

O/0784/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003707599
IN THE NAME OF RIBBON TECHNOLOGIES LTD
FOR THE TRADE MARK**



IN CLASS 9, 35, 38 AND 42

AND

**THE OPPOSITION THERETO UNDER NO. 430577
BY RIBBON COMMUNICATIONS OPERATING COMPANY, INC.**

Background and pleadings

1. On 07 October 2021, RIBBON TECHNOLOGIES LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 05 November 2021. The goods and services for which registration is sought are as follows:

Class 9: *Interactive software; Computer software to facilitate communication between businesses and customers; Computer software for evaluating customer behaviour in online shops; Computer software for carrying out product research; Computer software for carrying out market research.*

Class 35: *Market research services; Market research analysis; Market research services regarding customer satisfaction; Organisation, operation and supervision of market research services; Conducting market surveys; Opinion polling and feedback; Business research and surveys; Online consumer feedback management services for consumers and businesses, namely, allowing consumers to submit feedback regarding the products and services of others by linking them with companies.*

Class 38: *Telecommunication services; Provision of online forums; Provision of an online, interactive bulletin board for the collection of consumer feedback; Provision of online chatrooms for the transmission of messages; Provision of an online forum for consumers to provide feedback to companies; Provision of online facilities to businesses for real-time interaction with consumers.*

Class 42: *Product testing; Product research; Programming of software for market research purposes; Programming of software for evaluating customer behaviour in online shops; Software as a service (saas); Hosting online facilities for conducting interactive discussions.*

2. On 27 January 2022, RIBBON TECHNOLOGIES LTD (“the opponent”) opposed the application under Sections 5(2)(b) of the Trade Marks Act 1994 (“the Act”) based upon the trade marks shown below:

UK00003294471 (“the first earlier mark”)

RIBBON

Filing date: 5 March 2018; Registration date: 10 July 2020

Priority date: 15 September 2017; Priority country: United States of America: TM
from which priority claimed: 87610391

The opponent relies upon the goods and services for which the mark is registered, namely:

Class 9: *Communications equipment, namely, switches, media gateways, application servers for providing migration of voice traffic from a circuit network onto a data network, and computer software for controlling communications switches; Computer software for performing active and passive monitoring of voice service quality through deep packet inspection in an Internet telephony network; Downloadable software platform for use in analyzing and securing IP communications networks; Downloadable software applications for use in analyzing and securing IP communications networks; Computer security software; Computer software for use in monitoring, protecting, controlling, and securing application programming interfaces (APIs) used by businesses; Computer software for use in providing visibility and management of digital services and application programming interfaces (APIs) used by businesses; Computer software for protecting and controlling access to digital assets, data, and digital services; Computer software for enforcing data security policies, preventing data loss, and ensuring compliance with data security policies and procedures; Computer software for use in controlling calls in unified communications, voice mail and rich messaging applications; Computer hardware and software for control, signaling, security, and management of communication equipment and networks; Communication network hardware, namely, servers, routers, switches, devices, namely, hubs, session border controllers, media gateways in the nature of computer control hardware, and computer software and hardware for communication service applications, call, session border, and security control, and management of communication networks; Network computer software for routing, switching, and controlling communication*

service applications, call, session border and security control, and management of communication networks and network elements; Computer software for managing telecommunications service providers' service assurance agreements; Billing software and analytics software for telecommunications service providers; Communications software, namely, software for providing fault, performance and configuration management for gateway routers, network adaptors, switches, routers, and hubs; Computer software for network functions and lifecycle management and orchestration of communications functions for cloud computing communications networks; Computer software for enabling video conferencing, mobile messaging and virtual network functions; Downloadable Application Programming Interfaces (APIs) software and Software Development Kits (SDKs) for programming by applications developers for enabling collaborative communications services and embedded communications.

Class 38: *Technical consultation in the field of the operation and use of communications equipment; Over the top communications services for consumers in the nature of communication by electronic computer terminals.*

Class 42: *Software as a Service (SAAS) services featuring software for use in analyzing and securing IP communications networks; Cloud computing featuring software for use in analyzing and securing IP communications networks; Design for others in the field of communications; Updating and upgrading of computer software; Leasing of communications equipment software and hardware; Providing on-line, non-downloadable computer security software; Software as a Service (SAAS) services featuring software for use in monitoring, protecting, controlling, and securing application programming interfaces (APIs) used by businesses; Software as a Service (SAAS) services featuring software for use in providing visibility and management of digital services and application programming interfaces (APIs) used by businesses; Software as a Service (SAAS) services featuring software for protecting and controlling access to digital assets, data, and digital services; Software as a Service (SAAS) services featuring software for enforcing data security policies, preventing data loss, and ensuring compliance with data security policies and procedures; Computer security threat and risk analysis for protecting data;*

Computer security services, namely, restricting unauthorized access to digital assets, data, and digital services; Software as a Service (SAAS) services featuring software for use in controlling calls in unified communications, voice mail and rich messaging applications; Software as a Service (SAAS) services featuring software for use in enabling application programming interfaces (APIs), subroutines and wrappers to be embedded in internet applications to enable unified communications services to be provided over cloud networks or hosted infrastructures; Software as a Service (SAAS) services for enabling video conferencing, mobile messaging and virtual network functions; Unified Communications as a Service (UCaaS) services and Communications Platform as a Service (CPaaS) services, namely, featuring cloud computing services in the nature of cloud-based software for use in enabling communications network services, business calling connectivity services (SIP Trunking), and computer software applications for enabling business communications for calls, messaging, collaboration, chat, video, and contact center over data networks; Over the top communications services for consumers, namely, design of unified communication services for consumers; Software as a Service (SAAS) services featuring Application Programming Interfaces (APIs) software and online non-downloadable Software Development Kits (SDKs) for use by application developers for programming and for enabling collaborative communications services and embedded communications; Design and development of computer hardware and software; Computer software development and product development in the field of telecommunications technology; Maintenance of computer software in the field of telecommunications technology; Technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems, and technical advice related to the repair of computer software; Consulting in the field of telecommunications technology; Computer services, namely, providing an online computer database featuring information regarding computer software and hardware design and development; Design for others in the field of communications, namely, design of Unified Communications services, Embedded Communications services, Fixed, mobile and web based communications systems, software and clients, and corresponding administration user interfaces in the field of telecommunications technology.

UK00917868666 (“the second earlier mark”)



Filing date: 6 March 2018; Registration date: 1 September 2018

Priority date: 17 November 2017; Priority country: United States of America: TMs from which priority claimed: 87690045, 87690046, 87690047

The opponent relies upon the goods and services for which the mark is registered, namely:

Class 9: *Communications equipment, namely, switches, media gateways, application servers for providing migration of voice traffic from a circuit network onto a data network, and computer software for controlling communications switches; computer software for performing active and passive monitoring of voice service quality through deep packet inspection in an internet telephony network; downloadable software platform for use in analyzing and securing ip communications networks; downloadable software applications for use in analyzing and securing ip communications networks; computer security software; computer software for use in monitoring, protecting, controlling, and securing application programming interfaces (apis) used by businesses; computer software for use in providing visibility and management of digital services and application programming interfaces (apis) used by businesses; computer software for protecting and controlling access to digital assets, data, and digital services; computer software for enforcing data security policies, preventing data loss, and ensuring compliance with data security policies and procedures; computer software for use in controlling calls in unified communications, voice mail and rich messaging applications; computer hardware and software for control, signaling, security, and management of communication equipment and networks; communication network hardware, namely, servers, routers, switches, devices, namely, hubs, session border controllers, media gateways in the nature of computer control hardware, and*

computer software and hardware for communication service applications, call, session border, and security control, and management of communication networks; network computer software for routing, switching, and controlling communication service applications, call, session border and security control, and management of communication networks and network elements; computer software for managing telecommunications service providers' service assurance agreements; billing software and analytics software for telecommunications service providers; communications software, namely, software for providing fault, performance and configuration management for gateway routers, network adaptors, switches, routers, and hubs; computer software for network functions and lifecycle management and orchestration of communications functions for cloud computing communications networks; computer software for enabling video conferencing, mobile messaging and virtual network functions; downloadable application programming interfaces (apis) software and software development kits (sdks) for programming by applications developers for enabling collaborative communications services and embedded communications.

Class 38: *Over the top communications services for consumers in the nature of communication by electronic computer terminals.*

Class 42: *Software as a service (saas) services featuring software for use in analyzing and securing ip communications networks; cloud computing featuring software for use in analyzing and securing ip communications networks; design for others in the field of communications; updating and upgrading of computer software; leasing of communications equipment software and hardware; providing on-line, non-downloadable computer security software; software as a service (saas) services featuring software for use in monitoring, protecting, controlling, and securing application programming interfaces (apis) used by businesses; software as a service (saas) services featuring software for use in providing visibility and management of digital services and application programming interfaces (apis) used by businesses; software as a service (saas) services featuring software for protecting and controlling access to digital assets, data, and digital services; software as a service (saas) services featuring software for enforcing data security*

policies, preventing data loss, and ensuring compliance with data security policies and procedures; computer security threat and risk analysis for protecting data; computer security services, namely, restricting unauthorized access to digital assets, data, and digital services; software as a service (saas) services featuring software for use in controlling calls in unified communications, voice mail and rich messaging applications; software as a service (saas) services featuring software for use in enabling application programming interfaces (apis), subroutines and wrappers to be embedded in internet applications to enable unified communications services to be provided over cloud networks or hosted infrastructures; software as a service (saas) services for enabling video conferencing, mobile messaging and virtual network functions; unified communications as a service (ucaas) services and communications platform as a service (cpaas) services, namely, featuring cloud computing services in the nature of cloud-based software for use in enabling communications network services, business calling connectivity services (sip trunking), and computer software applications for enabling business communications for calls, messaging, collaboration, chat, video, and contact center over data networks; over the top communications services for consumers, namely, design of unified communication services for consumers; software as a service (saas) services featuring application programming interfaces (apis) software and online non-downloadable software development kits (sdks) for use by application developers for programming and for enabling collaborative communications services and embedded communications; design and development of computer hardware and software; computer software development and product development in the field of telecommunications technology; maintenance of computer software in the field of telecommunications technology; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems, and technical advice related to the repair of compute software; consulting in the field of telecommunications technology; computer services, namely, providing an online computer database featuring information regarding computer software and hardware design and development; design for others in the field of communications, namely, design of unified communications services, embedded communications services, fixed, mobile and web based communications systems, software and clients, and corresponding administration user interfaces in the field of

telecommunications technology; Technical consultation in the field of the operation and use of communications equipment.

UK00917868457 (“the third earlier mark”)

RIBBON

Filing date: 05 March 2018; Registration date: 25 August 2018

Priority date: 15 September 2017; Priority country: United States of America; TM from which priority claimed: 87610391

The opponent relies upon the goods and services for which the mark is registered, namely:

Class 9: *Communications equipment, namely, switches, media gateways, application servers for providing migration of voice traffic from a circuit network onto a data network, and computer software for controlling communications switches; computer software for performing active and passive monitoring of voice service quality through deep packet inspection in an internet telephony network; downloadable software platform for use in analyzing and securing ip communications networks; downloadable software applications for use in analyzing and securing ip communications networks; computer security software; computer software for use in monitoring, protecting, controlling, and securing application programming interfaces (apis) used by businesses; computer software for use in providing visibility and management of digital services and application programming interfaces (apis) used by businesses; computer software for protecting and controlling access to digital assets, data, and digital services; computer software for enforcing data security policies, preventing data loss, and ensuring compliance with data security policies and procedures; computer software for use in controlling calls in unified communications, voice mail and rich messaging applications; computer hardware and software for control, signaling, security, and management of communication equipment and networks; communication network hardware, namely, servers, routers, switches, devices, namely, hubs, session border controllers, media gateways in the nature of computer control hardware, and computer software and hardware for communication service applications, call, session border, and security control, and management of communication networks;*

network computer software for routing, switching, and controlling communication service applications, call, session border and security control, and management of communication networks and network elements; computer software for managing telecommunications service providers' service assurance agreements; billing software and analytics software for telecommunications service providers; communications software, namely, software for providing fault, performance and configuration management for gateway routers, network adaptors, switches, routers, and hubs; computer software for network functions and lifecycle management and orchestration of communications functions for cloud computing communications networks; computer software for enabling video conferencing, mobile messaging and virtual network functions; downloadable application programming interfaces (apis) software and software development kits (sdks) for programming by applications developers for enabling collaborative communications services and embedded communications.

Class 38: *Over the top communications services for consumers in the nature of communication by electronic computer terminals.*

Class 42: *Software as a service (saas) services featuring software for use in analyzing and securing ip communications networks; cloud computing featuring software for use in analyzing and securing ip communications networks; design for others in the field of communications; updating and upgrading of computer software; leasing of communications equipment software and hardware; providing on-line, non-downloadable computer security software; software as a service (saas) services featuring software for use in monitoring, protecting, controlling, and securing application programming interfaces (apis) used by businesses; software as a service (saas) services featuring software for use in providing visibility and management of digital services and application programming interfaces (apis) used by businesses; software as a service (saas) services featuring software for protecting and controlling access to digital assets, data, and digital services; software as a service (saas) services featuring software for enforcing data security policies, preventing data loss, and ensuring compliance with data security policies and procedures; computer security threat and risk analysis for protecting data;*

computer security services, namely, restricting unauthorized access to digital assets, data, and digital services; software as a service (saas) services featuring software for use in controlling calls in unified communications, voice mail and rich messaging applications; software as a service (saas) services featuring software for use in enabling application programming interfaces (apis), subroutines and wrappers to be embedded in internet applications to enable unified communications services to be provided over cloud networks or hosted infrastructures; software as a service (saas) services for enabling video conferencing, mobile messaging and virtual network functions; unified communications as a service (ucaas) services and communications platform as a service (cpaas) services, namely, featuring cloud computing services in the nature of cloud-based software for use in enabling communications network services, business calling connectivity services (sip trunking), and computer software applications for enabling business communications for calls, messaging, collaboration, chat, video, and contact center over data networks; over the top communications services for consumers, namely, design of unified communication services for consumers; software as a service (saas) services featuring application programming interfaces (apis) software and online non-downloadable software development kits (sdks) for use by application developers for programming and for enabling collaborative communications services and embedded communications; design and development of computer hardware and software; computer software development and product development in the field of telecommunications technology; maintenance of computer software in the field of telecommunications technology; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems, and technical advice related to the repair of compute software; consulting in the field of telecommunications technology; computer services, namely, providing an online computer database featuring information regarding computer software and hardware design and development; design for others in the field of communications, namely, design of unified communications services, embedded communications services, fixed, mobile and web based communications systems, software and clients, and corresponding administration user interfaces in the field of telecommunications technology; Technical consultation in the field of the operation and use of communications equipment.

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent's second and third and earlier marks were automatically converted into comparable UK trade marks. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. The opponent claims that the marks are highly similar and that the goods and services are identical or highly similar, giving rise to a likelihood of confusion.

5. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to Section 6 of the Act. As the opponent's marks have not completed their registration process more than 5 years before the application date of the contested mark, they are not subject to the proof of use provisions contained in Section 6A of the Act. The opponent can, therefore, rely on all the goods and services covered by its registrations.

6. The applicant filed a defence and counterstatement, denying the claims made.

7. Neither side filed evidence. No hearing was requested, but both parties filed submissions in lieu of a hearing. I make this decision following a careful consideration of the papers.

8. The opponent is represented by Tomkins & Co and the applicant by Harper James.

EU Law

9. 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 Trade Marks Act relied on 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.

DECISION

Section 5(2)(b)

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

“A trade mark shall not be registered if because-
[...]

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

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

11. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

12. 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

13. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

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

14. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- (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.

15. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

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

17. 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 the goods/services is to assess whether the relevant public are liable to believe that the 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.”

18. 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”

19. The opponent’s three earlier marks cover identical specifications in class 9. The specifications in class 38 differ only insofar as the first earlier mark has a broader specification and contains the additional services *technical consultation in the field of the operation and use of communications equipment*. The specifications in class 42 are nearly identical, save for the second and third earlier mark which contain the additional services *technical consultation in the field of the operation and use of communications equipment*. I will therefore limit my consideration to the first and third earlier marks which contain the additional term *technical consultation in the field of the operation and use of communications equipment*, in class 38 and 42 respectively, and cover the word-only mark ‘RIBBON’ which is closer to the applicant’s mark than the second earlier mark.

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

The applicant’s goods and services	The opponent’s goods and services
<p>Class 9: <i>Interactive software; Computer software to facilitate communication between businesses and customers; Computer software for evaluating customer behaviour in online shops; Computer software for carrying out product research; Computer software for carrying out market research.</i></p>	<p>Class 9: <i>Communications equipment, namely, switches, media gateways, application servers for providing migration of voice traffic from a circuit network onto a data network, and computer software for controlling communications switches; Computer software for performing active and passive monitoring of voice service</i></p>

	<p><i>quality through deep packet inspection in an Internet telephony network; Downloadable software platform for use in analyzing and securing IP communications networks; Downloadable software applications for use in analyzing and securing IP communications networks; Computer security software; Computer software for use in monitoring, protecting, controlling, and securing application programming interfaces (APIs) used by businesses; Computer software for use in providing visibility and management of digital services and application programming interfaces (APIs) used by businesses; Computer software for protecting and controlling access to digital assets, data, and digital services; Computer software for enforcing data security policies, preventing data loss, and ensuring compliance with data security policies and procedures; Computer software for use in controlling calls in unified communications, voice mail and rich messaging applications; Computer hardware and software for control, signaling, security, and management of communication equipment and networks; Communication network hardware, namely, servers, routers, switches, devices, namely, hubs, session border controllers, media</i></p>
--	---

	<p><i>gateways in the nature of computer control hardware, and computer software and hardware for communication service applications, call, session border, and security control, and management of communication networks; Network computer software for routing, switching, and controlling communication service applications, call, session border and security control, and management of communication networks and network elements; Computer software for managing telecommunications service providers' service assurance agreements; Billing software and analytics software for telecommunications service providers; Communications software, namely, software for providing fault, performance and configuration management for gateway routers, network adaptors, switches, routers, and hubs; Computer software for network functions and lifecycle management and orchestration of communications functions for cloud computing communications networks; Computer software for enabling video conferencing, mobile messaging and virtual network functions; Downloadable Application Programming Interfaces (APIs) software and Software Development Kits (SDKs) for programming by applications developers</i></p>
--	---

	<p>for enabling collaborative communications services and embedded communications.</p>
<p>Class 35: Market research services; Market research analysis; Market research services regarding customer satisfaction; Organisation, operation and supervision of market research services; Conducting market surveys; Opinion polling and feedback; Business research and surveys; Online consumer feedback management services for consumers and businesses, namely, allowing consumers to submit feedback regarding the products and services of others by linking them with companies.</p>	
<p>Class 38: Telecommunication services; Provision of online forums; Provision of an online, interactive bulletin board for the collection of consumer feedback; Provision of online chatrooms for the transmission of messages; Provision of an online forum for consumers to provide feedback to companies; Provision of online facilities to businesses for real-time interaction with consumers.</p>	<p>Class 38: Technical consultation in the field of the operation and use of communications equipment; Over the top communications services for consumers in the nature of communication by electronic computer terminals.</p>
<p>Class 42: Product testing; Product research; Programming of software for market research purposes; Programming of software for evaluating customer behaviour in online shops; Software as a service (saas); Hosting</p>	<p>Class 42: Software as a service (saas) services featuring software for use in analyzing and securing ip communications networks; cloud computing featuring software for use in analyzing and securing ip communications networks; design for</p>

online facilities for conducting interactive discussions.

others in the field of communications; updating and upgrading of computer software; leasing of communications equipment software and hardware; providing on-line, non-downloadable computer security software; software as a service (saas) services featuring software for use in monitoring, protecting, controlling, and securing application programming interfaces (apis) used by businesses; software as a service (saas) services featuring software for use in providing visibility and management of digital services and application programming interfaces (apis) used by businesses; software as a service (saas) services featuring software for protecting and controlling access to digital assets, data, and digital services; software as a service (saas) services featuring software for enforcing data security policies, preventing data loss, and ensuring compliance with data security policies and procedures; computer security threat and risk analysis for protecting data; computer security services, namely, restricting unauthorized access to digital assets, data, and digital services; software as a service (saas) services featuring software for use in controlling calls in unified communications, voice mail and rich messaging applications; software as

	<p><i>a service (saas) services featuring software for use in enabling application programming interfaces (apis), subroutines and wrappers to be embedded in internet applications to enable unified communications services to be provided over cloud networks or hosted infrastructures; software as a service (saas) services for enabling video conferencing, mobile messaging and virtual network functions; unified communications as a service (ucaas) services and communications platform as a service (cpaas) services, namely, featuring cloud computing services in the nature of cloud-based software for use in enabling communications network services, business calling connectivity services (sip trunking), and computer software applications for enabling business communications for calls, messaging, collaboration, chat, video, and contact center over data networks; over the top communications services for consumers, namely, design of unified communication services for consumers; software as a service (saas) services featuring application programming interfaces (apis) software and online non-downloadable software development kits (sdks) for use by application developers for programming and for enabling collaborative</i></p>
--	--

	<p><i>communications services and embedded communications; design and development of computer hardware and software; computer software development and product development in the field of telecommunications technology; maintenance of computer software in the field of telecommunications technology; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems, and technical advice related to the repair of computer software; consulting in the field of telecommunications technology; computer services, namely, providing an online computer database featuring information regarding computer software and hardware design and development; design for others in the field of communications, namely, design of unified communications services, embedded communications services, fixed, mobile and web based communications systems, software and clients, and corresponding administration user interfaces in the field of telecommunications technology; Technical consultation in the field of the operation and use of communications equipment.</i></p>
--	--

21. The applicant contends that it provides a service allowing businesses to interact directly with their customers to gain customer feedback, whilst the opponent delivers communications software and IP and optical networking solutions to service providers. Whilst the applicant might be correct, the fact that the parties have so far decided to target different segments of the market is irrelevant as my assessment must be limited to the specifications as registered and applied-for. Hence, I will say no more about this point.

Class 9: Interactive software; Computer software to facilitate communication between businesses and customers; Computer software for evaluating customer behaviour in online shops; Computer software for carrying out product research; Computer software for carrying out market research.

22. In its submission in lieu, the applicant argues that although it is accepted that the parties' marks cover various software goods in class 9, they are different types of software, and the goods are not similar.

23. I tend to agree with the applicant that the fact that all of the goods are software does not necessarily mean that there should be a finding of similarity because they all have the same nature, all software being a set of instructions to enable a computer to perform a specific task. If that approach were adopted, trade marks owners would be able to enforce their trade mark against others in completely different fields, where there is no commercial overlap.

24. I also tend to agree with the applicant that at least some of its software goods, namely those used in the context of marketing research, i.e. *Computer software for evaluating customer behaviour in online shops; Computer software for carrying out product research; Computer software for carrying out market research*, do not appear to be obviously similar to the opponent's software goods whose main function is to enable communication equipment, communication network and communication platforms to work and optimise the working of businesses' applications and access to digital services.

25. However, the opponent can also rely on its services in class 42 which covers *updating and upgrading of computer software* at large, and would notionally cover the updating and upgrading of all of the applicant's computer software goods, namely *Interactive software; Computer software to facilitate communication between businesses and customers; Computer software for evaluating customer behaviour in online shops; Computer software for carrying out product research; Computer software for carrying out market research*. Although there is no evidence on the point, from my experience in the field of computer science, producers of computer software will also commonly provide software-related services to keep the software updated. Even though the nature of these goods and services is not the same, at least the relevant public, the providers and the distribution channels of the goods and services coincide. Furthermore, the goods and services are complementary in the sense that the opponent's *updating and upgrading of computer software* services are indispensable or important for the use of the applicant's software goods in such a way that customers may think that the responsibility for those goods lies with the same undertaking.

26. Alternatively, the opponent's services in class 42 cover *design and development of computer software*, which include the design and development of the applicant's software goods. The goods and services have a different nature; however, they have the same purpose (namely to provide users with an identical software product), share trade channels (for example, a provider of software goods could either sell a ready-to-use software or design and develop a new software incorporating specific requirements for a business user) and are in competition.

27. Overall, I find that **all of the applied-for software goods in class 9 are similar to a low degree to the opponent's *updating and upgrading of computer software* services and *design and development of computer software* in class 42.**

Class 35: Market research services; Market research analysis; Market research services regarding customer satisfaction; Organisation, operation and supervision of market research services; Conducting market surveys; Opinion polling and feedback; Business research and surveys; Online consumer feedback management services for consumers and businesses, namely,

allowing consumers to submit feedback regarding the products and services of others by linking them with companies.

28. I have already found that there is no similarity between the opponent's software goods and the applicant's software for market and product research. The applied-for Market research services; Market research analysis; Market research services regarding customer satisfaction; Organisation, operation and supervision of market research services; Conducting market surveys; Opinion polling and feedback; Business research and surveys; Online consumer feedback management services for consumers and businesses, namely, allowing consumers to submit feedback regarding the products and services of others by linking them with companies are all marketing services and, as such, are one step removed from the opponent's goods in class 9. Further, I cannot see any obvious similarity with the opponent's services in class 38 (which relate to communication services by electronic computer terminals and technical consultation in the field of the operation and use of communications equipment) and class 42 (which relate to various software development and upgrading services and software licensing services). **These services are dissimilar.**

Class 38: Telecommunication services; Provision of online forums; Provision of an online, interactive bulletin board for the collection of consumer feedback; Provision of online chatrooms for the transmission of messages; Provision of an online forum for consumers to provide feedback to companies; Provision of online facilities to businesses for real-time interaction with consumers.

29. The opponent's specification in class 38 covers, *inter alia*, *over the top communications services for consumers in the nature of communication by electronic computer terminals*. Neither party explains what *over the top communications services* are, however, as I understand it, they are communications services bypassing telecommunication channels and provided directly to internet users, such as, for example, WhatsApp and Skype. Although there is no evidence on the point, from my experience, nowadays many businesses use *over the top communications services* (in the form of WhatsApp messaging, for example) to interact with their consumers. Although the applicant's *telecommunication services* might have a different nature (for example, providers of telecommunication services offer telephone services, voice

calling services and text services directly using telephone lines, whereas over the top communications services offer video calls and text messages using internet lines) they serve the same function for the end users, namely that of offering a communication service or a mean of interaction. The services have therefore the same or a similar purpose (i.e. they allow customers to interact with other individuals or with a business), target the same users and are in competition, although the trade channels for the provision of the services are different. The same apply to the other services in the applicant's specification, namely, *Provision of online forums; Provision of an online, interactive bulletin board for the collection of consumer feedback; Provision of online chatrooms for the transmission of messages; Provision of an online forum for consumers to provide feedback to companies; Provision of online facilities to businesses for real-time interaction with consumers.* **These services are similar to a low degree.**

Class 42: Product testing; Product research; Programming of software for market research purposes; Programming of software for evaluating customer behaviour in online shops; Software as a service (saas); Hosting online facilities for conducting interactive discussions.

30. The closest clash I can see between the opponent's services and the applicant's programming of software for market research purposes; programming of software for evaluating customer behaviour in online shops is with the opponent's *updating and upgrading of computer software*. The opponent's software updating and upgrading services is not limited in any way and, as such, would cover the updating and upgrading of *software for market research purposes and software for evaluating customer behaviour in online shops* in relation to which the applicant provides its software programming services. Again, in the field of computer science, programmers of computer software will also commonly provide software-related services to keep the software updated. Although the nature of these services is not the same, at least the relevant public, the usual producers/providers and the distribution channels of the services coincide. Furthermore, the goods and services are complementary. **I find that these services are similar to a medium degree.**

31. The applicant's software as a service (saas) clearly encompasses the opponent's *software as a Service (SAAS) services featuring software for use in analyzing and securing IP communications networks*. **These services are identical according to the principle outlined in *Meric*.**

32. As I understand it, the applicant's hosting online facilities for conducting interactive discussions is a service consisting in providing a platform to host facilities for conducting interactive discussions. The opponent's services in class 42 cover *software as a Service (SAAS) services for enabling video conferencing, mobile messaging and virtual network functions*, all of which allow computer-based interactive discussions. Software as a service (SaaS) is a software distribution model in which a cloud provider hosts applications and makes them available to end users over the internet. Both services perform therefore a hosting function for the purpose of allowing interactive discussions and are closely related thereto and would usually require the same technical operations/activities and specialised knowledge. Therefore, the services are likely to be provided by the same companies, target the same public and are sold through the same distribution channels. I find that **these services are similar to a medium degree**.

33. The applicant's product testing and product research are not limited in any way and include testing and research services in relation to products in the field of telecommunications technology. There is therefore an overlap with the opponent's *computer software development and product development in the field of telecommunications technology*, as the applicant's product testing and product research could be provided as part of (or in relation to) the opponent's product development services. The services therefore have a similar nature and purpose, target the same users, and share trade channels. Further, they are complementary and in competition as a business could decide to recruit a company to develop its product from beginning to end or could develop its own product in-house and select an external company to carry out the product testing and product research. I find that **these services are similar to a medium to high degree**.

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

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

35. As I found that the services Market research services; Market research analysis; Market research services regarding customer satisfaction; Organisation, operation and supervision of market research services; Conducting market surveys; Opinion polling and feedback; Business research and surveys; Online consumer feedback management services for consumers and businesses, namely, allowing consumers to submit feedback regarding the products and services of others by linking them with companies are dissimilar to the opponent's goods and services, the opponent's claim under Section 5(2)(b) is bound to fail in relation to these services.

Average consumer

36. 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. (as he then was) 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.”

37. The average consumer of the goods and service at issue is a member of the general public or a business user. The purchasing process for these goods is likely to be dominated by visual considerations. However, I do not discount aural considerations entirely as it is possible that the purchasing of these goods and services would involve oral discussions with sales representatives or word of mouth recommendations. The degree of attention may vary from medium to high, depending on the specialised nature of the goods and services, the frequency of purchase and their price.

Comparison of marks

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

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

39. 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. The respective marks are shown below:

The applicant's mark	The opponent's mark
	<p data-bbox="1034 472 1158 504">RIBBON</p>

40. The applicant's mark consists of the word 'RIBBON' presented in title case and placed after a blue device representing a ribbon. When trade marks consist of both verbal and figurative elements, in principle, the verbal element has a stronger impact on the consumer than the figurative element; this is because the public will more easily refer to the marks in question by their verbal element than by describing their figurative elements. This principle applies in this case, especially given that the blue figurative element reinforces the meaning of the word that follows.

41. The opponent's mark is a word-only mark consisting of the word 'RIBBON' presented in upper case. The overall impression lies in the word itself.

42. Visually, the marks coincide in the verbal element 'RIBBON'. Although the word 'RIBBON' is presented in title case in the applicant's mark, and in upper-case in the opponent's mark, the opponent's mark is a word-only mark, which notionally covers use in all possible fonts and typefaces. The marks differ in the applicant's figurative element, however, that element is less distinctive than the coinciding word element. Overall, the marks are visually similar to a high degree. Aurally, the figurative element in the applicant's mark will not be articulated and the marks will be pronounced identically. Conceptually, both marks will convey the concept of ribbon, which is defined as *"a long, narrow strip of fabric, used for tying something or for decoration"* and so, are conceptually identical.

Distinctive character of earlier mark

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

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

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

44. Registered trade marks possess various 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 distinctiveness of a mark can be enhanced by virtue of the use made of it.

45. The opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, therefore I only have the inherent distinctiveness of the mark to consider.

46. The word 'RIBBON' in the opponent's mark is neither descriptive nor allusive of the goods and services in question (as accepted by the applicant at paragraph 20 of its written submissions) and, as such, it has a medium degree of distinctiveness.

Likelihood of confusion

47. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective 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 mark, 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

48. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

49. I have found most of the goods and services in question to be similar to varying degrees. The selection of the goods and services will be predominantly visual and the average consumer's degree of attention when selecting the goods and services will vary from medium to high, depending on the nature and value of the goods and services. I have found the marks to be visually similar to a high degree, aurally identical and conceptually identical.

50. In my view, given the fact that the marks coincide in the most dominant and distinctive element 'RIBBON', and differ only in the presence of a figurative element which will be construed as a ribbon (only reinforcing the concept conveyed by the distinctive and dominant word 'RIBBON'), it is highly conceivable that the relevant public, even those who will pay a higher degree of attention (who will also have to rely on their imperfect recollection of the marks), will directly confuse the marks or perceive the applicant's mark as a sub-brand, a variation of the earlier mark, incorporating a logo in addition to the main brand 'RIBBON'. There is a likelihood of confusion.

51. As a result of the above, the opposition hereby succeeds for the goods and services that I found to be similar.

OUTCOME

52. The opposition is successful in relation to the following goods and services for which the application is refused:

Class 9: *Interactive software; Computer software to facilitate communication between businesses and customers; Computer software for evaluating customer behaviour in online shops; Computer software for carrying out product research; Computer software for carrying out market research.*

Class 38: *Telecommunication services; Provision of online forums; Provision of an online, interactive bulletin board for the collection of consumer feedback; Provision of online chatrooms for the transmission of messages; Provision of an online forum for consumers to provide feedback to companies; Provision of online facilities to businesses for real-time interaction with consumers.*

Class 42: *Product testing; Product research; Programming of software for market research purposes; Programming of software for evaluating customer behaviour in online shops; Software as a service (saas); Hosting online facilities for conducting interactive discussions.*

53. The opposition is unsuccessful in relation to the following services for which the application may proceed to registration:

Class 35: *Market research services; Market research analysis; Market research services regarding customer satisfaction; Organisation, operation and supervision of market research services; Conducting market surveys; Opinion polling and feedback; Business research and surveys; Online consumer feedback management services for consumers and businesses, namely, allowing consumers to submit feedback regarding the products and services of others by linking them with companies.*

COSTS

54. The opponent has enjoyed the greater degree of success and is, consequently, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I bear in mind the applicant's partial success, and I award the opponent the sum of £500 calculated as follows:

Preparing a statement and considering the applicant's statement:	£200
Preparing submissions	£200
Official fees:	£100
Total	£500

55. I therefore order RIBBON TECHNOLOGIES LTD to pay Ribbon Communications Operating Company, Inc. the sum of £500. This sum is to be paid within twenty-one

days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 15th day of August 2023

Teresa Perks

For the Registrar