

**O/0736/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003656350**

**BY ASSISTYOU GROUP B.V.**

**TO REGISTER THE FOLLOWING TRADE MARK:**



**IN CLASSES 9, 35, 38 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 429601 BY ASSIST SOFTWARE LLC**

## **Background and Pleadings**

1. On 16 June 2021, AssistYou Group B. V. ('the Applicant') applied to protect the trade mark shown on the cover page of this decision, being no. UK00003656350. The application, which has a priority date of 8 June 2021 based on the mark 1444508, registered by the Benelux Office for Intellectual Property, was published for opposition purposes in the Trade Marks Journal on 22 October 2021. Registration is sought for the following goods and services, the opposed terms shown in underlined text:

Class 9:

Software, also downloadable; apps [application software]; software in the nature of a platform; artificial intelligence and machine learning software; downloadable mobile applications; voice recognition software; voice assistant software; wireless communication devices for voice, data, or image transmission; software and software applications (also with artificial intelligence) for calling customer services and telephone answering services.

Class 35:

Business assistance, management and administrative services; administrative support and data processing services; telephone answering and message handling services; consultancy, information and information<sup>1</sup> relating to all the aforesaid services; all the aforesaid services also provided via electronic means, including the internet.

Class 38:

Telecommunication services; voice transmission services; voice messaging services; electronic data transfer; rental of access time to online files, websites, databases and computer networks; automatic telephone answering services; providing voice chat services; providing access to downloadable software;

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<sup>1</sup> It is presumed that the repetition of the word 'information' is a typographical error.

*consultancy, advice and information regarding the aforesaid services, including provided via electronic networks, such as the internet.*

Class 42:

*Software development; information technology (IT) programming and consultancy services; SaaS (Software as a Service) services; Installation, maintenance, adjustment and updating of computer software; rental of software; Design and development of software; Platform as a service (PaaS); providing apps, software and software platforms, in particular for telephone answering services; technical advice with regard to the application and use of software (applications) and online computer networks; providing of computer software for calling customer services and telephone answering services, including the improvement thereof (software as a service); consultancy, information and information relating to all the aforesaid services; all the aforesaid services also provided via electronic means, including the internet.*

2. On 23 December 2021, the application was opposed by Assist Software LLC ('the Opponent'), based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition is directed against some of the goods and services, i.e. those underlined above. The Opponent relies upon the following two earlier rights:<sup>2</sup>

i) UK00917979563

ASSIST SOFTWARE

Filing date: 2 November 2018

Date of entry in register: 15 October 2019

Registered for goods and services in classes 9, 11, 16, 28, 35 and 41, only the following of which are relied upon in this opposition:<sup>3</sup>

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<sup>2</sup> Both earlier marks are comparable marks pursuant to Article 54 of the Withdrawal Agreement, based on EUTMs which were registered prior to the withdrawal of the UK from the European Union.

<sup>3</sup> The full specification is set out in Annex 1 to this decision.

Class 35:

*Business assistance, management and administrative services; Business analysis, research and information services; Advertising, marketing and promotional services.*

This mark is relied upon only in respect of the opposed term *Business assistance, management and administrative services* (Class 35).

ii) UK00918013809



Filing date: 23 January 2019

Date of entry in register: 15 May 2019

Registered for the goods and services in classes 9, 28, 35 and 42, only the following of which are relied upon in this opposition:<sup>4</sup>

Class 9:

*Scientific research and laboratory apparatus, educational apparatus and simulators; Apparatus, instruments and cables for electricity; Scientific and laboratory devices for treatment using electricity; Optical devices, enhancers and correctors; Navigation, guidance, tracking, targeting and map making devices; Safety, security, protection and signalling devices; Information technology and audio-visual, multimedia and photographic devices; Diving equipment; Measuring, detecting and monitoring instruments, indicators and controllers; Recorded content.*

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<sup>4</sup> The full specification is set out in Annex 2 to this decision.

Class 35:

*Advertising, marketing and promotional services; Business analysis, research and information services; Business assistance, management and administrative services.*

Class 42:

*IT services; Design services; Science and technology services; Testing, authentication and quality control.*

This is relied upon in respect of all of the opposed terms.

3. The Opponent claims that the parties' marks and goods/services are similar, leading to a likelihood of confusion.
4. The Applicant filed a Defence and Counterstatement in which it:
  - denies that the parties' marks are similar;
  - concedes that the opposed class 35 services are identical to the services relied upon by the Opponent under its earlier mark i) UK00917979563;
  - denies that the opposed terms are similar to the goods/services relied upon by the Opponent under its earlier mark ii) UK00918013809, and puts the Opponent to proof thereof;  
and
  - denies that there is a likelihood of confusion between the parties' marks.
5. The Opponent is represented by Apex Agency Services Ltd. The Applicant is represented by Stevens Hewlett & Perkins.
6. Only the Opponent has filed evidence, which will be addressed in my decision, where appropriate. The evidence comes from Messrs Daniel Tănase and Alexandru Strujac, Managing Partner and Graphic Designer for the Opponent, respectively. There is also a Witness Statement from Florin Alexandru Hrebenciuc, dated 14 September 2022, 'an interpreter and translator of English and Italian,

authorised by the Romanian Ministry of Justice since 19 June 2001' to which English translations of press releases have been exhibited. A hearing was neither requested nor considered necessary. Only the Opponent has filed written submissions in lieu of a hearing, to which I will refer, where appropriate, in my decision.<sup>5</sup>

## **PRELIMINARY MATTERS**

### The Opponent's evidence

7. The Opponent has adduced evidence which shows how it has used its marks. However, it is not obliged to prove use of its mark, nor has the Applicant requested such proof. A party may be required to prove use of an earlier mark where section 6A of the Act is engaged. Section 6A provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of its mark. In the instant case, the earlier marks had been registered for less than five years on the priority date of the applied-for mark. The Opponent is therefore entitled to rely upon all of the goods and services that it seeks to rely upon. However, the evidence provided will be considered when assessing whether or not the earlier marks enjoy an enhanced level of distinctiveness.
  
8. The Witness Statement of Alexandru Strujac, Graphic Designer for the Opponent, dated 10 May 2023, is, in large part, devoted to Mr Strujac's own comparison of the parties' marks. While this is noted, this amounts to written submission, rather than evidence.

### The Opponent's Form TM7

9. I note that reference has been made, in the Opponent's evidence and submissions, to dilution of the Opponent's 'distinctive identity', reputational harm and unfair advantage.<sup>6</sup> These are heads of damage which are claimed in oppositions

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<sup>5</sup> I note that the author of the written submissions is Daniel Tanase, Manager of the Opponent company, even though Apex Agency Services is on record as the Opponent's representative.

<sup>6</sup> Witness Statement of Alexandru Strujac, [15]; Opponent's written submissions in lieu of a hearing, [11] and [12].

pursuant to section 5(3) of the Act. They are not proper to oppositions under section 5(2)(b) of the Act and will not, therefore, be considered as part of my assessment of the likelihood of confusion.

## **RELEVANCE OF EU LAW**

10. 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.

### **Relevant legislation**

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

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

(a) ...

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

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

### **Earlier marks**

12. In accordance with section 6 of the Act, the Opponent's marks are earlier marks by virtue of their filing dates, which fell before the priority date of the applied-for mark.

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

13. The following principles are derived from the decisions of the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG*, Case C-251/95; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98; *Matratzen Concord GmbH v OHIM*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P:

(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 be dominated by one or more of its components;

(f) however, it is also 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 great 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;

(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**

14. Section 60A of the Act provides:

(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.

15. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties’ goods and services must be taken into account:

“[23] 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”.

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

17. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281<sup>7</sup>, identified the following factors for assessing similarity of the respective goods and services:

- (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;

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<sup>7</sup> *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

(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.

18. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

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

19. In making an assessment between the competing goods and services, I bear in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*.<sup>8</sup> The General Court held to the effect that goods and services can be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

20. Case law establishes that ‘... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise’ but ‘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

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<sup>8</sup> Case T-133/05

language unnaturally so as to produce a narrow meaning which does not cover the goods in question.<sup>9</sup>

21. The goods and services to be compared are as follows:

Opponent's marks:	Applicant's mark:
<p>i) UK00917979563</p> <p>Class 35: <i>Business assistance, management and administrative services; Business analysis, research and information services; Advertising, marketing and promotional services.</i></p> <p>* This earlier right is relied upon to oppose the term <i>Business assistance, management and administrative services</i> (Class 35) only.</p>	<p>Class 9: <i>Software, also downloadable; apps [application software]; software in the nature of a platform; artificial intelligence and machine learning software; downloadable mobile applications; voice recognition software; voice assistant software; wireless communication devices for voice, data, or image transmission; software and software applications (also with artificial intelligence) for calling customer services and telephone answering services.</i></p>
<p>ii) UK00918013809</p> <p>Class 9: <i>Scientific research and laboratory apparatus, educational apparatus and simulators; Apparatus, instruments and cables for electricity; Scientific and laboratory devices for treatment using electricity; Optical devices, enhancers and correctors; Navigation, guidance, tracking, targeting and map making</i></p>	<p>Class 35: <i>Business assistance, management and administrative services;*</i> <i>administrative support and data processing services; telephone answering and message handling services; consultancy, information and information relating to all the aforesaid services; all the aforesaid services</i></p>

<sup>9</sup> *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch).

<p><i>devices; Safety, security, protection and signalling devices; Information technology and audio-visual, multimedia and photographic devices; Diving equipment; Measuring, detecting and monitoring instruments, indicators and controllers; Recorded content.</i></p> <p><b>Class 35:</b> <i>Advertising, marketing and promotional services; Business analysis, research and information services; Business assistance, management and administrative services.</i></p> <p><b>Class 42:</b> <i>IT services; Design services; Science and technology services; Testing, authentication and quality control.</i></p>	<p><i>also provided via electronic means, including the internet.</i></p> <p><b>Class 42:</b> <i>Software development; information technology (IT) programming and consultancy services; SaaS (Software as a Service) services; Installation, maintenance, adjustment and updating of computer software; rental of software; Design and development of software; Platform as a service (PaaS); providing apps, software and software platforms, in particular for telephone answering services; technical advice with regard to the application and use of software (applications) and online computer networks; providing of computer software for calling customer services and telephone answering services, including the improvement thereof (software as a service); consultancy, information and information relating to all the aforesaid services; all the aforesaid services also provided via electronic means, including the internet.</i></p>
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22. The Opponent's sole submission on the matter of the competing goods and services is as follows:

'[...] please note that the services offered under our trademarks and the Applicant's mark are highly similar, as both of us [sic] companies operate in the same market, providing technological solutions to businesses'.<sup>10</sup>

23. Given that the Opponent has not identified where the particular points of similarity lie, I have no alternative but to identify which of the Opponent's terms are the best comparators based on my own understanding of the terms.

### Class 9

Contested term: *wireless communication devices for voice, data, or image transmission*

24. I consider this term to include devices such as laptops, electronic tablets, smartphones and the like. These goods will be encompassed by the Opponent's broad class 9 term *Information technology and audio-visual, multimedia and photographic devices* under earlier mark ii). The parties' goods are, therefore, identical according to the principle in *Meric*.

Contested term: *Software, also downloadable; apps [application software]; downloadable mobile applications*

25. It is my understanding that 'software', in simple terms, is the set of instructions according to which a computer or other electronic device operates. Software is synonymous with 'computer programs'. The contested services are very broad terms which will encompass downloadable or 'application' software in any field and related to any subject. In the absence of any submission from the parties as to the closest comparator within the Opponent's specification, I will compare the contested services to the Opponent's class 9 term *Information technology [...] devices* under earlier mark ii). The respective goods will have different purposes; the Applicant's goods are used to enable electronic devices to operate, both generally and for specific tasks, whereas the Opponent's goods are the electronic

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<sup>10</sup> Opponent's written submissions in lieu of a hearing, [6].

devices which enable the user to complete various tasks by electronic means (a wide range of tasks, examples of which are accessing the web or word-processing). Users will necessarily overlap because IT devices cannot operate without software of some sort. Trade channels will be shared. Methods of use will differ. The respective goods will differ greatly in terms of physical nature. The parties' goods are not in a competitive relationship, neither being substitutable for the other. I do, however, find complementarity; devices cannot operate without software and the average consumer may presume both goods to derive from the same undertaking. All things considered, I find the parties' goods to have no more than a medium level of similarity.

Contested goods: *software in the nature of a platform*

26. It is my understanding that software in the form of a 'platform' is a self-contained system of software, sometimes referred to as an 'ecosystem', that enables a user to perform certain tasks. An example might be an intranet used by staff within an organisation in order to communicate, collaborate and share files. I compare the Applicant's goods to the Opponent's class 9 term *Information Technology [...]* devices under earlier mark ii). The specific purpose of 'software in the nature of a platform' will depend upon the particular tasks for which it is required. Broadly speaking, I consider the purpose for which the goods are sought to be their functionality as self-contained electronic infrastructures. The parties' goods will therefore have distinct purposes. Users will inevitably overlap given that software (whether in the nature of a platform, or otherwise) can only be used in conjunction with an electronic device of some sort. Trade channel overlap is possible. The goods will differ in methods of use and physical nature. There is no competition between the parties' goods. The respective goods will be complementary for the reason provided above at [25]. In the light of the foregoing, I find the parties' goods to have no more than a medium level of similarity.

Contested goods: *artificial intelligence and machine learning software*

27. It is my understanding that 'artificial intelligence', put simply, entails machines exhibiting intelligent or 'thinking' behaviour. From my own experience as an

ordinary member of the public, a common 'every day' example of this in operation is voice recognition technology; for example, a telephone call to a business where a recorded voice asks various questions and is able to 'listen to' and 'understand' the caller's responses. 'Machine learning', to my mind, entails the programming or training of computers to behave intelligently. I therefore consider the Applicant's goods to encompass software which: enables the 'intelligent' acts (of which voice recognition is just one example) to occur; and enables computers to be programmed in order to carry out such tasks. I compare these goods to the Opponent's broad class 9 term *Information technology [...] devices*. An 'information technology device' will, to my mind, encompass any computing device. The competing goods will differ in purpose; the Applicant's goods are specifically intended to enable machines/computers to perform intelligent tasks, whereas the Opponent's goods are the machines/computers performing those tasks. Users will necessarily overlap. Trade channels will likely overlap; the same undertaking might develop and market artificial intelligence/machine learning software as well as the machines through which the software is employed. The goods will differ in terms of methods of use and their physical natures. I do not find the respective goods to be competitive; neither being substitutable for the other. I do, however, consider there to be complementarity; the competing goods will be necessary for each other and the average consumer may presume both to originate from the same undertaking. In the light of the foregoing, I find the parties' goods to be similar to no more than a medium degree.

Contested terms: *voice recognition software; voice assistant software*

28. The Applicant's goods are a subset of artificial intelligence software; i.e. software specifically to enable a machine/device to listen to and 'understand' speech and perform tasks accordingly. I compare these goods to the Opponent's *Information technology [...] devices* and, for the reasons set out above at [27], find them to have no more than a medium level of similarity.

Contested terms: *software and software applications (also with artificial intelligence) for calling customer services and telephone answering services*

29. To my mind, a typical example of the goods covered by the Applicant's terms is the system according to which a caller is asked questions by an automated voice and the answers are 'listened to' and 'understood' by the system which then provides appropriate options/'acts' based on the caller's answers. I compare these goods to the Opponent's class 35 services *Business assistance, management and administrative services*. The Opponent's broad term will include services to deal with the answering of telephone calls, a typical administrative task for most businesses. The parties' goods and services will therefore overlap in purpose. Users will overlap to the extent that both will be purchased by professional consumers, i.e. businesses. Trade channel overlap is, in my view, unlikely but not impossible. The goods and services will differ in nature and methods of use. I consider the parties' offerings to be in competition; a prospective purchaser seeking a solution for dealing with customers telephone calls might deliberate over whether to purchase a piece of software or whether to engage the Opponent's services. Given my finding that trade channel overlap is unlikely, I do not consider the goods/services to complementary. I find the parties' goods and services to have no more than a medium level of similarity.

#### Class 35

Contested term: *Business assistance, management and administrative services*

30. This term also appears in the specifications for the Opponent's earlier mark i). The parties' services are, therefore, unequivocally identical.

Contested term: *administrative support [...]*

31. My view is that 'administrative support' will be encompassed by the broad terms 'business assistance [...]' and '[...] administrative services', under the Opponent's earlier mark ii)<sup>11</sup>. The parties' services are therefore identical according to the principle in *Meric*.

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<sup>11</sup> This term is also present in the specification for earlier mark i), but the Opponent does not rely on it to attack the contested term in question.

Contested services: *telephone answering and message handling services*

32. These services are administrative tasks which would be encompassed by the Opponent's 'business assistance [...]' and '[...] administrative services', present in the specifications for earlier mark ii). The parties' services are therefore identical according to the principle in *Meric*.

Contested term: [...] *data processing services*

33. It is my understanding that 'data processing' is the activity of turning raw data into information that can be used. One example might be the raw figures relating to sales being converted into a graph or chart. The processing of data is crucial to the operation of businesses. I consider that the contested term will be encompassed by the Opponent's broad term *Business assistance* under earlier mark ii). The parties' services are therefore identical according to the principle in *Meric*.

Contested term: [...] *information relating to all the aforesaid services*

34. The contested term encompasses the provision of information in respect of each of the services preceding it within the specification. Broadly speaking, I have found all of the preceding services to be 'business' services. I compare the contested term to the Opponent's *Business [...] *information services**, present in the specification for earlier mark ii). My view is that the competing terms are synonymous and, therefore, identical.

Contested term: *consultancy [...] *relating to all the aforesaid services**

35. 'Consultancy', to my mind, entails the provision of information, advice and expertise on a particular matter. The contested term, therefore, entails such provision relating to the 'business' services preceding it. I compare the contested term to the Opponent's *Business [...] *information services**, under earlier mark ii). The competing services will overlap in purpose to the extent that both offerings are intended to furnish the user with information on 'business' services. To my mind,

however, the Applicant's 'consultancy' service will go beyond the provision of mere information and will offer advice and expertise, often in the form of a written report. An example might be an analysis of a company's efficiency in order to improve its output. Users will overlap, both services being engaged by the professional public. Trade channels will be shared. Methods of use will coincide to the extent that an aspect of the Applicant's consultancy services will involve conveying information to the service-user. Where methods of use might differ, is in instances where a user has engaged the Applicant's service in order to obtain, say, an expert analysis of a particular business matter by way of a formal report. I find the respective services to be competitive in some instances; an average consumer seeking information on a particular business matter might deliberate over whether to engage an 'information' service or a 'consultancy' service. I do not, however, find complementarity. I also find complementarity; the provision of information on a business matter is part and parcel of providing consultancy services in business matters. In the light of the foregoing, I find the parties' services to be highly similar.

Contested term: *all the aforesaid services also provided via electronic means, including the internet*

36. It is my view that the Applicant's 'aforesaid services' to which this term relates are broad terms whose mode of delivery (i.e. by electronic means or otherwise) is not specified. They would encompass services delivered by electronic means as a matter of course. The contested term is therefore effectively redundant. Therefore, each of my findings above is to be taken to apply equally to the service in question when delivered by electronic means.

#### Class 42

Contested terms: *Software development; information technology (IT) programming and consultancy services; SaaS (Software as a Service) services; Installation, maintenance, adjustment and updating of computer software; rental of software; Design and development of software; Platform as a service (PaaS); providing apps, software and software platforms, in particular for telephone answering services; technical advice with regard to the application and use of software (applications)*

*and online computer networks; providing of computer software for calling customer services and telephone answering services, including the improvement thereof (software as a service); consultancy, information and information relating to all the aforesaid services; all the aforesaid services also provided via electronic means, including the internet.*

37. All of the above terms will be encompassed by the Opponent's class 42 term *IT Services* under earlier mark ii). The parties' services are therefore identical according to the principle in *Meric*.

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

38. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word "average" denotes that the person is typical. 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*.

### **Class 9**

39. With the exceptions of *software and software applications (also with artificial intelligence) for calling customer services and telephone answering services and machine learning software*, the average consumer of the relevant goods will be both the general and professional public. I consider that the purchasing act will be primarily visual to the extent that the prospective purchaser will likely first encounter the provider of the goods either online or having seen their premises on the street. There will likely be an aural aspect to some purchases where questions are asked of retail staff or advice sought before committing to a purchase or where there have been recommendations by 'word of mouth'. The level of attention paid will depend on the particular goods being purchased. Some purchases of complex software, for example, might conclude only after discussion of the customer's requirements with the seller. Purchases of electronic devices will often take place after

consultation with retail staff. In such instances, a high level of attention might be paid during the purchasing act. On the other hand, the decision on whether or not to purchase an App for one's mobile phone might be made without a particularly high level of care. In such instances, a low or average level of attention might be paid.

40. The average consumer of *software and software applications (also with artificial intelligence) for calling customer services and telephone answering services and machine learning software* is likely to be the professional public. The purchasing act will be primarily visual for the reason set out above at [39]. I consider these goods to be fairly niche and I would expect prospective purchasers to show a fairly high measure of prudence when considering whether to commit to a purchase. Many purchasers would discuss their business requirements with the seller first. I find that the average consumer of these goods would pay a high level of attention during the purchasing act.

#### Class 35

41. *Business assistance, management and administrative services* will almost always be engaged by businesses rather than the general public. The purchasing act will be primarily visual; the average consumer typically encountering the service-provider online, by way of adverts in printed matter or having encountered the provider's premises in the street. I acknowledge that, in some cases, there may be an aural aspect to the purchasing process in the manner already described. My view is that a fairly high level of attention would likely be paid because the services concerned are typically engaged in order to help the purchasers operate their businesses.

#### Class 42



42. For reasons analogous to those above at [41], I find that a fairly high level of attention will be paid during the purchasing act for professional consumers. I acknowledge that some services would also be purchased by the general public who may pay a lower level of attention.

## Comparison of the marks

43. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

44. The marks to be compared are as follows:

Opponent's marks:	Applicant's mark:
i) Assist Software  ii)  	

### Overall impression of the marks

Opponent's registration i)

45. This earlier mark is a word mark<sup>12</sup> comprising the words 'Assist Software' rendered in a plain typeface. I consider both words to play a role within the overall impression of the mark, with 'Assist' being the dominant element owing to the descriptive nature of the word 'Software'.

Opponent's registration ii)

46. This earlier mark is a figurative mark. The word 'ASSIST' features in large font in a stylised typeface. The words 'Innovative Minds' are arranged beneath the 'ASSIST' element in a much smaller font rendered in a plain typeface. I find that the element 'ASSIST' will play the greater role within the mark owing to its positioning and much greater size relative to the words 'Innovative Minds'. That said, I do not consider the 'Innovative Minds' element to be negligible. It will play a much lesser role within the overall impression of the mark due to its smaller size and because it may be seen as somewhat allusive to the goods/services under the mark.

Applicant's mark

47. The Applicant's mark comprises figurative and text elements. The text reads 'assist you' in a plain typeface, with each word on a separate line. The device consists of a square shape, with curved corners, within which the characters 'ay' are placed, with a curved line positioned underneath the 'ay' element. The arrangement of the elements within the device is such that, for a number of average consumers, it may resemble a 'smiley face'. The applicant has argued that the device is the mark's most prominent feature, with the text 'assist you' playing an ancillary role.<sup>13</sup> I

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<sup>12</sup> In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

<sup>13</sup> Applicant's counterstatement, at [14].

disagree. In this case, I consider both the device and text elements to contribute to the overall impression of the mark, with the 'assist you' element playing the greater role because, generally speaking, words 'speak louder' than devices. I consider the pairing 'Asst you' to be perceived as a unit because 'Assist' will be understood as qualifying the word 'you'. The text element occupies slightly more of the surface area of the mark, and is, in my view, where the eye is drawn first.

### Visual comparison

48. I will compare the contested mark to the opponent's earlier mark i) first. The word 'Assist' is present in both marks and rendered in a plain typeface in each. The points of visual difference are as follows:

- the presence of the device in the applied-for mark, which is absent from the earlier mark;
- the presence of the word 'you' in the applied-for mark, which is absent from the earlier mark;
- and
- the presence of the word 'software' in the earlier mark, which is absent from the applied-for mark.

In the light of the foregoing, I find the marks to have a low to medium level of visual similarity.

49. I now compare the applied-for mark to the Opponent's earlier mark ii). The word 'Assist' is present in both marks. Although the word is slightly stylised in the earlier mark, I consider the level of stylisation to be sufficiently slight that it would unlikely amount to a significant visual difference between the marks. The points of visual difference are as follows:

- the presence of the device in the applied-for mark, which is absent from the earlier mark;
- the presence of the word 'you' in the applied-for mark, which is absent from the earlier mark;
- and

- the presence of the ‘Innovative Minds’ element in the earlier mark, which is absent from the applied-for mark.

I find the marks to have a low to medium level of visual similarity.

### Aural comparison

50. I will compare the applied-for mark to the Opponent’s earlier mark i) first. The Opponent’s mark will likely be articulated in the usual way: ‘ASS-IST SOFTWARE’. Although the word ‘software’ is descriptive for some of the goods, just because a word is descriptive, it is not necessarily negligible or ‘aurally invisible’.<sup>14</sup> The Applicant’s mark will be articulated as ‘ASS-IST YOU’. I recognise that a number of average consumers might also articulate the device element of the applied-for mark, in which case it would likely be articulated as ‘AY WHY ASS-IST YOU’. The aural differences between the marks are as follows:

- the presence of ‘SOFTWARE’ in the earlier mark, which is absent from the applied-for mark;
- the presence of the ‘YOU’ sound in the applied-for mark, which is absent from the earlier mark;
- for the average consumers who will articulate the device, the presence of the ‘AY-WHY’ sound in the applied-for mark, absent from the earlier mark, will be another aural distinction.

Where the device in the applied-for mark is not articulated, I find the marks to be aurally similar to no more than a medium degree. Where the device is articulated, I find the marks to have a low level of aural similarity.

51. I now compare the contested mark to the Opponent’s earlier mark ii). It is my view that some average consumers may neglect to articulate the ‘Innovative Minds’ element of the Opponent’s mark, owing to its much smaller size and its positioning beneath the ‘ASSIST’ element. Both parties’ marks contain the ‘Assist’ sound.

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<sup>14</sup> BLO-115-22 PURITY HEMP, per Philip Harris sitting as the Appointed Person.

Where the average consumer neglects to articulate the ‘Innovative Minds’ element of the earlier mark and articulates the applied-for mark as ‘Assist You’, the marks will have a medium level of aural similarity.

Where the average consumer articulates the earlier mark in full, (i.e. ‘Assist Innovative Minds’) and articulates the applied-for mark as ‘Assist You’, the marks will have only a low level of aural similarity.

Where the average consumer neglects to articulate the ‘Innovative Minds’ element of the earlier mark (‘Assist’) and articulates the device ‘AY-WHY’ in the applied-for mark, the marks will have a low level of aural similarity.

Where the average consumer articulates the earlier mark in full, (i.e. ‘Assist Innovative Minds’) and the applied-for mark as ‘AY-WHY Assist You’, the marks will have a low level of similarity.

52. For ease of reference, I summarise these findings in the following table:

Articulation of earlier mark ii):	Articulation of applied-for mark:	Aural similarity:
ASS-IST	ASS-IST YOU	medium
ASS-IST INNOVATIVE MINDS	ASS-IST YOU	low
ASS-IST	AY-WHY ASS-IST YOU	low
ASS-IST INNOVATIVE MINDS	AY-WHY ASS-IST YOU	low

### Conceptual comparison

53. I will consider the Opponent’s earlier mark i) first. The words ‘assist’ and ‘software’ are common English words familiar to the average consumer. ‘Assist’ will be understood as a synonym for the words ‘help’ or ‘aid’. ‘Software’ will be understood as the computer programmes or instructions according to which devices operate. A significant proportion of average consumers will perceive the mark ‘Assist

Software’ as a reference to software that is helpful in some way. The ‘assist you’ text in the applied-for mark will, to my mind, convey the idea of providing personal assistance. The device will either be perceived as the initials for ‘Assist You’ or as a smiley face comprising those initials. Both marks convey the idea of ‘helping’ or ‘providing assistance: in the Opponent’s case, helpful software; in the Applicant’s case, personalised assistance of some sort. All things considered, I find the marks to have at least a medium level of conceptual similarity.

54. I now compare the applied-for mark to the opponent’s earlier mark ii). The ‘innovative minds’ element of the Opponent’s mark will likely convey the idea of an undertaking whose workforce is forward-thinking and dynamic in what it does. I consider that ‘Assist Innovative Minds’ will likely conjure the idea of a dynamic and cutting-edge business whose aim is to provide assistance of some sort. Conceptually speaking, both parties’ marks convey the idea of helping/assistance. Where the marks diverge is in the notions of innovation conveyed by the earlier mark, and the focus on personalised assistance conveyed by the Applicant’s mark. I find the marks to be conceptually similar to a least a medium degree.

### **Distinctive character of the earlier marks**

55. *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).”

56. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

Earlier mark i)

Assist Software

57. The words ‘assist’ and ‘software’ are commonly-used words in the English language with which the average UK consumer will be familiar. The relevant services under this mark for the purpose of these proceedings are *Business assistance, management and administrative services* in class 35. My view is that the word ‘software’, although, strictly speaking, not wholly descriptive of the particular services at stake (because the services are not literally ‘software’), will be seen as moderately allusive of them. The term in question will encompass a very broad range of activities designed to assist businesses, many of which will be delivered electronically. The word ‘assist’ is, to my mind, a fairly bland and mundane word in the context of branding, not least because the essential nature of any service is to help or ‘assist’ the user by meeting their needs. I consider the mark ‘Assist Software’ to have a level of inherent distinctive character inherent distinctive character somewhere above ‘low’ but not reaching the threshold for ‘medium’.

Earlier mark ii)



58. The words 'innovative' and 'minds' are words with which the average UK consumer will be familiar. Although they cannot be said to describe the relevant goods and services, I consider them to allude to the service-provider being forward-thinking, 'cutting edge' or dynamic. My observations on the word 'Assist' apply equally here. All things considered, I find the mark to have a level of inherent distinctive character somewhere above 'low' but not reaching the threshold for 'medium'.

Enhanced distinctiveness

59. I will now consider whether either or both earlier marks enjoy a level of enhanced distinctiveness. In this connection, it is convenient to note the following from the Opponent's evidence:

a) Mr Tănase, in his witness statement, dated 12 May 2023, has given narrative evidence that the Opponent company was set up in 1992 and that it became an internet service provider in 1999.<sup>15</sup> In 2000, it launched 'the first virtual city in Romania', the 'Virtual Suceava' portal.<sup>16</sup> In 2004, the Opponent became an ECDL (European Computer Driving Licence) Authorised Testing Center and a partner of the ATIC (association for Information Technology and Communications).<sup>17</sup> Mr Tănase states that the Opponent is an 'official partner of important names in the Science, Technology and Marketing industry, such as Adobe, Microsoft, MongoDB, Amazon Web Services, Shopify, Fujitsu, Intel, Google Cloud'.<sup>18</sup> A screenshot of the Opponent's website, dated 9 August 2022 shows these listed, along with the names 'Openstack' and 'Drupal'.

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<sup>15</sup> Witness Statement of Daniel Tănase, [5].

<sup>16</sup> As above, [6].

<sup>17</sup> As above, [7].

<sup>18</sup> As above, [9].

- b) The following figures have been provided, described as ‘Turnover strictly with UK partners for the period 2018 – 2021’:<sup>19</sup>

2018	£1,091,983
2019	£1,027,250
2020	£579,912
2021	£1,196,355

It is not possible to discern what proportions of the figures are referable to which goods and services.

- c) Various excerpts from the Opponent’s website have been provided, which detail projects, carried out between 2010 and 2017, most of which were funded by the European Commission, in which the Opponent has participated as a ‘partner’, together with ‘official project print-outs’.<sup>20</sup> The print-outs include information on the projects’ objectives, the other ‘partners’ and proportions of funding allocated to each. For each project, the ‘development location’, which I presume to be the location in which the work is carried out, is stated as Suceava, Romania. Broadly speaking, the Opponent’s contribution to the projects appears to have been the development of software and software platforms. For example: for a project in 2014, led by an organisation called ‘Sefaira’ concerning development of a cloud platform, the Opponent’s contribution was ‘the development of Sefaira’s corporate website, newsletter and the auto-scaling of the website on Amazon web services’. ‘Sefaira’ is referred to as a ‘partner’ of the Opponent under a testimonial on the Opponent’s website. The sums awarded to the Opponent by way of funding are generally in 6 figures, expressed in Euros. In another example, the Opponent is listed as one of the five partners of ‘ASPIRE project consortium’ in 2017. The ‘Assist Innovative Minds’ mark is shown alongside the other partners. Funding allocated to the Opponent is circa 348k EURO.

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<sup>19</sup> As above, [18].

<sup>20</sup> Witness Statement of Daniel Tănase, [11]; Exhibits D3 to D12.

d) A number of articles and photographs have been adduced to demonstrate the Opponent's participation in 'important international expositions' in the period 2017 – 2022.<sup>21</sup> I note the following examples:

- Photographs chronicling the events 'MWC Barcelona (2018 and 2019), 'Quovardis O&M' (2019) and 'Husum Wind' (2019) show the Opponent's mark ii) on signage and at trade stands.
- A photograph, stated to be of the Opponent's attendance at an event 'Midsize Enterprise summit in Phoenix' in 2019, shows a group of individuals seated in a 'boardroom' arrangement. A screen shows the Opponent's mark ii).
- A photograph stated to be of the Opponent's attendance at an event 'Euroshop 2020' is accompanied by a write-up on the Opponent's website states that 'Euroshop is the world's largest trade fair for retail investment requirements at which over 100,000 visitors participate every year.
- An article on the Opponent's website noting its forthcoming attendance at Hannover Mess 2021, an online virtual conference at which speakers include Dr Angela Merkel and the CEOs of Volkswagen and Siemens.

e) Material from the Opponent's social media accounts has been provided:<sup>22</sup>

- There are two printouts from a 'Facebook' account, which appear to be two versions or iterations of what might be described as the 'home' page. In each, both earlier marks are shown prominently; the 'Assist Innovative Minds' mark features as the 'profile' picture, while the 'Assist Software' mark is presented as the business to which the account relates. Both 'home' pages are undated, however the final 'post' on the former is dated

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<sup>21</sup> As above, [13].

<sup>22</sup> Exhibits DT13 and DT14.

17 September 2019.<sup>23</sup> I note that there have been 141 ‘reviews’ which I understand to be testimonials made via the Facebook page. The second ‘home’ page is undated and contains the information ‘18K likes’ and ‘19K followers’.<sup>24</sup> The geographical location of the account-holder is stated as ‘Tipografei nr.1, Suceava, Romania’. It is not possible to discern what proportions of the ‘likes’ or ‘followers’ are referable to UK consumers. It is evident from the content of the pages that the Opponent holds itself out as a provider of innovative software solutions in the international market.

- The ‘Assist Software’ mark features prominently on printouts from ‘LinkedIn’ and YouTube’ accounts. The pages are undated but appear to have been printed out on 12 May 2023. At that date, there appear to have been 5,736 followers on LinkedIn and 315K subscribers to, and 359,559 views of, the YouTube account.<sup>25</sup> I cannot tell in which geographical location these accounts are registered, nor what proportions of followers/views/subscribers are referable to UK consumers. Given that this evidence post-dates the priority date of the applied-for mark, I cannot be sure that it represents the position as at the relevant date for assessing whether the earlier marks enjoyed an enhanced level of distinctive character.
- f) Exhibit DT15 comprises copies of flyers ‘attesting that the company was a Silver Sponsor for the NSIRC 2020 Live Conference’.<sup>26</sup> The resolution of the text in the two flyers provided is very poor due to the small size of the copies, but I can just about make out that ‘NSIRC’ stands for National Structural Integrity Research Centre’. The Opponent’s mark ii) is shown clearly in both, alongside the marks of other sponsors for the event. Also included is a screenshot of the Opponent’s website documenting the Opponent’s attendance at an event in London on 27 November 2018 titled ‘Particulate Engineering for Industry 4.0 –

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<sup>23</sup> Exhibit DT13.

<sup>24</sup> Exhibit DT14.

<sup>25</sup> Exhibit DT14.

<sup>26</sup> Witness Statement of Daniel Tănase, [13].

From Feedstock To End Use'. The event relates to the manufacturing of metallic, polymeric and refractory materials.

g) Exhibit DT16 comprises a selection of websites where the Opponent is promoted as a 'partner', from which I note the following:

- The website of 'DevelopmentAid.org', dated 27 May 2022 includes what might be described as a 'profile' page for the Opponent in which it is described as being 'At the forefront of Romania's role as a significant provider of bespoke software development services'. The Opponent's mark ii) is clearly visible in header of page.
- The website of 'researchforindustry.ro', dated 2017, ('ro' indicates Romanian website) describes Opponent as 'a supplier of innovative solutions, adding business value through technology implementation at a professional level'.
- The website of 'Drupal.org', undated, features a profile of the Opponent.
- Printouts dated 28 September 2020 from the website of the British Institute of Non-Destructive Testing' name the Opponent as one of five companies forming the 'Bladesave Consortium' which works on 'wind turbine condition monitoring'.
- A printout, dated 9 January 2019, from the website of British organisation 'TWI Innovation Network' chronicles the Opponent's collaboration by way of its software and hardware expertise.

h) Three invoices have been provided in respect of sales to UK customers, whose names and addresses have been redacted. It is convenient to summarise the relevant information as follows:

date	Service purchased	Invoice amount
31 August 2018	'Backend/Cloud Platform July 2018'	21,056 EURO
20 February 2020	'software development services'	34,228 EURO

24 February 2021	'Charging-Mobile application [redacted] software development services.	22,590 EURO
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i) The Witness Statement of Florin Alexandru Hrebenciuc, dated 14 September 2022, 'an interpreter and translator of English and Italian, authorised by the Romanian Ministry of Justice since 19 June 2001' refers to translations of press releases promoting the Opponent's forthcoming participation at the following events:

- World Congress of Mobile Technologies in Barcelona, 25 – 28 February 2019. Attended by over 100,000 specialists from around the world. The articles states that the Opponent has over 250 international clients.<sup>27</sup>
- Press articles chronicling the Opponent's attendance at event 'Hannover Messe 2022' at which some 5,000 exhibitors participated from 75 countries and approximately 200,000 visitors attended.

60. My view is that the totality of evidence provided demonstrates that there is, at most, some level of awareness of the Opponent and its trade marks amongst some professionals in the UK. Although the UK sales figures are not insignificant, without any information on the size of the market for the relevant goods/services, I am unable to form a view on the Opponent's position within the UK market. Whilst it is clear that the Opponent has participated in conferences/'trade fair'-type events at an international level, for many of these events, it is not clear what proportion of attendees were UK consumers. For the event that took place in London, UK (Particulate Engineering for Industry), no information has been provided on the numbers of attendees. I recognise that the Opponent has attracted significant EU funding for various projects in which it has provided services relating to software under its marks and worked alongside UK-based collaborators. The information on the Opponent's social media presence demonstrates a following that is somewhat noteworthy; however, I cannot tell what exposure, if any, the Opponent's marks

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<sup>27</sup> Exhibits FAH3 and FAH4.

have had on the UK market through these channels. The three invoices produced clearly demonstrate that a number of sales have been made to UK-based customers amounting to tens of thousands of EUROS. However, I consider that the evidence in the round is insufficient to support a finding that the earlier marks enjoy a level of distinctiveness beyond the level found in my assessment of the inherent position, i.e. low (mark i)) and above low but below medium (mark ii)). Information on, *inter alia*, expenditure on advertising campaigns and marketing activities directed to UK consumers, and material to demonstrate the Opponent's position within the UK market, would have strengthened the Opponent's case.

### **Likelihood of confusion**

61. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*<sup>28</sup>. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*<sup>29</sup>, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

62. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [13]. When considering all relevant factors 'in the round', I must bear in mind that a greater

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<sup>28</sup> Case BL O/375/10 at [16].

<sup>29</sup> *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

Earlier mark i): Assist Software

63. I will first consider the opposition in relation to the earlier mark i), 'Assist Software', which has been relied upon to attack the applied-for term *Business assistance, management and administrative services* (Class 35), only. This term is also present in the Opponent's specification. The parties' services are therefore identical. I have found the marks to have a low to medium level of visual similarity. Aurally speaking, I have found that there are two ways in which the Applicant's mark might be articulated, depending on whether the average consumer is inclined to pronounce the 'AY' device or not. Where the average consumer neglects to articulate the device, the parties' marks will be aurally similar to no more than a medium degree. I have found the marks to have at least a medium level of conceptual similarity. My view is that, despite the services being identical, the net effect of the differences that I have identified between the marks is sufficient to mitigate against a likelihood of direct confusion. I have found the earlier mark to have a low level of distinctive character owing to the descriptive nature of the element 'software' and the fact that 'Assist' is a fairly mundane word in the context of branding.

64. Taking all of the above into account, and even bearing in mind the principle of imperfect recollection, I consider that the visual differences between the marks will not go unnoticed by the average consumer. The word 'You' in the Applicant's mark will, in my view, be readily noticed by the average consumer because it is qualified by the preceding word 'Assist', which accords unity to the two words. Although I have found that the device element within the Applicant's mark will play a lesser role within the overall impression of the mark, I find that its presence will nevertheless be registered by the average consumer. I find that there is no likelihood of direct confusion between the applied-for mark and the Opponent's earlier mark UK00917979563 in respect of *Business assistance, management and administrative services*. In reaching this conclusion, I have borne in mind that a greater degree of similarity *may* mitigate against a lesser degree of similarity

between marks. In the instant case, however, where the level of attention paid during the purchasing will typically be fairly high, I do not consider the fact that the parties' services are identical to diminish the impact upon the consumer of the differences between the marks.

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

66. I bear in mind that in *L.A. Sugar Limited v Back Beat Inc*<sup>30</sup> Mr Iain Purvis Q. C. (as he then was), as the Appointed Person, explained that [my words in parentheses]:

'17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

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<sup>30</sup> Case BL O/375/10

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

67. I do not consider that any of the above categories applies in the instant case. I acknowledge that these categories are not intended to be exhaustive. To my mind, there is no commercially sensible rationale for 'Assist You' to be a brand extension of 'Assist Software', or vice versa. The 'You' element cannot, to my mind, be conceived of as an 'add-on', given the unity of 'Assist You', as described above. I can conceive of no mental process by which the average consumer may notice the differences between the marks but conclude that both parties' marks originate from the same or economically-related undertakings. I can find no proper basis for a finding of a likelihood of indirect confusion between the parties' marks.

Earlier mark ii):



68. I now consider the opposition in relation to the earlier mark ii), which has been relied upon for all of the opposed goods and services. I have found the Applicant's goods and services to be either identical or to have some level of similarity with the Opponent's terms under its earlier mark ii). Despite the identity and similarity of the parties' offerings, I consider that the net effect of the visual and aural differences that I have identified is sufficient to support a finding that there is no likelihood of direct confusion between the marks. I have found the level of visual similarity to be low to medium. Aurally speaking, I have considered the various ways in which each party's mark might be articulated by the average consumer and found that the overlap, even at its highest, is only medium. I find that the differences between the parties' marks will be perceived by a significant proportion of average consumers. The earlier mark enjoys a level of distinctive character of above low but below the threshold for medium. Keeping in mind my observations on the 'Assist you' portion of the applicant's mark being a unit, and the contribution made by the 'AY' device, I conclude that there is no likelihood of direct confusion between the applied-for

mark and the Opponent's earlier mark ii) UK00918013809. I find this to be the case even where purchases are made with a low level of attention.

69. I now consider whether there is a likelihood of indirect confusion. For analogous reasons to those provided above at [67], I find that there is no likelihood of indirect confusion.

### **Conclusion**

70. The opposition has failed in its entirety. Subject to a successful appeal, the application may proceed to registration.

### **COSTS**

71. The Applicant is the successful party and is entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 2/2016, calculated as follows:

Consideration of the Opposition and preparation of Defence and Counterstatement	£200
Consideration of Opponent's evidence	£300
<b>Total:</b>	<b>£500</b>

72. I therefore order Assist Software LLC to pay to AssistYou Group B. V. the sum of £500. 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 5<sup>th</sup> day of August 2024**

**N. R. Morris**

**For the Registrar,  
the Comptroller-General**

## Annex 1

Full specification for UK00917979563:

Class 9:

*Cables for electricity.*

Class 11:

*Filters for industrial and household use.*

Class 16:

*Paper and cardboard; Printed matter; Bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; Stationery and educational supplies.*

Class 28:

*Toys, games, playthings and novelties; Festive decorations and artificial Christmas trees; Sporting articles and equipment.*

Class 35:

*Business assistance, management and administrative services; Business analysis, research and information services; Advertising, marketing and promotional services.*

Class 41:

*Entertainment and sport services; Entertainment and sports.*

## Annex 2

Full specification for UK00918013809:

**Class 9:**

*Scientific research and laboratory apparatus, educational apparatus and simulators; Apparatus, instruments and cables for electricity; Scientific and laboratory devices for treatment using electricity; Optical devices, enhancers and correctors; Navigation, guidance, tracking, targeting and map making devices; Safety, security, protection and signalling devices; Information technology and audio-visual, multimedia and photographic devices; Diving equipment; Measuring, detecting and monitoring instruments, indicators and controllers; Recorded content.*

**Class 28:**

*Toys, games, playthings and novelties; Festive decorations and artificial Christmas trees.*

**Class 35:**

*Advertising, marketing and promotional services; Business analysis, research and information services; Business assistance, management and administrative services.*

**Class 42:**

*IT services; Design services; Science and technology services; Testing, authentication and quality control.*