

O/0757/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF INTERNATIONAL REGISTRATION NOS.
WO0000001526904, WO0000001527244 AND WO0000001526171**

DESIGNATING THE UK

BY SHOPEE SINGAPORE PRIVATE LIMITED

IN CLASSES 9, 35, 36, 38, 39, 42 AND 45

AND IN THE MATTER OF OPPOSITIONS THERETO

UNDER NOS. 434571, 434572 AND 434575

BY SHOPIFY INC.

BACKGROUND AND PLEADINGS

1. Shopee Singapore Private Limited is the holder of the following international trade marks:



Shopee

IR no. 1526904
("the First IR")



IR no. 1527244
("the Second IR")

SHOPEE

IR no. 1526171
("the Third IR")

(together "the IRs")

2. The IRs were registered on 10 February 2020. With effect from 29 September 2021, the holder designated the UK as a territory in which it seeks to protect the IRs under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the IRs in relation to the goods and services set out in Annex 1 to this decision.

3. The request to protect the IRs was published on 25 March 2022. On 27 June 2022, Shopify Inc. ("the opponent") opposed the protection of the IRs in the UK based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

4. For the opposition against the First IR, based upon sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade marks:



(series of 2)

UKTM no. 3582880

Filing date 21 January 2021; registration date 13 June 2021

("the First Earlier Mark")

SHOPIFY

UKTM no. 3582878

Filing date 21 January 2021; registration date 21 May 2021

("the Second Earlier Mark")

For the opposition against the First IR, based upon section 5(4)(a) of the Act, the opponent relies upon signs identical to those in the First and Second Earlier Marks, which it claims to have been using throughout the UK since at least 2018 and 2009 respectively in relation to the goods and services set out in Annex 2 to this decision.

5. For the opposition against the Second IR, based upon sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade marks:



(series of 2)

UKTM no. 3582882

Filing date 21 January 2021; registration date 13 August 2021

("the Third Earlier Mark")



UKTM no. 917937901

Filing date 31 July 2018; registration date 12 December 2018

("the Fourth Earlier Mark")

For its opposition against the Second IR, based upon section 5(4)(a) of the Act, the opponent relies upon the signs identical to those in the Third Earlier Mark, which it claims to have been using throughout the UK since at least 2018 in relation to the goods and services set out in Annex 2 to this decision.

6. For the opposition against the Third IR, based upon sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the Second Earlier Mark only. For its opposition against the Third Earlier Mark, based upon section 5(4)(a) of the Act, the opponent relies upon the sign **SHOPIFY** which it claims to have been using throughout the UK since at least 2009 in relation to the goods and services set out in Annex 2 to this decision.

7. The goods and services for which the earlier marks are registered are set out in Annex 2 to this decision.

8. Under section 5(2)(b), the opponent relies upon all of the goods and services for which the earlier marks are registered and claims that the marks are similar, and the goods and services are identical or similar, resulting in a likelihood of confusion.

9. Under section 5(3), the opponent claims a reputation in relation to all goods and services for which the earlier marks are registered and claims that use of the IRs would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character or repute of the earlier marks.

10. Under section 5(4)(a), the opponent claims that use of the IRs would be contrary to the law of passing off.

11. The holder filed a counterstatement denying the claims made.

12. Only the opponent filed evidence. A hearing took place before me on 12 April 2023, by video conference. The opponent was represented by Leighton Cassidy of Fieldfisher LLP and the holder was represented by Ian Bartlett of Beck Greener LLP.

EVIDENCE AND SUBMISSIONS

13. The opponent filed evidence in the form of the witness statement of Robert Guay dated 21 November 2022, which is accompanied by 10 exhibits. Mr Guay is the Director, Associate General Counsel Intellectual Property for the opponent, a position he has held since July 2021 (although he has worked for the opponent for four and a half years in total).

14. I have taken the evidence into consideration in reaching my decision and will refer to it below where necessary.

RELEVANCE OF EU LAW

15. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

PRELIMINARY ISSUES

The Opponent's pleaded case

16. At the hearing, Mr Bartlett referred to the part of Mr Cassidy's skeleton argument, which states:

"54. The Applicant's actions indicate a clear intent to "ride off" or exploit the established reputation enjoyed by the Opponent in the SHOPIFY and the S SHOPIFY Bag marks in the United Kingdom." (my emphasis)

Mr Bartlett noted that this amounts to an allegation of bad faith and that it had not been foreshadowed in the opponent's pleading.

17. That is, of course, correct. There is no bad faith ground pleaded in this case and, as I noted at the hearing, no application has been made to add an additional ground.

18. However, intention is also relevant to an allegation of unfair advantage under section 5(3). No allegation of intent was made in the opponent's Notices of opposition. In the absence of a clear pleading, I do not consider it appropriate for the opponent to raise an allegation of intent at such a late stage. Clearly, it would not be appropriate for me to draw any adverse inferences against the holder on the basis of their failure to answer such an allegation, if it was not made clear at the outset. Consequently, I will assess the section 5(3) ground as pleaded only.

State of the Register

19. In his skeleton argument, Mr Bartlett drew my attention to various other marks that are registered which are shopping bags or contain the letter S in relation to the relevant goods and services. For the avoidance of doubt, I agree with Mr Cassidy's submission that this evidence does not assist the holder. There is no evidence of any of these marks being used in the marketplace at the relevant date. Even if they were in use, there may be any number of reasons as to why the opponent has not taken issue with the registration of these marks. For example, there may be a co-existence agreement in place. Consequently, I do not consider that this assists the holder in defending its designations.

DECISION

Approach

20. In his skeleton argument, Mr Cassidy confirmed that the opponent's best case in relation to the First IR is the First Earlier Mark and that its best case in relation to the Second IR is the Third Earlier Mark. Only the Second Earlier Mark is relied upon for the purposes of the opposition against the Third IR. Consequently, I need not conduct my assessment in relation to the Fourth Earlier Mark and I will proceed on that basis.

Section 5(2)(b)

21. Section 5(2)(b) of the Act reads as follows:

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

(a)...

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

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

22. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not completed their registration process more than 5 years before the designation date of the IRs in issue, they are not subject to proof of use. The opponent can, therefore, rely upon all of the goods and services identified.

23. The following principles are gleaned from the decisions of the EU courts 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 C-120/04, *Shaker 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 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 to mind the earlier mark, 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 will wrongly 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

24. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- (a) The respective 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.

26. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

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

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

28. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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

Class 9

Computer program for communication devices.

29. This term is, in my view, identical on the principle outlined in *Meric* to “downloadable software for messaging and communications” in the specification of the First, Second and Third Earlier Marks. If I am wrong in that finding, then they will overlap in trade channels, user, method of use, purpose and nature and will be highly similar.

Computer software applications, downloadable; computer programs [downloadable software]; computer software, recorded.

30. In my view, these goods are all identical on the principle outlined in *Meric* to “downloadable software for use in e-commerce and the retail industry to allow users to perform business management via a global computer network, namely, database management, sales and customer tracking and inventory management” in the specifications of the First, Second and Third Earlier Marks.

Secure terminals for electronic transactions; electronic point of sale terminals.

31. These goods are identical on the principle outlined in *Meric* to “point of sale terminals” in the specifications of the First, Second and Third Earlier Marks.

Computer e-commerce software to allow users to perform electronic business transactions via a global computer network.

32. In my view, these goods are identical on the principle outlined in *Meric* to “downloadable software for use in e-commerce and the retail industry, namely, software for point of sale transactions” in the specification of the First, Second and Third Earlier Marks.

Internet servers.

33. In my view, these goods are likely to overlap in trade channels with “business services, namely, customer services for others in the nature of providing assistance to customers in the field of leasing, configuring, updating, monitoring, optimizing, repairing and troubleshooting computer servers and other computer hardware that support hosted ecommerce, social commerce, retail and marketing websites, hosted software applications, hosted computer software, hosted electronic databases, hosted digital content, and hosted business computer software applications of others accessible via the Internet” in the specifications of the First, Second and Third Earlier Marks. This is because the same businesses that provide servers are also likely to provide support for those using those servers. There will be an overlap in user and the goods and services are complementary. However, they differ in nature, method of use and purpose. Consequently, I consider them to be similar to a medium degree.

Class 35

Administrative processing of purchase orders.

34. The opponent submits that this term is identical to “order fulfilment services” in the specification of the First, Second and Third Earlier Marks. This is because “fulfilling an

order encompasses carrying out the administrative processing”. My understanding is that order fulfilment services would include a full range of services from the point of an order being received to delivery of the product to the customer. Consequently, I accept that it would include the processing of the orders themselves and that these services are identical on the principle outlined in *Merix*. Even if I am wrong in that finding, they would overlap in trade channels, user, method of use, purpose and nature and would be highly similar.

Advertising services; advertising; compilation of advertisements for use as web pages on the internet; marketing research; marketing; on-line advertising on a computer network; opinion polling; organisation and management of customer loyalty programs; pay per click advertising; publicity; rental of advertising time on communication media; sales promotion for others; updating of advertising material; dissemination of advertising matter; publication of publicity texts.

35. In my view, all of these services are self-evidently identical or identical on the principle outlined in *Merix* to “advertising, marketing and promotion services” in the specifications of the First, Second and Third Earlier Marks.

Auctioneering; on-line auctioneering.

36. In my view, these services will overlap in trade channels with “operating online marketplaces for sellers and buyers of goods and/or services” in the specifications of the First, Second and Third Earlier Marks. This is because it is not uncommon for online marketplaces to involve a bidding/auction format. The users will also overlap. There will be some overlap in nature, method of use and purpose. There may also be a degree of competition. Consequently, I consider these services to be highly similar.

Business appraisals; business management assistance; business management consultancy; business organization consultancy; commercial or industrial management assistance.

37. These services are all self-evidently identical or identical on the principle outlined in *Merix* to “business management [...] consultancy” and “business management

services for online stores” in the specifications of the First, Second and Third Earlier Marks.

Business information; providing business information via a website.

38. These services are self-evidently identical or identical on the principle outlined in *Meric* to “providing business information via a website” in the specifications of the First, Second and Third Earlier Marks.

Business investigations.

39. In my view, these services are likely to be specialist services provided to customers looking to investigate actions undertaken by particular businesses. I can see no point of overlap in trade channels, method of use, purpose or nature with the specifications of the First, Second and Third Earlier Marks. I recognise that there may be some overlap in user, but I do not consider this to be sufficient for a finding of similarity. I do not consider them to be complementary or in competition. Consequently, I consider these services to be dissimilar.

Business research; commercial information agencies; commercial information and advice for consumers [consumer advice shop]; compilation of directories for publishing on the internet; provision of commercial and business contact information; price comparison services.

40. These services will be identical on the principle outlined in *Meric* to “providing business information via a website” in the specification of the First, Second and Third Earlier Marks. If they are not identical, then there will be an overlap in user, trade channels, method of use, purpose and nature and they will be highly similar.

Import-export agencies; procurement services for others (purchasing goods and services for other businesses).

41. These are specialist intermediary services which, in my view, would be provided by specialist businesses. They are not business management services. I can see no

point of overlap with the specification of the opponent's mark and I have no evidence before me to support such a finding. Consequently, I consider the services to be dissimilar.

Commercial intermediation services.

42. This term could involve acting as an intermediary between the sellers of goods and their customers. For example, it might include online marketplaces. Consequently, I consider these services to be identical to “operating online marketplaces for sellers and buyers of goods and/or services” in the specifications of the First, Second and Third Earlier Marks. If I am wrong in that finding, then there will be an overlap in purpose, method of use, trade channels, user and nature and the services will be highly similar.

Compilation of information into computer databases; compilation of statistics; systemization of information into computer databases; data search in computer files for others; updating and maintenance of data in computer databases.

43. These services are similar to a medium degree to “business services, namely, customer services for others in the nature of providing assistance to customers in the field of [...] hosting electronic databases [...]” in the specifications of the First, Second and Third Earlier Marks. This is because the same businesses that host databases are also likely to be responsible for their compilation, search facilities and updating/maintenance. There is an overlap in trade channels and user. The services are also complementary.

Computerised stock management; invoicing.

44. In my view, these are both services that could be provided as part of the “order fulfilment services” in the specifications of the First, Second and Third Earlier Marks. Consequently, the services are identical on the principle outlined in *Meric*.

Web site traffic optimization; search engine optimisation.

45. These services are identical on the principle outlined in *Meric* to “search engine and web site optimization” in the specifications of the First, Second and Third Earlier Marks.

Cost price analysis.

46. This is a service that may be undertaken for a business wishing to analyse the financial viability of a project or product. Consequently, I consider that this is identical on the principle outlined in *Meric* to “business management services relating to information and data [...] analysis” in the specifications of the First, Second and Third Earlier Marks.

Logistics services (business management and organisation of facilities and resources).

47. This term is identical on the principle outlined in *Meric* to “business management services for online stores” in the specifications of the First, Second and Third Earlier Marks.

Presentation of goods on communication media, for retail purposes; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), namely apparel, footwear, fashion accessories, jewellery, cosmetics, personal care products, electronics and peripherals, pet food and supplies, alcohol, food, beverages, video games, computer software, bags, luggage, wallets, mobile phones, supplements, sporting goods and equipment, furniture, bedding, homeware, kitchenware, stationery and office supplies, drawers and storage products, toys, diapers, milk formula, nursing products, books, musical instruments, CDs, DVDs, home appliances, automotive parts and accessories, enabling customers to conveniently view and purchase those goods from a general merchandise web site in the global communications network.

48. These services are highly similar to “operating online marketplaces for sellers and buyers of goods and/or services” in the specifications of the First, Second and Third Earlier Marks. They will overlap in nature, user, method of use and purpose. They will also be in competition.

Provision of an on-line marketplace for buyers and sellers of goods and services.

49. This term is self-evidently identical to “operating online marketplaces for sellers and buyers of goods and/or services” in the specifications of the First, Second and Third Earlier Marks.

Class 36

Financial services via global communications networks; monetary services via global communications networks; financial electronic transaction services via global communications networks; clearing and reconciling financial transactions electronically via global communications networks; payment administration services via global communications networks; providing services for making payment on prepaid cards via global communications networks; financial services for enabling transfer of funds and purchase of products and services offered by others, all provided via global communications networks; electronic foreign exchange services.

50. These services are identical to “providing electronic processing of credit card transactions and electronic payments via a global computer network” and/or “accepting, processing, and reconciling credit card, debit card, gift card and other forms of payment transactions via a global computer network” in the specifications of the First, Second and Third Earlier Marks.

Providing services for making payment on prepaid cards over shop counters.

51. These services are identical on the principle outlined in *Meric* to “accepting, processing, and reconciling credit card, debit card, gift card and other forms of payment transaction” in the specifications of the First, Second and Third Earlier Marks.

Financial intermediary services.

52. These are services that would include acting as an intermediary for the provision of loans. In my view, this is identical on the principle outlined in *Meric* to “loan services” in the specification of the First, Second and Third Earlier Marks, which would include both the provision of loans directly (such as by a bank) or the provision of loan products (which are actually provided by a third party).

Class 38

Computer aided transmission of messages and images; electronic bulletin board services [telecommunications services]; electronic mail; internet communication services; providing internet chatrooms; providing online forums; services for communication by electronic means; services for communication by wireless means; transmission of digital files.

53. These services are all identical on the principle outlined in *Meric* to “communication transmissions through internet platforms and portals”, “computer transmission of messages” and “transmission (uploading, posting or display) of data, information, pictures, images via online forums, audio and video” in the specifications of the First, Second and Third Earlier Marks.

Information about telecommunication; telecommunication services via computer network in relation to the communication of information between data banks.

54. These services are identical on the principle outlined in *Meric* to “transmission (uploading, posting or display) of data, information, pictures, images via online forums, audio and video” and “transmission of information on various topics via online and global computer networks” in the specifications of the First, Second and Third Earlier Marks.

Providing access to databases.

55. This term is self-evidently identical or identical on the principle outlined in *Meric* to “transmission (uploading, posting or display) of data...” in the specifications of the First, Second and Third Earlier Marks.

Providing on-line communications links which transfer the web site user to other local and global web pages.

56. This term is self-evidently identical to “provide online communication to transfer website users to other regional web pages and global web pages transmission link” in the specifications of the First, Second and Third Earlier Marks.

Providing telecommunication channels for teleshopping services; providing telecommunications connections to a global computer network; providing user access to global computer networks; telecommunication services relating to commerce; telecommunication services relating to electronic payments; telecommunication services relating to wireless payments.

57. These services are identical on the principle outlined in *Meric* to “computer communication services” in the specifications of the First, Second and Third Earlier Marks. If I am wrong in this finding then they will overlap in trade channels, user, method of use, purpose and nature and will be highly similar.

Telecommunications consultancy.

58. This term is identical on the principle outlined in *Meric* to “consulting services related to communication transmission” in the specifications of the First, Second and Third Earlier Marks.

Class 39

Courier services [messages or merchandise]; delivery of goods; delivery of goods by mail order; freight [shipping of goods]; freight forwarding;

59. These services are either self-evidently identical or identical on the principle outlined in *Meric* to “freight forwarding services” and/or “delivery of goods” in the specifications of the First, Second and Third Earlier Marks.

Gift wrapping; packaging of goods; rental of storage containers; rental of warehouses; storage information; storage of goods; transportation information; transportation logistics; warehousing; wrapping of goods.

60. These are all services that might be provided by companies that all offer “delivery of goods” in the specifications of the First, Second and Third Earlier Marks. For example, a business might offer another business the option of storing their products in their facilities and packaging those products up when they are purchased prior to shipping to the buyer. Similarly, the same businesses may provide information about these services. Consequently, I consider there to be an overlap in trade channels and user. The method of use may overlap, but the nature and purpose of the services will be different. In respect of some of the services, there may be complementarity. I consider the services to be similar to at least a medium degree.

Physical storage of electronically-stored data or documents.

61. These services relate to storage of electronic data/documents, rather than consumer goods. Consequently, the same overlap as described above will not apply. However, I accept that there may be some overlap in trade channels and user with “customer data management services” in the specifications of the First, Second and Third Earlier Marks. The nature and method of use of the services will differ. However, there may be some general overlap in purpose. The services are not in competition or complementary. I consider them to be similar to between a low and medium degree.

Class 42

Cloud computing.

62. My understanding is that cloud computing involves using a network of remote servers hosted on the internet to store, manage and process data. In my view, these services will overlap with “design, creation, hosting and maintenance of internet sites for third parties” in the specifications of the First, Second and Third Earlier Marks. In my view, there is likely to be an overlap in trade channels and user. The method of use, nature and purpose of the services may differ. I consider them to be similar to between a low and medium degree.

Computer programming; computer software consultancy; computer software design; computer system design; computer systems integration services; computer technology consultancy; design and development of computer programs for mobile phones; design and development of computer software for computers; technological consultancy; telecommunications technology consultancy.

63. These services will be in competition with “downloadable software development kits (SDK)” in the specifications of the First, Second and Third Earlier Marks. This is because a user may choose to either engage the services of a programmer/developer to build the software that they require or they may choose to use a package to develop it themselves. The users will clearly overlap. The nature and method of use of the goods and services will differ. I consider it unlikely that there would be an overlap in trade channels. However, there will clearly be an overlap in purpose. In my view, the goods and services are similar to a medium degree.

Computer security consultancy; computer virus protection services; maintenance of computer software relating to computer security and prevention of computer risks; updating of computer software relating to computer security and prevention of computer risks.

64. These services may be provided by a business specialising in technical security services. Consequently, I consider that there may be an overlap in trade channels with “business services, namely, customer services for others in the nature of providing assistance to customers in the field of network security management for ecommerce, social commerce, retail and marketing websites” in the specifications of the First, Second and Third Earlier Marks. There may also be an overlap in user. I recognise

that the specific purpose of the services may differ, as will the nature and method of use. Consequently, I consider there to be a medium degree of similarity.

Conversion of data or documents from physical to electronic media; data conversion of computer programs and data [not physical conversion]; data encryption and decoding services.

65. These services are, in my view, in competition with “Software as a Services (SAAS) services featuring software for use in database management [...]” in the specifications of the First, Second and Third Earlier Marks. This is because a business may choose to either purchase SAAS to manage its database and related activities or may engage the services of a business to do the same. The user will clearly overlap. The nature, method of use and trade channels may differ. However, the purpose will be the same. Consequently, I consider the similarity to be at a medium degree.

Creating and maintaining web sites for others; hosting computer sites [web sites]; outsource service providers in the field of information technology; web site design consultancy; web site design.

66. These services are identical on the principle outlined in *Meric* to “design, creation, hosting and maintenance of internet sites for third parties” in the specifications of the First, Second and Third Earlier Marks.

Diagnosis of faults in computer programs.

67. These services are identical on the principle outlined in *Meric* to “technical support services, namely, troubleshooting of computer software problems” in the specifications of the First, Second and Third Earlier Marks.

Hosting of software as a service (SaaS).

68. This service is identical on the principle outlined in *Meric* to “software as a service (SAAS) services, namely, hosting software for use by others for use as a software

code translation service” in the specification of the First, Second and Third Earlier Marks.

Providing information on computer technology and programming via a web site.

69. This service is likely to overlap in trade channels with “downloadable application programming interface (API) software that enables developers to build software applications for use in the retail and e-commerce industry” in the specifications of the First, Second and Third Earlier Marks because businesses that provide goods enabling users to programme are also likely to provide information on the subject. The users will clearly overlap. The nature, purpose and method of use of the goods and services will differ. They are neither in competition nor complementary. I consider them to be similar to between a low and medium degree.

Providing search engines for the internet.

70. In my view, this involves the provision of a type of non-downloadable software. I consider the term “computer services in the nature of providing customized web pages and other data feed formats featuring user-defined information” in the specifications of the First, Second and Third Earlier Marks would encompass the applicant’s search engine services. Consequently, I consider these services to be identical on the principle outlined in *Meric*. However, even if I am wrong in that finding, they will overlap in user, trade channels, method of use, purpose and nature and will be highly similar.

Providing temporary use of on-line non-downloadable authentication software for communications with computers via global communication network.

71. These services are identical on the principle outlined in *Meric* to “providing temporary use of non-downloadable software for messaging and communications” in the specifications of the First, Second and Third Earlier Marks.

Providing temporary use of on-line non-downloadable software for processing electronic payments; providing temporary use of on-line non-downloadable software for processing wireless payments.

72. These services are likely to overlap in trade channels and user with “payment services, namely, processing of credit card and debit card payments initiated via mobile electronic devices and digital wallets” in the specifications of the First, Second and Third Earlier Marks. They will overlap in purpose, although the nature and method of use will differ. They are complementary. Consequently, I consider the services to be similar to between a medium and high degree.

Providing temporary use of online non-downloadable software for e-commerce.

73. In my view, these services are either identical or highly similar to “software as a Service (SAAS) featuring software for use in e-commerce and the retail industry to allow users to perform electronic business transactions via a global computer network” in the specifications of the First, Second and Third Earlier Marks. If they are not identical, they will overlap in trade channels, method of use, purpose and user. They will also be in competition. Consequently, they will be highly similar.

Server hosting.

74. There will be an overlap in trade channels with “business services, namely, customer services for others in the nature of providing assistance to customers in the field of leasing, configuring, updating, monitoring, optimizing, repairing and troubleshooting computer servers and other computer hardware that support hosted ecommerce, social commerce, retail and marketing websites, hosted software applications, hosted computer software, hosted electronic databases, hosted digital content, and hosted business computer software applications of others accessible via the Internet” in the specifications of the First, Second and Third Earlier Marks. This is because the same businesses that host servers are also likely to provide support for those using those servers. There will be an overlap in user and the services are complementary. However, they differ in nature, method of use and purpose. Consequently, I consider them to be similar to a medium degree.

Software as a service [SaaS].

75. These services are identical on the principle outlined in *Meric* with “Software as a service (SAAS) services featuring software for computer software development tools” in the specifications of the First, Second and Third Earlier Marks.

Troubleshooting of computer software problems [technical support].

76. This term is self-evidently identical to “technical support services, namely, troubleshooting of computer software problems” in the specifications of the First, Second and Third Earlier Marks.

Providing user authentication services in e-commerce transactions.

77. These services could overlap in purpose with “providing an online platform featuring online non-downloadable computer software for use in the retail and e-commerce industry for facilitating retail store services” in the specifications of the First, Second and Third Earlier Marks because they could both be used for user authentication in e-commerce transactions. The user would also overlap. There would be competition. However, the method of use, trade channels and nature would differ. I consider these services to be similar to a medium degree.

Class 45

On-line social networking services.

78. The opponent refers to a previous decision of this Tribunal in which the Hearing Officer compared various on-line communication services with social networking and dating sites, concluding:¹

“76. The above services are all concerned with the provision of means of communication to users online. It is common for social networking or dating

¹ BL O/087/20

websites, as covered by the earlier specification in class 45, to allow users to create personal profile pages and to feature a messaging function within the site; it is entirely plausible that messages could be written, video or audio. Whilst it may be less likely to dating sites where personal security is more of a concern, I see no reason why a social networking site would not also incorporate electronic bulletin boards. There is, therefore, similarity in both nature and purpose, users will be the same and there is clear potential for complementarity. These services are similar to a fairly high degree.”

79. For the same reasons, the opponent submits that these services are similar to “communication transmissions through internet platforms and portals” in the specifications of the First, Second and Third Earlier Marks. I agree with the findings as outlined above and conclude that they are similar to between a medium and high degree.

Providing information regarding intellectual property management by intellectual property owners and enforcement policies relating thereto, all in order to assist program participants with inquiries and requests regarding use of intellectual property by others in an online marketplace.

80. With regard to these services, the opponent claims that they are similar to its “educational services, namely, developing, arranging, and conducting educational conferences and programs in the fields of e-commerce and technology” and “providing on-line training courses, seminars, and workshops in the field of e-commerce, business management, advertising, digital marketing, website design, and customer services” in the specifications of the First, Second and Third Earlier Marks. The opponent submits:

“The Applicant’s services in Class 45 relates to providing information on IP management to individuals to query use of IP by others on an online marketplace. This would be viewed as providing a form of education or training in relation to e-commerce and business management. Therefore, the services are similar.”

81. I accept that these services would overlap in trade channels and users. They may also be provided in similar ways, resulting in an overlap in method of use. The purpose of the services may also overlap as they may both involve the provision of information to assist with e-commerce activities of the user (which could include intellectual property issues). The nature of the services will differ. They may be complementary. In my view, they are similar to between a medium and high degree.

82. As some similarity of goods and services is essential for a finding of likelihood of confusion, the opposition based upon this ground must fail in relation to those services that I have found to be dissimilar to the opponent's specifications.

The average consumer and the nature of the purchasing act

83. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

84. The average consumer for the goods and services will be a member of the general public or a business user. The cost of the goods and services is likely to vary significantly, as will the frequency of purchase. However, even where the cost is low and the purchases frequent, various factors will still be taken into account (such as functionality, ease of use and suitability for particular requirements in relation to the goods and reliability and customer service for the services). Consequently, at least a

medium degree of attention will be paid during the purchasing process. However, I recognise that where the goods and services are particularly technical or they are purchased as part of the user's business activities, the level of attention paid may be between a medium and high degree.

85. The goods and services are likely to be purchased following perusal of signage on websites, in physical premises and on advertisements. Consequently, visual considerations will dominate the selection process. However, given that word-of-mouth recommendations may be made, I do not discount an aural component to the selection.

Comparison of trade marks

86. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

87. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

88. The respective trade marks are shown below:

| Opponent's trade marks | Applicant's trade marks |
|--|--|
|  <p>(series of 2) (the First Earlier Mark)</p> |  <p>Shopee (the First IR)</p> |
|  <p>(series of 2) (the Third Earlier Mark)</p> |  <p>(the Second IR)</p> |
| <p>SHOPIFY (the Second Earlier Mark)</p> | <p>SHOPEE (the Third IR)</p> |

The First IR and the First Earlier Mark

89. The First IR consists of a two-dimensional black bag device, which displays the letter S, above the word SHOPEE, presented in title case. The overall impression lies in the combination of these elements, with the word and the device playing a roughly equal role. The First Earlier Mark consists of the word SHOPIFY, in standard, lower case font, next to a three-dimensional shopping bag device (in grey in one mark in the series and green in the other). The bag device displays the letter S. Given its relative

size, the word SHOPIFY plays the greater role in the mark, with the device playing a slightly lesser role.

90. Visually, the First IR and the First Earlier Mark overlap to the extent that they both contain bag devices which display the letter S. The devices differ in that one is three-dimensional and the other is two-dimensional. They are also different colours, although as the First IR is presented in black and white it could be used in any colour. They also overlap in that the word elements both begin with the letters SHOP-. However, the endings differ -IFY in the First Earlier Mark and -EE in the First IR. The arrangement of the marks also differ, with the device appearing alongside the text in the First Earlier Mark and above it in the First IR. Overall, I consider the marks to be visually similar to a medium degree.

91. Aurally, I consider that only the word elements of each mark will be pronounced. Consequently, I consider the First Earlier Mark is likely to be pronounced SHOP-IFF-AYE or SHOP-EE-FY and the First IR likely to be pronounced SHOP-EEE. The first syllable will be pronounced identically in both cases. For some average consumers, the endings will differ. However, for a significant proportion (those who pronounce SHOPIFY as SHOP-EE-FY), I consider that there will be a significant overlap. For the latter group, the marks will be aurally highly similar.

92. Conceptually, both text elements of the marks are invented words which contain the word SHOP. The holder submits that the suffix -IFY in the opponent's marks acts as a point of conceptual difference because it will be seen as indicating "to make something a shop" (presumably in a similar vein to BEAUTIFY meaning to make beautiful). However, I do not consider it likely that this meaning will be immediately graspable for the average consumer. Even if that meaning is apparent for some consumers, there will certainly be a significant proportion of average consumers who do not recognise it. In any event, both words allude to relating in some way to shopping (perhaps services being offered to retail businesses). I consider it unlikely that the bag device itself will convey any conceptual message, although given that it will be recognised as a shopping bag, it may reinforce the conceptual message that the goods/services are related to shopping in some way. Consequently, I consider the marks to be conceptually highly similar.

The Second IR and the Third Earlier Mark

93. The Second IR consists of a two-dimensional white bag device, which displays the letter S, presented on a black background. The overall impression lies in the combination of these elements. The Third Earlier Mark consists of a three-dimensional bag (which is black in the first mark in the series, and green in the second) displaying the letter S. The overall impression lies in the combination of these elements.

94. Visually, the Second IR and the Third Earlier Mark overlap to the extent that they are both bag devices which display the letter S. However, the difference lies in the Third Earlier Mark being three-dimensional and the Second IR being two-dimensional. The black and white in each mark are reversed. In my view, the marks are visually similar to between a medium and high degree.

95. Aurally, if the marks are articulated, they will both be pronounced simply as the letter S. Consequently, they are aurally identical.

96. Conceptually, I do not consider that any real message will be conveyed by the bag devices on their own or the letter S and, consequently, the conceptual position is neutral. If any meaning is conveyed, then it will be identical for both.

The Third IR and the Second Earlier Mark

97. The Third IR consists of the word SHOPEE presented in a standard, upper case font. It is the word itself which plays the greater role in the overall impression. The Second Earlier Mark consists of the word SHOPIFY. There are no other elements to contribute to the overall impression which lies in the word itself.

98. Visually, the marks overlap to the extent that the first four letters are SHOP-. However, the endings differ, being -IFY in the Second Earlier Mark and -EE in the Third IR. Consequently, I consider the marks to be visually similar to a medium degree.

99. Aurally, the Second Earlier Mark is likely to be pronounced SHOP-IFF-AYE or SHOP-EE-FY and the Third IR is likely to be pronounced SHOP-EEE. As noted above, in relation to a significant proportion of average consumers, the first syllable will be identical and there will be a significant overlap in the pronunciation of the second syllable. Consequently, I consider the marks to be aurally highly similar.

100. Conceptually, both text elements of the marks are invented words which contain the word SHOP. Consequently, both allude to relating in some way to shopping (perhaps services being offered to retail businesses). In my view, they are conceptually highly similar.

Distinctive character of the earlier trade marks

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

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

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

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

103. All of the earlier marks consist of the word SHOPIFY and/or a bag device (displaying the letter S). For goods and services which are in some way retail focused (perhaps being used in conjunction with retail services or provided to retail-focused customers), I consider the earlier marks to be inherently distinctive to a relatively low degree. For other goods and services which are unrelated to retail, I consider the marks to be inherently distinctive to a medium (or average) degree.

104. I will now consider whether the distinctiveness of the earlier marks have been enhanced through use. For the avoidance of doubt, I note Mr Bartlett’s point that enhanced distinctiveness was not expressly pleaded by the opponent. However, given that the distinctiveness of a mark is a key factor in an assessment of likelihood of confusion, and the opponent has filed evidence of use and claimed reputation, it is not a matter which, in my view, must be expressly pleaded to enable me to consider it. I note that Mr Bartlett accepted that the opponent had a reputation in relation to the Second Earlier Mark only, but disputes the extent of the goods and services in relation to which reputation is claimed. With that in mind, I note the following from the opponent’s evidence:

- a) Mr Guay states that the opponent offers e-commerce solutions to online retailers and provides a platform on which they can run and grow their business. It appears that the opponent provides businesses with the ability to build an online store and offers tools to support that business such as inventory and payment tracking.²

² Exhibit 1

b) The opponent's shopify.co.uk website had over 60million page views between 1 January 2015 and 31 December 2020.³

c) An article dated 16 August 2021 describes the opponent as "one of the most successful online shopping platforms in the UK".⁴

d) Mr Guay has provided the following information about the number of "active merchants" using the Shopify platform in the UK:

| | |
|------|---------|
| 2007 | 58 |
| 2008 | 204 |
| 2009 | 545 |
| 2010 | 798 |
| 2011 | 1,895 |
| 2012 | 3,962 |
| 2013 | 8,331 |
| 2014 | 14,240 |
| 2015 | 23,712 |
| 2016 | 35,100 |
| 2017 | 50,639 |
| 2018 | 64,986 |
| 2019 | 79,992 |
| 2020 | 135,011 |
| 2021 | 157,399 |

e) Mr Guay has provided the following figures which represent the amount billed to merchants for their subscriptions:

| | |
|------|--------------|
| 2014 | \$6,742,243 |
| 2015 | \$11,308,976 |
| 2016 | \$18,247,037 |

³ Exhibit 11

⁴ Exhibit 4

| | |
|------|---------------|
| 2017 | \$28,752,454 |
| 2018 | \$42,140,961 |
| 2019 | \$58,242,578 |
| 2020 | \$86,105,983 |
| 2021 | \$132,055,225 |

- f) The opponent also makes money from revenue sharing arrangements for orders facilitated through the Shopify platform in the UK. These exceeded \$500million by the year ending 2019 and \$1.5billion by the year ending 2020. Revenue figures provided by year are set out below:

| | |
|------|---------------|
| 2013 | \$4,517,000 |
| 2014 | \$7,912,000 |
| 2015 | \$15,436,000 |
| 2016 | \$25,958,000 |
| 2017 | \$44,590,000 |
| 2018 | \$69,596,000 |
| 2019 | \$103,498,000 |
| 2020 | \$199,825,000 |

- g) Mr Guay has provided the following advertising expenditure figures for the UK, and the corresponding UK “impressions”:

| Year | Amount spent in USD | UK Total Impressions |
|-------------|----------------------------|-----------------------------|
| 2014 | 185,088.44 | 131,551,036 |
| 2015 | 972,823.52 | 231,206,371 |
| 2016 | 1,117,337.96 | 249,763,550 |
| 2017 | 8,868,638.52 | 233,368,766 |
| 2018 | 11,777,541.76 | 231,113,368 |
| 2019 | 15,247,734.78 | 1,082,727,144 |
| 2020 | 23,204,797.08 | 1,484,507,421 |
| 2021 | 34,338,786.12 | 2,660,614,444 |

- h) The opponent has been referenced in publications such as *The Independent* (August 2021), *The Guardian* (August 2021), *Mail Online* (November 2020),

The Daily Telegraph (July 2020), *The London Evening Standard* (October 2019) and *The Times* (May 2019).⁵

105. Clearly the opponent's revenue is high, as is the advertising expenditure. I have no information about market share or geographical spread of the use. However, there have been references to the opponent's brand in national publications. Taking the evidence as a whole into account, I am satisfied that the Second Earlier Mark has been enhanced through use to between a medium and high degree in relation to the provision of websites and business administration for third parties in the field of ecommerce. I also consider the same to apply to the First Earlier Mark. However, there is limited use of the Third Earlier Mark on its own (independent of the words SHOPIFY) and, consequently, I do not consider the distinctiveness of that mark has been enhanced through use.

Likelihood of confusion

106. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertaking being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

⁵ Exhibit 9

107. I have found as follows:

- a) The goods and services vary from being dissimilar to identical.
- b) The average consumer is a member of the general public or a business user, who will pay a medium degree of attention during the purchasing act (although between a medium and high degree of attention may be paid where the goods/services are technical in nature).
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The First IR and the First Earlier Mark are visually similar to a medium degree, and aurally and conceptually similar to a high degree.
- e) The Second IR and the Third Earlier Mark are visually similar to between a medium and high degree, and aurally identical. I consider it unlikely that a conceptual message will be conveyed at all, in which case the conceptual position is neutral. However, if I am wrong in that, then any message conveyed will be identical.
- f) The Third IR and the Second Earlier Mark are visually similar to a medium degree, and aurally and conceptually highly similar.
- g) The First and Second Earlier Marks are inherently distinctive to a relatively low degree for goods/services relating to ecommerce, which has been enhanced through use to between a medium and high degree for the provision of websites and business administration for third parties in the field of ecommerce. In relation to non-retail related goods/services, the First and Second Earlier Marks are inherently distinctive to a medium degree.
- h) The Third Earlier Mark is inherently distinctive to a relatively low degree for goods/services relating to ecommerce, or to a medium degree for goods/services that are not related to ecommerce/retail.

108. In relation to the First and Third IRs and the First and Second Earlier Marks, I recognise that the conceptual overlap is non-distinctive for many of the goods and services. Mr Bartlett directed me to the judgment of Mr Justice Arnold (as he then was), in *Whyte and Mackay Limited v Origin Wine UK Limited and Another* in which he stated:

“44. [...] It is not necessary for present purposes to go further into these questions, for what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

109. A similar point was made by the GC in a case concerning a dispute between the same parties as in the present proceedings.⁶ However, this is not a circumstance in which the only common element is non-distinctive. The second syllable of both marks is likely to be pronounced by a significant proportion of average consumers as an EE sound. This means that both the first syllable (which consists of a non-distinctive word) and the second syllable are identical aurally. Of course, the purchasing process is predominantly visual, and the visual differences are more obvious. However, in my view, there will still be a significant proportion of average consumers who, having become familiar with the opponent’s mark (the distinctiveness of which has been enhanced through use), then encounter the First and Third IRs and read the word as SHOP-EE (in the same way that the First and Second Earlier Marks remain in their mind as SHOP-EE-FY). For those consumers, they are likely to mistakenly recall or misremember the marks as each other, notwithstanding the visual differences. Further, I bear in mind that for those goods and services in the holder’s specifications which are similar to those for which the opponent has a reputation, the average consumer tends to see what he expects to see when confronted with a similar mark.⁷ I consider there to be a likelihood of direct confusion, where the marks are used on goods and services that I have found to be similar.

⁶ Case T-222/21

⁷ *Kennedy Fried Chicken*, Case BL O/227/04

110. In relation to the First Earlier Mark and the First IR, the likelihood that they will be mistakenly recalled or misremembered is increased by the presence of such similar shopping bag devices. The average consumer is likely to recall an invented word beginning with the word SHOP (followed by an EE sound) and the bag device, and, upon seeing the First IR, will believe that it is the mark of the opponent. Even if they are not misremembered, they may be viewed as an alternative mark being used by the same undertaking. Consequently, I consider there to be a likelihood of direct and indirect confusion amongst a significant proportion of average consumers.⁸

111. In relation to the Third Earlier Mark and the Second IR, the common bag devices with the letter S displayed upon them are likely to result in the average consumer mistakenly recalling or misremembering the marks as each other. Even if they are not misremembered, they may be viewed as an alternative mark being used by the same undertaking. Consequently, there is a likelihood of direct and indirect confusion in relation to the Second IR.

112. For the avoidance of doubt, I have borne in mind that the average consumer may be paying a higher level of attention in relation to some of the goods and services. I have taken this into consideration and my findings still apply even in those circumstances.

113. The oppositions based upon section 5(2)(b) against the IRs succeed in relation to all goods and services with the exception of the following:

Class 35 Business investigations; import-export agencies; procurement services for others (purchasing goods and services for other businesses).

Section 5(3)

114. Section 5(3) of the Act states:

“5(3) A trade mark which -

⁸ *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

115. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

116. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases

where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

117. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the IRs are similar. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier marks being brought to mind by the IRs. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

118. At the hearing, Mr Bartlett submitted that the case law tells us that the test for similarity is the same under sections 5(2)(b) and 5(3) and that "if you find that the marks are too dissimilar for there to be any likelihood of confusion, even with identical or highly similar goods and services, then you're not going to do any better" under section 5(3). In this regard Mr Bartlett relied upon two decisions, the most recent of which was a decision of Mr Philip Johnson, sitting as the Appointed Person, in which he stated:

"11. In *Mastercard International v Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), Peter Smith J rejected the submission that the test for similarity under section 5(3) was different from that applied under section 5(2) (at [62]). This is supported by C-115/19 *China Construction Bank v EUIPO*, EU:C:2020:469, [58] where the Court of Justice held that an earlier mark's reputation and enhanced distinctiveness are not relevant to the assessment of the similarity between two marks. The Hearing Officer was therefore required to adopt his earlier finding in relation to the similarity of the marks.

12. The Appellant cites T-480/12 *Coca-Cola v OHIM*, EU:T:2014:1062, [73] to [74] to suggest that the Hearing Officer was in error. I am not sure this decision takes the matter much further. Here the General Court reminded itself that there needs to be some similarity between the marks for the equivalent of section 5(3) to be engaged, and that the similarity of the marks is a factor to consider when determining whether there is a link or not ([73]). The Hearing Officer's decision was entirely consistent with this approach. The General Court then went on to hold that in the case before it, and despite the low level of similarity between the marks, the average consumer would still make a link. This is a finding of fact and has no wider application."

119. I agree with Mr Bartlett that the case law is clear that there must be a finding of some similarity between the marks in order for the section 5(3) ground to be engaged. The similarity of marks assessment is the same as it is under section 5(2)(b). For the same reasons set out above, I have found similarity between the marks in this case. The degree to which similarity of marks exists will, of course, be relevant to the assessment of link. However, for the avoidance of doubt, I do not consider that the tests under section 5(2)(b) and 5(3) are the same or that the outcome of one is bound to follow the other. They are different tests, and I have approached my assessment on that basis.

Reputation

120. In *General Motors*, Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

121. In determining whether the opponent has demonstrated a reputation for the services relied upon, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with those services. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it".

122. I have summarised the opponent's evidence of use above. For the same reasons, I consider that the opponent has a reasonably strong reputation in relation to the First and Second Earlier Marks for the provision of websites and business administration for third parties in the field of ecommerce. I do not consider the evidence sufficient to justify a finding of reputation in relation to the Third Earlier Mark.

Link

123. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

The First IR and the First Earlier Mark are visually and aurally similar to a medium degree, and conceptually similar to a high degree.

The Third IR and the Second Earlier Mark are visually similar to a medium degree, and aurally and conceptually highly similar.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

The majority of the applicant's class 9 goods are such that they do (or may) relate to e-commerce. Consequently, I consider it entirely possible that there may be some overlap in trade channels and user with the opponent's services, such that there would be at least some degree of similarity.

The majority of the applicant's class 35 services are also such that they may be provided by a business (such as the opponent) which provides, not only a website platform for its users, but also ancillary services to support their business.

The exception to this is *business investigations; import-export agencies; procurement services for others (purchasing goods and services for other business)* which I consider likely to be provided by specialist businesses and would be dissimilar to the services for which the opponent has a reputation.

Given that you might expect the same undertaking that provides the opponent's services to also provide a platform through which payments can be made/processed, I consider that there is some similarity (even if at a low level) with all of the applicant's class 36 services.

The same is also true in relation to the applicant's class 38 and 39 services, which you might expect the same undertaking to provide (even if this only results in a low degree of similarity).

Given that the opponent's services involve the provision of websites through which businesses can sell to their customers, this will inevitably involve the provision, maintenance and development of non-downloadable software. Consequently, I consider that there is some similarity with the majority of the applicant's class 42 services.

In relation to the applicant's class 45 services, I consider it likely that the same businesses that offer the opponent's services may also offer some assistance with intellectual property matters in an e-commerce setting. Whilst not a social networking service per se, it is reasonably foreseeable that a provider of the opponent's services may also provide some sort of networking service (online) for businesses to connect or for businesses to discuss issues/orders with their customers. Consequently, I consider there is some similarity to a very low degree with the applicant's class 45 services.

The strength of the earlier mark's reputation

The First and Second Earlier Marks have a relatively strong reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The First and Second Earlier Marks have a relatively low degree of inherent distinctive character which has been enhanced through use to between a medium and high degree for the provision of websites and business administration for third parties in the field of ecommerce.

Whether there is a likelihood of confusion

I have found there to be a likelihood of direct and/or indirect confusion, except for the services in class 35 referenced above.

124. Taking into account the extent of the opponent's reputation and the similarities between the marks, I consider that a link would be made in the mind of the public for

all goods and services that I have found to be similar to any degree to those for which the opponent has established a reputation.

Damage

125. I must now consider whether any of the types of damage pleaded will arise.

Unfair advantage

126. The opponent states as follows in its Notices of opposition:

“Due to the reputation of the Opponent’s mark, even if the undertakings are not perceived as connected, the Applicant, by using a similar mark, would be able to ride on the coattails of the Opponent and gain the benefits associated with a reputed and distinctive mark without the associated costs of developing or maintaining such a reputation. By doing so without investing in the development of its own reputation, and instead relying on the existing repute and distinctiveness of the Opponent’s mark (without the Opponent’s consent), the advantage gained by the Applicant would be inherently unfair. The Applicant’s mark, if used, would therefore gain an unfair advantage from the Opponent’s reputation and the distinctiveness of its mark.”

127. I bear in mind that unfair advantage has no effect on the consumers of the earlier marks’ goods and services. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods and services of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

128. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant’s intention. It is clear both from the wording of Article 5(2) of the Directive and

Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

129. The evidence shows that the opponent has a reputation for “excellent customer support”, being “versatile” and being “user-friendly”.⁹ I note that this exhibit is dated after the relevant dates, but in my view, given that this reputation is likely to have been built up over a period of time, this remains relevant in relation to the position at the relevant dates. Clearly, this image is capable of being transferred to the holder’s business. Damage is made out.

130. The section 5(3) ground succeeds in relation to the First and Third IRs for all goods and services, with the exception of those listed in paragraph **113** above. As the section 5(3) case has succeeded on the basis of unfair advantage, there is no need to consider the opponent’s case based on detriment to the earlier marks.

Section 5(4)(a)

131. At the hearing, Mr Cassidy acknowledged that the section 5(2)(b) ground was its strongest case. I agree that this ground does not put the opponent in any stronger position than it already is under the section 5(2)(b) and 5(3) grounds and, consequently, I decline to consider it any further.

⁹ Exhibit 4

CONCLUSION

132. The oppositions against the First, Second and Third IRs are successful in relation to the following goods and services, for which the applications are refused:

Class 9 Computer program for communication devices; computer software applications, downloadable; computer programs [downloadable software]; computer software, recorded; secure terminals for electronic transactions; electronic point of sale terminals; computer e-commerce software to allow users to perform electronic business transactions via a global computer network; internet servers.

Class 35 Administrative processing of purchase orders; advertising services; advertising; business appraisals; business information; business management assistance; business management consultancy; business organization consultancy; business research; commercial information agencies; commercial information and advice for consumers [consumer advice shop]; commercial or industrial management assistance; compilation of advertisements for use as web pages on the internet; compilation of directories for publishing on the internet; compilation of information into computer databases; compilation of statistics; computerised stock management; cost price analysis; data search in computer files for others; dissemination of advertising matter; invoicing; logistics services (business management and organisation of facilities and resources); marketing research; marketing; on-line advertising on a computer network; opinion polling; organisation and management of customer loyalty programs; pay per click advertising; presentation of goods on communication media, for retail purposes; price comparison services; providing business information via a web site; provision of an on-line marketplace for buyers and sellers of goods and services; provision of commercial and business contact information; publication of publicity texts; publicity; rental of advertising time on communication media; sales promotion for others; search engine optimisation; systemization of information into computer databases; the bringing

together, for the benefit of others, of a variety of goods (excluding the transport thereof), namely apparel, footwear, fashion accessories, jewellery, cosmetics, personal care products, electronics and peripherals, pet food and supplies, alcohol, food, beverages, video games, computer software, bags, luggage, wallets, mobile phones, supplements, sporting goods and equipment, furniture, bedding, homeware, kitchenware, stationery and office supplies, drawers and storage products, toys, diapers, milk formula, nursing products, books, musical instruments, CDs, DVDs, home appliances, automotive parts and accessories, enabling customers to conveniently view and purchase those goods from a general merchandise web site in the global communications network; updating and maintenance of data in computer databases; updating of advertising material; web site traffic optimization.

Class 36 Financial services via global communications networks; monetary services via global communications networks; financial electronic transaction services via global communications networks; clearing and reconciling financial transactions electronically via global communications networks; payment administration services via global communications networks; electronic foreign exchange services; financial intermediary services; providing services for making payment on prepaid cards via global communications networks; providing services for making payment on prepaid cards over shop counters; financial services for enabling transfer of funds and purchase of products and services offered by others, all provided via global communications networks.

Class 38 Computer aided transmission of messages and images; electronic bulletin board services [telecommunications services]; electronic mail; information about telecommunication; internet communication services; providing access to databases; providing internet chatrooms; providing online forums; providing on-line communications links which transfer the web site user to other local and global web pages; providing

telecommunication channels for teleshopping services; providing telecommunications connections to a global computer network; providing user access to global computer networks; services for communication by electronic means; services for communication by wireless means; telecommunication services relating to commerce; telecommunication services relating to electronic payments; telecommunication services relating to wireless payments; telecommunication services via computer network in relation to the communication of information between data banks; telecommunications consultancy; transmission of digital files.

Class 39 Courier services [messages or merchandise]; delivery of goods; delivery of goods by mail order; freight [shipping of goods]; freight forwarding; gift wrapping; packaging of goods; physical storage of electronically-stored data or documents; rental of storage containers; rental of warehouses; storage information; storage of goods; transportation information; transportation logistics; warehousing; wrapping of goods.

Class 42 Cloud computing; computer programming; computer security consultancy; computer software consultancy; computer software design; computer system design; computer systems integration services; computer technology consultancy; computer virus protection services; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; data conversion of computer programs and data [not physical conversion]; data encryption and decoding services; design and development of computer programs for mobile phones; design and development of computer software for computers; diagnosis of faults in computer programs; hosting computer sites [web sites]; hosting of software as a service (SaaS); maintenance of computer software relating to computer security and prevention of computer risks; outsource service providers in the field of information technology; providing information on computer technology and programming via a web site; providing search engines for the internet; providing temporary use of on-line non-downloadable authentication

software for communications with computers via global communication network; providing temporary use of on-line non-downloadable software for processing electronic payments; providing temporary use of on-line non-downloadable software for processing wireless payments; providing temporary use of online non-downloadable software for e-commerce; server hosting; software as a service [SaaS]; technological consultancy; telecommunications technology consultancy; troubleshooting of computer software problems [technical support]; updating of computer software relating to computer security and prevention of computer risks; web site design consultancy; web site design; providing user authentication services in e-commerce transactions.

Class 45 On-line social networking services; providing information regarding intellectual property management by intellectual property owners and enforcement policies relating thereto, all in order to assist program participants with inquiries and requests regarding use of intellectual property by others in an online marketplace.

133. The oppositions against the First, Second and Third IRs fail in relation to the following services, for which the applications may proceed to registration:

Class 35 Business investigations; import-export agencies; procurement services for others (purchasing goods and services for other businesses).

COSTS

134. The opponent has enjoyed the greater degree of success. Consequently, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Whilst I note that the opponent has only been partially successful, the proportion of success is so overwhelmingly in favour of the opponent that I do not consider it appropriate to make a reduction to the costs awarded. In the circumstances, I award the opponent the sum of **£3,100**, calculated as follows:

| | |
|--|------|
| Preparing the Notice of opposition and considering | £600 |
|--|------|

the holder's counterstatements

| | |
|---|---------------|
| Preparing and filing evidence | £900 |
| Preparing for and attending the hearing | £1,000 |
| Official fee (x3) | £600 |
| Total | £3,100 |

135. I therefore order Shopee Singapore Private Limited to pay Shopify Inc. the sum of **£3,100**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 9th day of August 2023

S WILSON

For the Registrar

ANNEX 1

The holder seeks protection for the following goods and services:

Class 9

Computer program for communication devices; computer software applications, downloadable; computer programs [downloadable software]; computer software, recorded; secure terminals for electronic transactions; electronic point of sale terminals; computer e-commerce software to allow users to perform electronic business transactions via a global computer network; internet servers.

Class 35

Administrative processing of purchase orders; advertising services; advertising; auctioneering; business appraisals; business information; business investigations; business management assistance; business management consultancy; business organization consultancy; business research; commercial information agencies; commercial information and advice for consumers [consumer advice shop]; commercial intermediation services; commercial or industrial management assistance; compilation of advertisements for use as web pages on the internet; compilation of directories for publishing on the internet; compilation of information into computer databases; compilation of statistics; computerised stock management; cost price analysis; data search in computer files for others; dissemination of advertising matter; import-export agencies; invoicing; logistics services (business management and organisation of facilities and resources); marketing research; marketing; on-line advertising on a computer network; on-line auctioneering; opinion polling; organisation and management of customer loyalty programs; pay per click advertising; presentation of goods on communication media, for retail purposes; price comparison services; procurement services for others (purchasing goods and services for other businesses); providing business information via a web site; provision of an on-line marketplace for buyers and sellers of goods and services; provision of commercial and business contact information; publication of publicity texts; publicity; rental of advertising time on communication media; sales promotion for others; search engine optimisation; systemization of information into computer databases; the bringing together, for the benefit of others, of a variety of goods (excluding the transport

thereof), namely apparel, footwear, fashion accessories, jewellery, cosmetics, personal care products, electronics and peripherals, pet food and supplies, alcohol, food, beverages, video games, computer software, bags, luggage, wallets, mobile phones, supplements, sporting goods and equipment, furniture, bedding, homeware, kitchenware, stationery and office supplies, drawers and storage products, toys, diapers, milk formula, nursing products, books, musical instruments, CDs, DVDs, home appliances, automotive parts and accessories, enabling customers to conveniently view and purchase those goods from a general merchandise web site in the global communications network; updating and maintenance of data in computer databases; updating of advertising material; web site traffic optimization.

Class 36

Financial services via global communications networks; monetary services via global communications networks; financial electronic transaction services via global communications networks; clearing and reconciling financial transactions electronically via global communications networks; payment administration services via global communications networks; electronic foreign exchange services; financial intermediary services; providing services for making payment on prepaid cards via global communications networks; providing services for making payment on prepaid cards over shop counters; financial services for enabling transfer of funds and purchase of products and services offered by others, all provided via global communications networks.

Class 38

Computer aided transmission of messages and images; electronic bulletin board services [telecommunications services]; electronic mail; information about telecommunication; internet communication services; providing access to databases; providing internet chatrooms; providing online forums; providing on-line communications links which transfer the web site user to other local and global web pages; providing telecommunication channels for teleshopping services; providing telecommunications connections to a global computer network; providing user access to global computer networks; services for communication by electronic means; services for communication by wireless means; telecommunication services relating to commerce; telecommunication services relating to electronic payments;

telecommunication services relating to wireless payments; telecommunication services via computer network in relation to the communication of information between data banks; telecommunications consultancy; transmission of digital files.

Class 39

Courier services [messages or merchandise]; delivery of goods; delivery of goods by mail order; freight [shipping of goods]; freight forwarding; gift wrapping; packaging of goods; physical storage of electronically-stored data or documents; rental of storage containers; rental of warehouses; storage information; storage of goods; transportation information; transportation logistics; warehousing; wrapping of goods.

Class 42

Cloud computing; computer programming; computer security consultancy; computer software consultancy; computer software design; computer system design; computer systems integration services; computer technology consultancy; computer virus protection services; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; data conversion of computer programs and data [not physical conversion]; data encryption and decoding services; design and development of computer programs for mobile phones; design and development of computer software for computers; diagnosis of faults in computer programs; hosting computer sites [web sites]; hosting of software as a service (SaaS); maintenance of computer software relating to computer security and prevention of computer risks; outsource service providers in the field of information technology; providing information on computer technology and programming via a web site; providing search engines for the internet; providing temporary use of on-line non-downloadable authentication software for communications with computers via global communication network; providing temporary use of on-line non-downloadable software for processing electronic payments; providing temporary use of on-line non-downloadable software for processing wireless payments; providing temporary use of online non-downloadable software for e-commerce; server hosting; software as a service [SaaS]; technological consultancy; telecommunications technology consultancy; troubleshooting of computer software problems [technical support]; updating of computer software relating to computer security and prevention of

computer risks; web site design consultancy; web site design; providing user authentication services in e-commerce transactions.

Class 45

On-line social networking services; providing information regarding intellectual property management by intellectual property owners and enforcement policies relating thereto, all in order to assist program participants with inquiries and requests regarding use of intellectual property by others in an online marketplace.

ANNEX 2

The opponent relies upon the following goods and services:

The First and Second Earlier Marks

Class 9

Downloadable software for use in e-commerce and the retail industry to allow users to perform business management via a global computer network, namely, database management, sales and customer tracking and inventory management; downloadable software for use in e-commerce and the retail industry, namely, software for point of sale transactions; downloadable application programming interface (API) software that enables developers to build software applications for use in the retail and e-commerce industry; Point of sale terminals; Card readers for credit and debit cards; Chip card readers; Magnetic encoded card readers; Downloadable software development kits (SDK); downloadable computer software development tools; downloadable computer software for the scripting of markup language; downloadable software for use in e-commerce and the retail industry, namely, software for supply chain management, drop shipping, product development and customizations; downloadable software for use in e-commerce and the retail industry to allow users to perform business management via a global computer network, namely, product pricing automation, tracking sales performance, order fulfillment, shipment tracking, database management, sales and customer tracking and inventory customization and management; downloadable software for use in managing business contacts, information and relationships; downloadable software for managing contact information of third parties, for capturing, recording, organizing and managing business transactions, and for managing social interactions between individuals related to business relationships; downloadable software for messaging and communications; downloadable educational software featuring instruction in ecommerce, business development and management, advertising, digital marketing, website design, and customer service; downloadable software for point-of-sale (POS) transactions, tracking sales performance, and managing customers, orders, and inventory; downloadable software for online shopping, tracking deliveries, use as a digital wallet, and discovering local businesses; downloadable software for online promotion, advertising and marketing, namely for search engine and web site

optimization, targeted and retargeting advertising, electronic messaging and text marketing, customer data management, and customer relationship management; downloadable software for advertising by transmission of on-line publicity for third parties through electronic communications networks; downloadable software for advertising on the Internet for others; downloadable software for advertising the goods and services of others via electronic media and specifically the internet; downloadable software for compilation of advertisements for use as web pages on the internet, dissemination of advertising for others via the Internet; downloadable software for on-line advertising for others on computer networks and placing advertisements for others; downloadable software for providing electronic commerce services in association with on-line live stream shopping; downloadable software for use in generating streaming advertisements on the web sites of others; downloadable software for use in e-commerce and the retail industry that provides carbon offset information for product deliveries.

Class 35

Business management and marketing consulting; business management services for online stores; business management services relating to information and data compilation and analysis; business marketing consulting; Promoting, advertising and marketing online web sites of others; targeted and retargeting advertising services; promoting and marketing the goods and services of others via electronic messaging and text messaging; customer data management services; customer relationship management services; Optimization of online websites for third parties; search engine and web site optimization; Operating online marketplaces for sellers and buyers of goods and/or services; arranging and conducting business conferences; business management services relating to supply chain management; business management services relating to drop shipping; business management services relating to product development and customizations; business management and marketing consultation; business management services for online stores; business marketing consultation; business management consultancy; business management assistance; marketing services; provision of an online marketplace for buyers and sellers of goods and services; providing business information via a website; Providing online business account administration service for others in the field of web hosting; business services, namely, customer services for others in the nature of providing assistance to

customers in the field of hosting ecommerce, social commerce, retail and marketing websites; business services, namely, customer services for others in the nature of providing assistance to customers in the field of hosting ecommerce, social commerce, retail and marketing websites, hosting software applications, hosting computer software, hosting electronic databases, hosting digital content, and hosting business computer software applications of others accessible via the Internet; business services, namely, customer services for others in the nature of providing assistance to customers in the field of leasing, configuring, updating, monitoring, optimizing, repairing and troubleshooting computer servers and other computer hardware that support hosted ecommerce, social commerce, retail and marketing websites, hosted software applications, hosted computer software, hosted electronic databases, hosted digital content, and hosted business computer software applications of others accessible via the Internet; business services, namely, customer services for others in the nature of providing assistance to customers in the field of bandwidth provision to ecommerce, social commerce, retail and marketing websites; business services, namely, customer services for others in the nature of providing assistance to customers in the field of managed data storage, backup and restoration of ecommerce, social commerce, retail and marketing websites; business services, namely, customer services for others in the nature of providing assistance to customers in the field of network security management for ecommerce, social commerce, retail and marketing websites; Marketing the goods and services of others by means of location-based advertising; on-line advertising and marketing services; advertising, marketing and promotion services; advertising by transmission of on-line publicity for third parties through electronic communications networks; advertising on the Internet for others; advertising the goods and services of others via electronic media and specifically the internet; compilation of advertisements for use as web pages on the internet; dissemination of advertising for others via the Internet; on-line advertising for others on computer networks; placing advertisements for others; providing electronic commerce services in association with on-line live stream shopping; dissemination of streaming advertisements for use on the web sites of others; order fulfilment services; Computerized tracking and tracing of packages in transit to ensure on-time delivery for business purposes.

Class 36

Cash advance services for businesses and merchants; Providing electronic processing of credit card transactions and electronic payments via a global computer network; Loan services; Financial account services for businesses and merchants; Payment services, namely, processing of credit card and debit card payments initiated via mobile electronic devices and digital wallets; Gift card transaction processing services; financial information processing; accepting, processing, and reconciling credit card, debit card, gift card and other forms of payment transactions via a global computer network; accepting, processing, and reconciling credit card, debit card, gift card and other forms of payment transactions; insurance services, namely, coverage services for loss or damage during shipment of goods of others; providing extended warranty service contracts on consumer goods of others.

Class 38

Communication transmissions through internet platforms and portals; transmission of information on various topics via online and global computer networks; computer transmission of messages; transmission (uploading, posting or display) of data, information, pictures, images via online forums, audio and video; provide online computer information inventory; provide online forums; consulting services related to communication transmission; computer communication services; point-of-sale communication transmission services; provide online communication to transfer website users to other regional web pages and global web pages transmission link; electronic messaging services; instant messaging services; video streaming of video material on the internet.

Class 39

Parcel shipping services; freight forwarding services; delivery of goods; providing shipping and delivery information.

Class 41

Arranging and conducting educational conferences; educational services, namely, developing, arranging, and conducting educational conferences and programs in the fields of e-commerce and technology; Providing on-line training courses, seminars, and workshops in the field of e-commerce, business management, advertising, digital marketing, website design, and customer service; entertainment services in the nature

of creation, development, and production of television programming; entertainment in the nature of ongoing television programs in the field of e-commerce, business management, and entrepreneurship; providing television programs, not downloadable, via video-on-demand transmission services; entertainment services, namely, production and distribution of ongoing television programs in the field of e-commerce, business management, and entrepreneurship; entertainment, namely, a continuing educational and reality shows broadcast over internet, television, and video media.

Class 42

Creation of online retail stores for others in the nature of web-based service that allows users to create hosted e-commerce stores to sell their goods and services online; providing an online platform featuring technology that enables users to create a unique URL for an online store and the ability for users to manage the content and inventory of their online store; design, creation, hosting and maintenance of internet sites for third parties; Software as a Service (SAAS) featuring software for use in e-commerce and the retail industry to allow users to perform electronic business transactions via a global computer network; Software as a Service (SAAS) services featuring software for use in database management, sales and customer tracking and management, and inventory management for the retail industry; providing an online platform featuring online non-downloadable computer software for use in the retail and e-commerce industry for facilitating retail store services; Software support services, namely, technical support services in the nature of troubleshooting of computer software problems; Technical support services, namely, troubleshooting of computer software problems; software as a service (SAAS) services, namely, hosting software for use by others for use as a software code translation service; application service provider featuring software for use as a software code translation service; Software as a service (SAAS) services featuring software for computer software development tools; providing temporary use of non-downloadable computer software development tools and computer software for the scripting of markup language; software as a service (SaaS) services featuring software for use in e-commerce and the retail industry, namely, software for supply chain management, drop shipping, and product development and customizations; software as a service (SaaS) services featuring software for use in e-commerce and the retail industry, namely, software to allow users

to perform business management via a global computer network, namely, product pricing automation, tracking sales performance, order fulfillment, shipment tracking, database management, sales and customer tracking and inventory customization and management; providing temporary use of non-downloadable computer software for use in managing business contacts, information and relationships; providing temporary use of non-downloadable computer software for managing contact information of third parties, for capturing, recording, organizing and managing business transactions, and for managing social interactions between individuals related to business relationships; Computer services in the nature of providing customized web pages and other data feed formats featuring user-defined information; providing temporary use of online non-downloadable software for customer relationship management and customer data management; providing temporary use of non-downloadable software for messaging and communications; providing temporary use of non-downloadable educational software featuring instruction in ecommerce, business development and management, advertising, digital marketing, website design, and customer service; providing temporary use of non-downloadable software for point-of-sale (POS) transactions, tracking sales performance, and managing customers, orders, and inventory; providing temporary use of non-downloadable software for online shopping, tracking deliveries, use as a digital wallet, and discovering local businesses; providing temporary use of non-downloadable software for online promotion, advertising and marketing, namely for search engine and web site optimization, targeted and retargeting advertising, electronic messaging and text marketing, customer data management, and customer relationship management; providing temporary use of non-downloadable software for advertising by transmission of on-line publicity for third parties through electronic communications networks; providing temporary use of non-downloadable software for advertising on the Internet for others; providing temporary use of non-downloadable software for advertising the goods and services of others via electronic media and specifically the internet; providing temporary use of non-downloadable software for compilation of advertisements for use as web pages on the internet, dissemination of advertising for others via the Internet; providing temporary use of non-downloadable software for on-line advertising for others on computer networks and placing advertisements for others; providing temporary use of non-downloadable software for providing electronic commerce services in association with on-line live stream shopping; providing

temporary use of non-downloadable software for use in generating streaming advertisements on the web sites of others; software as a service (SaaS) services featuring software for use in e-commerce and the retail industry that provides carbon offset information for product deliveries.

The Third Earlier Mark

Class 9

Downloadable software for use in e-commerce and the retail industry to allow users to perform business management via a global computer network, namely, database management, sales and customer tracking and inventory management; downloadable software for use in e-commerce and the retail industry, namely, software for point of sale transactions; downloadable application programming interface (API) software that enables developers to build software applications for use in the retail and e-commerce industry; Point of sale terminals; Card readers for credit and debit cards; Chip card readers; Magnetic encoded card readers; Downloadable software development kits (SDK); downloadable computer software development tools; downloadable computer software for the scripting of markup language; downloadable software for use in e-commerce and the retail industry, namely, software for supply chain management, drop shipping, product development and customizations; downloadable software for use in e-commerce and the retail industry to allow users to perform business management via a global computer network, namely, product pricing automation, tracking sales performance, order fulfillment, shipment tracking, database management, sales and customer tracking and inventory customization and management; downloadable software for use in managing business contacts, information and relationships; downloadable software for managing contact information of third parties, for capturing, recording, organizing and managing business transactions, and for managing social interactions between individuals related to business relationships; downloadable software for messaging and communications; downloadable educational software featuring instruction in ecommerce, business development and management, advertising, digital marketing, website design, and customer service; downloadable software for point-of-sale (POS) transactions, tracking sales performance, and managing customers, orders, and inventory; downloadable software for online shopping, tracking deliveries, use as a digital wallet, and discovering local businesses; downloadable software for online

promotion, advertising and marketing, namely for search engine and web site optimization, targeted and retargeting advertising, electronic messaging and text marketing, customer data management, and customer relationship management; downloadable software for advertising by transmission of on-line publicity for third parties through electronic communications networks; downloadable software for advertising on the Internet for others; downloadable software for advertising the goods and services of others via electronic media and specifically the internet; downloadable software for compilation of advertisements for use as web pages on the internet, dissemination of advertising for others via the Internet; downloadable software for on-line advertising for others on computer networks and placing advertisements for others; downloadable software for providing electronic commerce services in association with on-line live stream shopping; downloadable software for use in generating streaming advertisements on the web sites of others; downloadable software for use in e-commerce and the retail industry that provides carbon offset information for product deliveries.

Class 35

Business management and marketing consulting; business management services for online stores; business management services relating to information and data compilation and analysis; business marketing consulting; Promoting, advertising and marketing online web sites of others; targeted and retargeting advertising services; promoting and marketing the goods and services of others via electronic messaging and text messaging; customer data management services; customer relationship management services; Optimization of online websites for third parties; search engine and web site optimization; Operating online marketplaces for sellers and buyers of goods and/or services; arranging and conducting business conferences; business management services relating to supply chain management; business management services relating to drop shipping; business management services relating to product development and customizations; business management and marketing consultation; business management services for online stores; business marketing consultation; business management consultancy; business management assistance; marketing services; provision of an online marketplace for buyers and sellers of goods and services; providing business information via a website; Providing online business account administration service for others in the field of web hosting; business services,

namely, customer services for others in the nature of providing assistance to customers in the field of hosting ecommerce, social commerce, retail and marketing websites; business services, namely, customer services for others in the nature of providing assistance to customers in the field of hosting ecommerce, social commerce, retail and marketing websites, hosting software applications, hosting computer software, hosting electronic databases, hosting digital content, and hosting business computer software applications of others accessible via the Internet; business services, namely, customer services for others in the nature of providing assistance to customers in the field of leasing, configuring, updating, monitoring, optimizing, repairing and troubleshooting computer servers and other computer hardware that support hosted ecommerce, social commerce, retail and marketing websites, hosted software applications, hosted computer software, hosted electronic databases, hosted digital content, and hosted business computer software applications of others accessible via the Internet; business services, namely, customer services for others in the nature of providing assistance to customers in the field of bandwidth provision to ecommerce, social commerce, retail and marketing websites; business services, namely, customer services for others in the nature of providing assistance to customers in the field of managed data storage, backup and restoration of ecommerce, social commerce, retail and marketing websites; business services, namely, customer services for others in the nature of providing assistance to customers in the field of network security management for ecommerce, social commerce, retail and marketing websites; Marketing the goods and services of others by means of location-based advertising; on-line advertising and marketing services; advertising, marketing and promotion services; advertising by transmission of on-line publicity for third parties through electronic communications networks; advertising on the Internet for others; advertising the goods and services of others via electronic media and specifically the internet; compilation of advertisements for use as web pages on the internet; dissemination of advertising for others via the Internet; on-line advertising for others on computer networks; placing advertisements for others; dissemination of streaming advertisements for use on the web sites of others; order fulfilment services; provide online computer information inventory;.

Class 36

Cash advance services for businesses and merchants; Providing electronic processing of credit card transactions and electronic payments via a global computer network; Loan services; Financial account services for businesses and merchants; Payment services, namely, processing of credit card and debit card payments initiated via mobile electronic devices and digital wallets; Gift card transaction processing services; financial information processing; accepting, processing, and reconciling credit card, debit card, gift card and other forms of payment transactions via a global computer network; accepting, processing, and reconciling credit card, debit card, gift card and other forms of payment transactions; insurance services, namely, coverage services for loss or damage during shipment of goods of others; providing extended warranty service contracts on consumer goods of others.

Class 38

Communication transmissions through internet platforms and portals; transmission of information on various topics via online and global computer networks; computer transmission of messages; transmission (uploading, posting or display) of data, information, pictures, images via online forums, audio and video; provide online forums; consulting services related to communication transmission; computer communication services; point-of-sale communication transmission services; provide online communication to transfer website users to other regional web pages and global web pages transmission link; electronic messaging services; instant messaging services; video streaming of video material on the internet.

Class 39

Parcel shipping services; freight forwarding services; delivery of goods; providing shipping and delivery information; Computerized tracking and tracing of packages in transit to ensure on-time delivery for business purposes;.

Class 41

Arranging and conducting educational conferences; educational services, namely, developing, arranging, and conducting educational conferences and programs in the fields of e-commerce and technology; Providing on-line training courses, seminars, and workshops in the field of e-commerce, business management, advertising, digital marketing, website design, and customer service; entertainment services in the nature

of creation, development, and production of television programming; entertainment in the nature of ongoing television programs in the field of e-commerce, business management, and entrepreneurship; providing television programs, not downloadable, via video-on-demand transmission services; entertainment services, namely, production and distribution of ongoing television programs in the field of e-commerce, business management, and entrepreneurship; entertainment, namely, a continuing educational and reality shows broadcast over internet, television, and video media.

Class 42

Creation of online retail stores for others in the nature of web-based service that allows users to create hosted e-commerce stores to sell their goods and services online; providing an online platform featuring technology that enables users to create a unique URL for an online store and the ability for users to manage the content and inventory of their online store; design, creation, hosting and maintenance of internet sites for third parties; Software as a Service (SAAS) featuring software for use in e-commerce and the retail industry to allow users to perform electronic business transactions via a global computer network; Software as a Service (SAAS) services featuring software for use in database management, sales and customer tracking and management, and inventory management for the retail industry; providing an online platform featuring online non-downloadable computer software for use in the retail and e-commerce industry for facilitating retail store services; Software support services, namely, technical support services in the nature of troubleshooting of computer software problems; Technical support services, namely, troubleshooting of computer software problems; software as a service (SAAS) services, namely, hosting software for use by others for use as a software code translation service; application service provider featuring software for use as a software code translation service; Software as a service (SAAS) services featuring software for computer software development tools; providing temporary use of non-downloadable computer software development tools and computer software for the scripting of markup language; software as a service (SaaS) services featuring software for use in e-commerce and the retail industry, namely, software for supply chain management, drop shipping, and product development and customizations; software as a service (SaaS) services featuring software for use in e-commerce and the retail industry, namely, software to allow users

to perform business management via a global computer network, namely, product pricing automation, tracking sales performance, order fulfillment, shipment tracking, database management, sales and customer tracking and inventory customization and management; providing temporary use of non-downloadable computer software for use in managing business contacts, information and relationships; providing temporary use of non-downloadable computer software for managing contact information of third parties, for capturing, recording, organizing and managing business transactions, and for managing social interactions between individuals related to business relationships; Computer services in the nature of providing customized web pages and other data feed formats featuring user-defined information; providing temporary use of online non-downloadable software for customer relationship management and customer data management; providing temporary use of non-downloadable software for messaging and communications; providing temporary use of non-downloadable educational software featuring instruction in ecommerce, business development and management, advertising, digital marketing, website design, and customer service; providing temporary use of non-downloadable software for point-of-sale (POS) transactions, tracking sales performance, and managing customers, orders, and inventory; providing temporary use of non-downloadable software for online shopping, tracking deliveries, use as a digital wallet, and discovering local businesses; providing temporary use of non-downloadable software for online promotion, advertising and marketing, namely for search engine and web site optimization, targeted and retargeting advertising, electronic messaging and text marketing, customer data management, and customer relationship management; providing temporary use of non-downloadable software for advertising by transmission of on-line publicity for third parties through electronic communications networks; providing temporary use of non-downloadable software for advertising on the Internet for others; providing temporary use of non-downloadable software for advertising the goods and services of others via electronic media and specifically the internet; providing temporary use of non-downloadable software for compilation of advertisements for use as web pages on the internet, dissemination of advertising for others via the Internet; providing temporary use of non-downloadable software for on-line advertising for others on computer networks and placing advertisements for others; providing temporary use of non-downloadable software for providing electronic commerce services in association with on-line live stream shopping; providing

temporary use of non-downloadable software for use in generating streaming advertisements on the web sites of others; software as a service (SaaS) services featuring software for use in e-commerce and the retail industry that provides carbon offset information for product deliveries.