BL O/0082/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3612541

BY MSC R&D IP LIMITED

TO REGISTER THE TRADE MARK:

IN CLASSES 35, 36, 41 AND 45

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 426309

BY DR HAMISH STEVENSON

BACKGROUND AND PLEADINGS

1. On 18 March 2021, MSC R&D IP Limited ("the applicant") applied to register the trade mark shown on the cover page of this decision ("the contested mark") in the UK. The application was published for opposition purposes on 21 May 2021, and registration is sought for services in Classes 35, 36, 41 and 45.[1]

2. On 20 August 2021, the application was opposed by Dr. Hamish Stevenson ("the opponent") based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all the services in the application.

3. The opponent relies upon its UK trade mark number 2563643, 'FAST TRACK' ("the earlier mark"), which has a filing date of 8 November 2010 and a registration date of 23 December 2011. Initially the opponent relied on some of its services in Classes 35, 36 and 41, however, following the outcome of a related revocation action,[2] the opponent filed an amended Form TM7,[3] reducing the services relied upon to the following:

Class 35 Providing information; preparation of reports and articles for publication; all of the foregoing services in relation to league tables related to unquoted business enterprises; arranging networking opportunities in the context of business award recognition gatherings.

4. The earlier mark is subject to use conditions in accordance with section 6A of the Act because the mark was registered more than five years before the application date of the contested mark. The opponent has made a statement to the effect that it has used the mark in relation to all the services relied upon.

5. The opponent claims that the marks are phonetically and conceptually identical, and visually highly similar, and that the respective services are highly similar, if not identical, resulting in a likelihood of confusion and association.

[1] See services comparison
[2] CA505165
[3] Filed 5 March 2024

6. The applicant filed a counterstatement denying the grounds of opposition and requesting that the opponent provide proof of use of the earlier mark in respect of all the services relied upon.

7. Only the opponent filed evidence. Both parties filed written submissions. Neither party requested a hearing and only the opponent chose to file written submissions in lieu of a hearing. The written submissions of each of the parties will be referred to as and where appropriate during this decision. This decision is taken following careful consideration of the papers on file.

8. The opponent is represented by Serjeants LLP, and the applicant is represented by Swindell & Pearson Ltd.

EVIDENCE

9. The opponent filed evidence by way of a witness statement dated 14 March 2022, together with 11 exhibits (Exhibits DHS1 to DHS11). Dr Stevenson is the registered owner of the earlier mark, and was the director, founder and owner of the company Fast Track 100 Limited, before its liquidation. The purpose of the evidence is to demonstrate that the earlier mark has been put to genuine use in the UK during the relevant period in relation to the services relied upon.

10. Whilst I do not intend to summarise the evidence here, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary in the course of this decision.

RELEVANCE OF EU LAW

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Proof of use

12. I will begin by assessing whether there has been genuine use of the earlier mark in relation to the registered services relied upon. Section 6A of the Act states:

> "(1) This section applies where
>
> > (a) an application for registration of a trade mark has been published,
> >
> > (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
> >
> > (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if –
>
> > (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
> >
> > (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.
>
> (4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application i.e. 19 March 2016 to 18 March 2021.

14. Section 100 of the Act reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. Consequently, the onus is upon the opponent to prove that genuine use of the earlier mark was made within the UK in the relevant period, and in respect of the relevant services as registered.

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant services. For example, use of the mark by a single client which imports the relevant services can be sufficient to

demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

17. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the UKTM, in the course of trade, sufficient to create or maintain a market for the services at issue during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

i) The scale and frequency of the use shown;
ii) The nature of the use shown;
iii) The services for which use has been shown;
iv) The nature of those services and the market(s) for them; and
v) The geographical extent of the use shown.

18. Before assessing the opponent's evidence of use, I remind myself of the comments of Mr Daniel Alexander QC, (as he then was) sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, where he stated that:[4]

"22. The burden lies on the registered proprietor to prove use […]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the

[4] Case BL O/230/13

time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

And further at paragraph 28:

> "28. […] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted."

19. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.[5] Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

> "The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even

[5] Case BL O/424/14

where that mark may well have been widely used, simply as a result of a procedural error. […] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it"."

20. The comments of Mr Geoffrey Hobbs QC (as he then was) in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, where he sat as the Appointed Person, are also relevant.[6] He stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can

[6] Case BL O/404/13

> legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

21. Accordingly, whilst there is no requirement to produce any specific form of evidence, I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied that there has been genuine use of the mark.

Form of the mark

22. Before I move on to assess if the opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17

> *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).
>
> 17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO,* EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still".

23. The opponent's registration is for the word mark 'FAST TRACK'. Where the opponent has used its registration as registered, that will clearly be use on which the opponent can rely. For the avoidance of doubt this would also include slight variations to the mark, such as the words, 'Fast Track', on the basis that as the mark is registered in word-only format it can be used in any standard typeface, in any case, and in any colour. However, it is noted from the evidence that the opponent's mark has also been used in the following ways:

a) FAST TRACK 100 b) Fast Track 100 c) The Sunday Times Fast Track 100

d) The Sunday Times Virgin Fast Track 100

e) The Sunday Times Virgin Atlantic Fast Track 100

f)

g)

h)

i)

j)

k)

l)

24. With regards to use of the opponent's mark, shown above, the applicant submits the following in its written submissions:[7]

> "In relation to those materials that appear to be dated within the relevant period, for a number of reasons these clearly do not represent evidence that is acceptable to clearly substantiate the present Opposition.
>
> The term used consistently is Fast Track 100. There is no clear evidence of trade mark use of FAST TRACK per se, being the Earlier Trade Mark.
>
> A notable point of difference between the earlier trade mark and Fast Track 100 is the presence of the numeral 100. In the context, the presence of the numeral 100 clearly alters the distinctive character of the mark.
>
> […]
>
> Therefore, when considering the impact of the presence of the numeral 100 in Fast Track 100, this descriptiveness of FAST TRACK plays a key role in lifting

[7] Filed on 13 May 2022

the presence of the numeral 100 such that it very clearly alters the distinctive character of the whole.

Therefore, all use of and reference to Fast Track 100 in the materials submitted by the Opponent in support of the Opposition clearly fails to support the Opposition and must therefore be dismissed on this basis."

25. In conjunction with the above case law, I remind myself that Section 6A(4)(a) of the Act enables an opponent to rely on use of a mark "in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered". As the registered trade mark is in word only format the distinctive character of the mark resides in the words 'FAST TRACK'.

26. I acknowledge that where the registered mark is used as part of another mark or with additional matter, this may still constitute acceptable use of the mark as registered, where this element continues to act independently as an indicator of origin.[8] Accordingly, I am of the view that use of the marks shown above continue to indicate origin and therefore, do constitute use of the registered mark.

27. However, even if I am wrong in my finding, I am of the view that the additional elements, including the figurative elements, shown in the above versions, do not sufficiently alter the distinctive character of the registered mark, and therefore use of the above marks constitute acceptable variant use of the registered mark, upon which the opponent can rely.

28. In his witness statement Dr Stevenson states that companies use the awards obtained from 'Fast Track' as an indicator of success, and as such, display Fast Track's logo on their websites, leading to more exposure of 'FAST TRACK' with their specific customers, meaning people who may not ordinarily see the opponent's business become aware of it along with the gravitas and status that it holds.[9] Whilst the opponent's registered mark is used alongside trade marks belonging to other companies, for example, such as 'The Sunday Times Fast Track 100', I bear in mind

[8] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12
[9] Witness statement of Dr Hamish Stevenson, paragraph 16

that it is permissible for a registered mark to be used in conjunction with another mark, and indeed it is relatively common. Therefore, I consider the use of the opponent's registered mark alongside other companies trade marks, such as 'The Sunday Times', 'Virgin' and 'Virgin Atlantic', to be relevant use. As for the addition of '100', featured in some of the marks, I am of the opinion that this element will be viewed descriptively in relation to the number of companies appearing within the league table, for example, provided under the marks.

29. Similarly, with regards to the figurative marks shown above, where the words 'FAST TRACK' are shown in a standard blue font, I remind myself that 'normal and fair' use of a word-only mark includes use in a single colour. As for the figurative elements, where a mark is composed of a word and a figurative element, generally, the word element is more distinctive, as such, in my opinion, the figurative elements contained in the marks do not alter the distinctive character of the earlier mark. Further, in relation to the '2013', '2016' and '2020' elements, these are clearly descriptive of the year that the marks were used. Accordingly, in line with the case law, I am satisfied that the marks evidenced above constitute acceptable variant use of the mark as registered.

Use of the mark

30. Whether the use shown of the earlier mark is sufficient will depend on whether there has been real commercial exploitation of the same, in the course of trade, sufficient to create or maintain a market for the services at issue during the relevant five-year period.

31. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[10] As indicated in the case law above, use does not need to be quantitively significant to be genuine.

[10] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

32. The opponent claims to have used its earlier mark in relation to all the services relied upon, namely:

Class 35 Providing information; preparation of reports and articles for publication; all of the foregoing services in relation to league tables related to unquoted business enterprises; arranging networking opportunities in the context of business award recognition gatherings.

33. In his witness statement, Dr Stevenson states that he was the Director, founder and owner of 'Fast Track 100 Limited' from 24 February 1997 until its voluntary liquidation in 2021. He states that over the past 25 years the mark 'FAST TRACK' has been used to publish 127 annual league tables featuring 5,800 companies. However, from the evidence before me I note that not all of the 127 annual league tables fall within the relevant period, and furthermore, I have no precise details as to which of these league tables were provided under the 'FAST TRACK' mark and which were provided under other marks, observing from the evidence that the proprietor's company also compiled league tables under other names, such as 'PROFIT TRACK' and 'TOP TRACK'. Moreover, notwithstanding the league tables being referred to as annual, I have no exact dates on which the 'FAST TRACK' league tables were published, for example, in The Sunday Times.

34. Provided in support of the published league tables are three sets of extracts from The Sunday Times.[11] In relation to the first,[12] Dr Stevenson explains that it shows the first 'Fast Track 100' list which appeared in The Sunday Times on 7 December 1997.[13] However, this evidence pre-dates the relevant period. As for the second, he confirms that by December 2020, 'Fast Track 100' had progressed to a full pull-out edition in The Sunday Times,[14] and provides photographs of the same.[15] Not all the text contained in the extracts is legible. However, the words 'FAST TRACK 100' can be seen at the top of almost every page, as well as within the heading of the first page which reads 'FAST TRACK 100' with the words 'COVID 19 EDITION' underneath. The

[11] Exhibits DHS3, DHS4, DHS5
[12] Exhibit DHS3
[13] Witness statement of Dr Hamish Stevenson, paragraph 9
[14] Witness statement of Dr Hamish Stevenson, paragraph 10
[15] Exhibit DHS4

evidence includes a 100-list league table of ‘BRITAIN’S FASTEST-GROWING PRIVATE COMPANIES’, as well as subheadings of articles related to businesses and statistics and figures for business trends. The third shows a league table published in The Sunday Times on 11 April 2021, under the name ‘PROFIT TRACK 100’.[16] Dr Stevenson claims this is the last league table published in The Sunday Times, and that reference is made to the ‘FAST TRACK’ mark throughout the article.[17] However, again, due to the size and quality of the images provided in the exhibit I am unable to ascertain with any accuracy the content of the article.

35. In his witness statement Dr Stevenson states that he has hosted over 500 invitation-only events, attended by 18,000 entrepreneurs and directors. As such, he asserts that the general public recognise the earlier mark and it is highly regarded within the business sector.[18] However, what cannot be assessed from this is how many of the said events were hosted within the relevant period. The evidence does not show, the precise dates of the events, the nature of the events in relation to the registered services, the number of attendees present for each of the events, or the revenue generated from these events. Further, in this regard, I have not been provided with any turnover figures, invoices or supporting social media evidence, etc.

36. Additionally, Mr Stevenson claims that “Fast Track have featured rising stars such as ARM, Ocado and Fever-Tree and almost all the UK's unicorns ranging from Gymshark and Cazoo to Revolut.” He adds that their founders have attended and shared their stories at Fast Track’s events with keynote speakers, including Prime Minister Boris Johnson (as he then was), David Cameron and Gordon Brown.[19]

37. Various programmes referencing ‘FAST TRACK’ have been provided to support the narrative evidence. These include programmes for virtual award events held on 19 May 2021,[20] as well as award event programmes for 2006[21] and 2008.[22] Additionally, included within the evidence are three programme covers entitled ‘Alumni

[16] 11 Exhibit DHS5
[17] Witness statement of Dr Hamish Stevenson, paragraph 11
[18] Witness statement of Dr Hamish Stevenson, paragraph 3
[19] Witness statement of Dr Hamish Stevenson, paragraph 4

[20] Exhibit DHS6
[21] Exhibit DHS9
[22] Exhibit DHS10

dinners for entrepreneurs' all dated in 2019,[23] each referring to 'FAST TRACK'. Dr Stevenson confirms that there were between 20 to 50 guests attending these dinners. He states that the images contained in the exhibit relate to 2019, although the dinners also took place in other years. However, Dr Stevenson does not elaborate on this any further.[24] These appear to be private invitation-only events for entrepreneurs listed in previous league tables.[25] There are also programme covers for golf events and dinner events for entrepreneurs held in 2008 and 2009,[26] which fall outside the relevant period. There is nothing before me to indicate any revenue generated as a result of these events.

38. Provided in the evidence are a small selection of video stills relating to videos uploaded to the platform 'Vimeo' and available to the public via the internet.[27] These show either still images from conferences and award ceremonies dinners/events or their written description. Dr Stevenson explains that the videos range in date from 2015 to 2021.[28] Whilst I acknowledge that some of these video stills relate to 'FAST TRACK', the majority of these stills relate to 'SME EXPORT TRACK', 'INTERNATIONAL TRACK', 'PROFIT TRACK' or 'TOP TRACK' events and award ceremonies. Only 12 out of the 38 still images of the uploaded videos refer to 'FAST TRACK', of which only four appear dated within the relevant period, namely, 13 December 2017, Exhibit DHS2, page 2; 29 June 2017, Exhibit DHS2, page 13, 25 May 2018, Exhibit DHS2, page 18; and the award presentations 2021, Exhibit DHS2, page 22. Whilst I accept that the evidence shows award events for the years 2015 and 2017 as well as a 20th anniversary 'FAST TRACK' drinks party held on 29 June 2017, I have no information regarding the number of people in attendance at the events or the revenue that was generated as a result. Further, I have no information regarding who viewed the videos, and moreover, there are no comments or 'likes' shown for any of the videos.

39. A number of press articles relating to 'FAST TRACK' which fall within the relevant period are included in the evidence. Exhibit DHS1, includes articles from The Sunday

[23] Exhibit DHS7
[24] Witness statement of Dr Hamish Stevenson, paragraph 13
[25] Witness statement of Dr Hamish Stevenson, paragraph 3
[26] Exhibit DHS8, page 2
[27] Exhibit DHS2
[28] Witness statement of Dr Hamish Stevenson, paragraph 8

Times dated 28 May 2017, 9 August 2017 and 19 May 2019; articles from the website of Virgin, which sponsors the proprietor's award events, dated 7 December 2020; an article from Bureau van Dijk, published on their website (bvdinfo.com) relating to Britain's top 100 private companies, dated 8 July 2019; an article from 'WESTCAOST' relating to '18th in the Sunday Times FAST TRACK HSBC Top Track 100', dated 2 July 2020; and an article from 'BREWDOG' relating to 'Life in the Fast Track' which refers to BrewDog being included in the 2017 Sunday Times Virgin Fast Track 100, dated 5 May 2017. The stated articles all refer to 'FAST TRACK' in relation to either award events or the list/league table published in The Sunday Times.

Genuine use

40. With regard to the opponent's evidence of use, the applicant submits the following in its written submissions:[29]

> "There is nothing in the evidence that has been submitted that demonstrates use of the Earlier Trade Mark by Dr Hamish Stevenson as the registered proprietor.
>
> Whilst photographs of Dr Stevenson might appear in certain images and he may be referenced at certain (limited) points within the materials, none of these present any clear indication that Dr Stevenson as the registered proprietor of the Earlier Trade Mark is using the trade mark in that capacity.
>
> Moreover, there is no evidence that Dr Stevenson has appropriately licensed the use of the Earlier Trade Mark to any third party, including Fast Track 100 Limited.
>
> Dr Stevenson was not the sole director of that company and as such it cannot be assumed that he had total control and as a consequence there was any implied consent. Without any evidence of licence or consent, none can be assumed.

[29] Filed on 13 May 2022

References to FAST TRACK within the materials submitted are not clearly references to use of the Earlier Trade Mark by Dr Stevenson, and indeed are generally references that would be interpreted as referring to the company name, rather than the Earlier Trade Mark. The Opponent himself uses FAST TRACK to clearly refer to his company - see paragraph 7 of the Witness Statement of Dr Hamish Stevenson. Use of FAST TRACK in this way is use as a company name and not as a trade mark.

Evidence of use would usually be provided with supporting invoices and other such materials, clearly demonstrating commercial activity by the registered proprietor under and in relation to the trade mark. No such evidence has been submitted. Such evidence is fundamental in demonstrating use in the course of trade and a lack of any such materials is another reason why the evidence is inadequate.

The Earlier Trade Mark is registered for a range of services across classes 35, 36 and 41 [sic] relied on in the Opposition. It is clear that the materials submitted fall short of demonstrating any relevant use across the classes. It is therefore clear that the Opponent has failed to properly prove use of the Earlier Trade Mark in relation to the services relied upon, and as such the Opposition should be dismissed."

41. I remind myself that I must evaluate all the evidence submitted in an overall assessment, and that although pieces of evidence may be insufficient by themselves, they may contribute to proving use in combination.

42. It is apparent from the evidence that the opponent has used its mark in the UK, during the relevant period. However, as indicated in my analysis above, the evidence is not without its limitations. For example, there is no evidence of the services actually being offered for sale under the mark during the relevant period. No figures have been provided to confirm how much, if any, income was generated through the services, such as participation at the dinners, etc. Nor do I have any figures before me outlining the marketing budget or spend for the brand and I have no evidence relating to the size of the corresponding market or the percentage of market share enjoyed by the

opponent for the class 35 services at issue. Furthermore, I have no data before me that would enable me to determine the sales or turnover of the relevant services offered under the mark, in the UK, during the relevant period. Nor have any invoices been provided to enable me to ascertain the actual sales of the services relied upon under the mark for which genuine use has been claimed.

43. That being said, taking the evidential picture as a whole, it is clear that the opponent provided annual lists/league tables and related information under its mark and that these were annually published within The Sunday Times newspaper between (at least) the years 2011 and 2021. This is apparent from the extracts from The Sunday Times newspaper, as well as the assortment of publications from between 2011 and 2021, including via social media, from sponsors, and companies that have featured within the 'FAST TRACK' list/league table referring to such. Furthermore, when taken as a whole, the evidence shows that the opponent held annual, invitation-only award events, with notable key speakers, in 2021, 2020, 2019, 2017, 2015, 2012, 2008 and 2006. The evidence shows that at these events the opponent, using the 'FAST TRACK' mark, granted numerous awards to successful start-ups and fast-growing companies. These events resulted in press coverage and a number of third-party publications referencing the brand in relation to these awards. Though this is not direct evidence of the opponent using the mark itself, there is direct evidence of the opponent using the mark on event programmes and the uploaded video evidence of these events.

44. Accordingly, from the overall evidential picture, including the supportive narrative evidence provided in Dr Stevenson's witness statement, whilst there are gaps in the evidence, as discussed above, I am satisfied that the opponent has attempted to create and maintain a market under the mark 'FAST TRACK', and has done enough to demonstrate commercial exploitation of the mark in relation to the services at issue, in the UK, within the relevant period. Accordingly, I am satisfied that the opponent has demonstrated genuine use of its mark.

Fair specification

45. I must now consider whether, or the extent to which, the evidence shows use of the registered mark in relation to the services relied upon. I must bear in mind that fair protection is not to be achieved by identifying and defining particular examples of services for which there has been genuine use, but, rather, the particular categories of services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer for the services concerned.[30] In arriving at a fair specification, I must consider how the average consumer would fairly describe the services shown in evidence; the task is not to describe the use made of the registered marks in the narrowest possible terms, unless that is what an average consumer would do. I remind myself that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular services covered by the registrations.[31]

<u>The opponent's Class 35 services</u>

46. The opponent relies upon the following services:

Class 35 Providing information; preparation of reports and articles for publication; all of the foregoing services in relation to league tables related to unquoted business enterprises; granting awards to businesses for promotional purposes; arranging networking opportunities in the context of business award recognition gatherings.

47. I note from the applicant's written submissions[32] that they are of the view that the opponent's evidence fails to show proof of use of the mark, during the relevant period, in relation to the services relied upon.

48. From the evidence I have before me, the use shown by the opponent of the earlier mark 'FAST TRACK' in the UK, during the relevant period, does clearly demonstrate genuine use in relation to *the provision of information, preparation of reports and*

[30] *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10
[31] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors [2016]* EWHC 3103 (Ch)
[32] Filed on 13 May 2022

articles for publication, all in relation to league tables related to unquoted business enterprises in class 35. Whilst I note that The Sunday Times published the league tables and related articles, it is clear that the opponent under the 'FAST TRACK' mark was responsible for compiling them for publication by The Sunday Times. Further, I acknowledge that the information and league tables relate to fast growing start-up companies, which I am satisfied fits within the description of *unquoted business enterprises.*

49. In relation to use of the mark for the remaining services in class 35, from the evidence I have before me, I am prepared to accept that genuine use has been demonstrated in relation to *granting awards to businesses for promotional purposes*, based on the video evidence, award event programmes and third-party publications reporting on such. Likewise, I have been able to deduce from the evidence that during the award recognition events, for example, held by the opponent under the 'FAST TRACK' mark, *networking* opportunities and *business introductions* would have occurred. Accordingly, in my view the evidence sufficiently demonstrates use in relation to all the class 35 services relied upon.

Section 5(2)(b)

50. Sections 5(2)(b) is relied on and reads as follows:

> "5(2) A trade mark shall not be registered if because-
>
> > (a)…
> >
> > (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."

51. Section 5A states:

> […]
>
> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

52. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

53. As per my earlier findings, the opponent may rely upon the following services:

Class 35 Providing information; preparation of reports and articles for publication; all of the foregoing services in relation to league tables related to unquoted business enterprises; granting awards to businesses for promotional purposes; arranging networking opportunities in the context of business award recognition gatherings.

54. The applicant's opposed services are as follows:

Class 35 Business consultancy, advice and information services; business management advisory and assistance services; business management services; research, advisory and information services; tax advice, assessment, consultancy and planning; business support services; business analysis; planning of marketing strategies; strategic business planning; business reviews; business advice relating to growth financing; analysis of business data; advisory services (business -) relating to the exploitation of inventions; advisory services (business -) relating to the exploitation of designs; business strategy and planning services; preparation of tax declarations; advisory services provided to businesses needing funding; human resources consultancy; human resources management; serving as a human resources department for others; recruitment services; recruitment consultancy services; management advice relating to the recruitment of staff; business project management services; business acquisition consultation; advice relating to acquisitions; preparation of reports relating to the aforesaid services.

Class 36 Financial management services; valuation services; financial evaluation services; financial assessments; financial appraisals; tax services; financial strategy consultancy services; financial advisory services; financial advice relating to taxation; taxation consultancy services; financial planning; tax planning; funding services; financial analysis and research services; planning of finances relating to taxation; advisory services relating to taxation; fiscal assessments and valuation services; financing services for the securing of funds for business; information, advisory and consultancy services relating to research and design tax credits; applying for funding; applying for research and development grants; providing funding for the development of new technology; applying for Patent Box benefits; preparing research and development tax credit claims; research and development allowances; applying for capital allowances; financial brokerage services; intellectual property valuation services; preparation of reports relating to the aforesaid services; information, consultancy and advisory services relating to all of the aforesaid services.

Class 41 Education and training services; coaching services; organisation and provision of seminars, workshops and training events; arranging conferences; conducting conferences; provision of online electronic publications; publishing of newsletters; providing newsletters in the field of funding, tax relief, tax planning, intellectual property and human resources; providing newsletters in the field of research and design tax credits; provision of online electronic publications from the Internet; publication of printed matter relating to education and training.

Class 45 Intellectual property consultation; intellectual property licensing services; intellectual property audit services; intellectual property management services; investigations in relation to intellectual property; advisory services relating to intellectual property rights; advisory services relating to intellectual property licensing; legal services relating to intellectual property rights; professional advisory services relating to intellectual property rights.

55. Where the goods or services in the specification of one party are included in a broader term from the other party's specification, those goods or services are considered to be identical: See *Gérard Meric v OHIM*, Case T-133/05 at [29].

56. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> "23. In assessing the similarity of the goods or services concerned, … 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".

57. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat ")* [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

58. 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 OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

> "82. ...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

59. For the purposes of considering the issue of similarity of the goods, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark,* BL O-399-10.[33]

60. In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms: *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) [2024] UKSC 36*, at [365].

61. In its written submissions,[34] the applicant submits the following with regards to the similarity of the services:

> "In relation to the Opponent's class 35 services, these relate to certain services specifically relating to unquoted business enterprises, the granting of awards to businesses, arranging business introductions, networking services and the compilation of databases [sic].
>
> These are not the same or similar to many of the class 35 services of the present Application, including but not limited to business management services, research and advisory services, tax advice, assessment, consultancy and planning, business support services, business analysis, planning of marketing strategies, strategic business planning, growth financing, advisory services (business) relating to the exploitation of inventions, advisory services

[33] Paragraph 5
[34] Filed on 13 May 2022

(business) relating the exploitation of designs, business strategy and planning services, preparation of tax declarations, advisory services provided to businesses needing funding, human resources consultancy, human resources management, serving as a human resources department for others, recruitment services, recruitment consultancy services, management advice relating to the recruitment of staff, business project management services, business acquisition consultation, advice relating to acquisitions.

[…]

It is clear that most, if not all, of the services of the Opposed Application are not the same or similar to those covered by the earlier trade mark."

62. With regard to the similarity of the services, in its amended Form TM7,[35] the opponent submits the following:

"Both the Applicant's and Opponent's marks cover class 35 services, therefore the specification would be considered highly similar, if not identical for some terms. It is likely that due to the similarity of the marks, the consumer would at the very least assume that the goods [sic] provided under the marks were associated with each other, however they are more likely to assume that they are sold by the same company and the Applicant's mark is merely a sub brand of the Opponent. With this in mind it can be argued that there is sufficient similarity to cause confusion on the market place and so in accordance with section 5(2)(b) the application should not be allowed."

63. It is acknowledged that the applicant's submissions were filed before the services relied upon by the opponent were reduced on 5 March 2024,[36] as previously discussed in paragraph 3 of this decision. Further, I bear in mind that despite the reduction in the services relied upon, the opponent has maintained its opposition in relation to all of the applicant's services, namely those in classes 35, 36, 41 and 45, though, in its amended Form TM7, the opponent has only referred to the similarity of the respective

[35] Filed on 5 March 2024
[36] Amended Form TM7 and statement of grounds

class 35 services, as shown above, and has made no comments with regards to the similarity of its class 35 services and the applicant's services in classes 36, 41 and 45. Moreover, with regards to the comparison of the respective class 35 services, the opponent has not provided an explanation as to why it considers these services to be similar. However, I note from the opponent's written submissions, filed on 14 March 2022, (prior to the reduction of the services relied upon), that they state the following:

> "The class 35 services are similar. They are all related to business activities, the management of businesses and networking in business. Therefore, there is a high likelihood that the end user of the services would be the same, thereby causing a likelihood of confusion between the marks."

64. Accordingly, taking guidance from Iain Purvis KC, sitting as Appointed Person in the *SmartX* trade mark decision,[37] where the opponent has not provided a sufficient comparison between the services at issue, I will proceed to make my own. As per *Separode*, I will approach the comparison of the services at issue by grouping them collectively in as few groups as I consider logical. Further, where the terms listed are particularly wide or vague, I will endeavour to follow the principles outlined in *Skykick* by comparing what I consider to be the core meaning of the services, without affording them neither a too liberal, nor an artificially narrow, interpretation.

65. Pursuant to section 60A of the Act, I am mindful of the fact that the services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes. I also note that in *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense. Meanwhile, in *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.

[37] BL O/0911/24, at [32].

Class 35 of the contested application

Business consultancy, advice and information services; business management advisory and assistance services; business management services; research, advisory and information services; business support services; business analysis; business reviews; analysis of business data; preparation of reports relating to the aforesaid services

66. I find that the opponent's *providing information; preparation of reports and articles for publication; all of the foregoing services in relation to league tables related to unquoted business enterprises* is included in the above contested broad terms. Therefore, these services are considered identical in line with the principle set out in *Meric*. However, if I am wrong in my analysis, then I find that the respective services are similar to a high degree, on the basis that the services share a similar purpose and can coincide in producers, channels of trade and end users.

Tax advice, assessment, consultancy and planning; planning of marketing strategies; strategic business planning; business advice relating to growth financing; advisory services (business -) relating to the exploitation of inventions; advisory services (business -) relating to the exploitation of designs; business strategy and planning services; preparation of tax declarations; advisory services provided to businesses needing funding; human resources consultancy; human resources management; serving as a human resources department for others; recruitment services; recruitment consultancy services; management advice relating to the recruitment of staff; business project management services; business acquisition consultation; advice relating to acquisitions; preparation of reports relating to the aforesaid services

67. The above services will include a wide range of business responsibilities. I find these services to be fundamentally different in nature and purpose to the opponent's specific class 35 services, i.e. being either in relation to league tables related to unquoted business enterprises, in relation to the granting of awards, or in the context of business award recognition gatherings. Furthermore, providers and trade channels will also differ. Moreover, the services at issue are neither in competition nor complementary. Whilst there may be some overlap in user, that is not enough on its

own for a finding of similarity. Therefore, in the absence of any persuasive submissions from the opponent in relation to the comparison between the competing services, I find the above contested services to be dissimilar to all the opponent's services.

Class 36 of the contested application

Financial management services; valuation services; financial evaluation services; financial assessments; financial appraisals; tax services; financial strategy consultancy services; financial advisory services; financial advice relating to taxation; taxation consultancy services; financial planning; tax planning; funding services; financial analysis and research services; planning of finances relating to taxation; advisory services relating to taxation; fiscal assessments and valuation services; financing services for the securing of funds for business; information, advisory and consultancy services relating to research and design tax credits; applying for funding; applying for research and development grants; providing funding for the development of new technology; applying for Patent Box benefits; preparing research and development tax credit claims; research and development allowances; applying for capital allowances; financial brokerage services; intellectual property valuation services; preparation of reports relating to the aforesaid services; information, consultancy and advisory services relating to all of the aforesaid services

68. I am of the view that the above contested services have nothing in common with the opponent's class 35 services. The above services will satisfy different consumer needs and have different natures, purposes, and methods of use to that of the opponent's services. They will also originate from different providers and will move through different trade channels. Furthermore, the services are neither in competition nor are they complementary. Therefore, in the absence of any submissions from the opponent regarding the comparison of the respective services, I find the contested services to be dissimilar to all the opponent's class 35 services.

Class 41 of the contested application

Provision of online electronic publications; publishing of newsletters; provision of online electronic publications from the Internet

69. Whilst I note that the above contested services are not present in the opponent's list of services, I am of the view that they may overlap in providers, users and trade channels, with the opponent's *preparation of reports and articles for publication; all of the foregoing services in relation to league tables related to unquoted business enterprises* in Class 35. Whilst the respective services differ in their nature and method of use, I consider that they share a close relationship, and I find them to be complementary to the extent that the average consumer could reasonably expect the same or economically linked undertakings to be responsible for both the preparation of reports and articles for publication, and the publishing and provision of the publications via the internet. I therefore consider the respective services to be similar to a low degree.

Education and training services; coaching services; organisation and provision of seminars, workshops and training events; arranging conferences; conducting conferences; providing newsletters in the field of funding, tax relief, tax planning, intellectual property and human resources; providing newsletters in the field of research and design tax credits; publication of printed matter relating to education and training

70. The remaining contested class 41 services include a range of services which bear no obvious link with the opponent's services in class 35. Whilst there may be some overlap in user, that is not enough on its own for a finding of similarity. Accordingly, in the absence of evidence or submissions to the contrary, I find the contested services to be dissimilar to all the opponent's services.

Class 45 of the contested application

Intellectual property consultation; intellectual property licensing services; intellectual property audit services; intellectual property management services; investigations in relation to intellectual property; advisory services relating to intellectual property rights; advisory services relating to intellectual property licensing; legal services relating to intellectual property rights; professional advisory services relating to intellectual property rights

71. The contested services have nothing in common with the opponent's class 35 services. The contested services will satisfy different consumer needs, and have different natures, purposes, and methods of use to that of the opponent's services. They will also originate from different providers and will move through different trade channels. Furthermore, the services are neither in competition nor are they complementary. Moreover, the opponent has not provided any submissions in relation to the comparison between the competing services. Accordingly, I find that the above contested services are dissimilar to all of the opponent's class 35 services.

72. Similarity of goods and services is essential for a finding of a likelihood of confusion.[38] As a consequence, the opposition fails with respect of the following services:

Class 35 Tax advice, assessment, consultancy and planning; planning of marketing strategies; strategic business planning; business advice relating to growth financing; analysis of business data; advisory services (business -) relating to the exploitation of inventions; advisory services (business -) relating to the exploitation of designs; business strategy and planning services; preparation of tax declarations; advisory services provided to businesses needing funding; human resources consultancy; human resources management; serving as a human resources department for others; recruitment services; recruitment consultancy services; management advice relating to the recruitment of staff; business project management services; business acquisition consultation; advice relating to acquisitions; preparation of reports relating to the aforesaid services.

Class 36 Financial management services; valuation services; financial evaluation services; financial assessments; financial appraisals; tax services; financial strategy consultancy services; financial advisory services; financial advice relating to taxation; taxation consultancy services; financial planning; tax planning; funding services; financial analysis and research services; planning of finances relating to taxation;

[38] *Waterford Wedgwood plc v OHIM*, Case C-398/07 P, CJEU

advisory services relating to taxation; fiscal assessments and valuation services; financing services for the securing of funds for business; information, advisory and consultancy services relating to research and design tax credits; applying for funding; applying for research and development grants; providing funding for the development of new technology; applying for Patent Box benefits; preparing research and development tax credit claims; research and development allowances; applying for capital allowances; financial brokerage services; intellectual property valuation services; preparation of reports relating to the aforesaid services; information, consultancy and advisory services relating to all of the aforesaid services.

Class 41 Education and training services; coaching services; organisation and provision of seminars, workshops and training events; arranging conferences; conducting conferences; providing newsletters in the field of funding, tax relief, tax planning, intellectual property and human resources; providing newsletters in the field of research and design tax credits; publication of printed matter relating to education and training.

Class 45 Intellectual property consultation; intellectual property licensing services; intellectual property audit services; intellectual property management services; investigations in relation to intellectual property; advisory services relating to intellectual property rights; advisory services relating to intellectual property licensing; legal services relating to intellectual property rights; professional advisory services relating to intellectual property rights.

The average consumer and the nature of the purchasing act

73. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97.

74. 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. (as he then was) 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."

75. The average consumer of the overlapping services at issue will be business and professional users. The services are likely to be sourced from specialist providers by both visual and aural means. Overall, given the nature of the services at issue, I would expect the average consumer to pay at least a medium degree of attention.

Comparison of the marks

76. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

> "34. […] 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."

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

78. The trade marks to be compared are as follows:

Opponent's mark	Applicant's mark
FAST TRACK	

79. Both parties have filed submissions regarding the similarity of the marks. Whilst I do not propose to reproduce the parties' submissions here, I have taken them all into consideration in reaching my decision.

<u>Overall impression</u>

80. The opponent's mark is presented in standard uppercase letters without any stylisation and comprises the words 'FAST TRACK'. The average consumer is likely to perceive the words as a phrase, meaning, inter alia, *a quick way of achieving something*. Accordingly, I am of the view that neither of the words dominate and therefore the overall impression of the mark resides in the combination of the words.

81. The applicant's mark is a composite mark consisting of words and a figurative device element. The words 'Fast-track' are presented in white, standard sentence case, with a capital first letter, and lowercase letters following, and are placed within a large device element. The average consumer is likely to perceive the words as a phrase, meaning *a quick way of achieving something*. The device element resembles a stylised 'light bulb'. The centre of this device is dark blue or black in colour and is outlined in orange. The bottom of the light bulb element, depicted by three lines, is

also produced in orange. Whilst the figurative device element is much larger than the words, I find the eye is naturally drawn to the elements of the mark that can be read, keeping in mind *MigrosGenossenschafts-Bund v EUIPO*, T-68/17, where it was stated that:

> "…in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements…"

82. Accordingly, in the present case, given the size of the device, I find that the overall impression is roughly equal.

<u>Visual comparison</u>

83. Visually, the competing marks identically share the same words 'FAST TRACK / Fast-track'. I do not consider the distinction in letter case and letter colour between the marks to be points of significant difference between them. This is because the registration of word only marks provide protection for the word itself, irrespective of what colour it is presented in or whether it is presented in upper or lowercase.[39] The competing marks are visually different in that the applicant's mark contains a device element not replicated in the opponent's mark. Furthermore, the word element in the applicant's mark contains a hyphen ('Fast-track'), not replicated in the opponent's mark 'FAST TRACK'. Accordingly, weighing up the similarities with the differences, keeping in mind that both trade marks contain the words 'FAST TRACK / Fast-track', I find the competing marks to be visually similar to at least a medium degree.

<u>Aural comparison</u>

84. The device element in the applicant's mark will not be articulated. As for the word elements, both marks will be pronounced as 'FAST-TRACK'. The hyphen in the

[39] *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17

applicant’s mark will merely be perceived as a break in the pronunciation of the two words ‘Fast’ and ‘track’ and therefore its presence creates a natural pause. Whilst I note that the hyphen is not present in the opponent’s mark, as the mark consists of two words, a pause between the two words will naturally occur when they are pronounced. As such, I find the difference created by the hyphen in the applicant’s mark to be negligible or non-existent, and therefore both marks will be pronounced as ‘FAST-TRACK’, creating aural identity.

Conceptual comparison

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

86. In my view the ordinary dictionary words ‘FAST TRACK / Fast-track’ in the respective marks will be immediately recognisable for the average consumer, i.e. as reference to *a quick way of achieving something*. Accordingly, as the competing marks contain the words ‘FAST TRACK / Fast-track’ they convey the same concept despite the hyphen present in the applicant’s mark which does not detract from that concept, nor does it add a different concept. With regard to the figurative device element present in the applicant’s mark, this will merely be understood as representing a particular design, etc., but will have no clear relationship with the words ‘Fast-track’. As such, I find there to be a very high degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

87. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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 *WindsurfingChiemsee 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)."

88. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

89. With regards to the distinctive character of the earlier mark, in its written submissions,[40] the applicant submits the following:

"The earlier trade mark FAST TRACK is inherently descriptive. As a noun, it describes a route or method which provides for faster results than usual, or the quicker route to a given position or conclusion, and as an adjective it describes

[40] Filed on 13 May 2022.

a quicker than normal route to a given position or to accelerate the progress of something.

[…]

In the context of the services of the Earlier Trade Mark as relied on in the Opposition, this descriptive signification is abundantly clear.

[…]

Again, FAST TRACK per se is a term that should be considered entirely descriptive of the services relied upon in the Opposition. By way of example, fast track information services, fast track preparation of reports and articles for publication, fast track business introductions and so on.

It is acknowledged that the earlier registration presently subsists, and that as a consequence some distinctive character may have to be attributed to it, but it is the case that it should at most be taken to have only a scintilla of distinctive character.

The Opponent has not made any submissions or provided any proof of use of any additional or acquired distinctive character, and so the consideration of the trade marks should be made on the basis that the Earlier Trade Mark has incredibly little, if any, distinctive character."

90. In its written submissions in lieu,[41] the opponent submits the following in respect of the distinctiveness of its earlier mark:

"The Applicant [also] questions the validity of the mark and argues that it is descriptive. The UKIPO found that the mark was registrable at the time of filing and therefore the question of whether the Applicant believes that the mark is

[41] Filed 18 July 2022.

descriptive should not be considered in opposition proceedings. We therefore request that the examiner dismisses this point made by the Applicant."

91. The earlier mark comprises the words 'FAST TRACK' which, as previously stated, will likely be given its ordinary dictionary meaning, namely *a quick way of achieving something*. Consequently, I find that the phrase 'FAST TRACK' has a highly allusive nature in terms of the services at issue. However, as registered marks are assumed to have "at least some distinctive character",[42] I find the earlier mark to have a low degree of inherent distinctive character.

92. Earlier in this decision I considered the evidence filed by the opponent to support genuine use of the mark, which overall I found to be sufficient but limited in its extent. Accordingly, I find that there is nothing in the evidence before me to suggest that the opponent's mark has acquired an enhanced degree of distinctiveness in relation to the services at issue. I am therefore of the view that the opponent's evidence falls short of what would be required to show that the distinctiveness of the mark has been enhanced through use for the services at issue.

Likelihood of confusion

93. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

[42] *Formula One Licensing BV v OHIM*, Case C-196/11P

94. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and services down to the responsible undertakings being the same or related.

95. Earlier in the decision I found that:

- The marks are visually similar to at least a medium degree, aurally identical and conceptually similar to a very high degree;

- I have found the parties' services to range between identical and dissimilar;

- The earlier mark has a low degree of inherent distinctive character for the services at issue.

- The average consumer would be a business and professional user, who will source the services from specialist providers by both visual and aural means. Given the nature of the services, I would expect the average consumer to pay at least a medium degree of attention.

96. Whilst the marks are clearly not identical, I have found them to be visually similar to at least a medium degree, aurally identical and conceptually similar to a very high degree, on the basis that the marks identically share the only verbal element present in the marks, namely 'FAST TRACK / Fast-track', with the only difference between the words being that 'Fast' and 'track' in the applicant's mark are separated by a hyphen, and are placed within a figurative device resembling a light bulb.

97. In my view the dictionary words 'FAST TRACK / Fast-track' in the respective marks will be immediately recognisable for the average consumer, i.e. as reference to *a quick way of achieving something*. Accordingly, I find that the competing marks convey the same concept despite the hyphen present in the applicant's mark which does not detract from that concept, nor does it add a different concept. The fact that the marks share the words 'FAST TRACK / Fast-track' is an important point of coincidence. Given

the stated similarities between the marks, I am of the view that the average consumer is likely to remember the marks as 'FAST TRACK' marks, with the device element in the applicant's mark going unnoticed, being overlooked, or forgotten. Given the similarities of the marks and the similarity or identity between some of the services, the average consumer is unlikely to recall the differences between the marks resulting in a likelihood of confusion, despite some of the services being only similar to a low degree. Accordingly, taking all these factors into account, I find that there is a likelihood of direct confusion. This is so even bearing in mind the earlier mark's low level of inherent distinctive character. In reaching this conclusion I note that a degree of caution is required before finding a likelihood of confusion on the basis of common elements which are either descriptive or are low in distinctive character,[43] nevertheless, I maintain that there is a likelihood of direct confusion.

98. I will also assess if there is a likelihood of indirect confusion.

99. In *L.A. Sugar Limited v By Back Beat Inc,* Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

[43] *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch) and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

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

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

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).
(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

100. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

101. In the event that the figurative device and hyphen element in the applicant's mark are not overlooked or misremembered, in my view these elements are consistent with a brand variant, and therefore the applicant's mark is likely to be seen as a logo version of the 'FAST TRACK' mark. Accordingly, I am of the view that consumers will simply consider that the parties' marks, for the services that I have found to be identical and similar to varying degrees, are variations used by the same or economically linked undertakings. Therefore, I find that there is a likelihood of indirect confusion.

Conclusion

102. The opposition under section 5(2)(b) is partially successful in respect of the following services, for which the application is refused:

Class 35 Business consultancy, advice and information services; business management advisory and assistance services; business management services;

research, advisory and information services; business support services; business analysis; business reviews; analysis of business data; preparation of reports relating to the aforesaid services.

Class 41 Provision of online electronic publications; publishing of newsletters; provision of online electronic publications from the Internet.

103. The application can proceed to registration in respect of the following services for which the opposition has been unsuccessful:

Class 35 Tax advice, assessment, consultancy and planning; planning of marketing strategies; strategic business planning; business advice relating to growth financing; advisory services (business -) relating to the exploitation of inventions; advisory services (business -) relating to the exploitation of designs; business strategy and planning services; preparation of tax declarations; advisory services provided to businesses needing funding; human resources consultancy; human resources management; serving as a human resources department for others; recruitment services; recruitment consultancy services; management advice relating to the recruitment of staff; business project management services; business acquisition consultation; advice relating to acquisitions; preparation of reports relating to the aforesaid services.

Class 36 Financial management services; valuation services; financial evaluation services; financial assessments; financial appraisals; tax services; financial strategy consultancy services; financial advisory services; financial advice relating to taxation; taxation consultancy services; financial planning; tax planning; funding services; financial analysis and research services; planning of finances relating to taxation; advisory services relating to taxation; fiscal assessments and valuation services; financing services for the securing of funds for business; information, advisory and consultancy services relating to research and design tax credits; applying for funding; applying for research and development grants; providing funding for the development of new technology; applying for Patent Box benefits; preparing research and development tax credit claims; research and development allowances; applying for capital allowances; financial brokerage services; intellectual property valuation services; preparation of reports relating to the aforesaid services; information, consultancy and advisory services relating to all of the aforesaid services.

Class 41 Education and training services; coaching services; organisation and provision of seminars, workshops and training events; arranging conferences; conducting conferences; provision of online electronic publications; publishing of newsletters; providing newsletters in the field of funding, tax relief, tax planning, intellectual property and human resources; providing newsletters in the field of research and design tax credits; provision of online electronic publications from the Internet; publication of printed matter relating to education and training.

Class 45 Intellectual property consultation; intellectual property licensing services; intellectual property audit services; intellectual property management services; investigations in relation to intellectual property; advisory services relating to intellectual property rights; advisory services relating to intellectual property licensing; legal services relating to intellectual property rights; professional advisory services relating to intellectual property rights.

Costs

104. On balance, I consider both parties have enjoyed a share of success, with the greater part going to the applicant, who is, in principle, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016, as was relevant at the time the opposition was filed. I have made a reduction to the costs to reflect the partial extent of the success. Applying the guidance in that TPN, I consider the following to be fair:

Considering the notice of opposition, and filing a counterstatement:	£300
Considering the evidence and written submissions of the other side, and filing written submissions:	£800

Total:	**£1,100**

105. I therefore order Dr. Hamish Stevenson to pay MSC R&D IP Limited the sum of £1,100. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 29th day of January 2025

Sam Congreve
For the Registrar