aural component to the purchase, given that advice may be sought from retail assistants/specialists and word-of-mouth recommendations may be made.

### **Comparison of marks**

73. 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 Court of Justice of the European Union 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.”

74. It would be wrong, therefore, to dissect the trade marks artificially, 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.

75. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
LUNA	LUNA SERIES

76. The Opponent's mark consists of the word LUNA. There are no other elements to contribute to the overall impression, which lies in the word itself.

77. The Applicant's mark consists of the words LUNA SERIES, in title case. I find that 'LUNA' is the dominant element of the Applicant's mark and therefore plays the greater role in the overall impression of the mark. This is because the word 'SERIES' is likely to be seen as indicating that the goods or services offered under the mark are part of a series and is, therefore, non-distinctive.

78. Visually, the word LUNA appears identically in both marks. As both marks are word only marks, use in different fonts (title case v upper case) will be covered by notional and fair use of the marks. The word SERIES is a point of visual difference. In my view, the marks are visually similar to between a **medium** and **high** degree.

79. Aurally, the word LUNA is likely to be pronounced LOO-NAH. This will be the same for both marks. The word SERIES will be pronounced in the usual way and will act as a point of aural difference. In my view, the marks are aurally similar to between a **medium** and **high** degree.

80. Conceptually, the word LUNA may be understood as a female forename or as a reference to the Latin word for moon. In either case, the same meaning will be attributed to both marks. I find that 'LUNA' is the dominant element of the Applicant's mark. This word, combined with the word SERIES in the Applicant's mark, will be understood as being a series by the name of LUNA, indicating that the goods or services offered under the mark are part of a series. The concept of a series is a point of difference between the marks, albeit not a distinctive one. In my view, the marks are conceptually similar to between a **medium** and **high** degree.

## **Distinctive character of the earlier mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

82. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

83. The word LUNA is likely to be understood as a reference to the Latin word for “moon” or as a female forename. I do not understand it to be a particularly common

name and, in my view, it would attract a **medium** (or average) degree of distinctiveness in either case.

84. The Opponent has filed evidence that it sells audio production software designed for the recording, editing, mixing and mastering of digital audio files. I note that the Opponent does have distributors located around the UK (such as in Bournemouth, Birmingham, Glasgow and Liverpool).<sup>12</sup> However, only one of these distributors appear in the list which is dated prior to the relevant date. In 2023, the Opponent sold over \$130,000 to UK customers via their website.<sup>13</sup> I bear in mind that as the relevant date is in September, I cannot be sure how many of these sales relate to the period prior to the relevant date. The Opponent also sold almost \$8,000 via a software distribution tool in 2023. However, again, this is not broken down for the period prior to the relevant date. Overall, since 2020, the Opponent has sold over 15,000 licenses to customers with the UK as their residing country. However, this appears to be the figure as of the date of Mr Hanson's statement, and so it is not clear how many of these were sold prior to the relevant date. The Opponent has promoted its mark on social media, but I have no overall advertising/marketing expenditure figures.<sup>14</sup> Whilst I note that awards have been won, these do not appear to be UK awards and I have no information about how widely known they would have been amongst the UK public.<sup>15</sup> Taking all of this into account, I find the evidence to be insufficient to support a finding of enhanced distinctiveness.

### **Likelihood of Confusion**

85. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment

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<sup>12</sup> Exhibit EH2

<sup>13</sup> Exhibit EH3

<sup>14</sup> Exhibit EH7

<sup>15</sup> Exhibit EH9

where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods/services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

86. I have found as follows:

- The goods and services range from similar to a low degree to identical.
- I have identified that the average consumer is likely to comprise of members of the general public, professional and specialist consumers. They will select the goods primarily by visual means, although I do not discount an aural component;
- I have concluded that the level of attention paid during the purchasing process will vary from medium to higher than medium;
- I have concluded that the marks are visually, aurally and conceptually similar to between a medium and high degree.
- I have found the earlier mark to be inherently distinctive to a medium (or average) degree.

87. Taking all of the factors listed above I consider that the similarities between the parties' marks are such that the average consumer would directly confuse the Applicant's mark with the earlier mark. This is particularly the case given the medium to high visual and aural similarity between the marks.

88. Even when the average consumer pays a high level of attention to the purchasing process, it is my view that the consumer may mistake the earlier mark for the Applicant's mark since I have found the word LUNA plays the greater role in the overall impression of the mark and 'Series' is the non-distinctive element. Consequently, I find that imperfect recollection means they would fail to notice whether the word 'Series' is present or absent.

89. I consider this to be the case where the goods and services are similar to between a low and medium degree or higher. Where the goods and services are similar to only a low degree, I find that the distance between the goods and services is sufficient to offset the similarity of the marks.

90. Accordingly, I find there is a likelihood of direct confusion for all goods/services that I have found to be similar to between a low and medium degree or above.

91. For the sake of completeness, I will also consider indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>16</sup>

"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 recognised 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'.

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<sup>16</sup> BL O/375/10

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

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

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

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

92. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

93. In the present case, even if the differences between the marks are noticed, I have found the word ‘LUNA’ to be the dominant and distinctive element of the marks. The addition of the word SERIES is likely to be understood as referring to a series of goods/services offered under the LUNA mark and so will be a non-distinctive addition denoting a line or range of products attributed to LUNA. I consider that SERIES in the Applicant’s mark would be recognised by the average consumer as indicative of a brand extension or sub-brand of the earlier mark. This will apply where the goods and services are similar to between a low and medium degree or higher. Where the goods

and services are similar to only a low degree, the distance between them will be sufficient to offset the similarity of the marks. Consequently, I find there to be a likelihood of confusion for all good/services that I have found to be similar to between a low and medium degree or higher.

## **CONCLUSION**

94. The opposition under section 5(2)(b) has been partially successful in respect of the following goods, for which the application is refused:

Class 9      Data processing equipment, computers; computer hardware; custom built computers; communications servers [computer hardware]; computer software; smart phones; tablet computers; laptop computers; data processors; parts and fittings for all the aforesaid goods.

Class 35      Retail services connected with the sale of data processing equipment, computers, computer hardware, custom built computers, communications servers [computer hardware], computer software, smart phones, tablet computers, laptop computers, data processors and parts and fittings for all the aforesaid goods; information, advice and consultancy in relation to all the aforesaid services.

Class 37      Installation, maintenance and repair of computers, data processing equipment and computer hardware; information, advice and consultancy in relation to all the aforesaid services.

Class 40      Custom manufacture of computers and computer hardware for others; custom manufacture and assembly of information technology products; information, advice and consultancy in relation to all the aforesaid services; custom construction of computers, data processing equipment and computer hardware.

Class 42 Customization of computer hardware and software; design and development of computer hardware and software; installation, maintenance and repair of computer software; computer and information technology support and consultancy services; configuration of computer hardware, firmware, software, systems and networks; information, advice and consultancy in relation to all the aforesaid services.

95. The application can proceed to registration in respect of the following goods for which the opposition has been unsuccessful:

Class 40 Digital printing; printing of documents from digital media; Information, advice and consultancy in relation to all the aforesaid services.

Class 42 Computer programming; rental of web servers; information, advice and consultancy in relation to all the aforesaid services.

## **COSTS**

96. The Opponent has enjoyed the greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I apply an appropriate reduction for the only partial success. In the circumstances, I award the Opponent the sum of **£1180** calculated as follows:

Official filing fee for Notice of Opposition	£100
Preparing a statement of grounds and considering the other side's counterstatement	£225
Preparing evidence and considering and commenting on the other side's evidence	£540

Preparing written submissions in lieu of a hearing	£315
<b>Total</b>	<b>£1180</b>

97. I therefore order **PC Specialist Ltd** to pay **Universal Audio, Inc.** the sum of **£1180**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 25<sup>th</sup> day of March 2026**

**Janeve Manca**

**For the Registrar**