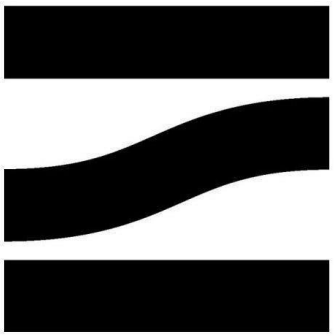
O/0089/26

TRADE MARKS ACT 1994

IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL REGISTRATION NO. 1744519 BY EQUITYZEN INC. FOR PROTECTION OF THE FOLLOWING TRADE MARK IN CLASSES 9, 36 & 42



AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 445814 BY

ZENOBE ENERGY LTD

BACKGROUND AND PLEADINGS

1. EquityZen Inc. (“the holder”) designated the international registration shown on the front cover of this decision for protection in the United Kingdom on 11 July 2023. This is also its international registration date. Priority is claimed from US Trademark No. 98009909 and the priority date is 23 May 2023. Protection is sought for the following goods and services:

> *Class 9*
> *Downloadable computer application software for mobile devices, namely, software for transacting in alternative assets of privately held companies and for private company investments.*
>
> *Class 36*
> *Financial services, namely, broker/dealer services on securities exchanges, private placements and over-the counter markets; brokerage of shares and other securities; financial investment brokerage service; funds investment; online securities brokerage services; providing information in the field of financial stock and equity markets; electronic financial trading services; financial services, namely, financial asset management in the nature of transacting in alternative assets of privately held companies and private company investments; financial services, namely, brokerage services in the nature of transacting in alternative assets of privately held companies and private company investments.*
>
> *Class 42*
> *Providing temporary use of a web-based software application for transacting in alternative assets of privately held companies; providing temporary use of a web-based software application for providing a marketplace for private company investments; software as a service (SAAS) services, namely, hosting and providing software for use by others for use in transacting in alternative assets of privately held companies; software as a service (SAAS) services, namely hosting and providing software for use by others for providing a marketplace for private company investments.*

2. On 12 February 2024, the designation was opposed by Zenobe Energy Ltd (“the opponent”). The opposition was originally based on sections 5(2)(b), 5(3), 5(4)(a) and

5(4)(b) of the Trade Marks Act 1994 ("the Act"). However, the section 5(3) and 5(4)(a) claims were dropped during the course of the proceedings.

3. The opposition under section 5(2)(b) concerns the goods in Class 9 and the services in Class 42. The opponent relies on UKTM No. 3720629, which has a filing date of 11 November 2021 and a registration date of 4 February 2022. The mark is registered for goods and services in Classes 9, 35, 39, 40 and 42 and is shown below:

4. Because the registration date of the mark is within the five-year period ending with the priority date of the contested IR, the opponent is not required to show it has genuinely used the mark. It may therefore rely on all the goods and services that it claims are similar to the holder's goods and services in Classes 9 and 42, namely:

Class 9

Software and firmware for electric battery units configured to store, manage and discharge electricity for residential and commercial use; software and firmware for energy usage monitors; artificial intelligence and machine learning software for optimising, monitoring and managing the distribution of energy and electricity; parts and fittings for all the aforesaid goods.

Class 35

Business services relating to storage, management and distribution of electricity; Collection, processing, management and analysis of data in the field of energy management; information, advisory and consultancy services for all of the aforesaid services.

Class 42

Design and development of software, computer firmware and computer programs for use with electric battery units and devices configured to store, manage and discharge electricity to and from a power grid and for use in energy management; design and development of energy management software; information technology services for use in the field of energy management, including

electricity and other renewable energy; maintenance, updating and designing of computer software, computer firmware, computer programs, computers and IT systems for use in energy management; Platform as a Service (PaaS) in the field of energy generation and for the storage, monitoring and distribution of electricity; Software as a Service (SaaS) in the field of energy generation and for the storage, monitoring and distribution of electricity; information, advisory and consultancy services for all of the aforesaid services.

5. The opponent claims that the earlier mark is highly distinctive, both inherently and through use, and that the marks are strikingly similar. Because of the similarity between the marks and between the goods and services, there is, according to the opponent, a likelihood of confusion, including a likelihood of association.

6. Under section 5(4)(b), the opponent claims that the earlier mark qualifies as an artistic work as defined under section 5 of the Copyright, Designs and Patents Act 1988 ("CDPA"). It asserts that it was created in 2020 by Wildish & Co, a design agency in London, commissioned by the opponent, to whom the ownership was assigned. The opponent claims that the contested IR *"clearly"* copies a whole or part of the work and use of the IR would infringe the opponent's copyright.

7. The holder filed a defence and counterstatement denying the claims made. Under section 5(2)(b), it denies that the marks are *"strikingly similar"* and claims that the goods and services are dissimilar, having a different nature, operating through distinct trade channels, having no overlap in use and users, and not being complementary. Under 5(4)(b), it denies all the claims and maintains that the IR was created independently by a US design agency in April 2023.

8. Both parties filed evidence. I summarise this briefly below. The opponent also filed written submissions dated 9 December 2024.

9. Neither side requested a hearing and both parties filed written submissions dated 8 January 2025 in lieu of the same. This decision has been taken following a careful consideration of the papers.

10. In these proceedings, the opponent is represented by Wiggin LLP and the holder is represented by Stevens Hewlett & Perkins.

EVIDENCE

11. The opponent's evidence in chief comes from Sophie Barr, General Counsel at Zenobe Energy Limited since July 2022. Prior to this, she was Head of Legal at Zenobe from July 2019. Her witness statement is dated 4 July 2024 and is accompanied by six exhibits. It has been filed to prove the claim to ownership of the copyright in the earlier mark and also goes to the holder's use of the contested IR.

12. The holder's evidence comes from Jean Brandolini Lamb, Chief Marketing Officer at EquityZen Inc since September 2024 and Head of Marketing at the same company between September 2022 and September 2024. Her witness statement is dated 2 October 2024 and goes to the creation of what is described as *"the EquityZen logo"*.

13. The opponent filed evidence in reply in the form of a witness statement from Peter Dawson, a partner at the opponent's legal representative, Wiggin LLP. It is accompanied by six exhibits. His evidence goes to the use made of the logo by the holder and to the respective fields of business of the parties. It also presents the results of searches of the UK Trade Mark Register for "E", "Z" and "EZ" logo marks.

RELEVANCE OF EU LAW

14. 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

Section 5(2)(b)

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

> "A trade mark shall not be registered if because-
>
> …

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

16. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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

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

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

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

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

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

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

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

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

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

k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

17. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when

> "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."

18. The opponent submits that the terms *Platform as a Service (PaaS) in the field of energy generation and for the storage, monitoring and distribution of electricity* and *Software as a Service (SaaS) in the field of energy generation and for the storage, monitoring and distribution of electricity* should be read as (i) PaaS/SaaS in the field of energy generation and (ii) PaaS/SaaS for the storage, monitoring and distribution of electricity: *"Put another way, whilst the PaaS and SaaS terms are limited to the field of energy generation, they are not also limited to the storage, monitoring and distribution of electricity."*[1] It submits that the services in (i) are similar to <u>all</u> the holder's goods and services opposed under this ground. These are:

> <u>*Class 9*</u>
> *Downloadable computer application software for mobile devices, namely, software for transacting in alternative assets of privately held companies and for private company investments.*
>
> <u>*Class 42*</u>
> *Providing temporary use of a web-based software application for transacting in alternative assets of privately held companies; providing temporary use of a web-based software application for providing a marketplace for private company investments; software as a service (SAAS) services, namely, hosting and providing software for use by others for use in transacting in alternative assets of privately held companies; software as a service (SAAS) services, namely hosting and providing software for use by others for providing a marketplace for private company investments.*

19. In paragraph 49 of its written submissions in lieu of a hearing, it sets out its reasons. These start from the position that the marketplaces and transactions enabled by the holder's Class 9 goods and Class 42 services are *"sector-agnostic"*, i.e. they cover investments and transactions in the assets of companies operating in any sector, including energy generation and renewable energy. It continues:

[1] Written submissions in lieu, paragraph 48.

> "The Opponent has broad protection for PaaS and SaaS services in the field of energy generation. This is not limited to the storage, monitoring and distribution of electricity. It therefore also encompasses software for financing, investing or transacting in assets of privately held companies in the field of energy generation."[2]

20. In construing the meaning of the terms at issue, I keep in mind the principles of interpretation of terms set out by the courts. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "12. … Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin said:

> "365. … The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 195; [2004] RPC 40 at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These

[2] Paragraph 49(c).

> principles are consistent with first, the requirement that the specification of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

22. In my view, the core meaning of the opponent's terms encompass software and software platforms used for the purpose of generating energy (or storing, monitoring and distributing electricity). This is because the average consumer would understand the phrase "in the field of…" to denote the activity for which the software or platform services are used. This is the generation of energy. The interpretation put forward by the opponent would extend the term to cover software or software platforms used for any purpose, provided that they were delivered to companies involved in energy generation or third parties such as investors interested in such companies. This, in my view, stretches the meaning beyond the core of the possible meanings: perhaps as far as word processing or diary management software, delivered as a service, and used by energy generation companies. I construe the term, even in the shortened form argued for by the opponent, to mean software as a service and platform as a service for use in energy generation. I do not agree with the opponent that they would include software for financing, investing or transacting in assets of energy generation companies.

23. I consider that the opponent's services and the holder's goods and services are targeted towards different users for different purposes. The holder's goods and services are all used in financial investment, while, as I have explained, the opponent's services are used in the generation of energy. It is likely that the parties' goods and services will be distributed through different trade channels. They are not complementary or in competition. The fact that they are all software or software platforms (supplied either as a good or service) is not sufficient in my view for a finding of similarity. I agree with the holder that the goods and services are dissimilar. I note here, for the sake of completeness, that the other goods and services relied on by the

opponent are all related to energy management and/or the storage, management and distribution of electricity, and so do not put it in a better position.

24. Section 5(2)(b) requires there to be some degree of similarity (or identity) between the parties' goods and/or services: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, paragraph 49. As I have found the goods and services to be dissimilar, the section 5(2)(b) ground fails at this point.

Section 5(4)(b)

25. Section 5(4)(b) of the Act is as follows:

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented–
>
> […]
>
> (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright, or the law relating to industrial property rights.
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of 'an earlier right' in relation to the trade mark."

26. In deciding this ground, I must address the following questions:

- Is the earlier mark a work under the Copyright, Designs and Patents Act 1988 ("CDPA") and therefore capable of being protected by copyright?
- Who is the owner of the work and when was it created?
- Does the work meet the qualification criteria for copyright protection?
- Would use of the contested mark constitute an infringement of any copyright?

Whether the earlier mark is a work under the CDPA

27. Section 1 of the CDPA states that:

"Copyright is a property right which subsists in accordance with this Part in the following descriptions of work–

(a) original literary, dramatic, musical or artistic works,

(b) sound recordings, films or broadcasts, and

(c) the typographical arrangement of published editions."

28. Section 4 of the CDPA is as follows:

"(1) In this Part 'artistic work' means-

(a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,

(b) a work of architecture being a building or a model for a building, or

(c) a work of artistic craftsmanship.

(2) In this Part –

…

'graphic work' includes –

(a) any painting, drawing, diagram, map, chart or plan, and

(b) any engraving, etching, lithograph, woodcut or similar work;

…"

29. The opponent's earlier mark is a graphic work. Section 1(1)(a) of the CDPA states that in order for copyright to subsist the work must be original. In *Infopaq International A/S v Danske Dagblades Forening*, Case C-5/08, the CJEU said:

"37. … copyright within the meaning of Article 2(a) of Directive 2001/29 is liable to apply only in relation to a subject matter which is original in the sense that it is its author's own intellectual creation."

30. The CJEU elaborated on this point in *Cofemel v G-Star Raw*, Case C-683/17:

“29. The concept of ‘work’ that is the subject of all those provisions constitutes, as is clear from the Court’s settled case-law, an autonomous concept of EU law which must be interpreted and applied uniformly, requiring two cumulative conditions to be satisfied. First, that concept entails that there exists an original subject matter, in the sense of being the author’s own intellectual creation. Second, classification as a work is reserved to the elements that are the expression of such creation (see, to that effect, judgments of 16 July 2009, *Infopaq International*, C-5/08, EU:C:2009:465, paragraphs 37 and 39, and of 13 November 2018, *Levola Hengelo*, C-310/17, EU:C:2018:899, paragraphs 33 and 35 to 27 and the case-law cited).

30. As regards the first of these conditions, it follows from the Court’s settled case-law that, if a subject matter is to be capable of being regarded as original, it is both necessary and sufficient that the subject matter reflects the personality of its author, as an expression of his free and creative choices (see, to that effect, judgments of 1 December 2011, *Painer*, C-145/10, EU:C:2011:798, paragraphs 88, 89 and 94, and of 7 August 2018, *Renckhoff*, C-161/17, EU:C:2018:634, paragraph 14).

31. On the other hand, when the realisation of a subject matter has been dictated by technical considerations, rules or other constraints, which have left no room for creative freedom, that subject matter cannot be regarded as possessing the originality required for it to constitute a work (see, to that effect, judgment of 1 March 2012, *Football Dataco and Others*, C-604/10, EU:C:2012: 115, paragraph 39 and the case-law cited).

32. As regards the second condition referred to in paragraph 29 of the present judgment, the Court has stated that the concept of a ‘work’ that is the subject of Directive 2001/29 necessarily entails the existence of a subject matter that is identifiable with sufficient precision and objectivity (see, to that effect, judgment of 13 November 2018, *Levola Hengelo*, C-310/17, EU:C:2018:899, paragraph 40).”

31. I consider that the colour of the work and the configuration and shape of the lines are the result of creative choices made by the author of the work, and so I find that it is capable of being protected by copyright.

Ownership of the work and its creation

32. Ms Barr states that in July 2020 the opponent commissioned a design agency called Wildish & Co Limited to create a new corporate logo.[3] She goes on to say that it was created on or around 17 November 2020 and that the opponent used it from 15 April 2021, including on its website and social media accounts.[4]

33. According to Clause 38.3 of the Terms of Business (IP Override),

> "The Client shall be entitled to receive, and Wildish & Co. hereby assigns by way of present, and where possible, future assignment to the Client, all rights, title and interest in and to all Intellectual Property arising in the performance of the Services ('Foreground Intellectual Property'). This however shall not include any Intellectual Property owned by Wildish & Co. before the commencement of the Services or any Intellectual Property in Wildish & Co.'s tools and methodologies existing before the commencement of the Services). …"[5]

34. Exhibit SB05 contains a confirmatory deed of assignment of copyright dated 26 January 2024 signed on behalf of the opponent and Wildish & Co. The logo is shown in Schedule 1, headed "The Works".

35. I find that the opponent is the owner of the work and that it was created before the relevant date in these proceedings, i.e. the priority date of 23 May 2023.

Whether the work meets the qualification criteria for copyright protection

36. Section 153 of the CDPA states that copyright does not subsist in a work unless certain conditions are met. These are set out in the following sections of the Act. Section 154 states that:

[3] Witness statement of Ms Barr, paragraph 6.
[4] Paragraphs 9 and 10.
[5] Exhibit SB04.

"(1) A work qualifies for copyright protection if the author was at the material time a qualifying person, that is-

(a) a British citizen, a British Dependent Territories citizen, a British National (Overseas), a British Overseas citizen, a British subject or a British protected person within the meaning of the British Nationality Act 1981, or

(b) an individual domiciled or resident in the United Kingdom or in the Channel Islands, the Isle of Man or Gibraltar or in a country to which the relevant provisions of this Part extend, or

(c) a body incorporated under the law of a part of the United Kingdom or of the Channel Islands, the Isle of Man or Gibraltar or of a country to which the relevant provisions of this Part extend.

…

(4) The material time in relation to a literary, dramatic, musical or artistic work is-

(a) in the case of an unpublished work, when the work was made or, if the making of the work extended over a period, a substantial part of that period;

(b) in the case of a published work, when the work was first published or, if the author had died before that time, immediately before his death.

…"

37. The holder has not challenged Ms Barr's statement that the work was first published on 15 April 2021. She refers to the work being used on the opponent's website and social media pages. I consider that this is publication, as set out in section 175 of the CDPA, where publication is defined as meaning *"the issue of copies to the public"*. I shall therefore take this to be the material time. Exhibit SB01 contains the commercial proposal from Wildish & Co, signed by the Director of the opponent on

27 July 2020. The footer to this document states that Wildish & Co was registered in England & Wales under the company number 07799598. The same information is provided in the confirmatory deed of assignment. Consequently, I consider that it is probable that the author of the work (Wildish & Co.) was incorporated under the law of England and Wales at the material time. I also note that this statement has not been challenged by the holder. Therefore, I find that the work qualifies for copyright protection.

38. The protected work was created and published before the priority date of the contested IR. Consequently, it is an earlier right for the purposes of section 5(4)(b) of the Act.

Whether use of the mark would constitute an infringement of the copyright in the work

39. Section 16 of the CDPA is as follows:

> "(1) The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom –
>
> (a) to copy the work (see section 17);
>
> (b) to issue copies of the work to the public (see section 18);
>
> (ba) to rent or lend the work to the public (see section 18A);
>
> (c) to perform, show or play the work in public (see section 19);
>
> (d) to communicate the work to the public (see section 20);
>
> (e) to make an adaptation of the work or do any of the above in relation to an adaptation (see section 21);
>
> and those acts are referred to in this Part as the 'acts restricted by the copyright'.
>
> (2) Copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorises another to do, any of the acts restricted by the copyright.

(3) References in this Part to the doing of an act restricted by the copyright in a work are to the doing of it –

(a) in relation to the work as a whole or any substantial part of it, and

(b) either directly or indirectly;

and it is immaterial whether any intervening acts themselves infringe copyright."

40. Section 17 of the CDPA provides that:

"(1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies should be construed as follows.

(2) Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form.

This includes storing the work in any medium by electronic means.

(3) In relation to an artistic work copying includes the making of a copy in three dimensions of a two-dimensional work and the making of a copy in two dimensions of a three-dimensional work.

…

(6) Copying in relation to any description of work includes the making of copies which are transient or are incidental to some other use of the work."

41. In *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/a Washington DC),* [2000] 1 WLR 2416, Lord Millett set out the approach to assessing whether artistic copyright has been infringed at [2425]-[2426]. He said:

"The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall

appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying.

…

Once the judge has found that the defendant's design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the copyright work. It does not depend upon its importance to the defendant's work, as I have already pointed out. The pirated part is considered on its own (see *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 293, *per* Lord Pearce) and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose."

42. The protected work and the contested IR are shown in the table below:

Protected Work	**Contested IR**
	

43. The opponent submits that the two logos are essentially identical, apart from the colour scheme. Both the protected work and the contested IR consist of three lines, the top and bottom of which are straight, horizontal lines, and the middle of which is curved, sloping gently upwards from left to right at a 45° angle. The protected work is orange in colour, while the contested mark is in black. Nevertheless, I remind myself that registration of a mark in black and white covers the use of the mark in colour: see *Specsavers International Healthcare & Ors v Asda Stores Ltd & Anor* [2014] EWCA Civ 1294, paragraph 5, and *J.W. Spear & Sons Ltd & Ors v Zynga Inc.* [2015] EWCA Civ 290, paragraph 47. Consequently, if granted protection, the contested IR could in principle be used in the same shade of orange as the protected work. The only other difference I can see is that the lines in the contested IR are thicker than those in the protected work. I find that the two logos are highly similar. However, I also consider that the elements from which the logos have been created are quite simple.

44. The next question I must address is whether the holder had prior access to the protected work. The opponent submits that it was *"widely"* in the public domain, appearing on its website and in news articles on third party websites.[6] Exhibit PD1 contains the following articles, which include images showing the protected work:

a) "Merseyside's mega-battery is switched on – and here's how it will save billions of pounds of bills and huge amounts of CO2", Sky News website, 11 February 2023;

b) "Zenobē begins construction of 300MW battery energy storage project in Scotland", Solar Power Portal, 16 February 2023;

c) "Zenobē and Ventura partner to deliver largest all electric bus depot in Australia", Australasian Bus & Coach, 23 February 2023;

d) "Zenobe's second-life batteries continue to power the paddock", Extreme E website, 1 March 2023;

e) "A second life battery company is helping Extreme E avoid 15 tons of CO2 emissions each season", electrek website, 1 March 2023;

[6] Written submissions in lieu of a hearing, paragraph 27.

f) “Zenobē Powers Global Expansion with c.£600 Million Investment from KKR and further c.£270m from Intracapital”, Zenobe press release, 7 September 2023.

45. The opponent also submits that both parties have an interest in the same sector:

> “27(f) The parties both have a commercial interest in the renewable energy market, specifically financial investment in the provision of electric vehicles. Zenobe is named as one of the ‘top companies by total battery storage PE [private equity] deals since 2018’ and a recipient of multiple awards recognising its financing operations, whilst EquityZen provides a marketplace for investments in privately held electric vehicle companies…”

46. The opponent argues that the holder had access to, and is likely to have known about, the opponent and the protected work.

47. The holder submits that the evidence does not allow the inference to be made that either it or its design agency had access to or would have come across the opponent’s logo prior to the design of the contested IR. With the exception of Sky News, it argues that the sources of the articles are specialist, focusing on power storage and electric vehicles. Furthermore, there is no evidence on the reach of these websites. It also submits that there is no evidence that these articles would have reached an audience in the US.

48. In *Sheeran & Ors v Chokri & Ors* [2022] EWHC 827, Zacaroli J (as he then was) said:

> “24. While the legal burden rests with the person alleging infringement, in the case of conscious copying the evidential burden shifts to the alleged infringer if there is proof of sufficient similarity and proof of access. There was some debate as to whether what was required was proof of access, or proof of the possibility of access.
>
> 25. The weight of authority supports the former: see, for example, *Designers Guild* (above), per Lord Millett at p.2425E; *Baigent v Random House* [2007] EWCA Civ 247 at [4], although I do not think anything turns on it in this case. Tens of thousands of new songs are uploaded to internet sites daily. It

clearly cannot be enough to shift the burden of proof that a song was uploaded to the internet thereby giving the alleged infringer *means* of accessing it. In every case, it must be a question of fact and degree whether the extent of the alleged infringer's access to the original work, combined with the extent of the similarities, raises a sufficient possibility of copying to shift the evidential burden. Where, for example, the original work was highly individual or intricate, and the alleged infringing work was very close to it, then only limited evidence of access may be sufficient in order to shift the burden. The same would not be true, on the other hand, where the original work was simple and involved relatively common elements."

49. The opponent submits that there are many different ways in which a letter "E" or a letter "Z", or a combination of the two, may be depicted, and so the holder's designer had a significant degree of freedom in creating the logo that makes up the contested mark. Examples are given in Exhibits PD4, PD5 and PD6. However, copyright law allows for independent creation, so these examples are not in themselves evidence that the holder copied the protected work.

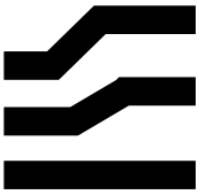
50. The final presentation to the holder on visual identity states:

> "The EquityZen logo embodies the company's commitment to fostering 'Growth with Intention' for investors commited [sic] to shaping the future they want to see. Drawing inspiration from Zen philosophy, the logo incorporates the concept of 'The Middle Way', a path of balance between extremes, representing harmony, balance and growth.
>
> Rich with symbolic meaning, the logo also evokes the triple bar from mathematics indicating equivalence and 'the power of three' an important concept across design, math and mythology signifying balance. The ascending middle line 'Path' shows progress, growth and an upward trend. The stylized capital 'E' and 'Z' integrate the brand's initials into the design and the abstract equals sign emphasizes the balance and democratic access that EquityZen offers."[7]

[7] Exhibit JBL4, page 31.

51. In my view, the logos are fairly simple. An upward trend line is a natural choice for a business involved in finance. Horizontal lines above and below that upward trend line are fairly common. The design company's initial ideas show a number of logos that essentially consist of three lines, whether horizontal or sloping upwards.[8] The opponent submits that none of these are the same or similar. The holder draws my attention to the following design on page 18:

It consists of three lines, each bisected by a sloping upward line. Elsewhere in these pages, I can see the following:



52. Both parties operate in different sectors: the opponent is a provider of battery storage, while the holder provides financial services relating to investments in privately-held companies in a variety of sectors and the software and platforms to support such transactions. Taking account of the specialist nature of all but one of the sources for the news articles and the relative simplicity of the design of the logos, I find that the opponent has not established a *prima facie* case that the holder had access to the protected work and copied it.

53. The opposition fails under section 5(4)(b).

CONCLUSION

54. The opposition to the designation of IR No. 1744519 has failed and, subject to a successful appeal, protection is granted.

[8] Exhibit JBL3, pages 18-20.

COSTS

55. The holder has been successful and is entitled to a contribution towards its costs, based on the scale published in Tribunal Practice Notice No. 1/2023. In the circumstances, I award the holder the sum of £1800, which is calculated as follows:

> *£400 for preparing a statement and considering the other side's statement;*
> *£1000 for preparing evidence and considering the other side's evidence;*
> *£400 for preparing submissions in lieu of a hearing.*
> ***£1800 in total***

56. I therefore order Zenobe Energy Ltd to pay EquityZen Inc the sum of £1800. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 2nd day of February 2026

Clare Boucher,
For the Registrar,
Comptroller-General