

BL O/0909//26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF:

INTERNATIONAL REGISTRATION WO0000001514927 DESIGNATING THE UK

AND

TRADE MARK REGISTRATION UK00801514927

IN THE NAME OF GIOTTO.AI SA

AND

RESPECTIVE APPLICATIONS 506717 AND 506718

BY ALMAVIVA S.P.A.

FOR DECLARATIONS THAT THE AFORESAID REGISTRATIONS ARE INVALID

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

BY GIOTTO.AI SA

AGAINST A DECISION OF N R MORRIS (O/0001/26)

DATED 5 JANUARY 2026

DECISION

Introduction

1. This is an appeal from a decision of N R Morris acting for the Registrar dated 5 January 2026 (**“the Decision”**) in relation to consolidated cancellation proceedings brought by ALMAVIVA S.P.A. (**“the Respondent”**) regarding International Registration WO0000001514927 designating the UK and UK trade mark registration no. UK00801514927 (**“the Appellant’s Marks”**) both registered in the following form:



2. The Appellant’s Marks are owned by Giotto.ai SA (**“the Appellant”**) and are registered for the same goods and services in classes 9, 42 and 45.
3. The Respondent applied to invalidate the Appellant’s Marks pursuant to ss.47(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (**“the Act”**) relying on the following five earlier rights (**“the Respondent’s Marks”**):



(“the First Earlier Mark”)





4. The Respondent's Marks are all registered in respect of the same goods and services as each other in classes 9, 42 and 45 and the applications for invalidity were directed against all of the goods and services of the Appellant's Marks.
5. Neither party filed evidence or written submissions in lieu of a hearing, and so the Hearing Officer reached her decision on the papers.

The Hearing Officer's Decision

6. The Hearing Officer found some of the goods and services to be identical, while others were found to be either similar to a medium degree, or highly similar.
7. Having reviewed each of the Respondent's Marks, the Hearing Officer decided that the First Earlier Mark was the closest comparator to the Appellant's Marks. She

concluded that the marks were visually similar to a medium degree, and aurally identical for those consumers who would only articulate the GIOTTO element of the First Earlier Mark (which would have been the majority of consumers). The conceptual differences were neither distinctive nor determinative. She found that the First Earlier Mark enjoyed a level of inherent distinctive character somewhere within the upper range of medium, noting that the dominant and distinctive element GIOTTO enjoyed a high level of inherent distinctive character by virtue of being seen as an invented or non-English word.

8. She concluded that while there was no likelihood of direct confusion, there was a likelihood of indirect confusion between the First Earlier Mark and the Appellant's Marks in respect of all the goods and services covered by the Appellant's Marks.

The Appeal

9. The Appellant filed a Notice of Appeal to the Appointed Person under s.76 of the Act. Neither party requested a hearing and only the Respondent filed written submissions in lieu of a hearing. Accordingly, I have reached my decision after a careful review of the papers.

Standard of Review

10. It is well established that, in order to interfere with the decision of the Hearing Officer, I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be "*wrong*" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "*outside the bounds within which reasonable disagreement is possible*" (*Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 at [80]). In

the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]).

11. In the judgment of the Court of Appeal in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262, Arnold LJ said at [110]:

“It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: Volpi v Volpi [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2](v) (Lewison LJ).”

12. The Supreme Court recently restated the approach to appeals of this kind in its judgment in *Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc* [2025] UKSC 25 at [94] to [95] as follows:

“94. It is perhaps obvious, and certainly an inevitable conclusion drawn from experience, that reasonable minds, and in particular reasonable judicially trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multifactorial questions. While of course the decision of an appellate court trumps that of the court below, the law has imposed structured constraints designed to prevent a free for all in a higher court whenever a party (with the necessary resources) wishes to challenge the first instance decision of the trial judge. The reasons for these constraints are set out in a string of well-known authorities including, in the intellectual property context, Fage UK Ltd v Chobani UK Ltd [2014] EWCA Civ 5; [2014] FSR 29, per Lewison LJ at para 114. The reasons there set out relevantly include the following:

- (i) The trial is not a dress rehearsal. It is the first and last night of the show.*
- (ii) Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court.*
- (iii) In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping.*

95. In *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8; [2024] Bus LR 532 this court reviewed those constraints in a trade mark context. After citing from the *Fage* case this court in a joint judgment said, at paras 49-50:

*"49. That does not, however, mean the appeal court is powerless to intervene where the judge has fallen into error in arriving at an evaluative decision such as whether an activity was or was not targeted at a particular territory. It may be possible to establish that the judge was plainly wrong or that there has been a significant error of principle; but the circumstances in which an effective challenge may be mounted to an evaluative decision are not limited to such cases. Many of the important authorities in this area were reviewed by the Court of Appeal in *In re Sprintroom Ltd* [2019] 2 BCLC 617, paras 72–76. There, in a judgment to which all members of the court (McCombe, Leggatt and Rose LJ) contributed, the court concluded, at para 76, in terms with which we agree, that on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.*

50. On the other hand, it is equally clear that, for the decision to be 'wrong' under CPR r 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation."

13. I have borne those principles firmly in mind.

Grounds of Appeal

14. The Appellant's Grounds of Appeal set out three grounds of appeal which I will consider in turn.

Ground 1: Comparison of the marks

15. The Appellant asserted that the Hearing Officer *"failed to give sufficient weight to the significant differences in stylisation, visual structure, and the additional wording present in the earlier marks"*. In particular, the Appellant relied on the presence of *"substantial additional verbal elements, most notably the invented word ALMAVIVA"*, and criticised the Hearing Officer for treating them as playing only a *"lesser distinctive role"*.

16. I find no error made by the Hearing Officer in this respect. The First Earlier Mark consisted of the star-like device with the G in the centre, with the invented or non-English word GIOTTO written prominently beneath it. The words ALMAVIVA ENTERPRISE DIGITAL PLATFORM appeared in much smaller lettering below the word GIOTTO and the Hearing Officer was entitled to find that, although many average consumers would be unlikely to understand the meaning of the word ALMAVIVA, they would read the words ENTERPRISE DIGITAL PLATFORM as informative, alluding to the offering in some way, rather than as an indication of trade origin. Accordingly, her conclusion that the word GIOTTO contributed most to the overall impression of the mark and was the distinctive and dominant element of the mark was one a reasonable tribunal could have reached.

17. Similarly, I reject the Appellant's criticisms of the Hearing Officer's conclusion that *"the average consumer will likely accord more trade mark significance to the word 'GIOTTO' than the device"*. The Hearing Officer stated the following with respect to the First Earlier Mark:

"Whilst the device nevertheless has an appreciable visual impact in the mark, I bear in mind that it is generally the case that the words 'speak louder' than devices. In the [Respondent's] mark, my view is that the average consumer will likely accord more trade mark significance to the word 'GIOTTO' than the device. The presence of the 'G' within the device, to my mind, reinforces this, because it will likely be seen as the initial for 'GIOTTO'"

18. This was a conclusion she was entitled to reach, and one I agree with.

19. Nor did the Hearing Officer make any error in finding that the word GIOTTO was the dominant and distinctive element of the Appellant's Marks, with the ring-shaped device playing a lesser role within the overall marks.

20. Accordingly, I reject the First Ground of Appeal.

Ground 2: Comparison of some of the goods and services

21. The Appellant submitted:

"the Hearing Officer was wrong to conclude that "off-site data backup" is properly characterised as a form of "technological services" for the purposes of the Meric principle (Decision, paragraph 25); that "licensing of

technology" is identical or sufficiently similar to "licensing of intellectual property" without properly distinguishing the legal and commercial scope of each activity (Decision, paragraph 32); and that "online social networking services" are similar to "software as a service (SaaS)" (Decision, paragraph 33)".

22. The Appellant's reasoning was the same for each of these comparisons, namely that the Hearing Officer adopted an overly broad and expansive interpretation of the specifications of the Respondent's Marks and misapplied the factors laid down in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97)[1999] ETMR 1.

23. The Hearing Officer said the following with respect to the first comparison:

"It is my understanding that 'off-site data back-up' involves data being held remotely (e.g. by a server) as opposed to on the user's own computer drive or some other data storage device (e.g. a USB stick). The [Respondent's] specification includes the very broad term '[...] technological services [...]. I consider the provision of 'off-site data back-up' to be a technological service and, therefore, encompassed by the [Respondent's] broad term. The parties' services are, therefore, identical based on the principle in Meric."

24. The Appellant did not provide any evidence to assist the Hearing Officer and gives no reasons why "off-site data back-up services" would not fall within the umbrella of "technological services". The Appellant has not demonstrated any error of principle made by the Hearing Officer.

25. The Hearing Officer said the following with respect to the second comparison:

"It is my understanding that the licensing of technology is encompassed by the [Respondent's] broader term Licensing of intellectual property. The licensing of intellectual property will include the licensing of patents, which concern rights in technologies. The parties' services are, therefore, identical based on the principle in Meric."

26. The Appellant does not explain why the Hearing Officer's reasoning did not properly distinguish "the legal and commercial scope of each activity". The Hearing Officer's example of patent licensing does fall within the scope of both licensing of intellectual property and technologies, and without any evidence to assist her further, cannot be criticised for the conclusions she reached.

27. The Hearing Officer said the following with respect to the third comparison:

“The contested term, as its wording suggests, entails facilitating connections between individuals or businesses within the digital realm. A well-known example is ‘LinkedIn’, which aims to connect people based on occupational or business interests. Neither party has identified which of the [Respondent’s] terms might be an appropriate comparator. I will, therefore, compare the contested services to the [Respondent’s] broad term Software as a service [SaaS] in Class 42. The [Respondent’s] software service may relate specifically to social networking. Users and trade channels will inevitably overlap; both being offered by the same undertaking, with both engaged by users hoping to connect with others. I find the services to be complementary given that both offerings could be part and parcel of the same package of services. I find a medium to high level of similarity between the parties’ services.”

28. Again, the Appellant has not explained how the Hearing Officer misapplied the *Canon* factors or why the respective services are “conceptually and functionally distinct” and as a result has not identified any error of principle made by the Hearing Officer in her conclusions in relation to this comparison.

29. I therefore reject the appeal under Ground 2.

Ground 3: Finding of Indirect Confusion

30. The Appellant criticised the Hearing Officer’s finding of a likelihood of indirect confusion based on the common element GIOTTO, arguing that the average consumer would need to look to the other elements of the marks to deduce the origin of the goods and/or services, stating:

“There is no plausible basis for the average consumer to infer a brand-link or brand-extension relationship between the parties from the presence of any shared element, particularly given the Hearing Officer’s own recognition of the significant differences between the device elements, stylisation and additional wording in the marks”

31. After setting out a summary of the applicable law on indirect confusion, including the three categories of examples of indirect confusion given by Iain Purvis KC sitting as the Appointed Person in *L.A. Sugar Limited v Back Beat Inc* (BL-O/375/10), the Hearing Officer set out her conclusion on indirect confusion in paragraph 75 of the Decision:

“I consider that the instant case most closely aligns with the first of Mr Purvis’ categories. The common element ‘GIOTTO’ is highly distinctive, and the additional wording, ‘ALMAVIVA ENTERPRISE DIGITAL PLATFORM’,

present in the [Respondent's] mark would most likely be seen as informative rather than indicating trade origin. The average consumer might see the different devices within the marks as simply stylistic differences between related marks belonging to the same or economically-related undertakings. For example, the variations might be seen as denoting different lines of goods or packages of services. The 'informative' wording within the [Respondent's] mark might be seen as an element which may, or may not, appear within either party's mark from time to time. I find that there is a likelihood of indirect confusion between the parties' marks. I find this to be the case for all of the [Respondent's] goods and services."

32. Mr Purvis' first category read as follows:

"(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)."

33. Contrary to the Appellant's submission (and bearing in mind that I have rejected the Appellant's criticisms of the Hearing Officer's findings regarding the impact of the other elements of the First Earlier Mark other than the GIOTTO element under Ground 1), I consider the examples given by the Hearing Officer in paragraph 75 of the Decision to be entirely plausible reasons why the average consumer might be likely to assume that the respective goods and services come from the same or economically-related undertakings.

34. Accordingly, the Hearing Officer made no error in reaching her conclusion in respect of the likelihood of indirect confusion, so I reject Ground 3 of the Appeal.

Conclusion

35. The appeal has failed for the reasons set out above.

Costs

36. Since the Appellant has been unsuccessful, the Respondent is entitled to a payment towards its costs in relation to the appeal, in respect of which I shall award £500. The Hearing Officer awarded costs of £800 to the Respondent.

Accordingly, I order the Appellant to pay to the Respondent the sum of £1,300 within 21 days of the date of this decision.

Simon Clark
The Appointed Person
1 October 2026

Representation:

Appellant:	Lewis Silkin LLP
Respondent:	Stevens Hewlett & Perkins