

O/0370/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4103777

IN THE NAME OF

MTRAC GLOBAL LIMITED

**TO REGISTER THE FOLLOWING OF TRADE
MARK:**

Mtrac

IN CLASSES 9, 35 36, 42 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 451832

BY CLYDESDALE BANK PLC

Background and pleadings

1. On 24 September 2024, Mtrac Global Limited (“the Applicant”) applied to register the trademark shown on the front page of this decision in the UK under application number 451832. The application was published for opposition purposes on 11 October 2024 and registration is sought for the following goods and services:¹

Class 9- Computer software, computer programs, computer applications, cloud computing software, desktop and mobile phone applications for facilitating, enabling and use in the fields of business services, financial services, market research, media research services, advertising research services, business intelligence, competitive intelligence, business research services, consumer and behaviour research services, business and brand consulting services, business forecasting, business scenario modelling, business decision making services, economic modelling and cost modelling, retail marketing and sales information services, promotional services, marketing services, artificial intelligence services, large language model services, modelling, simulation and optimization services, data analytics and insights, digital commerce services, digital services , mathematical algorithms services, automation and information technology .

Class 35- Providing business management consultation, business consultation services, market research services, media research services, advertising research services, business intelligence, competitive intelligence, business research services, brand commercialization, consumer and behaviour research services, business and brand consulting services, business forecasting, business scenario modelling, optimal business decision making services, economic modelling and cost modelling, retail marketing and sales information services, promotional services, marketing services, artificial intelligence services, large language model services, modelling, simulation and optimization services, data analytics and insights, digital commerce services,

¹ The Applicant’s specification contained typographical errors in classes 9, 35 and 42 which I have corrected.

digital services, mathematical algorithms services, automation and information technology in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

Class 36- Providing financial services and consultation, financial forecasting and analysis related to payer reimbursement, patient reimbursement, pharmacy reimbursement, medical insurance, insurance coverage, formulary coverage, impact of policy changes, international reference pricing, parallel trade, business valuations, financial risk management advisory and consultancy services, insurance risk management advisory and consultancy services; Financial engineering and risk management.

Class 42- Providing computer services and consultation, namely, programming, designing, developing and maintaining software and applications, on-line non-downloadable electronic databases and websites, software as a service [saas], automatic processing of information, robotic process automation, automate use of computer systems and software, platform as a service (paas) featuring computer software platforms, computer software support services, cloud computing, cloud computing consultancy, cloud computing networks and applications, hosting computer software applications in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

Class 44- Providing consulting services, namely, health, medical, pharmaceutical, health management and disease management information to pharmaceutical, biotechnology and healthcare manufactures.

2. On 10 January 2025, Clydesdale Bank plc (“the Opponent”) filed a notice of opposition against the application. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods and services in classes 9, 35, 36 and 42. The Opponent relies upon the following of trade mark:

M-TRACK

UK trade mark no. 3794578

Filing date 01 June 2022; registration date 16 September 2022.

Relying on the goods and services in classes 9, 16, 35 and 36 of the registration, namely:

Class 9- Computer software for facilitating or enabling access to banking and financial services; computer software and software upgrades supplied on-line from computer databases, computer networks, global computer networks or the Internet electronic interface providing banking and financial services; interactive software application delivered online through a web-browser, being a downloadable application; app delivered to any computing device including desktop, laptop and tablet computers as well as mobile devices; mobile phone and electronic device app or interface software; downloadable computer software for accessing, managing, controlling and interacting with banking services, business internet banking, financial services, business forecasting and cash flow purposes, inventory, sending of payments, ecommerce, marketing, HR and accounting and for managing financial affairs; mobile phone app for banking services, business internet banking, financial services, business forecasting and cash flow purposes, inventory, sending of payments, ecommerce, marketing, HR and accounting and for managing financial affairs; bank cards, encoded cards, smart cards and multifunction cards, cheque cards, debit cards, credit cards, charge cards; magnetic data carriers; encoded cards,

integrated circuit cards, all for financial transactions and financial services; cash dispensers, automatic teller machines, automatic paying-in and deposit machines; data processing apparatus; computer software to enable searching of data; computer software for facilitating or enabling access to business services, financial services, information services and e-mail services; app for a mobile communications device; electronic publications, newsletters, magazines, periodicals, pamphlets, leaflets, instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites); interactive computer software and interactive computer discs; instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites).

Class 16- Paper and cardboard; printed matter; printed publications; advertising materials; stationery; office requisites; brochures, vouchers, cheques, cheque books, paying-in books; bank cards, cash cards, cheque cards, debit cards, credit cards, charge cards; instructional and teaching materials; wrapping and packaging materials.

Class 35- Business advice and information; business forecasting; business inventory services; business services namely data modelling, commercial modelling and price management services; business decision making services; business scenario modelling services; commercial modelling services; business appraisal services; business risk analysis services; business portfolio modelling and analysis services; business decision making services; business scenario modelling services; business monitoring and control services; cost modelling services; administrative and business services being the tracking of business information and drawing up reports relating thereto; data collection services; business planning; business appraisals; business management assistance; business administration, management and support; economic forecasting and analysis for business purposes; profit and cash flow forecasting, analysis and planning, all being economic forecasting services; business collaboration and networking services; services to assist in

establishing networks of business contacts; arranging business introductions; arranging of exhibitions for business purposes; business information provided on-line from a computer database for the Internet; personnel management and employment consultancy; book-keeping and accounting services; tax assessment preparation, preparation and completion of income tax returns; provision of information relating to tax; tax consultancy and planning services; business networking services procurement of goods and services on behalf of businesses; purchasing of goods and services for other businesses; procurement services relating to business equipment, office supplies and office equipment; data processing services; computer database management, data processing, data verification and file management; computerized business information retrieval; credit card registration services; computerised record keeping, accounting and database management services; business advice and information, provided by telephone or provided on-line from a computer database, computer network, global computer network or the Internet; user incentive schemes relating to the use of credit cards, store cards, charge cards, cash cards, debit cards, payment cards, financial cards and purchase card; organisation, operation and supervision of loyalty programmes and of sales and promotional incentive schemes; advisory, consultancy, information, helpline and customer care services relating to all of the aforesaid services.

Class 36- Financial services; business internet banking; cash flow information services; provision of a financial platform for financial forecasting and monitoring of cash flow; banking services; financial services; mortgage services; savings services; bank account services; current account mortgage services; online digital retail banking services; banking services via an electronic interface; automated banking services; electronic banking, brokerage and funds transfer services; cash dispensing services; cash card services; credit card services; debit card services; home banking; telephone banking; internet banking; on-line banking; business banking services; arranging and financing of loans; asset financing; credit services; financial management; financial forecasting and planning; profit and cash flow forecasting and planning; international banking services; electronic payment transfer services; telegraphic payment transfer services; issuing and redemption of bank drafts;

currency account and exchange services; financial planning for retirement; financial advice and information; investment advice and information; mortgage advice and information; pensions advice and information; bank account information and information relating to bank accounts; financial services provided on-line from a computer database, computer network, global computer network or the Internet (including websites), mobile network or software application; information and advice relating to banking, finance mortgages, pensions and savings, provided on-line from a computer database, computer network, global computer network or the Internet; sending of payments via a mobile phone app or electronic interface; financial bill payment services, namely, accessing, managing, controlling, and determining the status of bills, statements and performing financial transactions over a computer network and mobile applications; investment services; mortgage services; pension services; retirement planning services; savings services; bank account services; business valuations; issuing letters of credit; provision of financial guarantees; collection of payments against shipping documents and bills of exchange; financial planning for retirement; sending of payments via a mobile phone app; financial bill payment services, namely, accessing, managing, controlling, and determining the status of bills, statements and performing financial transactions over a computer network and mobile applications; advisory, consultancy, information and helpline services relating to all the aforesaid services.

3. By virtue of its earlier filing date, the Opponent's mark constitutes an earlier mark within the meaning of section 6 of the Act. As the mark had not completed the registration process more than five years before the relevant date (the filing date of the mark in issue), it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.

4. The Opponent submits that the Applicant's mark is highly similar to the Opponent's and the respective goods and services are identical or similar, giving rise to a likelihood of confusion.

5. The Applicant filed a counterstatement denying the claims made.

6. In these proceedings, the Opponent is represented by Murgitroyd & Company. The Applicant is a litigant in person acting without legal representation. The Applicant filed evidence and the Opponent filed written submissions in reply. Neither party requested a hearing, though I note that the Applicant filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

Evidence

7. The Applicants evidence consists of the Witness Statement of Yohan Pandite, dated 10 March 2025. Mr Pandite is a director of Mtrac Global Limited and his statement is accompanied by 8 exhibits, being exhibits TG1-TG8.

8. The Applicant's exhibits TG1-TG6 go mainly to show the Opponent's alleged use of their earlier right. Exhibits TG7 and TG8 consist of evidence of a Companies House Certificate of Incorporation for 'Mtrac Global Limited', and the certificate of filing of the contested application.

9. I do not intend to summarise the evidence in full here, however, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

Preliminary remarks

10. Within their evidence and submissions in lieu the Applicant has raised points that I intend to address as preliminary issues. Before going further into the merits of the opposition, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

11. Within their written submissions in lieu the Applicant states that "the Opponent's position to pursue this opposition is undermined by the UKIPO's initial

examination process, wherein the examiner failed to cite the Opponent's earlier registration as a potential issue" and that the Applicant "relies on the principle of estoppel by examination".² The Applicant makes reference to their use of the Right Start trade mark examination process, which enables an Applicant to check that their application meets the requirements for registration before paying the full fee. The grounds upon which trade mark applications are examined do not include relative grounds (i.e. potential conflicts with earlier rights). While holders of earlier rights may be notified of similar applications, the application will proceed to registration if no formal opposition is filed. The fact that the examiner of the trade mark found that MTRAC GLOBAL LIMITED's application met the legal requirements for registration does not mean that the Registry considered that it is not similar to the Opponent's mark. As an opposition has been filed and it is the job of the tribunal to consider it upon its merits.

12. The Applicant also submits that "the Opponent must demonstrate genuine use and the true nature of their trade mark."³ The Opponent's trade mark completed its registration procedure on 16th September 2022, while the application at issue was filed on 24th September 2024. As stated at paragraph 3 above, the Opponent's mark had not completed the registration process more than five years before the relevant date (the filing date of the mark in issue), and as such it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.

DECISION

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.

² Applicant's written submissions in lieu, Paragraph 5b.

³ Applicant's written submissions in lieu, Paragraph 5c.

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-

(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. 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

17. In *Canon*, the Court of Justice of the European Union (“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”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

19. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically,

they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 fur 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”.

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

21. 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. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

22. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

23. The competing goods and services are as outlined in paragraphs 1 and 2 of this decision.

24. Both parties have provided me with submissions regarding the comparison of the goods and services which I have considered and will refer to as necessary.

Class 9

Computer applications, [...] desktop and mobile phone applications for facilitating, enabling and use in the fields of business services, financial services, market research, media research services, advertising research services, business intelligence, competitive intelligence, business research services, consumer and behaviour research services, business and brand consulting services, business forecasting, business scenario modelling, business decision making services, economic modelling and cost modelling, retail marketing and sales information services, promotional services, marketing services, artificial intelligence services, large language model services, modelling, simulation and optimization services, data analytics and insights, digital commerce services, digital services, mathematical algorithms services, automation and information technology.

25. The above goods are all forms of computer, desktop and mobile applications. It is my view that these goods would be encompassed by the Opponent's broader term *app delivered to any computing device including desktop, laptop and tablet computers as well as mobile devices*, which I understand to be application software able to operate on the devices specified. Therefore, I find the goods to be identical in line with the principle set out in *Meric*.

Computer software, computer programs, [...] cloud computing software, for facilitating, enabling and use in the fields of business services, financial services, market research, media research services, advertising research services, business intelligence, competitive intelligence, business research services, consumer and behaviour research services, business and brand consulting services, business forecasting, business scenario modelling, business decision making services, economic modelling and cost modelling, retail marketing and sales information services, promotional services, marketing services, artificial intelligence services, large language model services, modelling, simulation and optimization services, data analytics and insights, digital commerce services, digital services , mathematical algorithms services, automation and information technology.

26. The above goods are all forms of computer software and programs for facilitating, enabling and use in various fields. I compare these goods to the Opponent's broad term *app delivered to any computing device including desktop, laptop and tablet computers as well as mobile devices*. It is my view that the Opponent's goods would include computer software for facilitating, enabling and use in the same fields as covered by the Applicant's goods. As such I consider the goods to be identical in line with the principle set out in *Meric*.

27. If, however, I am wrong and the goods are not identical, I consider them to be highly similar. The goods have a similar nature, all being forms of software. They also overlap in purpose, method of use, user and will be available through the same trade channels.

Class 35

28. The Applicant's specification in class 35 is separated only by commas and contains the limiting term "in all business fields including..." I will proceed with my comparison on the basis that all the services contained in class 35 are limited to being "in all business fields".

Providing business management consultation in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

29. Albeit worded differently, I find the Applicant's services to be identical to the Opponent's *business [...] management [...] consultancy [...] relating to all of the aforesaid services.*

Business forecasting, business scenario modelling, optimal business decision making services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

30. The above terms "Business forecasting" and "business scenario modelling" are also included in the Opponent's specification and are self-evidently identical. The Opponent's specification also includes the term *business decision making services*, which I consider to be identical to "optimal business decision making services", albeit worded slightly differently.

Economic modelling and cost modelling in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

31. I consider that the Opponent's *cost modelling services* are identical to the Applicant's "cost modelling".

32. It is my understanding that "Economic modelling" involves the analysis of economic information in order to predict or forecast business or economic outcomes. I therefore consider that the Opponent's *cost modelling* would fall within the broader category of *Economic modelling*. They are therefore identical in line with *Meric*.

33. If, however, I am wrong and the services are not identical, I consider them to be highly similar. The services overlap in their nature and broader purpose; both being modelling services intended to analyse information in order to predict outcomes and inform decision making. The services will share a similar method of use, user and will be available through the same trade channels, with each of the services commonly being offered by the same undertakings. The services may also be in competition, in that consumers will choose between them for the purpose of modelling future outcomes.

Modelling, simulation [...] services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

34. Albeit worded differently, I consider the above services to be identical to the Opponent's *business scenario modelling services*.

Optimization services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

35. I consider the Opponent's *business scenario modelling services to be a form of optimization service*. As such I find these services to be identical in line with *Meric*.

Promotional services, marketing services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

36. It is my view that the Applicant's broad services would encompass the Opponent's *organisation, operation and supervision of loyalty programmes and of sales and promotional incentive schemes*, which I understand to be a form of promotional or marketing service. As such, they are identical in line with the principle set out in *Meric*.

Business consultation services, business [...] consulting services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

37. It is my view that the Opponent's *business [...] management [...] consultancy [...] relating to all of the aforesaid services*, would fall within the broader category of

the Applicant's "business consultation services and business [...] consulting services" and therefore these services are identical in line with *Meric*.

Brand consulting services [...] in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

38. I compare the above term to the Opponent's *business [...] management [...] consultancy [...] relating to all of the aforesaid services*. I consider that the services overlap in their nature, with each being a type of consultancy. There is a broad overlap in the overall purpose of the services in that both aim to improve the performance of a business or entity, however they differ in their specific focus, with the Opponent's services focusing more widely on improving the operations of an organisation as a whole, while the Applicant's more closely targets improvements to the businesses' brand and identity. The services are frequently offered business to business by the same undertakings and as such the trade channels will overlap, as will the users, with each of the services being sought by organisations or businesses seeking to improve their performance. Overall, I consider the services to be similar to a high degree.

Market research services, media research services, advertising research services, business research services, consumer and behaviour research services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

39. The above are all forms of research services which I understand involves the gathering and presentation of research and information in order to inform decisions and planning. I compare these services to the Opponent's *administrative and business services being the tracking of business information and drawing up reports relating thereto*. I consider the above services to be similar in their nature although they differ in their specific purpose. The services will each be sought by businesses or professional users and the method of use will overlap, with the services being engaged through consultation with the service provider and the delivery of finding back to the user. I do not consider these services to be complementary, nor do I think they are in competition. As such, I find the services to be similar to a low degree.

Brand commercialization in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

40. When compared to the Opponent's *business [...] management [...] consultancy [...] relating to all of the aforesaid services*, the services differ in their nature, with the Applicant's being services offered to businesses to assist them in developing a brand and bringing it to market and the Opponent's being a service that focuses more broadly on the overall running of a business. I am of the view that there is a broad overlap in the purpose of the services, with both being used to improve the commercial performance of a business, however they differ slightly in their specific purpose. There is likely to be some overlap in the users of the services, with each being sought by businesses seeking to improve their commercial performance. The services overlap in their method of use, with each being delivered through external consultancy and the trade channels will overlap, with the services commonly being offered through the same undertakings. I do not consider the services to be complementary, although there may be some degree of competition where business users choose between them when seeking improvements to commercial performance. Overall, I consider the services to be similar to a high degree.

Retail marketing and sales information services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

41. It is my view that the Opponent's broader term *Business [...] information* would encompass "retail marketing information and sales information". I therefore consider the above services to be identical in line with the principle set out in *Meric*.

Business intelligence, competitive intelligence, data analytics and insights in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

42. I understand the above to be services provided to entities involving the processing and examining of data to identify patterns or trends to help organizations to optimize their operations. I compare these services to the Opponent's *data processing services*, which I understand to be a service that involves collection, organising and storing of data for an organisation. I consider these services to be similar in their nature, both involving the handling of data, however they differ slightly in their purpose with the Applicant's services focused on analysis for the purposes of business optimization and the Opponent's the processing and storage of data. The method of use will therefore differ. Trade channels will overlap as companies offering data analysis are also likely to offer processing. The services will also target the same users, likely being businesses interested in gaining data insights. I also consider the services to be complementary to the extent that consumers would believe that the services derived from the same undertaking, in that the Applicant's services require data to be processed in order to provide analytics and insight. Overall, I consider the services to be similar to a medium degree.

Artificial intelligence services, large language model services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

43. I consider the above terms in class 35 to each be business services that use artificial intelligence to analyse data, support decision making and optimize business operations. When compared to the Opponent's *business administration, management and support* the services share the same broad purpose of supporting business operations and will overlap in their user, with each being sought by businesses. The method of use will be similar, with each service being engaged via consultation with the service provider and the sharing of business information and receiving of advice. There may be some degree of competition between the services, in that a business seeking to improve its operational performance may choose between the respective services to achieve this aim. I do not however consider that the services are complementary. I find the services to be similar to a medium degree.

Digital services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

44. I understand digital services to refer to any service that is delivered electronically over the internet. As I have no submissions on this point from either party, I interpret the Applicant's services in class 35 to be a form of business service or consultancy to offer advice to businesses via digital tools. These services share a similar nature and purpose with the Opponent's *business advice and information [...]*

consultancy [...] relating to all of the aforesaid services, which in my view include the offering of business advice and information. The users are likely to overlap, as will the trade channels and method of use. The services are likely to be in competition in that users may seek them for fulfilling the same purpose. Overall, the services are similar to a high degree.

Digital commerce services [...] in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

45. The above services enable, support or manage commerce conducted through digital means for businesses. These services differ in nature to the Opponent's *Business advice and information*, however they may overlap in their broader purpose, in that the Applicant's services are offered to businesses to support their digital commerce, and the Opponent's service may offer advice and information regarding this. The services are likely to overlap in their user with each being sought by businesses and professionals and they may be available through the same trade channels. I also consider that there may be competition between them where consumers choose between them. As such, I find the services to be similar to a medium to high degree.

Mathematical algorithms services in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

46. The above services are concerned with the development and running of mathematical formulas to optimize business processes, inform decision making or

process data. When compared to the Opponent's *business services namely data modelling*, I consider that the services differ in their nature, however they overlap in their board purpose, with both services being used for the processing of data to provide business insights optimize business performance and aid decision making. The service will also overlap in their users, with both being sought by businesses, and the method of use will be similar, with both services likely obtained through consultation with the provider. The services are not complementary; however, they may be in competition, in that a business user may choose between them when seeking to gain data insights. Overall, I find the services to be similar to a medium degree.

Automation and information technology in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

47. Broadly, I consider the above services to employ the use of IT systems and automated processes to support or improve business operations. These services differ in nature to the Opponent's *data processing services*, however they overlap in their purpose, with the respective services each being concerned with using digital tools for the purpose of providing business support. The services are each likely to be sought by businesses and as such will overlap in their user. I also consider that the services will overlap in their trade channels as the services commonly offered through the same undertakings. I do not consider the services to be complementary, however there may be a degree of competition between them. As such, I find the services to be similar to a medium degree.

Class 36

48. I note that the services in the Applicant's class 36 specification are separated only by commas; save the final term. The specification also contains the limiting term "related to". In view of this, I will proceed with my comparison on the basis that the services "Providing financial services and consultation" and "financial forecasting and

analysis” are related to “payer reimbursement, patient reimbursement, pharmacy reimbursement, medical insurance, insurance coverage, formulary coverage, impact of policy changes, international reference pricing, parallel trade, business valuations, financial risk management advisory and consultancy services, insurance risk management advisory and consultancy services”.

Providing financial services and consultation [...] related to payer reimbursement, patient reimbursement, pharmacy reimbursement, medical insurance, insurance coverage, formulary coverage, impact of policy changes, international reference pricing, parallel trade, business valuations, financial risk management advisory and consultancy services, insurance risk management advisory and consultancy services.

49. The above services will be encompassed by the Opponent’s broader *financial services and consultancy, [...] relating to all the aforesaid services* and are therefore identical in line with the principles set out in *Meric*.

Financial forecasting [...] related to payer reimbursement, patient reimbursement, pharmacy reimbursement, medical insurance, insurance coverage, formulary coverage, impact of policy changes, international reference pricing, parallel trade, business valuations, financial risk management advisory and consultancy services, insurance risk management advisory and consultancy services.

50. The Applicants services would be encompassed by the Opponent’s broader term *financial forecasting and planning* and as such are identical in line with the principle set out in *Meric*.

Financial [...] analysis related to payer reimbursement, patient reimbursement, pharmacy reimbursement, medical insurance, insurance coverage, formulary coverage, impact of policy changes, international reference pricing, parallel trade, business valuations, financial risk management advisory and consultancy services, insurance risk management advisory and consultancy services.

51. I understand the Applicant's *Financial analysis* to be a form of financial service that examines financial data in order to inform decisions. As such I consider that these services would be included in the more general category of *financial services* in class 36 of the earlier mark and are therefore considered to be identical under the principle outlined in *Meric*.

Financial engineering and risk management.

52. I interpret the above terms to be a form of financial service aimed at businesses to develop financial models and strategies in order to inform decision making and manage risks. It is my view that these services would fall within the broader category of the Opponent's *financial services*. Accordingly, I find these terms to be identical under the principle outlined in *Meric*.

Class 42

53. The Applicant's specification in class 42 is again separated only by commas and contains the limiting terms "namely" and "in the fields of". I will proceed with my comparison on the basis that all the services are forms of the preceding "Providing computer services and consultation namely, programming, designing, developing and maintaining" in the fields listed in the specification.

54. Within their written submissions the Applicant states that "the Opponent should be bound by the scope of their own registration. As they have not registered Class 42, it is not open to them to claim that the Applicants use of class 42 services is likely to cause confusion with their own goods".⁴ I acknowledge that the Opponent's earlier right is not registered in class 42, however, the fact that goods or services appear in different classes does not preclude a finding of similarity between them.⁵ As such, this line of argument does not assist the Applicant.

⁴ Applicant's written submissions in lieu, paragraph 5g.

⁵ See Section 60A of the Act.

55. Whilst the Opponent has addressed the similarity of the class 42 services with those of the earlier right within their statement of grounds, they have not given any further submissions. In respect of the class 42 services the Opponent states that “the services in class 42 which are so closely related to the goods in class 9 are provided by the opponent to support the sale and use of the class 9 goods”.

56. In this regard, I note that when Mr Iain Purvis KC, sitting as the Appointed Person, issued his decision in *SmartX Trade Mark, BL O/0911/24*. He said:

“28. ... it is for the Opponent to put forward the combination of goods [or services] 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 ... would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods [or services] 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.

57. Later in the same decision he said:

“31(v). In fact (as I have pointed out) the Hearing Officer went beyond the written submissions in making findings of similarity in respect of a number of groups of goods on the basis of arguments which had not been raised by the Opponent. If the Applicant had complained about this by way of an Appeal, there would probably have been a good argument that he had been the victim of procedural unfairness. ...”

58. I do not consider that the case law I have cited above means that I must find the parties' services to be dissimilar, however it would be unfair for me to assess every possible comparison between the parties' goods and services. Instead, I consider it reasonable that I identify the closest terms in the Opponent's class 9 and carry out the comparison with the Applicants class 42 on that basis. This is because the Opponent's

submissions clearly identify its class 9 goods as its strongest comparator to the Applicant's class 42 services. In doing so I will remain mindful of the Appointed Person's comments regarding the danger of procedural unfairness.

Providing computer services and consultation, namely, programming, designing, developing and maintaining software and applications [...] in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

59. I consider the Opponent's various forms of software and applications in class 9 to be the end result of the Applicant's programming, designing and developing. As such, I find that there exists a complementary relationship with the above contested services and the Opponent's computer software and applications, on the basis that without the above services there would be no end product of software or applications. Whilst I acknowledge that the nature and method of use of the respective goods and services differ, there may be an overlap in trade channels where companies that design and develop software and applications may also provide the Opponent's software and applications in class 9. There is also an overlap in the user of the goods and services and a degree of competition between them where consumers may select between a bespoke software product from a developer or software that is already on the market. As a result, I find the goods and services to be similar to a medium degree.

Providing computer services and consultation, namely, programming, designing, developing and maintaining [...] on-line non-downloadable electronic databases [...] in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information,

promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

60. The above services differ in nature and purpose to the Opponent's *computer software and software upgrades supplied on-line from computer databases* in class 9; with one being a service for the programming, designing, developing and maintaining of databases and the other being software provided through an online database. The goods and services share a broad overlap in user, in that they may both be sought by businesses. The method of use of the goods and services will differ and they are not in competition, however they may share the same trade channels and I consider that they are to complementary, in that the Applicant's services may allow for the creation of the databases that allow access to the Opponent's software and the average consumer would expect the creator of the software to be responsible for the provision of the database it is accessed from. Overall, I consider the goods and services to be similar to a low degree

Providing computer services and consultation, namely, programming, designing, developing and maintaining [...] websites [...] in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

61. The above services are for the creation and maintenance of websites to provide an online interface in various business fields. These services differ in nature and to the Opponent's *computer software for facilitating or enabling access to business services* in class 9, which I understand to be downloadable or installed software that facilitates access to business services. However, they overlap in their broader purpose, in that the Applicant's service is for the creation of a public interface in various fields including business fields and the Opponent's goods help facilitate access to

business services. The Opponent's goods will likely be available through physical retail premises and their online equivalents, while the Applicant's services will likely be engaged directly from the service provider following consultation. As such I find that the trade channels and methods of use will differ. The users of the goods and services will overlap as they would both be accessed by business users. I also consider there to be some degree of competition between the goods and services where users may select between engaging the Applicant's services for the creation of a bespoke website to provide access to their services and the Opponent's software to provide the same access. As a result, I find the goods and services to be similar to a low degree.

Providing computer services and consultation, namely programming, designing, developing and maintaining [...] software as a service [saas] [...] platform as a service (paas) featuring computer software platforms [...] cloud computing, cloud computing networks and applications [...] in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

62. In general, I understand the above services to entail the designing, developing and maintaining of forms of software that are licenced or rented, as opposed to software that is purchased outright. The Opponent's class 9 goods *interactive software application delivered online through a web-browser, being a downloadable application* differ in nature from the Applicant's services, however they overlap in their broader purpose, in that the services are for the programming, designing, developing and maintaining of software in various business fields, and the Opponent's goods are for the provision of software which may serve the same fields. As the Opponent's goods may include software in the same fields as the Applicants' services there is also an overlap in user. There may be an overlap in trade channels where companies that design and develop software also provide the Opponent's software and applications and a degree of competition between them where consumers may select between the

Applicants' services for the creation and maintenance of bespoke software solutions or the Opponent's software that is already on the market. While I consider that there may be a degree of complementarity between the goods and services, in that the interactive software applications may be required for the delivery of the Applicant's services, this relationship is not indispensable. Overall, I consider there to be a medium degree of similarity between the goods and services.

Providing computer services and consultation, namely, programming, designing, developing and maintaining [...] automatic processing of information, robotic process automation, automate use of computer systems and software [...] in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

63. In general, I understand the above to be services that allow for the design, development, maintenance and provision of systems in various fields for the automation of computer-based tasks and processes through the use of software. The above services differ in nature and purpose to the Opponent's *computer software and software upgrades supplied on-line from computer databases*, however the users may overlap where the users of the Opponent's software may seek services that allow them to develop systems that allow them to automate the use of the software. I also consider that there may be some overlap in trade channels as entities offering the Applicant's programming, designing, developing and maintaining of automation systems may also offer the software they are designed to automate. I do not consider the goods and services to be in competition, nor are they complementary. Overall, I find the goods and services to be similar to a low degree.

Providing computer services and consultation, namely, programming, designing, developing and maintaining [...] computer software support services [...] in the fields of market research, media research, advertising research, business intelligence,

competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

64. The nature and purpose of the above services and the Opponent's *computer software for facilitating or enabling access to business services, financial services, information services and e-mail services* in class 9 differ. Broadly speaking I understand the above services to be offered to users to design, develop, maintain and provide computer software support services to provide customers with software support, whereas the Opponent's services are the provision of software to enable access to business services. The goods and services may overlap in their users where businesses seeking software to offer access to their services also require the creation of support services for the software and they may be offered through the same trade channels where software providers also offer the creation of support services for their software. The goods are not in competition, although there is a degree of complementarity between them. Accordingly, I find the goods and services to be similar to a low degree.

Providing computer services and consultation, namely, programming, designing, developing and maintaining [...] cloud computing consultancy [...] in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

65. I interpret the above service to be for the programming, designing, developing and maintaining of systems that deliver computing consultancy online in various fields. This service differs in nature to the Opponent's *computer software for facilitating or*

enabling access to business services, financial services, information services and e-mail services in class 9. The purpose of the goods and services also differs; the Applicant's goods are for the creation of platforms to enable access to consultancy while the Opponent's are software to enable access to business services. I do not consider that the goods and services share the same method of use, nor will their user and trade channels overlap. They are not in competition, nor are they complementary. Overall, I consider them to be dissimilar.

Providing computer services and consultation, namely, programming, designing, developing and maintaining [...] Hosting computer software applications [...] in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

66. I understand the above to be services for the creation of platforms that store and deliver access to software applications over the internet in various fields. These services differ in nature purpose when compared to the Opponent's *computer software for facilitating or enabling access to business services, financial services, information services and e-mail services*. The goods and service will differ in their method of use, however there may be an overlap in trade channels, where the goods and services are offered by the same provider, and user, as businesses seeking the Opponent's software may also seek the design and development of a system to host it online. The goods are not in competition, although there is a degree of complementarity, between them. Overall, I find the goods and services to be similar to a low degree.

67. As a degree of similarity between the goods and services is necessary to engage the test for the likelihood of confusion, my findings above mean that the

opposition aimed against those services that I have found to be dissimilar will fail.⁶ For ease of reference, the opposition fails against the following class 42 services:

Providing computer services and consultation, namely, programming, designing, developing and maintaining [...] cloud computing consultancy [...] in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

The average consumer and the nature of the purchasing act

68. As the case law above indicates, it is necessary to determine who the average consumer is for the goods and services at issue. I must then determine the manner in which the goods and services are likely to be selected by the average consumer.

69. 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.

70. 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;

⁶ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

(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 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.

71. I consider that the average consumer of the goods and services at issue will predominantly be a business or professional user, although I do not exclude members of the general public. The frequency and cost of purchase of the goods and services at issue will likely vary; with some being relatively high, and consumers are likely to be alive to considerations such as the reputation of the service provider, business compatibility and the suitability of the goods and services to their needs. Overall, I consider that the average consumer will demonstrate at least a medium level of attention during the purchasing process.

72. The goods will be available at both general and specialist retailers and their online or catalogue equivalents. At the retailers' physical premises, the goods will be displayed on shelves and in cabinets, where they will be self-selected by consumers. A similar process will apply where the goods are selected online or via catalogues. In respect of the services, the average consumer is likely to have encountered the service provider through a website, directory of services or advertisement. In both cases, the purchasing act will be predominantly visual in nature, however, I recognize that there may also be an aural aspect to the purchasing process where advice is sought from a retail assistant or services are engaged following consultation with a provider.

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 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 relevant 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 trade 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 marks to be compared are as follows:

Opponent's Mark	Applicant's Mark
M-TRACK	Mtrac

76. The Opponent's mark is a word only mark consisting of the elements "M" and "Track" separated by a hyphen. I consider that the overall impression of the mark lies in the combination of these elements.

77. The Applicant's mark consists of the word "Mtrac". As there are no other additional elements, the overall impression of the mark resides in the word itself.

Visual comparison

78. Visually, the Applicant's mark is comprised of 5 letters, and the Opponent's of 6 letters separated by a hyphen. The marks share the 5 letters "Mtrac" in the same order, differing only through the hyphen between the letter's "M" and "T" and the addition of a "K" as the final letter in the Opponent's mark. I do not consider the presence of the hyphen separating the 'M' from 'Track' in the Opponent's mark and the differing final letter to be particularly visually noteworthy for the average consumer, however I acknowledge that they do create a visual difference between the marks. Overall, I consider the marks to be visually similar to a medium to high degree.

Aural comparison

79. The Applicant submits that the earlier right may be pronounced as "M Dash Track" or "M minus track".⁷ I am of the view that the consumers will not articulate the hyphen in the Opponent's mark, and will see it only as a pause or separation between the letters M and T, as such the mark will be pronounced as two syllables, "em-trak". With regard to the Applicant's mark, in my experience it is unusual for the letter "M" to

⁷ Applicant's written submissions in lieu, paragraph 5e

precede the letter “T”. As such it is my view that consumers will separate the letter “M” from “trac” when articulating the mark. The Applicant’s mark will therefore also be pronounced as the two syllables, “em-trak”. Consequently, I find the marks to be aurally identical.

Conceptual comparison

80. 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.

81. Within their submissions the Applicant states that their mark is a single word with no identifiable meaning, while the earlier right will, in the context of the goods and services for which it is registered, be interpreted as “Money- Track” alluding to a tracker for the monitoring forecasting and analysing banking and financial transactions. The Applicant has filed evidence to support this claim in exhibits TG3 and TG3a, consisting of screenshots of the Opponent’s use of the M-Track mark. Within their written submissions in reply, the Opponent states “the Opponent’s current use of its mark is not a consideration in the comparison of the Application and the Opponent’s Earlier Registration”.⁸

82. The Opponent is correct in this statement; the comparison I make must be conducted on a notional basis. This means that I must compare the earlier mark as it is registered and the later mark as it is applied for, how either mark is currently used in practice is not relevant to my assessment.

83. The word “track” has multiple definitions including as either a noun; being a narrow road or path; a piece of ground, often oval-shaped, that is used for races or one of the songs or pieces of music on a recording, or a verb meaning to follow or investigate something.⁹ I am of the view that the average consumer will be aware of each of these meanings and any of them may be evoked by the word “Track” in the

⁸ Opponent’s written submissions in reply, Paragraph 5

⁹ <https://www.collinsdictionary.com/dictionary/english/track>

Opponent's mark. The Applicant submits that the letter "M" will be interpreted as meaning "Money", however I do not consider that the average consumer will immediately make this link but will instead see the "M" element purely as an initial representing an unknown word.

84. With regards to the Applicant's mark, while the Opponent has claimed that the marks are conceptually identical,¹⁰ I find that the lack of separation between the terms "M" and "trac" in the Applicant's mark mean that the average consumer will have no reason to see the letter "M" as an initial or "trac" as the word "track". It is my view that the additional mental steps required to separate these elements will result in the Applicant's mark being seen entirely invented term which holds no conceptual meaning that will be immediately grasped by consumers. I therefore find the marks to be conceptually dissimilar.

Distinctive character of the earlier mark

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section

¹⁰ Opponent's written submissions in reply, Paragraph 11

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

85. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. The Opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness through the use made of it, nor has it filed any evidence to that effect. Therefore, I have only the inherent distinctiveness of the mark to consider.

86. As previously discussed in my conceptual comparison, the Opponent’s mark is likely to be seen as a combination of the initial “M”; for an unknown word or name, and the ordinary dictionary word “Track”. These words are neither descriptive nor allusive to the goods and services in question. As such I find the earlier mark to be distinctive to a medium degree.

Likelihood of confusion

87. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

88. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and the goods down to the responsible undertakings being the same or related.

89. Earlier in this decision I concluded that:

- The competing goods and services are identical or similar; where similarity has been found, the goods and services are similar to between a low and a high degree;
- The average consumer will primarily comprise business or professional users, although I do not exclude members of the general public. All consumers will demonstrate at least a medium level of attention during the selection process;
- The purchasing process will be predominantly visual in nature, though aural considerations will not be discounted;
- The Opponent's earlier mark holds a medium degree of inherent distinctiveness;
- The Opponent's mark is visually similar to the Applicant's mark to a medium to high degree;
- The Opponent's mark is aurally identical to the Applicant's mark;
- The Opponent's mark is conceptually dissimilar to the Applicant's mark.

90. Weighing the above factors and bearing in mind the principle of imperfect recollection, I find that the that the differences between the marks are sufficiently slight that they may be overlooked and that the marks are likely to be mistakenly recalled or misremembered as each other by the average consumer. Although I have found the marks to be conceptually dissimilar, I do not consider this sufficient to neutralize the medium to high level of visual similarity and the aural identity of the marks.¹¹ As such the average consumer could easily misremember the Applicant's mark as containing

¹¹ In *Nokia Oyj v OHIM*, Case T-460/07, the GC stated: "Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98)."

a hyphen or recall the Opponent's mark as not. Further the presence of "K" at the end of the Opponent's mark; and lack of in the Applicant's, will, in my view, be easily overlooked given its position at the end of the mark. While I have found some of the respective goods to be similar to a low degree, this is offset by the degree of visual and aural similarities between the marks. I therefore find there is a likelihood of direct confusion.

Conclusion

91. The partial opposition under section 5(2)(b) of the Act has partially succeeded. Subject to any successful appeal against my decision, the application is refused for the following goods and services:

Class 9- Computer software, computer programs, computer applications, cloud computing software, desktop and mobile phone applications for facilitating, enabling and use in the fields of business services, financial services, market research, media research services, advertising research services, business intelligence, competitive intelligence, business research services, consumer and behaviour research services, business and brand consulting services, business forecasting, business scenario modelling, business decision making services, economic modelling and cost modelling, retail marketing and sales information services, promotional services, marketing services, artificial intelligence services, large language model services, modelling, simulation and optimization services, data analytics and insights, digital commerce services, digital services , mathematical algorithms services, automation and information technology .

Class 35- Providing business management consultation, business consultation services, market research services, media research services, advertising research services, business intelligence, competitive intelligence, business research services, brand commercialization, consumer and behaviour research services, business and brand consulting services, business forecasting,

business scenario modelling, optimal business decision making services, economic modelling and cost modelling, retail marketing and sales information services, promotional services, marketing services, artificial intelligence services, large language model services, modelling, simulation and optimization services, data analytics and insights, digital commerce services, digital services, mathematical algorithms services, automation and information technology in all business fields including Aerospace, Automotive industry, Banking Industry, Biologic Companies, Consumer Products Industry, E-commerce, Electronics, Energy, Financial Institutions, Healthcare Industry, Insurance Industry, Media, Medical Devices Companies, Pharmaceutical and Lifesciences Companies, Private Equity, Publics Sector, Retail, Telecommunications, Transportation and Logistics, Travel and Tourism.

Class 36- Providing financial services and consultation, financial forecasting and analysis related to payer reimbursement, patient reimbursement, pharmacy reimbursement, medical insurance, insurance coverage, formulary coverage, impact of policy changes, international reference pricing, parallel trade, business valuations, financial risk management advisory and consultancy services, insurance risk management advisory and consultancy services; Financial engineering and risk management.

Class 42- Providing computer services and consultation, namely, programming, designing, developing and maintaining software and applications, on-line non-downloadable electronic databases and websites, software as a service [saas], automatic processing of information, robotic process automation, automate use of computer systems and software, platform as a service (paas) featuring computer software platforms, computer software support services, cloud computing, cloud computing networks and applications, hosting computer software applications in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information,

promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

92. For completeness, the mark will proceed to registration in respect of the uncontested services and the services that I have found to be dissimilar, namely:

Class 42- Providing computer services and consultation, namely, programming, designing, developing and maintaining [...] cloud computing consultancy [...] in the fields of market research, media research, advertising research, business intelligence, competitive intelligence, business research, brand commercialization, consumer and behaviour research, business and brand consulting, business forecasting, business scenario modelling, optimal business decision making, economic modelling and cost modelling, retail marketing and sales information, promotional and marketing services, artificial intelligence, large language models, scientific analysis, scientific research algorithms, research and design, scientific and technological services.

Class 44 - Providing consulting services, namely, health, medical, pharmaceutical, health management and disease management information to pharmaceutical, biotechnology and healthcare manufactures.

COSTS

93. As the Opponent has shared the greater degree of success, they are entitled to a contribution towards their costs. Awards of costs in proceedings commenced on or after 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 1 of 2023. Taking account of that scale, I award the Opponent the sum of £700, calculated as follows:

Preparing a statement and considering the other side's statement:	£250
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Filing submissions:	£350
Official fee:	£100
Total:	£700

94. I therefore order MTRAC GLOBAL LIMITED to pay the sum of £700 to CLYDESDALE BANK PLC. 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 30th day of April 2026

Jacob Robinson
For the Registrar