O/0814/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3588923 BY BORDERLINK BROADBAND LIMITED TO REGISTER AS A TRADE MARK (SERIES OF THREE):

IN CLASSES 9, 38 & 42

AND

OPPOSITION THERETO UNDER NO. 428650 BY GO INTERNET LTD

BACKGROUND & PLEADINGS

1. Borderlink Broadband Limited ("**the applicant**") applied to register the series of marks shown on the front page of this decision in the United Kingdom. The application was filed on 2 February 2021 and was published on 10 September 2021. For the purposes of this partial opposition the relevant goods and services in the specification are:

> **Class 9:** Computer software; Internet access software; telecommunications software; communications apparatus; communication hubs; communications equipment; communications networks; communications apparatus; communication hubs; communications equipment; communications networks; communications instruments; telecommunications transmitters; telecommunications networks; telecommunications instruments; telecommunication apparatus; telephone apparatus; electronic communication installations; mobile telecommunication apparatus; signal transmission apparatus; data transmission apparatus; satellite transmission apparatus; signal transmission apparatus; data transmission apparatus; satellite transmission apparatus; apparatus for transmission of communication; signalling instruments; digital transmitters; sensors; security control apparatus; security surveillance apparatus; safety, security, protection and signalling devices; peripherals adapted for use with computers and other smart devices; telecommunications cables; network cables; broadband installations; internet phones; VOiP phones; electronic communication installations; mobile telecommunication apparatus; data transmission cables; optical cables; electrical and electronic instruments for the reception of data; data transmission networks; computer application software; application software for smart tv; satellites for signal transmission; aerials for telecommunications networks; data transmission cables; satellites for signal transmission; electronic security systems for home network; security software,

cameras and alarms; surveillance cameras; security cameras; digital sensors; alarm sensors; motion detectors; computer software for the creation of firewalls; business intelligence software; security software; antivirus software; privacy software; parts and fittings for the aforesaid goods.

Class 38: Telecommunications services; telephone communications; communication services; digital communication services; transmission of digital information; internet communication; internet communication services; mobile communication; mobile communication services; telecommunication network services; electronic network communications; satellite capacity provision [telecommunications]; data transmission; cable transmission; broadcasting services; wireless communications services; digital network telecommunications services; provision of access to content, websites and portals; telecommunication services provided via internet platforms and portals; message transmission services; secure transmission of data, sound or images; hire of telecommunications installations; provision of broadband telecommunication access; internet broadcasting services; providing access to the internet and other communications networks; wireless broadband communication services; optical fibre telecommunications services; provision of broadband telecommunications access; transmission of telephone calls; Voice over Internet Protocol [VoIP] services; Voice over Internet Protocol [VoIP] communication services; provision of telecommunications connections to the internet or computer databases; electronic mail, message sending; data streaming services; digital transmission of data; telecommunication of information (including web pages); provision of telecommunications links to computer databases and websites on the internet; information, consultancy and advisory services relating to the aforesaid services.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services;

design and development of computer hardware and software; software installation; software creation; software engineering; software research; software design; software development; updating of software; software customisation services; computer software maintenance; maintaining databases; database design; data security services; maintenance of websites; computer services; computer advisory services; computer programming; installation of computer programs; development of computer software; software development, programming and implementation; development and testing of software; custom design of software packages; it security, protection and restoration; it consultancy, advisory and information services; IT services; technical data analysis; computer software installation; computer software integration; electronic storage of data; updating of software for communication systems; hosting of platforms on the internet; hosting of communication platforms on the internet; maintenance and updating of software for communication systems; custom design and engineering of telephony systems, cable television systems and fiber optics; computer security system monitoring services; environmental testing; internet security consultancy; installation of internet access software; information, consultancy and advisory services relating to the aforesaid services.

2. For ease of reference, I will refer to the series of contested marks as the 'contested mark', unless it becomes necessary to differentiate between the marks which comprise the series.

3. GO INTERNET LTD ("**the opponent**") opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent is the proprietor of the UK registration number 3388099 for the following mark:

gointernet

4. The opponent's mark was filed on 29 March 2019 and registered on 21 June 2019 for various goods and services in Classes 9, 37, 38 and 42.

5. For the purposes of this opposition, the opponent relies on all the goods and services of its earlier mark, as shown in paragraph 31 of this decision.

6. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as protection of the opponent's earlier mark was conferred less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

7. The opponent in its notice of opposition claims that "the Applicant's Mark is highly similar to the Opponent's Mark in identical and highly similar services, and there exists a likelihood of confusion which may be detrimental to the Opponent."

8. The applicant filed a defence and counterstatement denying that "the Application and the Opponent's Earlier Mark and goods/services covered by the respective marks are similar enough to give rise to a likelihood of confusion."

9. In these proceedings, the opponent is represented by Lawdit Solicitors Limited and the applicant by Stobbs.

10. 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.

THE OPPONENT'S EVIDENCE

11. This consists of two witness statements, dated 20 June 2022 and 16 December 2022, from Trevor Cook, the director of the opponent.

12. In his first witness statement, Mr Cook introduces Exhibit TC1 and states:

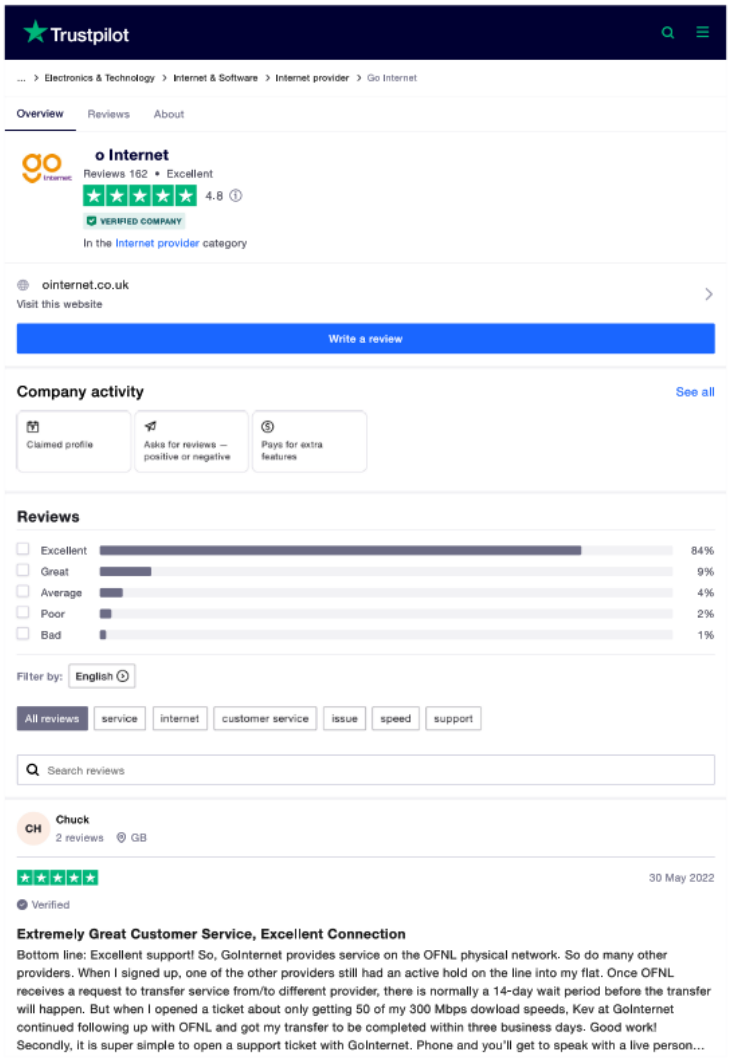
> "4. The Opponent since 2010, and under the Opponent's Mark since 2018, has operated a business in the UK. The Opponent has built a successful business on the basis of high-quality services, operating with a strong sense of customer awareness and providing a customer led service. The Opponent has exposure to a nationwide audience and this has allowed the Opponent to grow and be recognised as a quality company within the telecommunications industry. The Opponent has built a valuable reputation which is undeniably an important element of the Opponent's value as a business. With the Opponent providing full fibre services nationwide, this goodwill and reputation will only strengthen.
>
> 5. The Opponent's customer recognition can be evidenced by its Trustpilot website. A platform set up to allow customers to provide truthful feedback on businesses, it will provide a clear picture of a business's success and reputation. The Opponent has achieved a 4.8 out of 5 star rating on its Trustpilot portfolio. I am shown evidence of such on page 2 of Exhibit TC1. This only serves to reiterate the Opponent's position within its industry and the goodwill and reputation at stake."

13. In relation to Exhibit TC1 (shown below), Mr Cook states that:

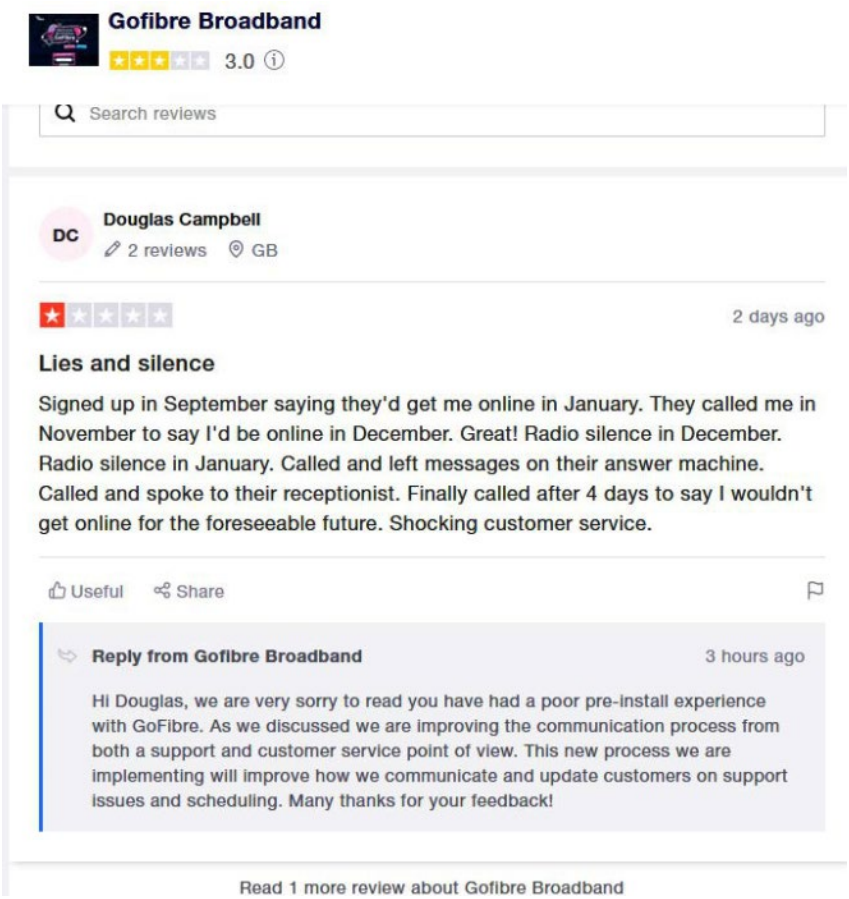
> "9. I am now shown on page 3 of Exhibit TC1, screenshots of a 1-star review posted on the Opponent's Trustpilot page. This review is a complaint over poor service received. On investigation, it became apparent that the reviewer was not and had never been a customer of the Opponent. On receipt of this review, the Opponent took

immediate steps to ascertain the situation. When it became apparent that the customer had confused the Opponent with the Applicant, the 1-star review had been removed from the Opponent's page and reposted on the Applicant's page. This was later acknowledged by the Applicant, indicating its validity. I am now shown evidence of such on page 4 of Exhibit TC1."

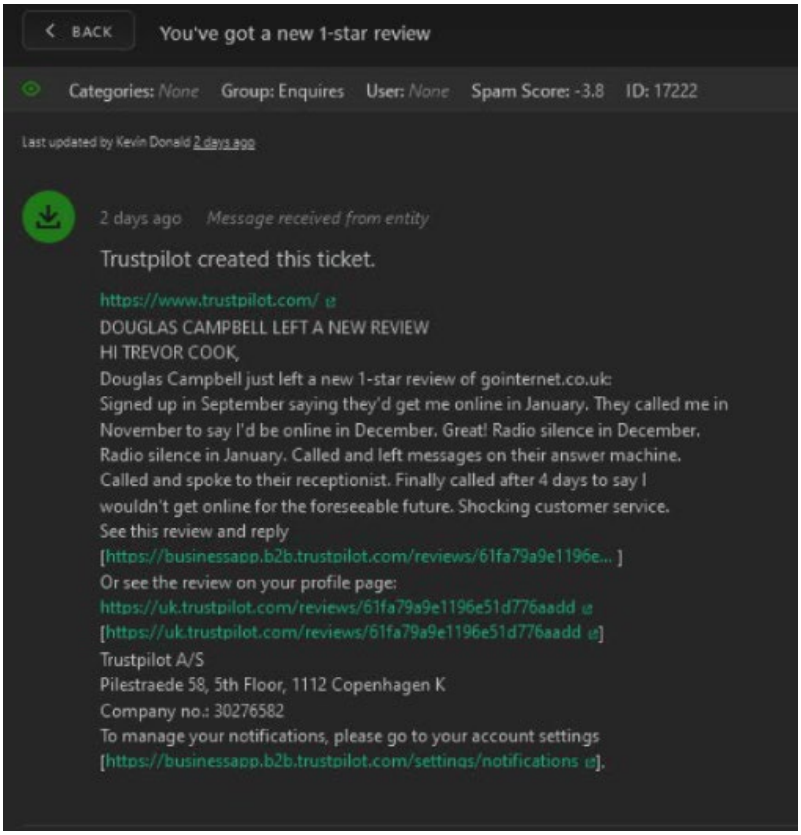
14. **Exhibit TC1** consists of screenshots which it is said to be from the Trustpilot website. It is said that the first page of the exhibit displays the overview of the opponent's page on Trustpilot, revealing a total rating of 4.8 stars. At the bottom of the page, a 5-star review dated 30 May 2022 can be seen.



As reproduced below, the last page of the Exhibit consists of a screenshot that shows a 1-star review from the Trustpilot page of the ‘Gofibre Broadband’:



On the second page of the Exhibit, shown below, there is an undated screenshot of a notification that Mr Cook received from Trustpilot. This notification reveals that the same 1-star review was posted by the same individual on the opponent’s page.



15. The second witness statement of Mr Cook consists of submissions, rather than evidence of fact. Thus, I will not reproduce this here and will refer to it only where I consider this necessary.

THE APPLICANT'S EVIDENCE

16. The applicant's evidence consists of a witness statement, dated 17 October 2022, of Dan Bishopp, the Chief Technology Officer ("CTO") of the applicant, who has held this position since July 2022, and was the Head of Architecture at Borderlink previously, introducing 3 Exhibits.

17. **Exhibit DB1** presents screenshots from *uk.trustpilot.com* displaying two reviews of an individual, as depicted in the opponent's evidence (Exhibit TC1), featured on the applicant's Trustpilot page. The first review, dated 2 February 2022, mirrors the review demonstrated in the opponent's Exhibit TC1, while the second review, dated 31 January 2022, is a separate one-star review. Notably, Mr Bishop mentions that "[…] the individual who left the review on the Opponent's Trustpilot page on 2nd Feb 2022 (as

evidenced in the Opponent's Exhibit TC1) managed to leave an earlier review on Borderlink's Trustpilot page two days earlier, without any apparent difficulty or confusion between Borderlink or the Opponent arising when leaving that earlier review."

18. **Exhibits DB2** and **DB3** comprise printouts of definitions of the terms "fibre" and "fibre optics" as provided by the Cambridge and Collins online dictionaries.

19. **Exhibit DB4** contains printouts of the term "Internet" as shown in Cambridge and Collins online dictionaries.

THE HEARING AND PRELIMINARY ISSUE

20. The matter came to be heard by me via video conference on 23 May 2023. The applicant was represented by Mr Julius Stobbs of Stobbs IP, and the opponent was represented by Mr Joshua Marshall of counsel, instructed by Lawdit Solicitors Ltd.

21. At the start of the hearing, I addressed the preliminary issue in relation to the opponent's pleadings, which was raised in the applicant's skeleton argument. The issue concerned the opponent's statement of grounds and its reliance solely on the earlier services, but not the earlier goods. According to Mr Stobbs, this was evident in paragraphs 12-13 of the opponent's statement of grounds, where no reference was made to the earlier goods while comparing the competing goods and services. On the other hand, Mr Marshall submitted that the opponent relies on all goods and services of the earlier specification as shown in the Form TM7 and the Annex 1 of the opponent's skeleton argument. After hearing both sides, I stressed that the opponent had selected to rely on all goods and services

in Q1 of its TM7, which was sufficient despite the lack of reference to the earlier goods in the statement of grounds.[1]

DECISION

Section 5(2)(b)

22. Sections 5(2)(b) and 5A of the Act are as follows:

> "5(2) A trade mark shall not be registered if because-
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
>
> […]
>
> 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."

23. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di*

[1] See also *SKYCLUB*, BL O/044/21, in paragraph 22.

L. Laudato & C. Sas v OHIM (Case C-334/05 P) and Bimbo SA v OHIM (Case C-519/12 P):

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 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/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (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."

25. 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."

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

> "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 für 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 *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold set out the following summary of the correct approach to interpreting specifications:

> "[…] the applicable principles of interpretation are as follows:
>
> (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

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

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

29. 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."

30. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

31. The competing goods and services to be compared are shown in the following table:

Opponent's Goods	Applicant's Goods & Services
Class 9: Broadband installations; Telecommunications apparatus; Telecommunications networks; Telecommunications apparatus and instruments; Servers for web hosting; Internet access software; Internet messaging software.	**Class 9:** Computer software; Internet access software; telecommunications software; communications apparatus; communication hubs; communications equipment; communications networks; communications apparatus; communication hubs; communications equipment; communications networks; communications instruments; telecommunications transmitters; telecommunications networks; telecommunications instruments; telecommunication apparatus; telephone apparatus; electronic communication installations; mobile telecommunication apparatus; signal transmission apparatus; data transmission apparatus; satellite transmission apparatus; signal transmission apparatus; data transmission apparatus; satellite transmission apparatus; apparatus for transmission of communication;

	signalling instruments; digital transmitters; sensors; security control apparatus; security surveillance apparatus; safety, security, protection and signalling devices; peripherals adapted for use with computers and other smart devices; telecommunications cables; network cables; broadband installations; internet phones; VOiP phones; electronic communication installations; mobile telecommunication apparatus; data transmission cables; optical cables; electrical and electronic instruments for the reception of data; data transmission networks; computer application software; application software for smart tv; satellites for signal transmission; aerials for telecommunications networks; data transmission cables; satellites for signal transmission; electronic security systems for home network; security software, cameras and alarms; surveillance cameras; security cameras; digital sensors; alarm sensors; motion detectors; computer software for the creation of firewalls; business intelligence software; security software; antivirus software; privacy software; parts and fittings for the aforesaid goods.
Class 37: Installation, maintenance and repair of wireless telecommunications equipment and wireless local area networks; Installation, maintenance and repair of telecommunications equipment and networks; Information, advice and consultancy in relation to all the aforesaid services.	
Class 38: Wireless broadband communication services; Provision of broadband telecommunications access;	**Class 38:** Telecommunications services; telephone communications; communication services; digital communication

Telecommunications consultancy; Telecommunications services; Interactive telecommunications services; Telecommunications access services; Rental of telecommunications apparatus; Digital network telecommunications services; Providing telecommunications connections to the Internet or data bases; Providing telecommunications connections to a global communication network or databases; Telecommunications services provided via the Internet, intranet and extranet; Provision of telecommunication connections for data centres; Providing internet access; Internet communication services; Internet telephony services; Provision of internet access services; Voice over Internet Protocol [VoIP] communication services; Information, advice and consultancy in relation to all the aforesaid services.	services; transmission of digital information; internet communication; internet communication services; mobile communication; mobile communication services; telecommunication network services; electronic network communications; satellite capacity provision [telecommunications]; data transmission; cable transmission; broadcasting services; wireless communications services; digital network telecommunications services; provision of access to content, websites and portals; telecommunication services provided via internet platforms and portals; message transmission services; secure transmission of data, sound or images; hire of telecommunications installations; provision of broadband telecommunication access; internet broadcasting services; providing access to the internet and other communications networks; wireless broadband communication services; optical fibre telecommunications services; provision of broadband telecommunications access; transmission of telephone calls; Voice over Internet Protocol [VoIP] services; Voice over Internet Protocol [VoIP] communication services; provision of telecommunications connections to the internet or computer databases; electronic mail, message sending; data streaming services; digital transmission of data; telecommunication of information (including web pages); provision of telecommunications links to computer databases and websites on the internet; information, consultancy and

	advisory services relating to the aforesaid services.
Class 42: Telecommunications engineering; Telecommunications technology consultancy; Telecommunications engineering consultancy; Research in the field of telecommunications technology; Server hosting; Hosting of databases; Hosting of servers; Web site hosting services; Hosting of web portals; Hosting of digital content; Hosting platforms on the Internet; Hosting services, software as a service, and rental of software; Hosting of communication platforms on the internet; Hosting on-line facilities for conducting interactive discussions; Provision of data centre facilities; Hosting of communication platforms on the internet; Information, advice and consultancy in relation to all the aforesaid services.	**Class 42:** Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; software installation; software creation; software engineering; software research; software design; software development; updating of software; software customisation services; computer software maintenance; maintaining databases; database design; data security services; maintenance of websites; computer services; computer advisory services; computer programming; installation of computer programs; development of computer software; software development, programming and implementation; development and testing of software; custom design of software packages; it security, protection and restoration; it consultancy, advisory and information services; IT services; technical data analysis; computer software installation; computer software integration; electronic storage of data; updating of software for communication systems; hosting of platforms on the internet; hosting of communication platforms on the internet; maintenance and updating of software for communication systems; custom design and engineering of telephony systems, cable television systems and fiber optics; computer security system monitoring services; environmental testing; internet security consultancy; installation of internet

	access software; information, consultancy and advisory services relating to the aforesaid services.

32. In Annex 1 of his skeleton argument, Mr Marshall included tables that outline the similarity and/or identity of the competing goods and services. When asked to provide further clarification on the complementary relationship between competing goods and services, as mentioned in paragraph 30 of his skeleton argument, Mr. Marshall gave an example of specific goods and services that are considered complementary: "[…] you often need a network connection, apparatus and a network itself for the purposes of operating surveillance equipment, whether that is professional or residential. So for arguments sake it is often the case that you might obtain a video feed through an app where you have a camera outside your property for the purposes of surveillance. Again by way of judicial notice, the app Ring is relatively common now, so that is a good example of where we say goods and services a complementary."[2]

33. During the hearing, Mr Stobbs took a more comprehensive analysis of the goods and services comparison. However, he did make two general points: first, some goods are similar only to a very low degree, if at all; and second, even though some goods are identical or highly similar, they are technical goods, and, as a result, "they may impact on the purchasing process for the nature of the average consumer"[3]. In my assessment below, I will address any relevant points noted by Mr Stobbs, to the extent I consider necessary.

34. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where

[2] Page 11 of the transcript.

[3] Page 18 of the transcript.

they are sufficiently comparable to be assessed in essentially the same way for the same reasons.[4]

Class 9

Internet access software; broadband installations; telecommunication apparatus; telecommunications networks; telecommunications instruments

35. The contested terms are identically worded as the earlier terms. Thus, I find them to be identical.

Computer software; telecommunications software; computer application software

36. The contested terms are broad terms which encompass the earlier term "*Internet access software*" in the same Class. In this regard, and based on the *Meric* principle, the respective goods are identical.

Application software for smart tv; computer software for the creation of firewalls; business intelligence software; security software; antivirus software; privacy software

37. Mr Stobbs referred me to *Skykick* and the scope that broad terms can afford. In particular, he submitted that:

> "Because software is such a pervasive thing and can cover such a huge range of potential uses, you cannot simply say they are highly similar because they are software. The earlier right covers specific types of software, internet access and we are talking about you and I getting on to the internet and the fact that you might need some software on your computer or phone to be able to do that. That, in my

[4] *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

submission, is very different from the provision of a firewall, the provision of a security service, the provision of antivirus, the provision of privacy or particularly the provision of business intelligence. All those things are totally different, and you would expect as a consumer, unless it is Microsoft which is the equivalent of going into a supermarket and saying that everything in a supermarket is similar to one another, you would expect actually that there are different proprietors providing these various different things. So we say that is an example where, […], the similarity is at such a high and oversimplistic level that actually you should consider these either to have a very low degree of similarity or to be not similar at all. We would say a very low degree of similarity would be a reasonable conclusion to draw in relation to those terms."[5]

38. When it comes to interpreting broad terms, I am mindful of the case law that emphasises the importance of taking their literal meaning into account. In my view, the natural and literal meaning of the contested goods is in relation to software specifically designed for smart TVs, or to provide security, antivirus protection, and privacy protection to users; and business intelligence, firewall creation, and software. Therefore, I agree with the opponent that there is similarity with the earlier terms "*Internet access software; Internet messaging software*". Although the competing goods share the same nature (software), their purpose differs. The purpose of the opponent's goods is to provide access to the Internet and online messaging, whereas the contested goods are purpose-specific software, such as security and antivirus protection. I note that the method of use will be the same as either type of software is used in the same way through a computer or a smart device. Also, it is likely that the competing goods will be sold in the same retail or online stores, but potentially in different sections, not next to each other. I do not consider that there is a degree of

[5] Page 19 of the transcript.

complementarity or competition between the goods. I find them to be similar to a medium degree.

Telecommunications transmitters; telephone apparatus; mobile telecommunication apparatus; aerials for telecommunications networks; parts and fittings for the aforesaid goods.

39. The contested terms are all telecommunication equipment/devices and will be covered by the opponent's broad terms "*Telecommunications apparatus; Telecommunications networks*". Therefore, I find them to be identical in line with the principles in *Meric,* or else highly similar, sharing the same nature, purpose, users, method of use, and trade channels.

Communications apparatus; communication hubs; communications equipment; communications networks; communications instruments; signal transmission apparatus; data transmission apparatus; satellite transmission apparatus; apparatus for transmission of communication; signalling instruments; digital transmitters; peripherals adapted for use with computers and other smart devices; telecommunications cables; network cables; internet phones; VOIP phones; data transmission cables; optical cables; electrical and electronic instruments for the reception of data; data transmission networks; satellites for signal transmission

40. Mr Stobbs conceded that there is a high similarity between the contested terms and the opponent's "*Telecommunications apparatus; Telecommunications networks; Telecommunications apparatus and instruments*" as shown in Annex 1 of the opponent's skeleton argument. I agree and find that they will coincide in nature, purpose, users, trade channels, and there might be a degree of complementarity and competition between some of the terms. Thus, I consider the respective terms to be highly similar.

Electronic communication installations

41. I have considered Mr Stobbs' submissions in relation to the interpretation of the word "*installations*" being a piece of equipment potentially for telecoms business.

42. When considering the core and literal meaning of the contested term, in my view, it relates to equipment that facilitates the exchange of digital messages and data through electronic means such as email, live chat, and websites. In this respect, the closest comparable term from the earlier specification is "*broadband installations*". The competing goods may coincide in nature (both being equipment), but they will differ in general purpose. The contested goods have a narrower end-purpose, namely exchange messages, while the earlier goods are intended to connect the users to the Internet. Further, the users and trade channels may overlap. However, I do not consider that there is competition or complementarity between the goods. I find them to be similar to between a medium and high degree.

Sensors; security control apparatus; security surveillance apparatus; safety, security, protection and signalling devices; electronic security systems for home network; security […] cameras and alarms; surveillance cameras; security cameras; digital sensors; alarm sensors; motion detectors

43. The opponent claims that the contested goods are complementary to its earlier goods "*Telecommunications apparatus; Telecommunications networks; Telecommunications apparatus and instruments*". Mr Marshall's submissions shown above in paragraph 32 of this decision are relevant in this instance.

Mr Stobbs challenged Mr Marshall's submissions by positing that:

"[…] you may need a network to be able to run your surveillance equipment. If we take that as the answer, then we need a network to be able to run this hearing but that does not make telecoms services similar to the provision of an IP hearing in relation to trade marks.

The mere fact that internet access or a piece of telecoms equipment might be needed in the potential operation of some goods and services cannot be taken for that to mean what complementary is about. Most of the cases that talk about complementarity are about, you know, I am in a rest rand, and it would be complementary for me to receive bread in the context of getting my meal, or I am getting a Freeview television service. I am actually provided with a box in order to be able to access my Freeview television service.

This is nothing like that. *Security surveillance apparatus* is nothing to do with a piece of telecoms equipment and we say if you find any similarity at all it must be at a very low degree."[6]

44. The contested goods are all products that intend to provide additional security to their users. They differ in nature and purpose from the earlier terms "*Telecommunications apparatus; Telecommunications networks; Telecommunications apparatus and instruments*", which facilitate communication and transfer of data. Although some of the contested goods may be operated through a mobile application using a telecommunications network, I do not consider that "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." Thus, in the absence of evidence, I am not inclined to take judicial notice to find complementarity between the competing terms. The competing goods differ in method of use and trade channels as they would be found in different departments or different category listings. Any overlap in users

[6] Page 20 of the transcript.

is insufficient on its own for a finding of similarity. Further, I do not consider that there is any element of competition. I find the goods to be dissimilar.

Class 38

Wireless broadband communication services; Telecommunications services; Voice over Internet Protocol [VoIP] services; Voice over Internet Protocol [VoIP] communication services; information, consultancy and advisory services relating to the aforesaid services

45. The contested terms are clearly identical to the opponent's as they are identically worded or ostensibly the same.

Communication services; digital communication services; transmission of digital information; internet communication; internet communication services; data transmission; cable transmission; provision of broadband telecommunication access; optical fibre telecommunications services; provision of broadband telecommunications access

46. The contested terms are all communication and broadband telecommunication services. The opponent's terms "*Wireless broadband communication services; Provision of broadband telecommunications access; Telecommunications services*" are broad terms and would readily cover the contested services. Thus, I find the competing terms to be identical as per the *Meric* principle. If I am wrong in this finding, they are highly similar as they will share the same nature, purpose, users, trade channels, and would be in competition.

Telephone communications; mobile communication; mobile communication services; telecommunication network services; electronic network communications; wireless communications services; digital network telecommunications services; provision of access to content, websites and portals; telecommunication services provided via internet platforms and portals; providing access to the internet and other communications networks; transmission of telephone calls; provision of telecommunications connections to the internet or computer databases; telecommunication of information (including web pages); provision of telecommunications links to computer databases and websites on the internet

47. The contested services are all telecommunication services and services providing access to the Internet. I agree with the opponent that the earlier terms "*Telecommunications services; Interactive telecommunications services; Telecommunications access services; Digital network telecommunications services; Providing telecommunications connections to the Internet or data bases; Providing telecommunications connections to a global communication network or databases; Telecommunications services provided via the Internet, intranet and extranet; Provision of telecommunication connections for data centres; Providing internet access; Internet communication services; Internet telephony services; Provision of internet access services*" are identical to the contested terms. This is because the earlier terms are broad terms that would encapsulate the contested terms in accordance with *Meric*.

Satellite capacity provision [telecommunications]

48. The contested term concerns the provision of services in relation to the satellite capacity for telecommunication purposes. Against that background, I consider that the earlier term "*Telecommunications services*" is a broad term that would cover the contested services, as laid down in *Meric*. Therefore, I find them to be identical.

Broadcasting services; message transmission services; secure transmission of data, sound or images; internet broadcasting services; electronic mail, message sending; data streaming services; digital transmission of data

49. The contested services are largely broadcasting and data streaming services. They are similar to the opponent's services "*Telecommunications services; Digital network telecommunications services; Providing telecommunications connections to the Internet or data bases; Telecommunications services provided via the Internet, intranet and extranet; Providing internet access; Internet communication services; Internet telephony services; Provision of internet access services*". The competing services share the same general nature being services in the same/closely related fields, users, and trade channels. I consider that there is a degree of complementarity as the average consumer would expect the competing services to be provided by the same undertaking. Consequently, I find them to be similar to a high degree.

Hire of telecommunications installations

50. The contested term relates to the provision of hiring services for telecommunication installations. The opponent claims identity with its earlier term "*rental of telecommunications apparatus*". I consider that the terms are identical, or esle they are similar to a high degree as they coincide in their general nature (both being telecommunication services), purpose, users, and trade channels.

Class 42

Hosting of platforms on the internet; hosting of communication platforms on the internet

51. The contested terms are clearly identical to the opponent's as they are identically worded to the earlier services.

Electronic storage of data

52. The contested term could be readily covered by the broad term "*server hosting*" in the opponent's specification, which is a form of storing data. Thus, I consider that the competing terms are identical. If I am wrong, they are highly similar as they will be coinciding in nature, purpose, users, trade channels, and providers.

Maintenance of website

53. The contested terms are similar to the opponent's "*web site hosting services*". There is an element of complementarity between the services where the consumers could expect the same undertaking to provide both services. They also share a similar nature, and the same users, and trade channels. I find them to be highly similar.

IT consultancy, advisory and information services; information, consultancy and advisory services relating to the aforesaid services; computer advisory services; internet security consultancy

54. The contested terms are all consultancy or advisory services in the field of IT. These are similar to the opponent's "*Telecommunications technology consultancy; Telecommunications engineering consultancy; information, advice and consultancy in relation to all the aforesaid services".* Although they share the same general nature and purpose as they are consulting activities on technical matters, I note that the specific purposes/natures are not the same. Nevertheless, they may coincide in users, trade channels, and providers. I find them to be similar to between a medium and high degree.

IT services; computer services

55. The contested terms are broad terms that could encompass the earlier services "*Server hosting; Hosting of databases; Hosting of servers; Web*

site hosting services; Hosting of web portals; Hosting of digital content; Hosting platforms on the Internet; Hosting services, software as a service, and rental of software; Hosting of communication platforms on the internet", which are all considered to be IT services, and the same businesses are likely to offer them. These services will be identical or else highly similar, as they will overlap in nature, purpose, trade channels and users.

Maintaining databases; database design

56. The contested services are database-related services. I consider them to be similar to the opponent's "*hosting of databases*". The competing services may coincide in nature and purpose. There may be a degree of complementarity between them, as maintaining and designing databases could be essential to hosting them and vice versa. Additionally, I think they would share the same users and trade channels. As a result, I find them to be highly similar.

Data security services; IT security, protection and restoration; Computer security system monitoring services

57. The contested services are cyber security monitoring services that identify and detect IT-related threats and malicious attacks. I consider that there is similarity between the contested services and the opponent's "*hosting of databases*". This is because both services might overlap in users and trade channels. Although such services are commonly used together, I do not consider that they are indispensable to each other. As a result, I do not consider that there is a complementary relationship between them. Thus, I find them to be similar to a low degree.

Software engineering; computer programming

58. The opponent claims similarity based on its earlier term "*telecommunications engineering*". The competing services may overlap in

nature, but they differ in purpose as the contested services concern the design of software whereas the opponent's concern the design of telecommunications equipment and systems. In light of this, it is my view that the users and trade channels will be different. In the absence of evidence, I do not consider that there is a degree of complementarity or competition between the services. I find the respective services to be similar to a medium degree at best.

Maintenance and updating of software for communication systems; updating of software for communication systems

59. There is similarity between the earlier term "*telecommunications engineering*" and the contested terms "*maintenance and updating of software for communication systems; updating of software for communication systems*". There is an element of complementarity as the provision of such services may be offered by the same provider. Although there is also an overlap in nature, the purposes are different. I consider that there could be an overlap in users and trade channels. I find the competing services to be similar to a high degree.

Custom design and engineering of telephony systems, cable television systems and fiber optics

60. The contested services are bespoke engineering services in the field of telecommunications. I consider that the earlier term "*telecommunications engineering*" is a broad term that would cover the contested services. Therefore, I find them to be identical based on *Meric*, or else they are highly similar as there will be an overlap in trade channels, users, purpose, and nature.

Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; technical data analysis; environmental testing

61. At the hearing I asked Mr Marshall to elaborate on the complementary relationship between the contested term "*environmental testing*" and the earlier terms, where he submitted that "*environmental testing"* and "*quality control"*, that they are "[…] a loose form of research. So if you are testing something you are researching, checking what the outcome of the test is and for that reason we say there is similarity."[7]

62. Mr Stobbs submitted that any connection between the competing terms is tenuous, having different natures, purposes, and users. He added that even research activity may be involved in the provision of some of those services is not sufficient to find similarity. Mr Stobbs concluded stating that:

> "Environmental testing as an example, how can that really be similar to research in the field of telecoms technology? The subject matter, intended purpose, consumer is totally different so we would say actually there are some things there that you should be regarding as dissimilar. There are other things where perhaps -- industrial analysis, industrial research arguably could be similar to a low degree because it is slightly closer to the term that is being cited, but design and development of computer hardware and software compared to research in the field of telecoms technology. They are just different services. I think some of them are different and some of them may have a low degree of similarity but they are certainly not highly similar."[8]

[7] Page 11 of the transcript.

[8] Page 20 of the transcript.

63. The opponent claims that the contested services are highly similar to its earlier services "*Research in the field of telecommunications technology*". I consider that there is similarity between the earlier term and the contested "*Scientific and technological services and research […] relating thereto; industrial analysis, industrial research […]*", as they may share the same nature, purpose, users and trade channels. There may also be a degree of competition between the respective services. Therefore, I find them to be similar to a high degree.

64. In contrast, I can see no meaningful similarity between the earlier services and the rest of the terms, namely *"[…] design relating thereto; […] and industrial design services; quality control and authentication services; technical data analysis; environmental testing*", as they differ in nature, intended purpose, users and trade channels. Bearing in mind the rationale in *Avnet*, and in the absence of evidence, I agree with Mr Stobbs' submissions and consider that the opponent's research-based services should not be interpreted broadly to cover the above contested services. Further, they will not be considered to be complementary "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". Thus, I find them to be dissimilar.

Software installation; computer software installation; computer software integration; installation of computer programs; installation of internet access software

65. The contested services are all various software installation services. The opponent claims similarity between the contested services to its earlier services "*Installation, maintenance and repair of wireless telecommunications equipment and wireless local area networks; Installation, maintenance and repair of telecommunications equipment and networks; Information, advice and consultancy in relation to all the aforesaid services*" in Class 37. The competing services will coincide in users, trade channels and may be provided by the same undertakings.

This is so, as the installation, maintenance, repair, information and consultancy services for such equipment may also involve the installation of the relevant software and the relevant support by the same provider thereto. Therefore, I find them to be similar to a medium degree.

66. For completeness, I note that there is complementarity between the contested term "*installation of internet access software*" and the earlier goods "*internet access software*" in Class 9. Although there is a difference in the nature (goods v services), the competing terms coincide in purpose, users, and trade channels. I find them to be similar to a medium degree.

Design and development of computer hardware and software; software research; software development; software creation; software design; updating of software; software customisation services; computer software maintenance; development of computer software; software development, programming and implementation; development and testing of software; custom design of software packages

67. The opponent claims similarity between the contested services and the earlier goods "*Internet access software; Internet messaging software*" in Class 9.

68. Mr Stobbs submitted that the sale of that software is totally different than the design and development of computer hardware and software services. Mr Stobbs made the distinction that when a consumer buys a software in Class 9 is not provided with the design and the development of computer software services. He added that the competing terms are totally unrelated, concluding that they are not similar or else they are similar at a very low level.

69. The contested services are all specialist services offered by experts in the field, whilst the earlier goods contain software that allows users to access the internet and instant messaging and connect with each other. As the contested services are services that cover software at large, I consider that

they may include, for example, the design of internet access software. In this respect, although their nature and purpose are different, they may share the same trade channels, providers, and likely the same users. I consider the respective goods and services are similar to a low degree.

70. The likelihood of confusion does not arise in relation to the application's goods and services in Classes 9 and 42 which are dissimilar to the goods and services of the earlier mark.[9] **The opposition cannot succeed against dissimilar goods and services and, therefore, is dismissed insofar as it concerns the following terms:**

> **Class 9:** Sensors; security control apparatus; security surveillance apparatus; safety, security, protection and signalling devices; electronic security systems for home network; security […] cameras and alarms; surveillance cameras; security cameras; digital sensors; alarm sensors; motion detectors.
>
> **Class 42:** "[…] design relating thereto; […] and industrial design services; quality control and authentication services; technical data analysis; environmental testing".

Average Consumer and the Purchasing Act

71. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

[9] Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

> "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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

72. Mr Marshall directed me to the cases of *easyGroup Ltd v Easyway SBH* [2021] EWHC 2007 (IPEC) and *Match Group LLC & Anr v Muzmatch Limited* [2022] EWHC 941 (IPEC), positing that although these are infringement cases, the same logic applies when addressing or dealing with the relevant grounds of refusal. Against that background, Mr Marshall submitted that the average consumer should be determined by considering the goods and services for which the trademark is registered, not by the quirks of the applicant's customers. He also argued that certain goods and services are aimed at the general public, and a portion of that public may not be tech-savvy and that there is no evidence as to how tech-savvy the relevant public is.

73. Mr Stobbs pointed me to paragraphs 45-46 of the *Loop* (O/194/21) decision, which he said is relevant to this opposition proceedings as it provides a comparison between the same goods and services in general terms. Mr Stobbs then guided me through the table, which was included in Annex 1 of Mr Marshall's skeleton argument, comparing the competing goods and services. He drew my attention to the terms that were directed towards technical experts or professionals, for example, aerials for telecommunications, signal transmission apparatus, broadband installations, and satellite capacity provision. Mr Stobbs explained that such terms would require a high or very high degree of care.

74. Prior to my analysis, I will address the case law cited by both parties. I note that the IPEC decisions that Mr Marshall referred me to pertain to

infringement proceedings, which are not directly pertinent in opposition proceedings where familiarity with the earlier mark is not a prerequisite. Further, decisions by fellow Hearing Officers will, of course, be determined on their own facts and are, anyway, not binding or strong precedent for other cases before the Tribunal. Notably, whilst I have considered the above cases, I am not bound by them. Further, for the avoidance of doubt, I note that for the determination of the average consumer the goods and services listed in both the earlier and the contested specifications should be considered.[10]

75. The average consumer of the goods and services at issue will be either a member of the general public or professional and business users. The goods and services range from relatively commonplace, such as internet access software and computer software, to more bespoke and sophisticated ones, such as aerials for telecommunications, satellite capacity provision [telecommunications], and software engineering. In relation to the goods at issue, they are usually offered for sale in retail or specialist stores, brochures, catalogues, and online. The goods will be displayed on shelves in retail premises, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative. As for the services at issue, the average consumer's encounter with such services will be on a visual level, such as signage on premises, promotional material, journal advertisements and reports, and website

[10] The GC in case T-328/05, *Quartz*, EU:T:2008:238, stated in paragraph 23:

> "Second, although it is possible that both the earlier mark and the mark applied for also target categories of potential purchasers other than information technology specialists, the fact remains that the relevant public for the assessment of the likelihood of confusion is composed of users likely to use both the goods and services covered by the earlier mark and the product covered by the mark applied for."

use. Also, word-of-mouth recommendations and independent reviews may play a part in the selection process.

76. The degree of attention will vary from average to high depending on the importance, cost, and suitability of the goods and services. Also, regardless of the cost, the average consumer will likely examine the relevant goods in Class 9 to ensure software and hardware compatibility with other components or systems. In relation to those services which are infrequent and expensive purchases, such as hosting of platforms on the Internet, and maintaining databases in Class 42, a higher than average to a high, although not the highest, level of attention will be paid when selecting a service provider in order to ensure the integrity of the services and that they are fit for purpose. I also note that for all the above goods and services, prior consultation or research is conducted before purchase.

Comparison of Trade Marks

77. 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."

78. 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.

79. The marks to be compared are:

Opponent's Mark	Applicant's Series of Three Marks
gointernet	

Correct Approach to the Comparison of the Marks

80. Mr Marshall directed me to paragraphs 11 to 12 of the *Dreamersclub*[11] judgement where *La Superquimica*[12] is cited. Mr Marshall explained that

[11] *Dreamersclub Ltd's Trade Mark Application (DREAMERS CLUB)* [2019] RPC 16

[12] T-*24/17 La Superquimica v EUIPO,* EU:T:2018:668, paragraph 39 states that:

> "it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be

the "Applicant's mark is effectively a stylised presentation of the word GO FIBRE"[13], and on that basis, later in the hearing, he submitted that the correct approach "to compare the marks in this opposition […] should be [by] comparing GOINTERNET as a word mark with the words GO FIBRE, rather than focused on the stylised presentation of those words."[14]

81. Mr Stobbs challenged the above by submitting that the *Dreamersclub* decision was in relation to the use of a mark in a stylised font and not the scope of protection of the mark. Mr Stobbs further highlighted that:

> "But to say that the visual presentation of our mark is simply only a stylisation I would say is wrong, depending on how you interpret the word stylisation. It has its own device element, it was characterised as the dot on the I but it is integrated in the mark. But this is not just a set of stylised words, it has this flying electron, we say, device. You can interpret it how you will but it is a significant additional device element and not one that itself is lacking in distinctive character. […] Whilst of course the verbal analysis is important, you cannot ignore the fact that actually this is presented in a different way. You have the arrow included in the F, you have the initial capitals."[15]

82. I concur with Mr Stobbs' submissions and reiterate the correct approach for assessing the similarity of the marks should be based on the principles established in *Sabel BV v. Puma AG,* as previously cited in this decision. If I were to adopt Mr Marshall's approach, I would have unjustly and erroneously reduced the nature and scope of protection of the applicant's mark. Therefore, my analysis is as follows:

---

taken into account. It follows that a word mark may be used in any form, in any colour or font type […]."

[13] Page 7 of the transcript.

[14] Ibid.

[15] Page 17 of the transcript.

Overall Impression

83. The applicant's mark is a composite mark and a series of three. They all consist of the word elements "Go" and "Fibre". The former word sits at the top left of the latter, and both words are capitalised and in a standard typeface. The letter 'F' in the word 'Fibre' is slightly stylised with an arrow device replacing one of the arms of the letter. A spinning electron device is also placed diagonally and between the two word elements. This device appears to replace or connect to the dot of the letter 'i' in "Fibre". It is worth noting that the above elements in the series, including the background, feature different colour variations. Because of their primary position and font size, the words "Go Fibre" will be the dominant elements of the mark, having the greatest weight in the overall impression, whilst the devices, namely spinning electron and arrow, will have some but less relative weight in the overall impression of the mark with the use of colour and background playing a minimal role.

84. The earlier mark consists of the conjoined words "gointernet" in lower case. Registration of a word mark protects the word itself.[16] The overall impression of the earlier mark lies in the conjoined words, with neither word component dominating the other. Notwithstanding the conjunction, both words will still be identified.

Visual Comparison

85. The word element in the earlier mark is ten letters long, whereas the contested mark is seven. Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,[17] the competing marks share the first two letters, namely the common word element/component "Go/go-". However, there are points of visual differences. More specifically, the marks differ in the word elements

[16] See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

[17] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

"-internet" and "Fibre". Another point of visual difference is the presence/absence of the spinning electron and arrow devices in the competing marks. Considering all the factors, including the overall impression of the marks, I find them to be visually similar to between a low and medium degree.

Aural Comparison

86. Mr Stobbs submitted that the earlier mark could be articulated either as 'GOYN-TER-NET' or 'GO INTERNET'. However, Mr Marshall challenged the articulation of the earlier mark as 'GOYN-TER-NET' and submitted that it should be disregarded.

87. In the absence of evidence, I agree with Mr Marshall and note that the word components "go-" and "-internet" will be recognised, and the average consumer will pronounce them in the ordinary way. Therefore, the average consumer will articulate the earlier mark as "GOH-IN-TUH-NET" and the contested mark as "GOH-FIE-BUH". There are differences in the length and syllables of the marks. The earlier mark is four syllables long, whereas the contested mark is three. In more detail, the competing marks only share the first syllable, "GOH-", but differ in the remaining ones. I do not consider that the average consumer will attempt to pronounce the devices in the contested mark. Taking into account the above factors and the overall impressions, I consider that the marks are aurally similar to between a low and medium degree.

Conceptual Comparison

88. Mr Marshall submitted that the definition provided with the applicant's witness statement is "a granular technical distinction"[18] between the word 'internet' and 'fibre'. In this regard, Mr Marshall invited me to take judicial notice as "in common parlance it is common or quite often consumers will use the words 'internet', 'broadband', 'fibre optic' and 'wifi' as being

[18] Page 9 of the transcript.

synonymous. It is often the case that someone will say "do you have internet" and the response will be "yes, I have fibre optic". The terms are used synonymously."[19] He also highlighted that 'fibre' should be interpreted as a means of delivering data for accessing the internet. Mr Marshall concluded that the competing marks are highly conceptually similar, despite the technical distinction between the two words.

89. In his submissions, Mr Stobbs highlighted that there is no evidence to support Mr Marshall's claim that the terms ''internet' and 'fibre'' are synonymous, as this is also countered with the definitions provided with the evidence (Exhibits DB2-4) of the applicant. Mr Stobbs emphasised the importance of considering the entirety of the marks in the conceptual analysis. He also added that "'Internet' is the conceptual of this large, joined network and 'fibre' is a medium for transmitting data; they are two different things."[20] Although Mr Stobbs accepted that they can be involved in the provision of each other, he submitted that there is a conceptual difference between the marks, and it would be wrong to find them conceptually identical or very similar.

90. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

91. Both marks share the word element "Go/go-" which is a well-known dictionary word with more than one meaning and may convey the concept of movement or encouragement in this case at hand. Regardless of how the average consumer conceptualises the word "Go", they are likely to form the same concept of that word when it appears in the competing marks. However, I note that there is no evidence to support the opponent's

[19] Ibid.

[20] Page 28 of the transcript.

contentions that the remaining words ‘internet’ and ‘fibre’ are synonymous, and I am not prepared to accept this on the basis of judicial notice. Taking into account the definitions provided with Exhibits DB2-4 of the applicant, it is my view that the consumers will conceptualise the dictionary words “internet” and “Fibre” differently. “Internet” will be understood as a global network of computer networks, while “fibre” will be associated with the technology of transmitting information through glass fibres. Additionally, consumers will perceive the diverging words as allusive in the context of the goods and services being offered. Further, the concepts of the spinning electron and arrow devices in the contested mark will introduce additional concepts that are not present in the earlier mark. Taking into account all the above and the marks as a whole, including the overall impressions, I find them to be similar to between a low and medium degree based on the common element ‘Go’.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

92. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> “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).
>
> 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)."

93. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

94. Mr Marshall submitted that the dominant and distinctive element of the earlier word mark is the first word component 'go-' whilst the second word component '-internet' is descriptive. In contrast, Mr Stobbs submitted that the earlier mark should be afforded the minimum degree of distinctive character to allow it to be registered. He added that the word element 'go-' must be considered weak at best, and any distinctive character stems from the combination of the words 'go' and 'internet'.

95. The opponent has not shown use of its mark with its evidence and, thus, it cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. The earlier mark consists of the conjoined word "gointernet", which is an invented word consisting of the conjunction of the ordinary and dictionary words "go-" and "-internet", conveying the meaning described earlier in this decision. Although the mark in its entirety may be considered "invented", the conjoining of those words is not significantly fanciful. In this regard, while I recognise the level of inventiveness of the mark, I bear in mind that only the common element between the respective marks should be considered to evaluate the relevant (to the question of confusion)

distinctiveness,[21] a point that I shall return to later in this decision. With this in mind, the first word component, "go-", is an ordinary and dictionary word, affording a normal degree of distinctiveness, whilst the second word component, "-internet", alludes to the nature of the registered goods and services, and I consider it to be a weaker element. Consequently, I consider the inherent distinctiveness of the mark as a whole to be of a low degree.

LIKELIHOOD OF CONFUSION

96. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.[22] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater may be the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[23]

97. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

98. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's

---

[21] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

[22] See *Canon Kabushiki Kaisha*, paragraph 17.

[23] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

> "18 The judgment in Bimbo confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
>
> 20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER)."
>
> 21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there

is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

99. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. (as he then was) as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

100. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., (as he then was) sitting 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (’26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.)

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

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.[24]

101. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of

[24] See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

a bourbon whiskey under the sign “American Eagle”. In his decision, Lord Justice Arnold stated that:

> “13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

102. Earlier in this decision I concluded that:

- the goods and services at issue range from identical to dissimilar;
- the average consumer for the goods at issue will be either a member of the general public or professionals and business users, and the selection process is predominantly visual without discounting aural considerations. The level of attention paid will vary from average to high depending on the importance, cost, and suitability of the goods and services;
- the competing marks are visually, aurally, and conceptually similar to between a low to medium degree;
- the earlier mark is inherently distinctive to a below medium degree.

103. Mr Marshall submitted that there is a likelihood of direct confusion based on the dominant and distinctive element “Go” shared in both marks having a non-distinctive or descriptive second word element/component. Mr Stobbs submitted that the marks coincide in the non-distinctive element ‘GO’ and directed me to the *SHOPIFY* (T-222/21) judgement as to the assessment of the likelihood of confusion when the competing marks coincide in an element that is weakly distinctive. He further noted that there

is no direct confusion as the average consumer would not ignore the differences in the marks.

104. Taking into account the above guidance and the factors while considering the identical goods and services in play, there is no likelihood of direct confusion. Notwithstanding the doctrine of imperfect recollection, the differences are sufficient to enable the average consumer to distinguish the respective marks. I agree with Mr Stobbs and note that the word component “go-” in the earlier mark does not play an independent distinctive role by itself in the overall impression, but rather it creates a unit with the word component “-internet”. Therefore, even though the competing marks share common beginnings (“Go/go-”), the average consumer will recognise and remember the differences arising from the rest of the dictionary and well-known word elements present in the competing marks, i.e. “-internet/Fibre”, and the presence/absence of the device elements. Thus, the overall impressions and various visual, aural, and conceptual differences between the competing marks previously identified are, in my view, sufficient, and, as a result, the marks will not be directly confused.

105. Turning to indirect confusion, Mr Marshall submitted that the average consumer would indirectly confuse the marks by concluding that “GO FIBRE” is a sub-brand or brand extension of “gointernet” following the rationale in *L.A. Sugar*. Mr Stobbs reiterated that the common element is non-distinctive and that the contested mark consists of a number of elements, and the overall impression of the marks would not justify an indirect confusion as laid down in *L.A. Sugar*.

106. I bear in mind that there should be a proper basis for a finding of a likelihood of indirect confusion. I see no reasonable basis on which the consumer would be induced to believe that the competing marks are variants or sub-brands of each other. This is because the use of the common word component/element “Go” is not so strikingly distinctive that the average consumer would consider that only one undertaking could be

using it as a trade mark. Further, the diverging word and device elements in the contested mark are not, in my view, non-distinctive additions of a kind that one would expect to find in a sub-brand or brand extension. Thus, this case does not fall into the first and second categories identified by Mr Purvis. In contrast, taking into account the overall impressions of the marks and that the goods and services at issue are identical, I find that the contested mark would constitute a brand extension by substituting the allusive word element "internet" for "Fibre", which is likely to cause consumers to see the differences as logical with a brand extension. This is also due to the doctrine of imperfect recollection, where the average consumer may not recall that the earlier mark is a single word, and they may misremember it as two words. Further, I note the device elements in the contested mark have less weight in the overall impression, and, thus, their presence will not lessen the impact of the shared common element to avoid a finding of indirect confusion. Consequently, I consider that the consumers would believe that the marks originate from the same or economically linked undertakings, and as such, I find that there is a likelihood of indirect confusion.

107. The above findings extend to the goods and services I have found to be similar at any degree.

Evidence of actual confusion

108. The opponent claims actual confusion by relying on its evidence filed with Exhibit TC1 (see paragraph 14 of this decision). However, the parties disagree on the relevance of this evidence in the current proceedings due to the various differences in the presentation of the marks on the Trustpilot websites. Additionally, there is disagreement on the significance and weight that a single instance of actual confusion should carry in the proceedings at hand.

109. It is not clear that the evidence exhibited in TC1 pertains to the same marks as those in this opposition. This is because there are noticeable visual

differences that cannot be ignored. The alleged earlier mark, as exhibited, appears to have a different presentation, with the word ‘go’ being highly stylised and more prominent than the word ‘internet’, which is located below the letter ‘O’. Additionally, the alleged contested mark is presented as a single word, ‘Gofibre’, followed by the word ‘Broadband’, next to an unclear device. I agree with Mr Stobbs and note that these do not appear to be the same marks per se, and I am unwilling to overlook the differences and accept them at face value as equivalents of the marks before me. Even if I am wrong on the above point, it is unclear how representative and conclusive this instance could be in determining whether the average consumer, who is reasonably circumspect and observant, would likely confuse the competing marks. Therefore, I consider that even if this is a genuine instance of actual confusion, it should not be given such weight or importance to affect my findings on the likelihood of confusion as advanced above.

OUTCOME

110. The opposition under Section 5(2)(b) **succeeds and**, subject to an appeal against this decision, **the application will be refused for all the goods and services except for the following which I found to be dissimilar**:

> **Class 9:** Sensors; security control apparatus; security surveillance apparatus; safety, security, protection and signalling devices; electronic security systems for home network; security […], cameras and alarms; surveillance cameras; security cameras; digital sensors; alarm sensors; motion detectors.
>
> **Class 42:** “[…] design relating thereto; […] and industrial design services; quality control and authentication services; technical data analysis; environmental testing”.

COSTS

111. In terms of costs, whilst both parties have achieved a measure of success, proportionately, the opponent has been significantly more successful than the applicant. Awards of costs are based upon the scale published in Tribunal Practice Notice 2/2016. The sum is calculated as follows:

Official fee	**£100**
Preparing a statement and considering the other side's statement	**£400**
Preparing evidence and considering the applicant's evidence	**£600**
Preparing for and attending the hearing	**£900**
Total	**£2,000**

112. I, therefore, order Borderlink Broadband Limited to pay GO INTERNET LTD the sum of £2,000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of August 2023

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General