

O-251-20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3296846 BY
OLIVER LENNON**

**TO REGISTER AS A SERIES
THE FOLLOWING TWO TRADE MARKS:**

SYNDEO
Syndeo

FOR SERVICES IN CLASS 42

AND

**IN THE MATTER OF OPPOSITION TO ITS REGISTRATION
UNDER NO. 413784
BY
OCLC, INC.**

Background and pleadings

1) On 14 March 2018 Mr. Oliver Lennon applied to register the following series of two marks for the following services:

1 of 2

The logo for SYNDEO features the word "SYNDEO" in a bold, blue, sans-serif font. A small blue horizontal bar is positioned above the letter "E".

2 of 2

Syndeo

Class 42: *Computer services for contact centres and organisations who need to communicate with their customers. Computer services; namely, managing interactions and interaction flows over digital channels between organisations and their customers; providing use of a nondownloadable use of web application software for management and reporting of the messages and customer interactions; providing temporary use of software for creating and defining interaction workflows, managing skills for employees (experts) who can assist customers, defining routing decisions when interactions from customers need managed by live experts, managing groups of experts, enabling experts to register and set their skills; Providing downloadable and nondownloadable software applications for experts to communicate with customers when assisting them to resolve customer service queries and issues, providing temporary use of software for artificial intelligence to assist experts in resolving customer queries. Computer and consulting services to help organisations tune and refine machine learning algorithms which are used to automate customer interactions for customer service. Computer software for creating interaction workflow processes (interaction flows) to enable organisations to communicate with their customers over digital channels. A computer software platform delivered on a SaaS basis incorporating Artificial Intelligence and Machine Learning to streamline communications between organisations and their customers for customer*

service to deliver customer outcomes, facilitating interaction over digital channels, namely, messaging platforms, mobile apps, websites and text messaging; Providing software for connecting individuals to facilitate self-service through automation and assisted service through peer-to peer communication between customers and individuals with expert knowledge (experts) to help resolve customer queries and issues; Provision of technical reports and management information for organisations to understand the volume and type of interaction they receive over digital channels, customer feedback, agent/expert metrics such as speed of response, duration of interactions, number of messages resolved, and number of outcomes achieved; Providing software using artificial intelligence and machine learning to analyse customer communications, based on processing natural language and directed dialogue queries, with an understanding of customer intent, customer sentiment analysis, and trust based routing to ensure the customer is connected to the best expert to help solve their query; Computer software to aggregate customer messages across multiple messaging apps into a single platform; Software to enable integration to customer relationship (CRM) management and other enterprise solutions to help with organisations with pre-sales, sales and post sales scenarios with their customers.

The application was published for opposition purposes on 20 July 2018.

2) On 20 September 2018 OCLC, Inc. (“the Opponent”) filed a notice of opposition. The opposition is brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon UK trade mark registration no. 3281044 (“the earlier mark”) for the following mark in respect of the following goods and services:

SYNDEO

Class 9: *Computer software for use in developing, archiving, managing, accessing metadata and electronic databases in the field of information management and library services; Computer software for use in database management; Computer software for searching, locating, requesting,*

retrieving, and delivering documents for purposes of accessing a variety of databases in the field of information management and library services; Computer software for management and analysis of metadata and electronic databases in the field of information management and library services; Computer application software for mobile phones, mobile devices, tablets, and handheld computers, namely, software for management and analysis of data relating to libraries' holdings and collections; Computer application software for mobile phones, mobile devices, tablets, and handheld computers, namely, software for management and analysis of library workflows, resources and operations; Downloadable mobile application for management and analysis of data relating to libraries' holdings and collections; Downloadable mobile application for management and analysis of library workflows, resources and operations.

Class 35: *Search and retrieval by others of electronic databases in the field of information management and library services; database management for libraries; search and retrieval of information from databases for use by libraries and library patrons.*

Class 41: *On-line library services, namely, online union cataloging and shared cataloging, classification of collection materials using library and other classification schemes, reference services, resource discovery, collection management; online library services.*

Class 42: *Computer services; namely, information storage; electronic storage of information for use by libraries and library patrons; providing temporary use of a non-downloadable web application for management and analysis of data relating to libraries' holdings, collections, inventory, circulation, acquisitions, workflows, resources, loan requests, finances, marketing and operations; Providing on-line non-downloadable software for use in database management; Design, development, maintenance and providing temporary use of non-downloadable software for management and analysis of data relating to libraries' holdings, collections, inventory, circulation, acquisitions, workflows, resources, loan requests, finances, marketing and operations;*

Providing online non-downloadable software for libraries, museums, archives, cultural heritage institutions, information repositories and their respective patrons, namely, online non-downloadable software for union cataloging and shared cataloging, facilitating interlibrary loans, serial controls and acquisitions, classification of collection materials using library and other classification schemes, reference services, resource discovery, collection management, providing electronic bibliographic, abstract, journal and book content; Providing non-downloadable software for searching library databases; Providing temporary use of non-downloadable reference management computer software for libraries.

3) The earlier mark was filed on 8 January 2018 and completed its registration procedure on 18 May 2018. The significance of the respective dates given above is that (1) the earlier mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the Applicant's mark.

4) The Opponent is represented by Squire Patton Boggs (UK) LLP. The Applicant is represented by FR Kelly. The Opponent claims that the marks applied for are identical to the earlier mark and to be registered for identical or similar goods or, further or in the alternative, that the marks are similar and to be registered for identical or similar goods or services, and that consequently the marks applied for offend against sections 5(1), 5(2)(a) or 5(2)(b) of the Act. The Applicant filed a notice of defence and counterstatement, denying that the first mark in the series applied for is identical or similar to the earlier mark in such way as to give rise to a likelihood of confusion, the more so given the nature of the services for which registration is sought by the Applicant, these being highly specialised and sophisticated. The Applicant contends that consumers of such services will take great care in selecting the services and notice such differences in the marks. The Applicant denies that the services for which it seeks registration are identical or similar to the goods and services covered by the Opponent's earlier mark, contending that they are subject to qualifications as a result of which the goods and

services can be distinguished. Accordingly, the Applicant requests that the opposition be rejected in its entirety.

5) Only the Opponent filed evidence. Neither party requested a hearing, and both the Opponent and the Applicant filed written submissions in lieu of attendance at a hearing. In its submissions the Applicant stated that it wished to amend the specification of its Application to the following:

Computer software services for creating Interaction workflow processes to enable organisations to provide customer service and communicate with their customers over digital channels, namely messaging platforms, mobile apps, websites and text messaging; Saas using artificial Intelligence and machine learning to analyse customer communications by processing natural language and directed dialogue queries and routing the communications to ensure the customer is connected to the appropriate expert; Saas to aggregate customer messages across multiple messaging apps into a single platform.

I shall address this proposed amendment when I come to make my assessment of the relevant goods and services.

Evidence summary

6) In a witness statement of 27 August 2019, to which seven exhibits are appended, Ms. Julie Presas explains that she is “General Counsel and Vice President of Legal Services, Secretary of OCL, Inc.” and has held this position since March 2014. Her further statements are summarised in paragraph 7 below.

7) The Opponent is a non-profit cooperative, funded by its membership's use of shared services and programs. It has established, maintains and operates an international computerised network of bibliographic cataloguing services for libraries and also promotes library use. Cloud-based technology has created the means to work in a networked environment and the Opponent has introduced a suite of services which facilitate national and regional library collaboration under the Trade Mark SYNDEO. In Europe the Opponent first promoted the suite of services under

the Trade Mark at a Regional Council Meeting of the Opponent held in Edinburgh in February 2018 and it also set up a website just prior to the event. An analytics report from the website shows 41 hits from the UK in the 12 months up to July 2019. The SYNDEO Trade Mark is used in relation to a platform through which very large organisations can manage their member libraries and the delivery of their software services. Because the Opponent targets large organisations and consortia representing many libraries around the world, it does not engage in advertising other than via its website and its sales teams who have identified the relevant customers. The Opponent's market is large national service organisations, not individual libraries. This means it has one customer in the UK: namely, JISC, i.e. the UK higher, further education and skills sectors' not-for-profit organisation for digital services and solutions. JISC entered into a partnership with the Opponent to set up the National Bibliographic Knowledgebase based on the SYNDEO suite of services and used by 96 libraries.

Sections 5(1) and 5(2)

8) Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

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

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

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

or

(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.”

Sections 5(1) and 5(2)(a)

9) In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held (at paragraph 54) that, for the purposes of the provision of Directive 89/104/EEC which corresponds to section 5(2)(a) of the Act, a sign is identical with a trade mark where it reproduces, without any modification or addition, all the elements constituting that trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer. I shall explain below that I think that some consumers may notice the short horizontal stroke above the letter E in the opposed mark number one. In view of this, it will be convenient to turn first to the Opponent’s claim under section 5(2)(b), before considering the implications for the claims under sections 5(1) and 5(2)(a).

Section 5(2)(b)

10) The following principles are 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 B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

11) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

12) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services

c) The respective trade channels through which the goods or services reach the market

d) 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;

e) 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.

13) In *Gérard Meric v OHIM* Case T- 133/05 (“*Meric*”), the General Court (“the GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the 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 (Case T-104/01 *Oberhauser v OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM — Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)”.

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

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

This principle also applies to services.

15) The significance of classification and the relevance of class numbers were considered by the courts in *Altecnic Ltd's Trade Mark Application* [2002] R.P.C. 639, *Pathway IP SARL v Easygroup Ltd* [2018] EWHC 3608 (Ch) and most recently in *Multi-Access Ltd v Guangzhou Wong Lo Kat Great Health Business Development Co Ltd* [2019] EWHC 3357 (Ch). In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J held:

“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.”

Jacob J also said, in *Treat*:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade”.

16) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 it was held that specifications should not be given an unnaturally narrow meaning. The Court of Appeal also considered the interpretation of specifications in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 (in the context of a non-use issue):

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the

court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”.

17) In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) observed:

"... 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 or 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."

18) In its written submissions in lieu of attendance at a hearing the Applicant proposed an amendment to its specification. Since no amendment to the specification has been undertaken, this proposal amounts to a fall-back position on the Applicant's part. Accordingly, I must first make my assessment of the similarity of goods and services on the basis of the Applicant's specification as it currently stands and then, if appropriate, consider whether the position would be altered if the Applicant's specification were amended in accordance with the Applicant's proposal.

19) In its counterstatement the Applicant denies that the services for which it seeks registration are identical or similar to the goods and services covered by the Opponent's earlier mark, contending that they are subject to qualifications as a result of which the goods and services can be distinguished. In its written submissions in lieu of attendance at a hearing the Applicant reiterated this point with particular reference to its proposed amendment of its specification:

“The amended services in the specification of the Trade Mark of the Applicant can, due to the fact that they are very specific, be distinguished from the goods and services covered by the earlier right of the Opponent. It must be borne in mind that the average consumer of the goods and services is sophisticated and the nature of the goods and services are such that a great deal of care and attention is paid to the selection of those goods and services. As a result, the consumer will pay attention to and notice differences in Trade Marks and will take great care to ensure that they select the goods and/or services required. As a result, it is submitted that, when all factors are taken into account, there would be no likelihood of confusion between the respective Trade Marks. In this regard, we would refer to the interdependency principle and submit that any similarities between the respective Trade Marks would be offset by the differences in the respective goods and/or services having regard to the nature of those goods and services and the care taken in the selection process.”

20) In its written submissions in lieu of attendance at a hearing, and referring to the Applicant’s unamended specification, the Opponent contends that “(a) not all the items within the Opponent’s specification are so qualified and (b) as the Applicant has made no specific qualification to its specification, there could still be an overlap – the phrase “*Computer services for organisations who need to communicate with their customers*”, for example, being broad enough to encompass libraries”. In its statement of grounds the Opponent also claims that the Class 42 computer services for which the Applicant seeks registration are identical to “computer services” at large within the Opponent’s Class 42 specification.

21) Before making my comparison I note two points. Firstly, while it is true that the phrase *Computer services* in the Opponent’s Class 42 specification is followed by a semi-colon, it is also immediately followed by qualifying words: *Computer services; namely, information storage*. The Opponent’s specification does not therefore include *Computer services* at large, these services being limited to *information storage*.

22) Secondly, the parties' submissions on similarity of goods and services, purchasing process, and the relevant public and its perceptions were confined to the general points I have noted above. Though showing the use to which the earlier mark is currently put in practice, the Opponent's evidence did not assist me materially in determining the ambit of the Opponent's specification for the purposes of the purely notional comparison of goods and services I am required to make. Nor did the Applicant file evidence. It would have been useful to have had more detailed and specific submissions, backed by concrete evidence, on the similarity of the goods and services of the respective specifications, purchasing process, and the relevant public and its perceptions. In the absence of such more focused submissions and evidence I can only really consider factors which are obvious. I must adopt the approach of Neuberger J in *Beautimatic* and give the words their natural meaning, subject to their being construed within their context. I must also bear in mind the comments of Jacob J in *Avnet*, Floyd J in *YouView TV Ltd v Total Ltd* and of the Court of Appeal in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd*.

23) I turn first to comparison of the Applicant's and the Opponent's respective services in Class 42. I am inclined to agree with the Opponent that the phrase *Computer services for contact centres and organisations who need to communicate with their customers* is broad enough to encompass libraries. The term "customer" is used very broadly nowadays, and I consider that it could cover the patron of a library. It would certainly do so in the case of a library which charged for its services. In my view the following services of the Opponent's specification can all serve the purpose (amongst others) of communicating information between libraries and their patrons: *electronic storage of information for use by libraries and library patrons* (on the basis that it may be accessed by library patrons); *providing non-downloadable software for searching library databases* (on the basis that it may be used by library patrons); *Providing temporary use of non-downloadable reference management computer software for libraries* (on the basis that reference management software can be used by scholars, researchers, etc.). These services could therefore all fall within the ambit of the Applicant's *computer services for contact centres and organisations who need to communicate with their customers*, and thus be identical under the principle in *Meric*.

24) I consider that such actions as the perusal of library catalogues and the searching of library databases over digital channels by library patrons, and the provision of electronic bibliographic, abstract, journal and book content, could be described as interactions between libraries and their patrons. Assuming that *customers* may include *library patrons*, the Applicant's *computer services; namely, managing interactions and interaction flows over digital channels between organisations and their customers* therefore seems to me to be framed in sufficiently broad terms to cover the following services of the Opponent (on the basis that they enable patrons to access over digital channels the information stored by the organisation): *Electronic storage of information for use by libraries and library patrons; Providing online non-downloadable software for libraries, museums, archives, cultural heritage institutions, information repositories and their respective patrons, namely, online non-downloadable software for union cataloging and shared cataloging, facilitating interlibrary loans, serial controls and acquisitions, classification of collection materials using library and other classification schemes, reference services, resource discovery, collection management, providing electronic bibliographic, abstract, journal and book content; Providing non-downloadable software for searching library databases.* Accordingly, the services are identical under the principle in *Meric*.

25) Services of the Opponent such as those I have considered in paragraph 24 involving the electronic storage of information for use by libraries and library patrons, union and shared cataloging, facilitating interlibrary loans, reference services, providing electronic bibliographic, abstract, journal and book content and providing software for searching library databases may be used both by libraries and their patrons. I think that, for example, the accessing by library patrons of catalogues, bibliographic data, reference services, etc., or requests for interlibrary loans, may reasonably be seen as messages and customer interactions falling within the ambit of the Applicant's *providing use of a nondownloadable use of web application software for management and reporting of the messages and customer interactions*, making it identical, under the principle in *Meric*, with those services of the Opponent which I considered above in paragraph 24.

26) My conclusions in paragraphs 23 to 25 above are drawn on the assumption that the term “customer” can cover library patrons. In case I am wrong about this, or in case it should be found that my interpretation of the terms of the Applicant’s or the Opponent’s specification has strayed from their core meaning, there are other grounds which I consider give rise to similarity between the respective specifications in Class 42, and I consider these below. I shall make the comparison by grouping together the Applicant’s services insofar as they are apt to be assessed in essentially the same way and for the same reasons¹. I have found it helpful to consider the Applicant’s services in Class 42 as falling broadly into the following groups:

Computer services for contact centres who need to communicate with their customers; Providing downloadable and nondownloadable software applications for experts to communicate with customers when assisting them to resolve customer service queries and issues, providing temporary use of software for artificial intelligence to assist experts in resolving customer queries; Computer and consulting services to help organisations tune and refine machine learning algorithms which are used to automate customer interactions for customer service; A computer software platform delivered on a SaaS basis incorporating Artificial Intelligence and Machine Learning to streamline communications between organisations and their customers for customer service to deliver customer outcomes, facilitating interaction over digital channels, namely, messaging platforms, mobile apps, websites and text messaging; Software to enable integration to customer relationship (CRM) management and other enterprise solutions to help with organisations with pre-sales, sales and post sales scenarios [sic] with their customers.

All the above services are explicitly specified as relating to customer service and customer relationship management functions, such as those typically undertaken by call centres and contact centres.

27) I now turn to the following services:

¹ See the observations of Mr Geoffrey Hobbs, QC, sitting as the Appointed Person, in *Separode Trade Mark* BL O/399/10.

Providing temporary use of software for creating and defining interaction workflows, managing skills for employees (experts) who can assist customers, defining routing decisions when interactions from customers need managed by live experts, managing groups of experts, enabling experts to register and set their skills; Providing software for connecting individuals to facilitate self-service through automation and assisted service through peer-to-peer communication between customers and individuals with expert knowledge (experts) to help resolve customer queries and issues; Provision of technical reports and management information for organisations to understand the volume and type of interaction they receive over digital channels, customer feedback, agent/expert metrics such as speed of response, duration of interactions, number of messages resolved, and number of outcomes achieved; Providing software using artificial intelligence and machine learning to analyse customer communications, based on processing natural language and directed dialogue queries, with an understanding of customer intent, customer sentiment analysis, and trust based routing to ensure the customer is connected to the best expert to help solve their query.

Although customer service or customer relationship management are not explicitly mentioned in the above items, they clearly describe the functions typically undertaken for those purposes by call and contact centres: i.e. the provision of software to classify and route customer calls, emails, etc. automatically to the appropriate automatic response or the person able to resolve the query; the monitoring of the efficient operation of such systems; and the use of artificial intelligence and machine learning for these purposes.

28) The final group of services are as follows:

Computer services for organisations who need to communicate with their customers; Computer services; namely, managing interactions and interaction flows over digital channels between organisations and their customers; Providing use of a nondownloadable use of web application software for management and reporting of the messages and customer interactions; Computer software for creating interaction workflow processes (interaction

flows) to enable organisations to communicate with their customers over digital channels; Computer software to aggregate customer messages across multiple messaging apps into a single platform.

All the above services also clearly cover software provided for customer service or customer relationship management functions, but are more broadly worded, so as to cover all kinds of communications and interactions between organisations and their customers (though, of course, any kind of communication between an organisation and its customers can in the broadest sense be said to involve customer management of some kind). In fact, all the services covered by the Applicant's Class 42 specification are neatly comprehended and described in its first item: *Computer services for contact centres and organisations who need to communicate with their customers.*

29) In its counterstatement and written submissions the Applicant contends that the services for which it seeks protection are highly specialised and sophisticated and that the specifications of the respective goods and services of the Applicant and the Opponent are subject to qualifications as a result of which those goods and services can be distinguished. In fact, however, there are two items of the Opponent's Class 42 specification which are not qualified by a reference relating the respective service specifically to libraries or comparable institutions, namely: *Computer services; information storage* and *Providing on-line non-downloadable software for use in database management.* The services thus specified at large under both these items may be provided to consumers of any of the Applicant's services.

30) I have already observed that although the Opponent filed evidence showing how it currently markets its services, and the use to which the earlier mark is currently put in practice, neither the Opponent nor the Applicant filed evidence to establish consumer perceptions and trade practice with regard, for example, to trade channels or the comparison goods and services as they relate to the purely notional comparison of the complete ambit of the respective specifications which I am required to make. In particular, there is no evidence before me to suggest, for example, either that the Applicant's services on one hand and the Opponent's goods and services on the other are in practice predominantly supplied by different

undertakings through different trade channels, or that they are routinely supplied by the same undertakings through the same trade channels. In the absence of such evidence I can only really consider factors which are obvious and arrive at my conclusions on the basis of general considerations of principle.

31) I have pointed out that all the services covered by the Applicant's Class 42 specification are neatly comprehended in its first item: *Computer services for contact centres and organisations who need to communicate with their customers*. There is no reason to think that any contact centre (or any organisation needing to communicate with its customers) would not also require information storage and database management capacities (which would nowadays invariably be provided digitally) in order to fulfil its wider customer management and communication purposes. In fact it is difficult to see how any organisation can manage and keep track of its customer communications (whether in the specific context of the customer management functions covered in the specification items listed in paragraphs 26 and 27 above or in the wider context of customer interactions covered in the items listed in paragraph 28 above) without such capacities. On the other hand, it is no doubt true that a great many computer-based or software-dependent commercial operations require information storage capacity or database management software for their successful completion. The question is therefore whether the connection is simply too general to give rise to a perception of similarity by the average consumer of the respective services.

32) There is a clear overlap in the users of the respective services. The mere fact that different services are supplied to the same users, however, need not in itself indicate similarity. The nature and purpose of the Applicant's Class 42 services differ from those of the Opponent; the former relate specifically to the facilitation of communication between contact centres and other organisations and their customers; the latter relate to the more general purposes of information storage and database management. They are not in competition; one cannot be substituted for the other.

33) I have observed that there is clear potential user overlap. I have also pointed out that the specific nature and purpose of the Applicant's Class 42 services differ

from the more general purposes of information storage and database management. I think that the consumer will consider it quite natural to find them supplied by different undertakings; but on the other hand I do not consider them to be so different in nature and purpose that the consumer will be surprised to find them supplied by the same undertaking. The consumer of all these services will include a range of companies and organisations of varying sizes. Larger organisations with in-house IT specialists may be more inclined to source their various IT needs from a range of specialist suppliers, whereas smaller undertakings with less in-house expertise may prefer to deal with suppliers who can provide a fuller suite of services to supply their needs. A company or organisation may need to buy in from a third party supplier information storage capacity and/or software for use in database management in order to fulfil its commercial purpose of communicating efficiently with its customers; it will see these services as necessary to the achievement of the overall organisational purpose of customer communication.

34) Therefore, although the Applicant's services considered in paragraphs 26-28 above are different services from the Opponent's *Computer services; namely information storage and Providing online non-downloadable software for use in database management*, I consider that there is a close connection between them in the sense that one may be indispensable or important for the use of the other in such a way that customers may think that the responsibility for them may lie with the same undertaking. Overall, I consider that there is a medium degree of similarity between the Opponent's *Computer services; namely information storage and Providing online non-downloadable software for use in database management* and each of the services of the Applicant's Class 42 specification, as considered in paragraphs 26-28 above.

35) Since I consider that the Opponent's services in Classes 9, 35 and 41 do not take its case beyond the degree of similarity with the Applicant's services which I have already found to be provided by the Opponent's Class 42 services discussed above, I shall not consider them in detail here. I simply observe briefly that I think it might be argued that its *Computer software for use in developing, archiving, managing, accessing metadata and electronic databases in the field of information management and library services; Computer software for searching, locating,*

requesting, retrieving, and delivering documents for purposes of accessing a variety of databases in the field of information management and library services; Computer software for management and analysis of metadata and electronic databases in the field of information management and library services in Class 9 are limited not simply to library services but to the field of information management more generally too. This depends on whether one reads the “and” in “*information management and library services*” disjunctively (as meaning, in effect, “information management or library services”, or conjunctively (as meaning in effect “information management relating to library services”). I am inclined to think that the use of the singular “field” rather than the plural “fields” tends to indicate that the latter interpretation is the correct one.

36) In practice nothing turns on this, however, because the Opponent’s *Computer software for use in database management* in Class 9 is not qualified by a reference relating it specifically to libraries or comparable institutions. Essentially for the same reasons I have given in paragraphs 31-34 (clear potential overlap both in users and in organisational purpose, and complementarity), therefore, I consider that these goods too have a medium degree of similarity with all the Applicant’s services.

37) I must now consider whether the position would be different if the Applicant’s specification were amended in accordance with the Applicant’s proposal as follows:

Computer software services for creating Interaction workflow processes to enable organisations to provide customer service and communicate with their customers over digital channels, namely messaging platforms, mobile apps, websites and text messaging; Saas using artificial Intelligence and machine learning to analyse customer communications by processing natural language and directed dialogue queries and routing the communications to ensure the customer is connected to the appropriate expert; Saas to aggregate customer messages across multiple messaging apps into a single platform.

38) I have explained in paragraph 24 that I consider that such actions as the perusal of library catalogues and the searching of library databases over digital channels by library patrons, and the provision of electronic bibliographic, abstract, journal and

book content, could reasonably be described as interactions between libraries and their patrons. Assuming that customers may include library patrons, it therefore seems to me that the Applicant's *Computer software services for creating Interaction workflow processes to enable organisations to provide customer service and communicate with their customers over digital channels, namely messaging platforms, mobile apps, websites and text messaging* is probably framed in sufficiently broad terms to cover those services of the Opponent which I have described in paragraph 24 as enabling patrons to access over digital channels the information stored by the organisation. They would thus be identical under the principle in *Meric*.

39) *SaaS using artificial Intelligence and machine learning to analyse customer communications by processing natural language and directed dialogue queries and routing the communications to ensure the customer is connected to the appropriate expert*, on the other hand, seems to me to relate quite specifically to the particular customer service centre function of connecting a caller to the appropriate customer service adviser. I think the same applies in essence to *SaaS to aggregate customer messages across multiple messaging apps into a single platform*. They do not cover, and are not covered by, any of the Opponent's services, and there is no identity under *Meric*.

40) Quite apart from my findings in paragraphs 38 and 39, however, there are other grounds which I consider give rise to similarity between the Opponent's services and each of those in the Applicant's proposed revised specification. For the same reasons that I have already explained in paragraphs 31-34 (clear potential overlap both in users and in organisational purpose, and complementarity) I consider that the Opponent's *Computer services; namely information storage and Providing online non-downloadable software for use in database management* have a medium degree of similarity with each of the services of the Applicant's proposed revised specification.

The average consumer and the purchasing process

41) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

42) The average consumer of the Class 42 services of the Applicant will consist of organisations who need to communicate with their customers. Typically these will be commercial undertakings who wish to use such services for the purpose of customer service management. I consider that they might also include organisations such as charities, museums, galleries, etc. which need to communicate with their patrons and subscribers for the purposes of promoting their causes and services, soliciting subscriptions, etc.

43) Most items of the Opponent's Class 42 services are expressly limited by reference to libraries, although one refers additionally to museums, archives, cultural heritage institutions, information repositories and their respective patrons. I think one must bear in mind, however, that organisations such as charities, museums and cultural and scientific institutions may also operate libraries, some of which may potentially offer their services on a commercial basis.

44) The respective services of the Opponent and of the Applicant will therefore be purchased for professional purposes by businesses and organisations: i.e. commercial undertakings who wish to acquire software services for the purpose of customer service management, marketing, etc., or by libraries or comparable institutions wishing to facilitate national and regional library collaboration, adopting software relating to such library operations as inventory, cataloguing, loan requests, reference management, etc. The selection of these services will in both cases involve a high degree of attention commensurate with their commercial or professional importance for the organisations concerned. In both cases they will wish to ensure that the services offered to them are suitable for their needs. The services in question may initially come to their attention through direct approach, articles in professional journals, advertisements, brochures, websites, catalogues, directories and trade publications, etc., but the decision to acquire them will be a carefully considered one; it will probably involve exploratory meetings or conversations with, or invited tenders from, the potential suppliers. There may be negotiations. There will be written dealings. The selection of such services is thus likely to be predominantly a visual process, but oral dealings may also play a part and will also be considered in my assessment.

45) The relevant public for the Opponent's information storage services and for its on-line non-downloadable software for use in database management in Class 42 (and its computer software for use in database management in Class 9) could conceivably be a wide one, but I think it fair to reflect that it will probably in practice consist predominantly of businesses and other comparable organisations, and that the purchasing process will involve a high degree of attention commensurate with its commercial or professional importance for the organisations concerned. The selection of these services too is likely to be predominantly a visual process, but oral dealings may also play a part and will also be considered in my assessment. I also bear in mind that the Opponent's *computer software for use in database management* in Class 9 may be provided in the form of software recorded on magnetic media or downloaded from a remote computer network.

Comparison of the marks

46) 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.”

47) It would be wrong, therefore, to dissect the trade marks artificially, 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.

48) The marks to be compared are shown below:

The opposed mark number one in the series	The opposed mark number two in the series	The earlier mark
	Syndeo	SYNDEO

49) In making my visual comparison of the opposing marks I bear in mind that notional and fair use both of the opposed mark number two and of the earlier mark

would include use in both upper and lower case², so letter case is irrelevant to the comparison of any of the marks; but in any case I do not consider that letter case in itself would play a role in consumer perception of the marks. On the contrary, it would go unnoticed by the average consumer. The opposed mark number two in the series and the earlier mark are thus in effect visually identical³. In both cases, their distinctive character lies in the word SYNDEO.

50) The earlier mark being a word mark not limited to colour, it would be registered in all colours⁴, lessening the significance of colour in the comparison with the opposed mark number one in the series. The contrast between the grey of the lettering and the light blue of the short horizontal stroke above the letter E in the opposed mark number one may result in the horizontal stroke's being noticed; it may or may not be perceived as some sort of accent; but accents are unfamiliar to, and routinely disregarded by, the average British consumer, and I do not consider that the relevant public will accord it any material distinctive significance. The distinctive character of the mark lies overwhelmingly in the word SYNDEO. If not visually identical, it is at any rate very highly similar to the earlier mark.

51) The Applicant submits that "the additional device element appearing above the letter E" in the first mark in the Applicant's series "also results in a different pronunciation with the E being emphasised and being pronounced aaay". I have already observed that accents are routinely disregarded by the average British consumer, and I do not consider that the stroke above the E in the Applicant's mark will cause the consumer to pronounce it differently from the earlier mark. Not being a recognised word in the English language, there is no acknowledged authorised pronunciation of SYNDEO. Some may pronounce the first syllable to rhyme with DINE, and others to rhyme with DIN. Some may pronounce the second syllable as DEE-OH, and others as DAY-OH. However consumers pronounce the word, though, they will pronounce it in the same way in all three marks. The marks are aurally identical.

² See *Peek & Cloppenburg v OHIM*, T-386/07 at paragraph 47 and *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, C-291/0 at paragraph 54.

³ Although the Applicant has not explicitly conceded this, the denial of similarity in its counterstatement is sensibly confined to the opposed mark number one in the series.

⁴ See *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2014] EWCA Civ 1294 at paragraph 5 and *Starbucks v EUIPO*, T-398/16 at paragraphs 53-54.

52) The average consumer in the UK will perceive SYNDEO either as an invented word or as a word, probably foreign, the meaning of which is unknown to him or her. None of the marks have any conceptual content to be compared.

The distinctive character of the earlier mark

53) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, either on the basis of inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

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

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

54) I find that SYNDEO, being an invented or unfamiliar word which is neither descriptive nor allusive of the relevant goods and services of the earlier mark, has a high degree of inherent distinctiveness when used in respect of those goods and services. Although it was not explicitly pleaded by the Opponent that the distinctiveness of the earlier mark had been enhanced through the use made of it, it submits that “It is clear from the Witness Statement of Julie Presas that the Opponent has significant goodwill and reputation in the United Kingdom in respect of the SYNDEO Trade Mark.” However, I consider that the evidence of the relatively recent use of the earlier mark in connection with a suite of services to facilitate national and regional library collaboration in the context of the Opponent’s partnership with what it describes as its one customer in the UK, the JISC, falls short of what is required to show that the mark’s distinctive character for the goods and services for which it is registered has been materially enhanced beyond what I have in any case already found to be its high degree of inherent distinctiveness⁵.

Likelihood of Confusion

55) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

56) I have found as follows:

- There is at least a medium degree of similarity between services of the Opponent and each of the services of the Applicant’s specification.

⁵ It is not clear to me from the evidence exactly who the 41 hits shown on the analytics report on the website set up by the Opponent (Exhibit 6) came from. The evidence is to the effect that the Opponent has only one customer in the UK, this being the JISC – which was presumably the UK attendant at the regional conference held in Edinburgh. It is not clear to me from the evidence who in the UK was exposed to the Opponent’s use of its SYNDEO mark apart from the JISC itself and its employees or agents.

- The opposed mark number two in the series is in effect visually identical with the earlier mark and the opposed mark number one is, if not visually identical, at any rate very highly similar to the earlier mark.
- The marks are all aurally identical.
- None of the marks have any conceptual content to be compared.
- The earlier mark has a high degree of distinctiveness.
- Purchases of the Applicant's IT services in respect of customer relations management functions and of the Opponent's IT services for libraries and comparable institutions will be made with a high degree of attention. The relevant public for the Opponent's software for use in database management and information storage services could be a wider one, but will in practice consist predominantly of businesses and other organisations, the purchasing process involving a high degree of attention commensurate with its commercial or professional importance for the organisations concerned.

57) The Applicant contends that the nature of the services for which it seeks registration are highly specialised and sophisticated, that consumers of such services will take great care in their selection, and that they will note the differences in the marks. It argues in effect that the respective highly specialised services of the Applicant and Opponent are specified in ways which make them so clearly different that, given the attention with which they are selected, the difference between, at any rate, the opposed mark number one and the Opponent's mark will be sufficient to avoid confusion.

58) The Opponent has given evidence that the SYNDEO Trade Mark is used in relation to a platform through which very large organisations can manage their member libraries and the delivery of their software services, its market being addressed to these large national service organisations, not individual libraries, its sole customer in the UK being the JISC. Superficially, this might be thought to add weight to the Applicant's line of argument, especially if it could be shown that there

was no overlap between the Applicant's and Opponent's respective markets⁶. Such a conclusion would be misconceived, however.

59) It is settled law that in order to assess the similarity of the goods at issue it is the group of services protected by the marks at issue which must be taken into account, *not the services actually marketed under those marks*⁷. In assessing whether there is a likelihood of confusion I must make my comparison on the basis of notional and fair use over the whole range of goods and services covered by the Applicant's and (since the earlier mark is not subject to proof of use under section 6A of the Act) the Opponent's respective specifications. It is the inherent nature of the goods and services described in the specifications which I have to consider; current use and business strategy are not relevant to this notional comparison. My task, therefore, is to conduct the comparison simply on the basis of the goods and services *as they are set out in the respective specifications*.

60) Bearing in mind that it is this notional comparison which I have to make, I have pointed out that there are two items of the Opponent's Class 42 specification which are not qualified by a reference relating the respective service specifically to libraries or comparable institutions, namely: *Computer services; information storage and Providing on-line non-downloadable software for use in database management*. The services thus specified at large under both these items may be provided to consumers of any of the Applicant's services. In making my assessment of the likelihood of confusion I must therefore bear in mind the notional possibility that, for example, consumers of any of the Applicant's services may also come across the Opponent's mark SYNDEO used in connection with the Opponent's *Computer services; information storage and Providing on-line non-downloadable software for use in database management* – and *vice versa*. I have found the respective services to have a medium degree of similarity. Similar considerations apply in respect of those Class 9 services of the Opponent which I have also found in paragraph 36 to be of medium similarity with all the Applicant's services.

⁶ According to the case-law, the relevant public I need to consider consists of persons likely to use both the goods covered by the earlier mark and those covered by the mark applied for (see (see *Apple Computer v OHIM*, T-328/05, paragraph 23, and *PVS v OHIM*, T-270/09, paragraph 28))

⁷ See *Devinlec Développement Innovation Leclerc SA v OHIM*, C-171/06P, paragraph 59, *Kureha v OHIM*, T 487/08, paragraph 71, and *Kitzinger v OHIM*, T 249/10, paragraph 23).

61) Even bearing in mind that the selection of the respective services will involve the considered process I have described in paragraphs 44 and 45 and a high degree of attention commensurate with the commercial or professional importance of the services for the organisations concerned, taking into account the fact that the Opponent's mark is either identical or very highly similar to the Applicant's marks, I consider that there is a likelihood that a consumer of the Opponent's services and goods mentioned in paragraph 60 marketed under the Opponent's mark who encountered any of the Applicant's services marketed under either of the Applicant's marks would think that they came from the same or economically linked undertakings. This would also apply where a consumer of the any of the services supplied under the Applicant's marks subsequently encountered the Opponent's mark used in connection with the Opponent's services and goods mentioned in paragraph 60. In the absence of any evidence to the contrary, for example, I consider it reasonable to imagine that a client of the Applicant encountering the Opponent's *computer software for use in database management* in Class 9 downloadable from an online source under the SYNDEO mark might well assume that it must originate from the Applicant. I have found that the contrast between the grey of the lettering and the light blue of the short horizontal stroke above the letter E in mark number one in the Applicant's series may result in the horizontal stroke's being noticed; but I do not consider that the average consumer will accord this any distinctive significance. He or she will simply see it as a variant presentation of the SYNDEO mark.

Sections 5(1) and 5(2)(a)

62) Inasmuch as the second mark in the Applicant's series is identical with the earlier mark, the likelihood of confusion technically falls to be determined under Sections 5(1) or 5(2). If I am correct in my assessment of the identity of the services examined in paragraphs 23-25 and paragraph 38 above, the opposition to the number two mark in the Applicant's series succeeds under section 5(1) in respect of those services of the Applicant; otherwise, the opposition to the number two mark in any case succeeds under section 5(2)(a), for the reasons I have given in paragraphs 31-34 and paragraph 36.

A revised specification?

63) I have already pointed out that to support a finding of confusion the relevant public must consist of consumers who are likely to use both the goods and services covered by the earlier mark and those covered by the marks applied for⁸. With that in mind I have considered whether the Applicant's specification could be amended in such a way that its services would address a completely different public from that of the Opponent's services, so that a likelihood of confusion would not arise. In particular, I have considered whether this might be achieved by adding a limitation explicitly and clearly limiting all the Applicant's services so as to relate exclusively and specifically to the provision of call or contact centre functionality – thus confining them to a highly specific market which is clearly the focus of the Applicant's interest. I have come to the conclusion that this would not be a viable solution, basically for the reasons I have already given in paragraphs 31-34 and paragraph 36.

Outcome

64) The opposition succeeds in its entirety, and the Applicant's mark may not proceed to registration.

Costs

65) The Opponent has been successful and is entitled to a contribution towards its costs. Since the registration procedure for the Opponent's mark was completed less than five years before the publication of the Applicant's mark, the Opponent was not required to file proof of use. While showing the use to which the earlier mark is currently put, the evidence did not assist me materially in determining the ambit of the Opponent's specification for the purposes of the purely notional comparison of goods and services I was required to make. I have also remarked on the limitations of the evidence when it came to determining whether the earlier mark's distinctiveness had been enhanced through use. Moreover, there was no evidence

⁸See, to that effect, judgment of 1 July 2008 in *Apple Computer v OHIM - TKS-Teknosoft (QUARTZ)*, T-328/05, EU:T:2008:238, paragraph 23, and judgment of 30 September 2010 in *PVS v OHIM - MeDiTA Medizinische Kurierdienst (medidata)*, T-270/09, EU:T:2010:419, paragraph 28.

from the Applicant to consider. I have thought it fair to reflect these considerations in my award.

66) I hereby order Oliver Lennon to pay OCLC, Inc. the sum of £1,000. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£200
Preparing evidence	£300
Preparing written submissions	£400

The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of April 2020

**Martin Boyle
For the Registrar,
The Comptroller-General**