

O/0376/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004033708

IN THE NAME OF

DIGITAL INC. LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

**sift.**

**sift**

(series of 2)

IN CLASSES 9 AND 38

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000449767

BY SIFT SCIENCE, INC.

## **Background and pleadings**

1. On 02 April 2024, Digital Inc. Limited (“the Applicant”) applied to register the series of two trade marks shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 21 June 2024 in respect of the following goods and services:

Class 9: VPN [virtual private network] operating software; Telecommunications apparatus for use with mobile networks; Internet of Things [IoT] sensors; Computer application software for use in implementing the Internet of Things [IoT]; Internet phones.

Class 38: Wireless cellular phone services; Wireless cell phone services; Communications by cellular phones; Telecommunications services using cellular radio networks; Providing telecommunications connections to the Internet in a cafe environment; Cellular telephone communications; Wireless transfer of data via digital mobile telephony; Cellular telecommunications services; Cellular telephone communication; Cellular communications services; Mobile telecommunications network services; Communications by mobile phones; Providing telecommunications connections to the Internet or data bases; Providing telecommunications connections to a global computer network or databases; Providing access to computer networks; Provision of access to computer networks and the internet; Mobile telecommunication network services; Providing user access to computer networks and the Internet; Providing access to the Internet and other communications networks; Providing telecommunications connection to a global computer network; Providing virtual private network (VPN) services; Providing wireless telecommunications via electronic communications networks; Providing high speed access to computer and communication networks; Providing computer access to communication networks; Wireless mobile phone services; Providing users with secure remote access via the internet to private computer networks; Wireless cellular telephone services; Wireless transfer of data

via wireless application protocols; Wireless broadband communication services; Wireless transfer of data via the Internet.

2. On 23 September 2024, Sift Science, Inc. (“the Opponent”) opposed the application under Sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all goods and services in the application. The Opponent relies upon the following two marks:

## **SIFT**

UK Registration no. UK00003298990<sup>1</sup> (“The first earlier mark”)

Filing date: 23 March 2018

Date of registration: 03 August 2018

Relying upon the following services:

Class 42: Providing online, non-downloadable software for monitoring the risk presented by online user-generated content; providing online, non-downloadable software for automating online fraud prediction and prevention; providing online, non-downloadable software for facilitating fraud prevention in the field of online user account creation and utilization, online payments, promotional programs, and other online transactions; providing online, non-downloadable software for preventing fraud by preventing online accounts from being compromised.

## **SIFT SCIENCE**

UK Registration no. UK00003298156<sup>2</sup> (“The second earlier mark”)

Filing date: 20 March 2018

Date of registration: 22 June 2018

Relying upon the following services:

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<sup>1</sup> Opposition based on Section 5(2)(a)

<sup>2</sup> Opposition based on Section 5(2)(b)

Class 42: Providing online, non-downloadable software for monitoring the risk presented by online user-generated content; providing online, non-downloadable software for automating online fraud prediction and prevention; providing online, non-downloadable software for facilitating fraud prevention in the field of online user account creation and utilization, online payments, promotional programs, and other online transactions; providing online, non-downloadable software for preventing fraud by preventing online accounts from being compromised.

3. The Opponent submits that the series of applied for marks are identical to the first earlier mark relied upon and that the goods and services are highly similar. The Opponent submits that the series of applied for marks are highly similar to the second earlier mark relied upon and that the goods and services are highly similar.
4. The Applicant filed a counterstatement within which it denied the claims made and put the Opponent to proof of use in respect of both earlier marks.
5. The Opponent filed evidence during proceedings. Neither party requested a hearing, however the Opponent filed submissions in lieu. This decision is taken following a careful consideration of the papers.
6. The Applicant is not professionally represented; the Opponent is represented by Stratagem IPM Limited.
7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **Evidence**

8. The Opponent filed evidence in the form of the witness statement of Grace Mok, of Strategem IPM Limited, the Opponent's representative, signed and dated 30 March 2025. The witness statement is accompanied by exhibits GM1 – GM2.
9. The Opponent also filed evidence in the form of the witness statement of Eva Gutierrez, General Counsel of Sift Science, Inc., signed and dated 28 March 2025. The witness statement is accompanied by exhibits EG1 – EG10.
10. The evidence seeks to show proof of use of the Opponent's marks.

## **DECISION**

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

11. The opposition is based upon Sections 5(2)(a) & (b) of the Act, which read as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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”.

12. 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.”

### **Proof of use**

13. The Opponent’s earlier marks had been registered for more than five years at the filing date of the application and therefore the proof of use provisions apply.

14. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(5) Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

...”

15. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the Opponent's marks is the five-year period ending with Applicant's filing date i.e. 03 April 2019 to 02 April 2024.

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36];

*Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent

of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

### **Evidence of use**

18. The exhibits provided by Ms Mok are undated screenshots from the respective parties’ websites. I have not been provided with any narrative information regarding the relevance of these exhibits.

19. In her witness statement, Ms Gutierrez states that the Opponent was founded in June 2011 and that its services are aimed at businesses rather than the general public.

20. Ms Gutierrez states that the Opponent’s revenue for the relevant period was approximately £5.34million.<sup>3</sup> They support this with Exhibit EG1 which contains a table of revenue by customers per quarter. I note that all information save for the Quarter 2 totals for 2019 (\$75,000) and 2024 (\$1,918,000) is blurred out.

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<sup>3</sup> Paragraph 11 of the Witness Statement of Eva Gutierrez

21. Provided in Exhibit EG2 are sample invoices and EG3 is a selection of order forms. Some of the data is redacted however, I can see that they are dated within the relevant period and they show general areas within the UK for the consumers' addresses (such as London, Nottingham etc).

22. Below are a selection of extracts from the invoices showing 'Sift' or 'Sift Science':



Hi [REDACTED]  
**Thank you for choosing Sift.**  
This is your invoice for effective period 6/1/2024 - 6/30/2024  
Please remit payment in the Sift console or by using one of the methods below.

**Bill From:**  
Sift Science, Inc.  
525 Market St.

Thank you,  
Sift  
[sift.com](https://sift.com)

I note that the 'items' mentioned within the invoices are as follows:

- CONTENT ABUSE/CONTENT INTEGRITY
- PAYMENT ABUSE/PAYMENT PROTECTION
- CHARGEBACKS
- DEVICE FINGERPRINTING
- ACCOUNT ABUSE/ACCOUNT DEFENSE
- PROMOTION ABUSE/PROMOTION PROTECTION

Within her witness statement, Ms Gutierrez states that the items and products described in the invoices and order forms "all relate to the services as registered in the Registrations".<sup>4</sup>

23. I have been provided with extracts from the Opponent's website (Exhibit EG6) between 11 April 2019 and 1 April 2024 which pertain to the abovementioned categories. I note the following excerpts from their website pages:

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<sup>4</sup> Paragraph 13 of the Witness Statement

- “Processing 35 billion events per month, we provide the highest accuracy in the industry so you can reduce fraud by 80% or more”.<sup>5</sup>
- The ‘CONTENT INTEGRITY’ page states it ‘eliminates bad content at its source’ and it can ‘proactively block spam, scams and other malicious content to safeguard the integrity of your platform and your brand’. There is a reference to their ‘real-time machine learning’.
- The ‘ACCOUNT DEFENSE’ page states that it is ‘complete protection for your users and your brand’ and it can ‘stop fake sign ups instantly, and shield your loyal customers from account takeover’. The page references ‘the sift engine’ and again mentions their ‘real-time machine learning’.
- The ‘PAYMENT PROTECTION’ page has the heading ‘detect & prevent payment fraud to boost revenue’ and that it is ‘fueled by intelligent automation at every touchpoint’.

24. Below is an extract from one of the invoices to show that a ‘quantity’ is mentioned; although I have not been provided with any narrative evidence regarding the quantities, upon viewing this together with the ‘billing event’ section in Exhibit EG3 it could be the number of accounts created and checked/detected:

Item	Quantity	Start Date	End date	Rate	Amount
<b>ACCOUNT_ABUSE</b> \$create_account	3,647	6/1/2024	6/30/2024		
<b>SIFT_PREPAID_SUBSCRIPTION</b> Usage drawn down against prepayment	1	6/1/2024	6/30/2024		

25. Exhibits EG4 and 5 are google analytics reports. The Opponent notes that some of this information falls outside of the relevant dates. The report in Exhibit EG5 shows just over 51,000 ‘active users’ of the site between 1 April 2019 and 6 January 2025.

26. Throughout the pages there are mentions of the ‘Sift Platform’, ‘Sift engine’ and ‘Sift Digital Trust & Safety Suite’. There are multiple references throughout the website pages to the Sift ‘AI-powered platform’.

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<sup>5</sup> Page 1 of Exhibit EG6

27. Ms Gutierrez states that exhibits EG 7,8 and 9 show advertisement and promotion.

Exhibit EG7 is a report of prospective customer leads but, as with some of the other evidence provided by the Opponent, a lot of it is redacted and I am not convinced this exhibit shows any particularly useful information. Exhibit EG8 is regarding an ICE London event in February 2024 which is noted as being a three day conference in which the Opponent had a booth. There are photos of the booth showing the device mark I have already show above at paragraph 22. The exhibit also notes their “pre-event efforts” including mentioning they had paid LinkedIn adverts and a print advert in iGB Magazine.

28. Exhibit EG9 contains two blog posts from the Opponent’s website. I note that the first blog post mentions ‘a trust and safety architect at Sift Science’. I have no information from the Opponent as to the visits to the webpage or readership of the blog.

29. Finally, Exhibit EG10 contains example articles from The Telegraph, The Financial Times and the Fintech Times from June 2022, January 2021 and 2020 respectively. Further is a non-UK article from The Paypers. Within the article from The Telegraph, Sift are referred to as a “fraud prevention company”. In the article from the Financial Times it states that “the fraudulent payments measured by Sift, which protects transactions on 34,000 sites or apps globally, were identified as using stolen payment information and blocked by the security company”.<sup>6</sup> In The FINTECH Times, Sift are referred to as “providers of solutions to help combat payment fraud” and The Paypers refers to them as “digital trust and safety solution provider”.

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<sup>6</sup> Page 5 of Exhibit EG10

## Analysis

### Form of the mark/how the mark is used

30. The first earlier mark as registered is featured throughout the invoices, particularly on the sample invoices provided. I note that throughout the evidence the 'SIFT' mark is often seen in a stylised version with a device as follows:



31. I consider that the first earlier mark is registered is a word mark and therefore, this protects the letters or words themselves and not the form in which they are presented and that the font in which the word mark might be presented must not be taken into account; a word mark may be used in any form, in any colour or font type.<sup>7</sup> Therefore, the above presentation is still an acceptable use of the 'SIFT' mark.

32. Further, I note the device of the blue dots on the left hand side of the mark. The alteration or omission of a non-distinctive element does not alter the distinctive character and where a mark contains words and a figurative element the word element will usually be more distinctive, which suggests changes in figurative elements are less likely to change the distinctive character than changes to the word elements.<sup>8</sup> I consider that the device element does not alter the distinctive character of the mark and therefore, this is an acceptable variation of the 'SIFT' mark being used within the evidence.

33. Regarding the 'SIFT SCIENCE' mark, the only references to this are on the invoices – under the heading 'Bill From' and one mention within Exhibit EG9- the blog on their own website.

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<sup>7</sup> *LA Superquimica v EUIPO*, T-24/17, EU:T:2018:668 paragraph 39

<sup>8</sup> *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22 paragraph 15

## Conclusions from the evidence on genuine use

34. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods and services for which has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

35. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>9</sup>

36. I note that the Opponent has stated their revenue for the relevant period was approximately £5.34million which I consider to be a fairly significant amount, together with sample invoices dated throughout the relevant period which show sales as being made across England and Scotland. I note I have not been given any details of a price point or number of customers to enable me to understand the scale and frequency further. Although they have not provided me with any evidence regarding market size/share, it is likely to be well known that online transactions are very widespread and therefore it follows that protection for those transactions is also likely to be a fairly large market.

37. I can see from the evidence references to fraud prevention and online safety and I can see multiple references to their own machine learning. The webpage extracts correspond to the headings within the invoices, as detailed above, and the witness statement confirms that these correspond with the services registered. I consider

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<sup>9</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

that there are many references to fraud prevention/protection and content integrity throughout the evidence.

38. I note again that there have been some marketing efforts as exemplified in exhibits 7 through 10. For the most part, I have not been given any information regarding the number of attendees/readers that these adverts would have reached. I note that the Telegraph and Financial Times would both likely be considered as well-known newspapers with a large audience. They are called a 'Fraud Prevention Company' in one article and it says they "protect transactions on 34,000 sites or apps globally".
39. The evidence mostly has references to the first earlier mark, being 'SIFT' solus. This features on the headings of the invoices, the headings of the order forms, website and it is mostly how the company is referred to in the blog posts and advertisements. Therefore, I consider that the Opponent has shown use of the first earlier mark for the services as registered.
40. The second earlier mark appears infrequently in the evidence, mostly on invoices with the company address. In my mind, this is not enough to show that the Opponent has created or maintained a market under this particular mark, (especially since 'SIFT' alone is used more frequently in the same documents).<sup>10</sup> Therefore, I find the Opponent has not demonstrated use of the second earlier mark. As a consequence, the claim under section 5(2)(b) fails here.

### **Identity of the marks**

41. It is a prerequisite of section 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ("CJEU") held that:

"54...a sign is identical with the trademark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where,

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<sup>10</sup> *Memory Opticians Ltd's Application*, BL O/528/15

viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

Contested Marks	Earlier Mark
<p style="text-align: center;">sift.</p> <p style="text-align: center;">sift</p> <p style="text-align: center;">(SERIES OF 2)</p>	<p style="text-align: center;">(The first earlier registration):</p> <p style="text-align: center;">SIFT</p>

42. Both the contested marks and the earlier mark are word marks. Normal and fair use of a word mark includes use in upper and lower case letters. Therefore ‘sift’ from the series of two is evidently identical to the earlier mark.

43. I consider that the addition of the full stop at the end of the other contested mark is so insignificant that it may go unnoticed by the average consumer and therefore, I also find it to be identical to the earlier mark.

**Distinctive Character of the Earlier Mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

45. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up 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. The Opponent has submitted evidence regarding use of its marks which I have summarised above. I will review the evidence to see whether it shows that use of the marks can be said to have enhanced the distinctiveness of the earlier mark.

46. In order to do this, first I must consider the level of inherent distinctiveness the earlier mark has. I consider that ‘SIFT’ is an ordinary dictionary term which could be viewed as allusive to the services provided, that is, the services are looking to ‘sift out’ fraud. I therefore find it to be inherently distinctive to between a low and medium degree.

47. Turning now to the evidence of use, as detailed above, they have just over £5million in sales over the relevant period. Although, as I have mentioned above, this is a fairly significant amount, I do not have an idea of price point of the Opponent’s services to enable me to contextualize this figure in terms of the

number of sales made/number of customers. I have numerous invoices and order forms however, the redacted information prevents me from understanding how many different consumers there are. I have not been provided with any marketing expenditure figures (although I note there are a couple of articles from independent papers/magazines) nor do I have any evidence of market share. Therefore, I do not believe that the evidence provided amounts to a finding of enhanced distinctiveness of the earlier mark.

### **Comparison of goods**

48. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

49. 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.

50. 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 OHIM*, Case T-325/06, the General Court stated that ‘complementary’ means:

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

51. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way 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).

52. The Parties’ respective specifications are:

<b>Contested goods and services</b>	<b>Opponent’s services</b>
Class 9: VPN [virtual private network] operating software; Telecommunications apparatus for use with mobile networks; Internet of Things [IoT] sensors; Computer application	Class 42: Providing online, non-downloadable software for monitoring the risk presented by online user-generated content; providing online, non-downloadable software for

software for use in implementing the Internet of Things [IoT]; Internet phones.

Class 38: Wireless cellular phone services; Wireless cell phone services; Communications by cellular phones; Telecommunications services using cellular radio networks; Providing telecommunications connections to the Internet in a cafe environment; Cellular telephone communications; Wireless transfer of data via digital mobile telephony; Cellular telecommunications services; Cellular telephone communication; Cellular communications services; Mobile telecommunications network services; Communications by mobile phones; Providing telecommunications connections to the Internet or data bases; Providing telecommunications connections to a global computer network or databases; Providing access to computer networks; Provision of access to computer networks and the internet; Mobile telecommunication network services; Providing user access to computer networks and the Internet; Providing access to the Internet and other communications networks; Providing telecommunications connection to a global computer network; Providing virtual private

automating online fraud prediction and prevention; providing online, non-downloadable software for facilitating fraud prevention in the field of online user account creation and utilization, online payments, promotional programs, and other online transactions; providing online, non-downloadable software for preventing fraud by preventing online accounts from being compromised.

<p>network (VPN) services; Providing wireless telecommunications via electronic communications networks; Providing high speed access to computer and communication networks; Providing computer access to communication networks; Wireless mobile phone services; Providing users with secure remote access via the internet to private computer networks; Wireless cellular telephone services; Wireless transfer of data via wireless application protocols; Wireless broadband communication services; Wireless transfer of data via the Internet.</p>	
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Class 9

*VPN [virtual private network] operating software*

53. The above term from the Applicant's specification and the Opponent's terms both overlap in nature in so far as they are software related however, the Applicant's term is a good versus the Opponent's services. Further, the Applicant's term is VPN software generally whereas the Opponent's terms are online fraud prevention. I consider that a VPN is likely to contain/be used for security purposes and therefore, there is also an overlap in purpose and potentially user. It therefore follows that there might be an element of competition between them. They are not complementary. I therefore find them to be similar to a medium degree.

*Telecommunications apparatus for use with mobile networks; Internet of Things [IoT] sensors; Internet phones*

54. These goods from the Applicant's specification differ in nature as they are hardware goods versus the Opponent's online software services. Whilst there

might be a very general overlap of user, this on its own is not enough for a finding of similarity. I do not find there to be any overlap in trade channels, purpose, competition nor complementarity and therefore, I find these goods to be dissimilar to the Opponent's services.

*Computer application software for use in implementing the Internet of Things [IoT]*

55. I consider that the above term refers to software that connects/manages physical devices (such as sensors and cameras). The Opponent's services are software services which are focused on fraud prevention. Therefore, as I have stated above, they overlap in nature in so far as they are software related but no further than that. Their purposes differ and I consider that the users differ (the Opponent's services are aimed at those who run websites and applications whereas I believe the Applicant's goods will be used more generally by the public). I do not find there to be any overlap in trade channels. There is no competition nor complementarity. The very general overlap in nature is, in my mind, not enough on its own to establish a finding of similarity and therefore, I find these goods to be dissimilar.

Class 38

*Wireless cellular phone services; Wireless cell phone services; Communications by cellular phones; Telecommunications services using cellular radio networks; Providing telecommunications connections to the Internet in a cafe environment; Cellular telephone communications; Wireless transfer of data via digital mobile telephony; Cellular telecommunications services; Cellular telephone communication; Cellular communications services; Mobile telecommunications network services; Communications by mobile phones; Providing telecommunications connections to the Internet or data bases; Providing telecommunications connections to a global computer network or databases; Providing access to computer networks; Provision of access to computer networks and the internet; Mobile telecommunication network services; Providing user access to computer networks and the Internet; Providing access to the Internet and other communications networks; Providing telecommunications connection to a global computer network; Providing virtual private network (VPN) services; Providing wireless telecommunications via electronic*

*communications networks; Providing high speed access to computer and communication networks; Providing computer access to communication networks; Wireless mobile phone services; Providing users with secure remote access via the internet to private computer networks; Wireless cellular telephone services; Wireless transfer of data via wireless application protocols; Wireless broadband communication services; Wireless transfer of data via the Internet.*

56. I consider that the above services from the Applicant's specification, which all relate to accessing telecommunications networks/computer networks/the internet are likely to contain security/fraud prevention measures and therefore, there could be an overlap in purpose and potentially user. It therefore follows that there might be an element of competition between them. They do not overlap in nature as one is a connection service and the other is a software service. I do not think they overlap in trade channels nor are they complementary. I therefore find them similar to between a low and medium degree.

57. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

58. As I have found no similarity for the following goods, the opposition in relation to them fails here:

Class 9: Telecommunications apparatus for use with mobile networks; Internet of Things [IoT] sensors; Internet phones; Computer application software for use in implementing the Internet of Things [IoT]

59. I shall continue considering the opposition in relation to:

Class 9: *VPN [virtual private network] operating software*

Class 38: Wireless cellular phone services; Wireless cell phone services; Communications by cellular phones; Telecommunications services using cellular radio networks; Providing telecommunications connections to the Internet in a cafe environment; Cellular telephone communications; Wireless transfer of data via digital mobile telephony; Cellular telecommunications services; Cellular telephone communication; Cellular communications services; Mobile telecommunications network services; Communications by mobile phones; Providing telecommunications connections to the Internet or data bases; Providing telecommunications connections to a global computer network or databases; Providing access to computer networks; Provision of access to computer networks and the internet; Mobile telecommunication network services; Providing user access to computer networks and the Internet; Providing access to the Internet and other communications networks; Providing telecommunications connection to a global computer network; Providing virtual private network (VPN) services; Providing wireless telecommunications via electronic communications networks; Providing high speed access to computer and communication networks; Providing computer access to communication networks; Wireless mobile phone services; Providing users with secure remote access via the internet to private computer networks; Wireless cellular telephone services; Wireless transfer of data via wireless application protocols; Wireless broadband communication services; Wireless transfer of data via the Internet.

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

60. 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.

61. 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 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.

62. I consider that the average consumer of the Opponent's services are more likely to be professional or business consumers. There could be professional or business consumers of the Applicant's goods and services however, I do not discount that there may be members of the general public who might also purchase them. The costs of these goods and services are likely to vary greatly between low and high cost. I would consider that these goods and services will be purchased relatively infrequently although there is potential for some to be more frequent. The average consumer will need to take into consideration the cost and suitability of these goods and services in accordance with their needs. I therefore consider that the level of attention paid by the average consumer would vary from an average degree (for more general VPNs and access to computer networks) to a higher-than-average level (for fraud prevention services) during the purchasing process.

63. The above goods and services are likely to be selected from specialist retailers, websites, advertisements and signs on a physical property. I therefore believe that visual considerations will dominate the selection process. However, I do not discount the possibility that there could be aural considerations from word-of-mouth recommendations or advice from a sales assistant.

### **Likelihood of Confusion**

64. 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 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 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 and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods 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.

65. The following factors must be considered to determine if a likelihood of confusion can be established:

- The marks are identical.
- The remaining goods and services at issue are similar to between a medium degree or between a low and medium degree.
- I consider that the average consumer is likely to be both the general public and professionals/businesses who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that between an average and a higher than average level of attention will be paid during the purchasing process.
- The earlier mark is inherently distinctive to between a low and medium degree.

66. In the present case, as is necessary for all section 5(2)(a) claims, the marks are identical. I have found the remaining goods and services to range in similarity from a very low to a fairly high degree. Due to the interdependency principle, the identity of the marks together with the low to medium degree of inherent distinctiveness will offset the average to higher level of attention and lower levels of similarity between the goods and services and will mean the average consumer is likely to mistake one for the other. Therefore, I consider there to be a likelihood of direct confusion.

67. For the avoidance of any doubt, even if I had found use of the Opponent's second earlier mark, this would not have taken the Opponent's case any further and the outcome would have remained the same.

## CONCLUSION

68. The opposition based upon section 5(2)(a) has been successful in relation to the following goods and services, for which registration is refused, subject to any successful appeal:

### Class 9

*VPN [virtual private network] operating software*

### Class 38

*Wireless cellular phone services; Wireless cell phone services; Communications by cellular phones; Telecommunications services using cellular radio networks; Providing telecommunications connections to the Internet in a cafe environment; Cellular telephone communications; Wireless transfer of data via digital mobile telephony; Cellular telecommunications services; Cellular telephone communication; Cellular communications services; Mobile telecommunications network services; Communications by mobile phones; Providing telecommunications connections to the Internet or data bases; Providing telecommunications connections to a global computer network or databases; Providing access to computer networks; Provision of access to computer networks and the internet; Mobile telecommunication network services; Providing user access to computer networks and the Internet; Providing access to the Internet and other communications networks; Providing telecommunications connection to a global computer network; Providing virtual private network (VPN) services; Providing wireless telecommunications via electronic communications networks; Providing high speed access to computer and communication networks; Providing computer access to communication networks; Wireless mobile phone services; Providing users with secure remote access via the internet to private computer networks; Wireless cellular telephone services; Wireless transfer of data via wireless application protocols; Wireless broadband communication services; Wireless transfer of data via the Internet.*

69. The opposition under section 5(2)(b) is unsuccessful in its entirety. The opposition under section 5(2)(a) is unsuccessful in relation to the following goods for which the application shall proceed to registration, subject to any appeal:

Class 9

*Telecommunications apparatus for use with mobile networks; Internet of Things [IoT] sensors; Internet phones; Computer application software for use in implementing the Internet of Things [IoT]*

**COSTS**

70. The opponent has been largely successful and is entitled to a contribution towards its costs. Award of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 1/2023. In accordance with that TPN, I award the opponent the sum of **£1300**, calculated as follows:

Official fee	£100
Preparing the Notice of Opposition and Considering the counterstatement	£250
Preparing evidence	£600
Preparing submissions in lieu	£350

71. I order Digital Inc. Limited to pay Sift Science, Inc the sum of £1300. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 30<sup>th</sup> day of April 2026**

**L Nicholas**  
**For the Registrar**