O/0836/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3749019
BY MOAT SYSTEMS LTD
TO REGISTER:

Moat Systems

AS A TRADE MARK IN CLASS 9

AND

IN THE MATTER OF TRADE MARK APPLICATION NO. 3810251
BY MOAT SYSTEMS LTD
TO REGISTER:

MOATSYSTEMS

AS A TRADE MARK IN CLASS 9

AND

IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 433511 & 436849 BY
MOAT INC.

BACKGROUND AND PLEADINGS

1. On 29 January 2022, Moat Systems Limited ("the applicant") applied to register **Moat Systems** as a trade mark in the United Kingdom in respect of the following goods:

> *Class 9*
> *System software; System and system support software, and firmware.*

2. On 17 July 2022, the applicant applied to register **MOATSYSTEMS** as a trade mark in the United Kingdom in respect of the following goods:

> *Class 9*
> *Software; Software applications; Computer software for use as an application programming interface (API).*

3. Both applications were opposed by Moat, Inc. ("the opponent"). The oppositions are based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and concern all the applied-for goods.

4. Under section 5(2)(b), the opponent is relying on International Registration ("IR") No. 162633:

MOAT

The IR was registered on 7 October 2021 and designated for protection in the UK on 18 February 2022. It has a priority date of 7 April 2021.[1] The IR is protected for the following services, all of which are relied upon:

> *Class 42*
> *Software as a service (SaaS) services featuring online non-downloadable software for measuring viewability of digital advertising, providing marketing*

[1] Priority is claimed from US Trademark No. 90629326.

measurements, data and analytics; providing an online, non-downloadable computer operating system software for return on investment (ROI) measurement of ad campaigns and monitoring effectiveness of advertising.

5. Under section 5(2)(b), the opponent claims that the marks are highly similar and that the goods and services covered by the marks are similar. It also claims that the distinctive character of the earlier IR has been enhanced through the use made of it, particularly in relation to software for data collection and analytics. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

6. The opponent also relies on this IR under section 5(3). In addition, it is relying on UK Trade Mark ("UKTM") No. 914680136, **MOAT**, which has a filing date of 15 October 2015 and a registration date of 15 February 2016. The mark is registered for the following services, for which the opponent claims that the mark has a reputation:

Class 35
Collection and analysis of quality metric data for network of online advertisers for business purposes; Advertising services, namely, evaluation of advertising effectiveness; Consulting services in the field of internet marketing.

7. The opponent claims that use of the contested marks would, without due cause, take unfair advantage of the reputation of the earlier marks, or be detrimental to their distinctive character.

8. Both the IR and the UKTM relied on by the opponent qualify as earlier marks under section 6(1) of the Act by virtue of their earlier priority date and filing date respectively. Only the UKTM completed its registration procedures more than five years before the filing date of the contested marks and so the opponent has stated that it has used this mark during the five-year period ending on the date of application of each of the contested marks.

9. The applicant filed defences and counterstatements denying the claims made and putting the opponent to proof of use of the UKTM.

10. Only the opponent filed evidence but both parties made written submissions during the evidence rounds. The opponent's are dated 20 September 2022 and 17 January 2023 and the applicant's were filed on 13 March 2023.

11. Neither side requested a hearing and the opponent filed final written submissions on 17 April 2023.

12. In these proceedings, the opponent is represented by CMS Cameron McKenna Nabarro Olswang LLP and the applicant is self-represented.

EVIDENCE

13. The opponent's evidence comes from Matthew Sarboraria, the Vice-President of Moat, Inc. It goes to the use of the marks in the UK and their reputation, and is dated 6 October 2022.

PRELIMINARY REMARKS

14. Before I consider the claims made by the opponent under the two pleaded grounds, I find it convenient to address a number of points made by the applicant.

15. In both its counterstatements and submissions, the applicant states that the word "MOAT" is used by other businesses and refers to searches undertaken on Google and the UK Trade Mark Register. These arguments have little, if any, relevance to the question of whether there is a likelihood of confusion between the applicant's marks and that of the opponent. In the case of the businesses and websites mentioned in the counterstatements, it is not clear what goods or services are offered, and where it is possible to make a reasonable inference (as with Moat Community College) the services are likely to be dissimilar to those of the opponent's earlier IR. The existence of trade marks on the register is not in itself relevant as that information would not tell me how many of such trade marks were effectively used in the market: see *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and*

Designs) (OHIM), Case T-400/06, paragraph 73.[2] Marks would need to have been used on the market for them to have any impact on how the average consumer might perceive the opponent's and applicant's marks.

16. The applicant states that it believes the opponent's oppositions to be invalid as *"the organisation doesn't develop Application Programming Interfaces (APIs) and sell them to consumers in the marketplace"*. *Computer software for use as an application programming interface (API)* is one of the goods in the specification of Application No. 3810251. When assessing the opposition under section 5(2)(b), I must base my decision on the specification of the earlier IR as registered and how it could fairly be used. It is not necessary for the goods or services of the opponent to be identical to those of the applicant. They merely need to be similar enough to lead to a likelihood of confusion under section 5(2)(b). For section 5(3), there is no requirement for the goods or services even to be similar. What the opponent must persuade me of here, is that, because of the reputation of the earlier mark, the relevant public will make a link between the earlier mark and the application(s) that will lead to damage. In short, whether the opponent sells APIs or not will not determine the outcome of these oppositions.

17. The applicant also argues that it has been using the contested marks since 28 January 2022 and that it has not received any indications that consumers have been confused. The courts have held that absence of evidence of actual confusion may not be significant in trade mark cases, as there may be several reasons for this lack, including limited use of one or more of the marks: see *Roger Maier & Anor v ASOS & Anor* [2015] EWCA Civ 220, paragraph 80; *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 at [291].

18. The applicant states that it owns the domain name *moatsystems.com*. The ownership of a domain name has no relevance to the grounds that I am required to consider in these proceedings. The applicant also says that the fact that the opponent

[2] 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 refer to the trade mark case law of EU courts, although the UK has left the EU.

had not registered the domain name is an indication that it is not truly the owner of the brand. It is important to note that the opponent has not claimed to be the proprietor of the sign **Moat Systems** or **MOATSYSTEMS**, but rather it is the proprietor of an IR and a UKTM for the word **MOAT**.

19. Finally, I note that the applicant submits that *"Our trademark is protected under the fair use doctrine."* It is not entirely clear what it means by this. Trade mark protection requires registration, and a mark may not be registered if there is a likelihood of confusion with an earlier mark, or if its use without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of an earlier mark. Those matters fall to me to decide here.

DECISION

Section 5(2)(b)

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

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

21. The IR on which the opponent relies under this section is not subject to proof of use.

22. In considering the oppositions under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union

("CJEU") in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH OHIM* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

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

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

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;

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

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

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

k) if the association between the marks creates a risk that the public 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

23. Section 60A of the Act states that:

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

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

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

(2) In subsection (1), the 'Nice Classification' means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 Jun 1957, which was last amended on 28 September 1979."

24. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

> "… 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."[3]

25. The goods and services to be compared are shown in the table below:

Contested goods	**Earlier services**
<u>*Class 9*</u> *System software; System and system support software, and firmware* (UKTM(A) 3749019) *Software; Software applications; Computer software for use as an application programming interface (API)* (UKTM(A) 3810251)	
	<u>*Class 42*</u> *Software as a service (SaaS) services featuring online non-downloadable software for measuring viewability of digital advertising, providing marketing measurements, data and analytics; providing an online, non-*

[3] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

Contested goods	Earlier services
	downloadable computer operating system software for return on investment (ROI) measurement of ad campaigns and monitoring effectiveness of advertising.

UKTM(A) 3749019

26. The opponent submits that the applicant's *System software* would include operating systems, which are the subject of one of its services. This accords with my own understanding. The applicant's goods and opponent's services would be targeted towards the same users and have overlapping purposes, although the method of use would be different. The goods and services are in competition, as the consumer may choose to purchase the software itself or a service that provides the software, perhaps on a subscription basis. There is likely to be some overlap in trade channels, with goods and services being offered by through the same outlets and by some of the same suppliers. I also consider that the goods and services are complementary, as the opponent's services rely on the applicant's goods and the average consumer would expect them to come from the same undertaking. I agree with the opponent that the goods and services are highly similar.

27. The same reasoning applies with regard to *System and system support software*.

28. According to the opponent, *Firmware* is *"a specific type of software installed on a device or piece of hardware".*[4] There is clearly a point of difference between these goods and the opponent's non-downloadable software, as this will not be installed on a device but accessed remotely. The purpose of the firmware is to provide the instructions that control the functioning of the device or hardware on which it is installed. There is a degree of similarity with the purpose of the opponent's services, providing software containing instructions for given tasks. The goods and services would be targeted towards the same users. The method of use would be different.

[4] Statement of grounds, paragraph 2.4.5.

There may be some overlap in trade channels. The goods and services are neither complementary nor in competition with each other. I find that they are similar to a low degree.

UKTM(A) 3810251

29. All the contested goods could include the software provided through the applicant's services. The users are the same and the goods and services would have overlapping purposes, although the method of use would be similar. The goods and services are in competition with each other. I also consider that the goods and services are complementary, as the opponent's services rely on the applicant's goods and the average consumer would expect them to come from the same undertaking. I find that they are highly similar.

Average consumer and the purchasing process

30. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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*, paragraph 26.

31. The opponent's services will be bought by businesses and other organisations, rather than the general public. I acknowledge that the applicant's goods have a wider customer base, particularly *Software* and *Software applications* in UKTM(A) 3810251. However, I shall focus on those customers who would be exposed to both parties' goods and services. The goods are likely to be purchased relatively infrequently and to be fairly costly, although I accept that there may be some less expensive options available, particularly for small businesses. The same applies to the opponent's services: even where, as in *Software as a service*, subscription fees may be charged on a regular and frequent basis, I would expect the customer to sign up to a contract. Given the importance of software and related services to the running of the business,

the average consumer would, in my view, pay a relatively high degree of attention during the purchasing process.

32. When choosing a provider of the goods and services, the average consumer would consult websites and may also use printed promotional material. I consider that they may also receive word-of-mouth recommendations or advice from consultants. Both the verbal and aural elements of the marks will be relevant.

Comparison of marks

33. It is clear from *SABEL* (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 in *Bimbo* that:

> "… it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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."[5]

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

35. The respective marks are shown below:

[5] Paragraph 34.

Contested marks	Earlier mark
Moat Systems **MOATSYSTEMS**	MOAT

36. The earlier mark is a plain word mark “MOAT”. The overall impression of this mark lies in that word.

37. The contested marks are also word marks, “MOAT SYSTEMS” and “MOATSYSTEMS”. Both will be seen as the two words “MOAT” and “SYSTEMS”, although in the latter they are combined into a single word. In the context of the goods for which registration is sought, “SYSTEMS” is descriptive, and so “MOAT” is the dominant and distinctive element of the mark.

38. The earlier mark can be seen as the first four letters of the contested marks. As it is the dominant and distinctive element of these marks, the remaining letters will carry less weight, but their descriptiveness does not mean that they can automatically be disregarded: see *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd (PURITY HEMP COMPANY IMPROVING LIFE AS NATURE INTENDED)*, BL O-115-22, paragraph 31. I find that the contested marks are visually similar to the earlier mark to at least a medium degree.

39. The words in the marks are in standard English usage and will be given the usual pronunciation. As with the visual comparison, the weight to be attached to the second and third syllables of the contested marks (i.e. the word “SYSTEMS”) is less than that of the first. I find that the contested marks are aurally similar to the earlier mark to at least a medium degree.

40. The word “MOAT” will be understood by the average consumer to mean a ditch filled with water that surrounds a castle or other property in order to prevent intruders gaining entrance. “SYSTEMS” suggests a collection of things that work together as part of a whole. As the concept of “MOAT” is shared by the earlier and contested marks, I find that they are conceptually similar to a high degree.

Distinctive character of the earlier mark

41. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Alternberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

42. 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.

43. The word "MOAT" is, as I have already noted, a common English word. As it does not describe or allude to the services on which the opponent is relying under this section, the inherent distinctive character of the earlier mark is medium.

44. The opponent submits that the distinctive character of this mark has been enhanced through the substantial reputation that it has acquired. The relevant date for assessing this claim is 29 January 2022 and it is use in the UK that matters.

45. Mr Sarboraria states that the mark has been used in the UK and elsewhere since the opponent was founded in 2007 for software services that collect and analyse data to measure consumer attention and the impact of advertising activity. 40% of UK websites that use advertising tracking technologies use the opponent's services. This amounts to over 9,000 customers. The figure was current on 2 September 2022.[6] This is, of course, after the relevant date. However, Exhibit MS3 contains 106 sample invoices dated between 29 January 2017 and 29 January 2022 for analytics services (albeit with the financial information redacted) and Exhibit MS4 provides six examples of collaborations between the opponent and UK customers between 2016 and 2021.

46. These are specialist services that the evidence shows have been promoted through content on the blog of the opponent's parent company, electronic publications, YouTube videos and events.[7] What is not clear is how much of an impact any of this activity has had in the UK. The same applies to the evidence of awards. The opponent has won several awards between 2019 and 2021 from the publication *Adweek,* which claims to have an audience of 6 million industry professionals and appears to be based in the US.[8] Mr Sarboraria notes that *Adweek "regularly"* holds events in London and refers to what was, at the time of the witness statement, a forthcoming Social Media Week in November 2022.[9] The frequency and scale of such events is not clear.

47. The evidence, in my view, falls short of what would be required to show that the inherent distinctive character of the mark had been enhanced through the use made of it.

[6] Exhibit MS2.
[7] Exhibit MS6.
[8] Exhibit MS7, page 6.
[9] Paragraph 6.2.2.

Conclusions on likelihood of confusion

48. There is no arithmetical formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

49. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

50. The dominant and distinctive element of the contested marks is identical to the earlier mark. As “SYSTEMS” is descriptive, or at least highly allusive, for the goods for which registration is sought, the average consumer will give it less weight and is likely to recall the later marks imperfectly, even though they are paying a relatively high degree of attention to their purchase. As a result, I find that even where the goods and services are similar to only a low degree, there is a likelihood of direct confusion. In the event that the average consumer does recognise that the marks are different, they will assume that the addition of the descriptive or allusive word “SYSTEMS” represents another version of the earlier IR used by the same undertaking. Consequently, I also find a likelihood of indirect confusion.

51. The oppositions are wholly successful under section 5(2)(b).

Section 5(3)

52. Given the success of the oppositions under section 5(2)(b), the section 5(3) ground puts the opponent in no better a position. However, for the sake of completeness, I shall briefly deal with it here.

53. Section 5(3) of the Act is as follows:

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

54. The conditions of section 5(3) are cumulative. First, the applications must be similar to the earlier marks. This condition has already been met. Secondly, the opponent must satisfy me that the earlier IR has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

55. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

"24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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

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

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

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

56. The relevant date is 29 January 2022. The opponent claims that the earlier IR has a reputation for the services relied on under section 5(2)(b). Earlier in my decision, I found that the opponent had not shown that the distinctive character of the earlier IR had been enhanced through use. Reputation is not exactly the same as enhanced distinctive character, but the same factors are to be taken into account. In the light of my earlier findings, I find that the opponent has not shown that this mark has a qualifying reputation.

57. The opponent is also relying on a comparable mark (UKTM 914680136), which it claims has a reputation for the following services: *Collection and analysis of quality metric data for network of online advertisers for business purposes; Advertising services, namely, evaluation of advertising effectiveness; Consulting services in the field of internet marketing* in Class 35. A "comparable mark" is one which has been converted from an EU Trade Mark, following the UK's departure from the European Union. Schedule 2A, Paragraph 10, of the Act provides that where the reputation of such marks is required to be considered at any time before IP completion day (31 December 2020), I need to consider reputation within the EU up to that date and the UK thereafter.

58. I can accept that the first and second of these at least are services that are delivered through the software services I considered under section 5(2)(b). However, there remain the same issues with the evidence in respect of the EU as I have already identified in respect of the UK. I therefore am unable to find that the opponent has shown that the earlier comparable mark has a reputation, and so the opposition fails under section 5(3).

OUTCOME

59. The oppositions are successful and Application Nos. 3749019 and 3810251 are refused registration.

COSTS

60. The opponent has been successful in these proceedings and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 2/2016. In the circumstances, I award the opponent the sum of £1700 which has been calculated as shown below. I have taken into account the degree of duplication between the two statements of grounds and the failure of the section 5(3) ground.

Preparing statements and considering the other side's statements: £400
Preparing evidence: £750
Preparing written submissions in lieu of a hearing: £350

Official fees (x2): £200

TOTAL: £1700

61. I therefore order Moat Systems Ltd to pay Moat Inc. the sum of £1700. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of September 2023

Clare Boucher,
For the Registrar,
Comptroller-General