

**O/0455/26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00004250127**

**BY**

**EBIQUITY PLC**

**TO REGISTER:**

The logo consists of the letters 'ERA' in a bold, sans-serif font. The letter 'E' is on the left, followed by 'R', and 'A' on the right. The 'R' and 'A' are connected at their top right corners. A stylized, four-pointed star or asterisk shape is positioned between the 'E' and the 'R', overlapping the top of the 'R'.

**AS A TRADE MARK IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. OP600003888**

**BY MICO HOLDING LTD**

## BACKGROUND AND PLEADINGS

1. On 15 August 2025, Ebiquity Plc (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 5 September 2025. The applicant seeks registration for the following services:

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

2. On 3 December 2025, the application was opposed by MICO Holding Ltd (“the opponent”) under the fast track opposition procedure, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The opponent relies on the following mark:

**era GROUP** (1 of 2 in series)

**ERA GROUP** (2 of 2 in series)

UKTM No. 3851953

UK Filing date: 22 November 2022

Registration date: 17 November 2023

Relying on the following services:

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<sup>1</sup> 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.

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

3. The mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to the use provisions in section 6A of the Act. The opponent can, therefore, rely upon all of the services identified without having to demonstrate use.
4. The opponent claims that the marks are similar and that the respective services are similar, with the result that there is a likelihood of confusion.
5. The applicant filed a counterstatement wherein it admitted that the marks coincide in the word "ERA" however, due to the differences between the respective services, there would be no likelihood of confusion.
6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that: "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit." The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions.

However, no leave was sought to file any evidence in respect of these proceedings.

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

## **DECISION**

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

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

“(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.”

## Section 5(2)(b) case law

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

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, 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 services**

11. The services to be compared are as follows:

<b>Opponent's services</b>	<b>Applicant's services</b>
Class 35: Business consultancy; business management assistance; business management consultancy; business organisation consultancy; accounting consultancy; compilation and provision of business analysis, business information or business reports; business analysis and consultancy relating to cost; business analysis and consultancy relating to purchasing; cost-containment consultancy; cost-containment analysis; cost savings	Class 35: Advertising and promotional services; advertising, media and marketing consultancy; analysis of advertising response and market research; compiling indexes of information for commercial or advertising purposes; media auditing; modelling for advertising or sales promotion; none of the aforesaid services being in relation to strategic cost services, organisations/business cost reduction services, cost analysis services, cost

<p>analysis services; cost savings consultancy; all of the aforesaid in relation to strategic consulting services, namely, strategic cost services, organisations/businesses cost reduction services, cost analysis services, cost management services, business to business process improvement services, procurement services; none of the aforesaid in relation to real estate and real estate franchising.</p>	<p>management services, business to business process improvement services or procurement services.</p>
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12. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union stated that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular,

whether they are or are likely to be found on the same or different shelves;

- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)*, 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.”

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

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

16. I also bear in mind the comments of Mr Iain Purvis KC, sitting as a deputy High Court judge in *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)* [2024] EWHC 1098 (Ch).<sup>2</sup> He reiterated that the overall purpose of considering similarity between goods is to identify similarities which might be relevant to the likelihood of confusion, and that the greater the level of generality at which some similarity can be found, the less relevant it could be.

17. In its statement of grounds, the opponent asserts that the general public will view the competing services in a generic manner and will not be aware of the limitations, as such there will be an association between the competing services. Whilst I note such an assertion, the opponent has not provided any further submissions identifying precisely which of its earlier services it believes are similar to the applicant's exact services nor has it given precise reasons why the competing services would be similar to one another. Consequently, whilst conducting the services comparison, I shall keep the principles of *Smart X*,<sup>3</sup> in mind and proceed to compare terms on the basis of obvious similarity (or lack thereof) only.

18. In its submissions in lieu, the applicant submits that their advertising/promotional/media/marketing services are different from the opponent's business/consultancy/management/analysis services.

19. The applicant has also referred to and included several prior decisions of the Registrar wherein business services have been compared to advertising services.<sup>4</sup> Whilst I note the contents and findings of those decisions I am not bound by them and will proceed to conduct a full comparison, having regard to the case law above and all the relevant factors.

Advertising and promotional services; advertising, media and marketing consultancy; none of the aforesaid services being in relation to strategic cost

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<sup>2</sup> Paragraphs 23 and 24

<sup>3</sup> BL O/0911/24

<sup>4</sup> Decisions BL O/656/22, BL O/435/19, BL O/736/18, BL O/330/16, BL O/327/16 and BL O/280/13

services, organisations/business cost reduction services, cost analysis services, cost management services, business to business process improvement services or procurement services.

20. The above services and the opponent's services differ in nature, method of use and intended purpose. The applicant's services are concerned with promoting a business and enhancing its reputation among consumers, whereas the opponent's services relate to the internal management and reduction of business costs. The applicant's limitation also serves to further distinguish the respective specifications. The trade channels are also different; there is nothing before me to suggest that providers of advertising and marketing services would ordinarily also provide specialist cost-management or procurement consultancy. The services are neither competitive nor complementary. The fact that businesses may make use of both types of service is not sufficient, in itself, to establish similarity. Accordingly, I find the services to be dissimilar.

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

21. I compare the above terms to the opponent's term *compilation and provision of business analysis, business information or business reports; all of the aforesaid in relation to strategic consulting services, namely, strategic cost services, organisations/businesses cost reduction services, cost analysis services, cost management services, business to business process improvement services, procurement services*. The opponent's services concern the preparation of business analysis and reports, specifically in the context of cost management and cost reduction. While there is a broad degree of overlap in that both sets of services involve the analysis and compilation of information, this overlap is too general to warrant a finding of similarity. The applied-for services are directed at

advertising and marketing, whereas the opponent's services are focussed on strategic business consultancy relating to cost control. Their nature, method of use and intended purpose therefore differ. The trade channels are also distinct. I say this because the applicant's services would typically be provided by advertising and marketing specialists, while the opponent's services would be offered by consultants specialising in cost management, business efficiency or procurement. The services are neither competitive nor are they complementary: one cannot substitute for the other, and neither is necessary for the use of the other to the extent that customers would believe that they originate from the same undertaking. Although there may be an overlap in users, this is too broad for a finding of similarity. I find the services to be dissimilar.

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

22. To my mind, the applied-for services concern media auditing, namely the analysis of advertising activity to assess its effectiveness and the extent to which it has reached the intended target audience. I bear in mind that the specification is subject to a limitation excluding services relating to strategic cost, cost management and cost analysis. Accordingly, the services do not extend to the assessment of media spend but are instead directed at matters such as verifying compliance with media placements and evaluating reach and frequency. In light of this, the nature, method of use and intended purpose of the applied-for services differ from the opponent's services, which are specifically concerned with cost-related business consultancy. The trade channels also differ: the applied-for services would be provided by marketing or media specialists, whereas the earlier services would be offered by business consultants specialising in cost management or procurement. The services are neither competitive nor complementary. One cannot substitute for the other, and neither is necessary or important for the use of the other. Nor would consumers reasonably expect the same undertaking to provide both. While businesses may make use of both

services, this is insufficient, in itself, to establish similarity. Overall, I find the services to be dissimilar.

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

23. The limitation makes clear that the above services are confined to promotional activity and exclude any form of cost-related business consultancy. As such, there is no overlap in terms of nature, purpose and method of use compared to any of the opponent's services. The services are not complementary, nor is there any competition between the same. There is no obvious overlap in user and trade channels, even if I did consider there to be some overlap, I do not consider this connection would be enough to warrant a finding of similarity. Consequently, these services are dissimilar.

24. As a level of similarity is required between the competing services in order for there to be a likelihood of confusion under section 5(2)(b) of the Act,<sup>5</sup> the opposition would fail irrespective of whether the competing marks were found to be identical or similar.

## **CONCLUSION**

25. The opposition under section 5(2)(b) of the Act has failed. Subject to any appeal against this decision, the application shall proceed to registration.

## **COSTS**

26. The applicant has been successful and is entitled to a contribution towards its costs. Therefore, considering the guidance in Tribunal Practice Notice 1/2023, set

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<sup>5</sup> *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

out under 'scale adaptations for trade mark fast track opposition proceedings', I award the applicant costs on the following basis:

Preparing a counterstatement and considering the statement of grounds:	£150
Preparing submissions in lieu of a hearing:	£300
<b>Total:</b>	<b>£450</b>

27. I therefore order MICO Holding Ltd to pay Ebiquity Plc. the sum of £450. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 28<sup>th</sup> day of May 2026**

**Catrin Williams**  
**For the Registrar**