

BLO/730/21

In the Matter of THE TRADE MARKS ACT 1994

-and-

In the matter of Trade Mark Application no. 3260746 for the trade mark WAYVE in classes 09 and 39 by Wayve Technologies Limited ("Wayve")

-and-

In the Matter of Opposition thereto under no. 411499 by Waymo LLC ("Waymo")

On Appeal from the Decision of the Hearing Officer of the Trade Marks Registry, Ms Louise White (Decision Blo/059/20)

MR. GWILYM HARBOTTLE appeared for the **Appellant**.

Ms. IONA BERKELEY appeared for the **Respondent**.

DECISION OF THE APPOINTED PERSON

IAIN PURVIS QC

1. This is an appeal against the decision of the Hearing Officer, Louise White, dated 30th January 2020, in an Opposition brought by the Opponent Waymo LLC, against an application made by Wayve Technologies Limited. I gave my decision orally after the hearing on 6 July, but indicated that I would tidy up and clarify the wording of the decision in a written version to be handed down in due course. The effect and the reasoning are the same as the oral decision.

2. The Application is for the mark WAYVE. It was filed on 2nd October 2017 and the mark was applied for in respect of goods in class 9, (including artificial intelligence, computer vision, reinforcement learning and machine learning for robotics applications, including autonomous vehicles, and software for self-driving cars or autonomous vehicles) and in class 39, for a range of services concerning the arrangement of various transport services, including rental and delivery services. The exact specifications are set out by the Hearing Officer in paragraph 1 of her Decision.

3. The Opponent opposed the application based on its earlier marks comprising the word WAYMO. The Opposition was on three grounds: likelihood of confusion with its earlier registered marks under 5(2)(b) of the Trade Marks Act 1994 ('the Act'); damage or an unfair advantage gained by the applicant under the extended protection provided to earlier marks with a reputation by section 5(3) of the Act; and contravention of the 'well-known marks' protection provided by section 6 of the Act. The section 6 ground has not been pursued on appeal.

4. The WAYMO earlier marks are
 - (i) a European Union trade mark for WAYMO, covering goods in classes 9 and 12 and services in class 39.
 - (ii) an international trade mark for WAYMO, covering goods in classes 9 and 12, and services in classes 38, 39 and 42.

5. The specifications of the earlier marks include a number of categories of goods and services some of which are identical with (or at least cover goods or services identical with) the specifications of the marks applied for. These include autonomous cars and vehicles, computer software for vehicle navigation, navigation apparatus for vehicles and steering apparatus for vehicles, transportation services and providing software services for transportation services.

6. The Hearing Officer rejected the Opposition. So far as s5(2) is concerned, she held there was no likelihood of confusion between the two marks when used in relation to the goods and services applied for, even those which were identical or close to identical. So far as the extended protection provisions of section 5(3) are concerned, she held that the Opponent had shown no reputation sufficient to entitle them to rely on those provisions.

7. On this Appeal, Mr. Harbottle, appearing for the Opponent, alleges that the Hearing Officer ought to have found that the marks were sufficiently similar, in particular having regard to the reputation of the earlier mark and the identity of the goods and services, for there to be a likelihood

of confusion under s5(2) amongst average consumers. So far as 5(3) is concerned, he says that the Hearing Officer was wrong to find that his client had not established a reputation sufficient for section 5(3) at the relevant date.

8. Mr Harbottle accepts that the decisions under appeal under both s5(2) and s5(3) were evaluative, multifactorial decisions by an experienced Hearing Officer. However, he contended that they were undermined by distinct and material errors of principle and therefore I should either come to my own independent view on the evidence, applying the correct legal test, or remit the matter for a further hearing.
9. I will deal with these alleged errors of principle in turn by reference to Mr Harbottle's helpful skeleton argument which approaches the matter by reference to his client's Grounds of Appeal.
10. Starting with the objection under section 5(2), the first alleged error of principle relates to the Hearing Officer's findings as to the reputation of the mark WAYMO with the relevant public at the filing date. Specifically, it is said that she should have found that the mark had acquired an enhanced distinctiveness in the mind of the relevant public as a result of its use in the United Kingdom at that date and that this would have increased the likelihood of confusion.
11. There is no doubt that the Hearing Officer understood the potential significance of a finding of enhanced distinctiveness in terms of increasing the likelihood of confusion under s5(2), since she cites the

relevant authorities on the point. However, in paragraph 24 of her decision, she concluded as follows:

"The Opponent claims to both enjoy a reputation and well-known status. As regards enhanced distinctiveness, it is noted that the earlier trade mark has enjoyed some press exposure via websites with a large reach. However, this is intermittent and its impact is unclear."

12. Mr. Harbottle took me through the evidence which was filed on behalf of his clients in relation to its use of WAYVE in the United Kingdom before the application date, and invited me to find that the Hearing Officer was simply wrong to draw that conclusion on the evidence. However, having reviewed the evidence that he has shown me, I agree entirely with the Hearing Officer's characterisation of it.

13. Essentially, the evidence consisted of some publicity which was given to the WAYMO mark in the United Kingdom. The first and main occasion of this publicity was when the name was adopted as the name of a spin-off company from Google (or its parent Alphabet), which had been researching and developing autonomous or self-driving car technology in the United States. The WAYMO company was spun out of Google at some point in mid-December 2016. At that time, no doubt due to press releases and the like, the change of name received some publicity in a number of news outlets in the United Kingdom, including Mail Online, The Guardian, the BBC and the Financial Times. I accept therefore, that over the period 13th December through to 15th December the adoption of the name WAYMO was shown to have gained some degree of

publicity in the United Kingdom. However, it is very difficult to assess precisely the effect of this publicity because no evidence has been filed as to the penetration of this news with the general public. The best one can say is that, given the well-known nature of the outlets that published the story, a non-negligible number of people in the UK must have become aware of it in this small time-window.

14. However, after that period, there is very little evidence of significant publicity. On some later occasions between December 2016 and the filing date, which is October 2017, further publicity was given to the WAYMO name on certain online news and technology platforms. For example, on 9th January 2017 an article appeared on the BBC Technology website about a self-driving minivan. In May 2017 there was an article in the New York Times about a deal with Lyft. In June 2017 there was a story about the Firefly car, which had been developed originally by Google, being dropped, which appeared in TechCrunch and on the BBC website. This was highly sporadic, and the extent of the publicity, in respect of any individual story, appears to have been pretty limited.

15. So far as I can see, therefore, the conclusion reached by the Hearing Officer (who plainly considered the evidence I have referred to and indeed summarised it in her decision) that the press exposure was intermittent and its impact was unclear, was entirely correct. There is therefore no basis, in my view, for the assertion that she made an error of principle in considering the evidence on the question of acquired distinctiveness.

16. I should also say that it is hard to see how this particular ground of appeal could have undermined the Hearing Officer's conclusion anyway. The Hearing Officer concluded that the earlier mark WAYMO should be considered to be distinctive to a high degree (due to the inherent distinctive character of the word itself) and therefore made her assessment of the likelihood of confusion against a finding of distinctiveness highly favourable to the Opponent. It is hard to see how a different attitude to the evidence of use would have made any real difference to the result. I therefore reject the first ground of appeal.

17. I turn to the second ground of appeal against the finding under section 5(2), which relates to the Hearing Officer's assessment of the conceptual similarity between the mark applied for and the earlier mark. Here, the submission of Mr. Harbottle was that the Hearing Officer was wrong to conclude that the average consumer would consider that WAYMO had 'no conceptual meaning'.

18. The finding with which he takes issue is contained in paragraph 19 of the Hearing Officer's Decision, expressed as follows:

"Conceptually, the earlier trade mark has no meaning. It is noted that the Opponent claims that the term is meant to evoke the idea of moving forward with mobility but it is considered this is far from obvious. It is far more likely to be seen as an invented word."

19. Mr. Harbottle points out that there is no necessary dichotomy between

an invented word and a word without conceptual meaning. An invented word can obviously have some conceptual meaning built into it (indeed this is relatively common). I agree with that proposition. However I do not think that is what the Hearing Officer meant or thought. What she meant was WAYMO is far more likely to be seen as an invented word with no particular meaning rather than (as had been suggested by the Opponent) (i) being taken to be a composite word made up of the words "WAY" and "MO" and (ii) further broken down by analysis of the meanings of "WAY" and "MO" to reach the conceptual conclusion of 'moving forward with mobility'.

20. I agree with the Hearing Officer that the public would take WAYMO as a whole and would be highly unlikely to break it down into its component parts. They certainly would not see it (or in any event not very clearly) as having any particular meaning. Mr. Harbottle relied in support of his argument on some statements in press articles to the effect that WAYMO was meant to mean something like a new way forward. I do not consider that that these references (I suspect taken from press releases rather than evidencing the journalist's own assessment) are very compelling. Certainly they were not shown to have had sufficient impact on the average consumer as to change the way in which they would see the earlier trade mark.

21. So far as the concept of the mark applied for is concerned, the Hearing Officer found that WAYVE is highly likely to be pronounced as "wave" and as such will most likely be understood as referring to a moving swell of water, or the directional hand action. I entirely agree. I also agree

with the Hearing Officer's finding that on that basis the mark applied for and the earlier trade mark have no concept in common. Mr. Harbottle urged me to find that the mark applied for would in fact be understood by the average consumer as comprising the elements "WAY" and "VE" and thus taken as a composite mark essentially meaning "way vehicle". I do not accept that either. It seems to me that the 'composite word' argument is even more fanciful in respect of the mark applied for than it is in respect of the earlier mark.

22. I therefore reject this second ground of appeal.

23. The third ground of appeal under s5(2) was that the Hearing Officer had erred in not taking into account the 'interdependency principle'. This is the principle that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks and vice versa. Essentially, it is a complicated way of stating the well-known and obvious principle that the more similar are the goods or services to which the respective marks are applied, the more likely it is that the public will be confused between them. Mr. Harbottle suggested that although the Hearing Officer had set out all the relevant principles to be applied on the question of likelihood of confusion in paragraph 25, including the interdependency principle, she had neglected to take it into account when weighing up the likelihood of confusion on the facts of the case. I do not accept that, not least because in paragraph 26 of her decision (where she makes her finding that there is no likelihood of confusion), she specifically says she bears in mind that some of the goods and services for which the marks applied for are identical with

goods and services for which the earlier mark is registered. This is a shorthand way of saying that she is taking the interdependency principle into account in the Opponent's favour.

24. The fourth ground of appeal (still in relation to 5(2)) is that the Hearing Officer erred in considering the degree of attention which the average consumer would be likely to pay to the respective marks. To quote the Hearing Officer precisely in paragraph 26, she holds that

"the level of attention expected to be displayed during the purchasing process will be at least medium and may indeed be high".

That is based on her analysis in paragraph 22, where she points out that the goods and services in question will appeal both to the general public and to professionals, such as businesses or those who operate in the autonomous vehicle industry:

"For both the goods and services, making the right choice is likely to be important and may represent a significant monetary outlay. Safety considerations may also play a part. The nature of the purchase may follow a period of research and/or word of mouth recommendations. Their visual considerations are not ignored. The level of attention one would expect to be displayed therefore would be at least medium and may be high."

25. Mr. Harbottle submitted that in relation to some of the categories of services covered by the application and the earlier trade mark, including

the arrangement of transport and the booking of transport, the average consumer would be likely to pay very little attention to the marks. In this respect he gave the specific example of people who are urgently seeking a taxi on a one-off basis for a short journey, or downloading an app for that purpose. He said the Hearing Officer did not take that category of consumers into account.

26. I do not accept that analysis. I consider that Ms. Berkeley is right to point out that we are not concerned in trade mark cases with consumers who are unwary or careless. In any event, so far as this particular category of services is concerned, namely the arrangement of taxi transport, there is no basis to consider that consumers do not pay significant attention to the nature of the provider of those services. Plainly, taxi services, at whatever time of day or night and for whatever purpose they are sought, are important services and people care sufficiently about reliability and price level to wish to be sure that they get the provider they are looking for. I therefore reject the fourth ground of appeal as well.

27. Those were the grounds relied on at the Hearing before me under section 5(2). It will be apparent that I do not accept that the appeal had any merit in respect of any of them. Mr. Harbottle invited me, if I agreed with him on any of them, to review the evidence and to assess the overall likelihood of confusion as being in his client's favour. For the avoidance of doubt I should say that on my own evaluation of the evidence, the marks and the goods and services in question, I believe that I would have reached the same conclusion as the Hearing Officer, namely that there

was no likelihood of confusion in this case amongst average consumers. Thus, even if I had thought that the Hearing Officer had erred in principle in respect of any of the grounds identified, I would nonetheless have rejected the appeal.

28. So far as section 5(3) is concerned, the sole ground of appeal is against the Hearing Officer's finding that no sufficient reputation in the UK had been established at the filing date for the Opponent to be able to rely on the extended protection given by section 5(3).

29. The argument for a reputation in the UK was based on the same evidence I have referred to in the first ground of appeal under s5(2), (acquired distinctiveness). Mr. Harbottle says that the Hearing Officer erred in applying too stringent a test to the evidence required to establish a reputation. In particular, he complains that the Hearing Officer ought to have reminded herself of the decision of Arnold J (as he then was) in **Enterprise Holdings Inc. v Europcar [2015] EWHC 17** and in particular his remark at [120] that the requirement to prove reputation under section 5(3) of the act is

'not a particularly onerous requirement'

30. I disagree that it was incumbent on the Hearing Officer to remind herself of these words, which are little more than a passing comment and were hardly intended to establish a test which can be applied in other cases. Indeed, in **Enterprise** the comment is immediately followed by the words:

'As the Court of Justice explained in General Motors Corp v Yplon SA (C-375/99)'

and the learned Judge then quotes paragraphs [24] to [27] of that decision, which set out the test universally applied by the Courts in this jurisdiction.

31. It is hard to see how any criticism can be made of a Hearing Officer who sets out precisely the same paragraphs as those cited by Arnold J (she quotes them in paragraph 32 of her decision). The key paragraphs here are [26] and [27] in which the Court of Justice say:

"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."

"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."

32. Whether one considers that this test is *"not particularly onerous"* or not, the test is the test and the Hearing Officer plainly applied it.

33. Turning to the Hearing Officer's reasoning, she pointed out that the

evidence that was advanced by the Opponent to seek to show a reputation at the filing date suffered from a number of defects. The bulk of the evidence was dated after the relevant date or is undated. It does not demonstrate any tangible activity in the United Kingdom and there are no sales nor any customers. Rather, the focus of the business is on the United States. I entirely agree with that characterisation of the evidence and I did not take Mr. Harbottle to disagree with it either.

34. The Hearing Officer went on to point out, fairly so far as the Opponent is concerned, that the relevant field of activity was technologically innovative, that it had generated a notable degree of press interest and she referred to the website where the adoption of the name Waymo and the various developments had been given some publicity. She stated that all of those had a significant reach. She noted, from the evidence, that any development in this field from Waymo had attracted coverage, from the initial from Google to the change of structure and name to Waymo, to testing results.

35. Ultimately she concluded as follows:

"The activities of the Opponent was clearly at the relevant date focused in the United States. Further, though there has been notable press focus, these can be accurately described as pockets of interest. By this I mean that new developments in the field by Waymo resulted in very similar articles appearing on more than one website over the space of a couple of days on each occasion. These are not examples of press saturation which may have been more compelling. I am unpersuaded therefore that

at the relevant date the Opponent enjoyed a reputation which had an impact in the United Kingdom."

36. It seems to me that this is a balanced and fair approach to the evidence and what it showed about the impact of the Opponent's mark on average consumers in the United Kingdom. This was essentially a United States business, which occasionally managed to get some sporadic publicity in the United Kingdom. It is very difficult to know how much the publicity given to the name penetrated the perception of the public generally, but I suspect very little. It seems to me that without a survey, without any good evidence of the impact of these articles, and without any other evidence, whether from social media or otherwise, which might have enabled the Hearing Officer to evaluate the real extent of knowledge of this mark amongst the public, there was nothing like enough here to prove a reputation amongst a significant proportion of average consumers in the United Kingdom by the filing date. Therefore, I consider the Hearing Officer came to entirely the right conclusion, namely that insufficient reputation had been shown in the United Kingdom to give rise to the extent of protection of section 5(3).

37. It is therefore not necessary for me to consider whether, if she had found there was a sufficient reputation, the other requirements of section 5(3) should be taken to have been satisfied. However, I have little doubt that the answer would have been no. Any objection under s5(3) requires proof of a link being likely to be made in the mind of the public between the earlier mark and the trade mark applied for. I think this is unlikely. I agree with Ms. Berkeley that the likelihood of the earlier trade mark

WAYMO being called to mind by the mark WAYVE is very small. I also find it hard to see how, on the evidence that I have seen, the use of WAYVE could be said to give rise to an unfair advantage. If there were any ‘calling to mind’ of WAYMO in the mind of the public, in my view it would have been to at such a weak level that it would have provided no advantage of any kind to the Applicant. Similarly, it seems to me unlikely that there would be any detriment to the Opponent as a result of the use of WAYVE to the distinctive character of the trade mark WAYMO.

38. In the circumstances therefore, I reject the appeal so far as section 5(3) is concerned and I note, as I did with 5(2), that I would have come to the same conclusion as the Hearing Officer on the basis of the evidence that was before her.

39. For those reasons I therefore reject this Appeal. The parties agreed following my oral version of this Judgment, that the appropriate order for costs of the Appeal was £1000.

IAIN PURVIS QC
THE APPOINTED PERSON
4 OCTOBER 2021