

O/0129/25

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO WO1699872
DESIGNATING THE UK**

BY Realytics Corp Limited

TO REGISTER THE TRADE MARK:

Realytics

IN CLASSES 35 & 42

AND

THE OPPOSITION THERETO

UNDER NO. 441112

BY Crealytics GmbH

Background and pleadings

1. Realytics Corp Limited is the holder of the International Registration no. WO0000001699872 (“IR”) in respect of the mark shown on the front page of this decision with a UK designation date of 23 September 2022. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder claims a priority date of 15 August 2022 with filing number 92906 and seeks protection for the services set out below:

Class 35: *Business research; market intelligence services; market studies; marketing; marketing research; providing commercial information and advice for consumers in the choice of products and services; competitive intelligence services; compilation of company information into computer databases; targeted marketing; providing user rankings for commercial or advertising purposes; providing user reviews for commercial or advertising purposes; systemization of information into computer databases; web indexing for commercial or advertising purposes; consumer profiling for commercial or marketing purposes.*

Class 42: *Research in the field of artificial intelligence technology; software as a service [SaaS].*

2. The request to protect the contested mark was published on 3 March 2023. On 1 June 2023 Crealytics GmbH (“the Opponent”) opposed the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. The Opponent relies upon UKTM no. 3362253 for the mark **crealytics** which was filed on 20 December 2018 and registered on 10 May 2019. The Opponent relies upon all of the services for which the mark is registered, namely:

Class 35

Advertising, marketing and promotional services; Business assistance, management and administrative services; Purchasing services; Retail services in relation to computer software; Advertising, marketing and promotional

consultancy, advisory and assistance services; Loyalty, incentive and bonus program services; Public relations services; Distribution of advertising, marketing and promotional material; Provision of advertising space, time and media; Digital marketing; Development and implementation of marketing strategies for others; Advertising services provided via the internet; Assistance to management in commercial enterprises in respect of advertising; On-line advertising and marketing services; Provision of information and advisory services relating to e-commerce; Market research; Computerised market research; Analysis of market research data; Interpretation of market research data.

Class 38

Telecommunication services; Computer communication and Internet access; Provision of access to content, websites and portals; Transmission of electronic mail.

Class 42

IT services; Science and technology services; Design services; Software development, programming and implementation; IT consultancy, advisory and information services; Web site design consultancy; Design, development and programming of computer software; Rental of computer software.

Class 45

Licensing of computer software [legal services].

4. The Opponent claims that the marks are “highly similar”, and the services are “identical” or “highly similar”, with the result that there is a likelihood of confusion.
5. The Holder filed a counterstatement denying the claims made.
6. The Holder is represented by Albright IP Limited and the Opponent is represented by Meissner Bolte (UK) Limited.

7. Neither party elected to file evidence or submissions during the evidence rounds. No hearing was requested and neither party elected to file written submissions in lieu of a hearing. This decision has been taken following a careful consideration of the papers before me.

RELEVANCE OF EU LAW

8. 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)

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

“5(2) 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”.

10. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The Opponent may rely on all of the services it has identified without demonstrating that it has used the mark.

Legislation and Case Law

11. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (“CJEU”) stated that:

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

12. The following principles 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.

The Principles

(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

13. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

14. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia¹:

- (a) the physical nature of the goods or acts of service;
- (b) their intended purpose;
- (c) their method of use / uses;
- (d) who the users of the goods and services are;
- (e) the trade channels through which the goods or services reach the market;
- (f) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (g) whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors)

or

(h) whether they are complementary to each other. Complementary means *“there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”*.² I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.³

¹ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

² *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

³ *Kurt Hesse v OHIM*, Case C-50/15 P

15. The case-law definition with regard to complementarity implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows therefore that goods and services cannot be complementary if they are intended for different publics.⁴

16. I note that I do not have any evidence or submissions from the parties with regard to the interpretation of their respective specifications and so I shall interpret them in accordance with the following:

(a) that it is *“necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”, although “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 [and services] in question”*.⁵

(b) where *“the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services”*.⁶

(c) the following applicable principles of interpretation: *“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) 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. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded.”*⁷

⁴ *Commercy AG v OHIM*, Case T-316/07

⁵ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

⁶ *Pathway IP Sarl* (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited), [2018] EWHC 3608 (Ch), paragraph 94

⁷ See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

17. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also includes an assessment of the channels of trade of the respective goods or services.

18. In *Gerard Meric v Office for Harmonisation in the Internal Market* (‘*Meric*’), the General Court (“GC”) stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

19. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

20. The competing services are as follows:

Opponent's services	Holder's services
<u>Class 35</u> Advertising, marketing and promotional services; Business assistance, management and administrative services; Purchasing services; Retail services in relation to computer software;	<u>Class 35</u> Business research; market intelligence services; market studies; marketing; marketing research; providing commercial information and advice for consumers in the choice of products and

Advertising, marketing and promotional consultancy, advisory and assistance services; Loyalty, incentive and bonus program services; Public relations services; Distribution of advertising, marketing and promotional material; Provision of advertising space, time and media; Digital marketing; Development and implementation of marketing strategies for others; Advertising services provided via the internet; Assistance to management in commercial enterprises in respect of advertising; On-line advertising and marketing services; Provision of information and advisory services relating to e-commerce; Market research; Computerised market research; Analysis of market research data; Interpretation of market research data.	services; competitive intelligence services; compilation of company information into computer databases; targeted marketing; providing user rankings for commercial or advertising purposes; providing user reviews for commercial or advertising purposes; systemization of information into computer databases; web indexing for commercial or advertising purposes; consumer profiling for commercial or marketing purposes.
<u>Class 38</u> Telecommunication services; Computer communication and Internet access; Provision of access to content, websites and portals; Transmission of electronic mail. .	<u>Class 42</u> Research in the field of artificial intelligence technology; software as a service [SaaS].
<u>Class 42</u> IT services; Science and technology services; Design services; Software development, programming and implementation; IT consultancy, advisory and information services; Web	

site design consultancy; Design, development and programming of computer software; Rental of computer software.	
<u>Class 45</u> Licensing of computer software [legal services].	

Definition of Opponent's services

21. I note that the Opponent is relying on all services within their specification. As I have not been provided with any evidence or submissions on their best case for the services comparison, I note what was said by Iain Purvis KC as the Appointed Person in *Abus August Bremicket Sohne AG v Muhammad Ali*, Case BL O/0911/24, at paragraph 9 that:

“9. In a case like this where the marks cover a multitude of different goods, it is obviously necessary for the Opponent to identify with precision, both in its pleaded case and in any submissions made to the Registry, which goods of its own registrations are alleged to be similar to which goods of the Application. If this is not done, it is unfair to the Applicant and it is extremely difficult if not impossible for the Hearing Officer to decide the case.”

22. I will therefore proceed on the basis of which services I believe are their best case.

Services comparison class 35

Web indexing for commercial or advertising purposes

23. To my mind ‘*web indexing*’ is the method used to index contents on a website or the internet. The Holder’s above services are stated as being for advertising and commercial purposes. ‘*Commercial*’ is concerned with ‘commerce’ and involves the buying or selling of goods with the intention to make profit.⁸ The purpose of the Opponent’s ‘*advertising*’ is to promote products, also with a view to make profit, for

⁸ [COMMERCIAL definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/definition-of/commercial)

example. The Opponent's term covers a wide range of services including the provision of advertising services by electronic means, including the internet, therefore, they may coincide in service provider and the relevant public. The contested '*web indexing for commercial or advertising purposes*' are advertising services or services carried out to help the sale of products or services, therefore I consider the above services coincide in purpose user, nature and trade channels with the Opponent's '*advertising*'. Although I do not find them to be complementary, in that web indexing may be part and parcel of an advertising service, I do consider them to be in competition. As the Holder's '*web indexing*' service is for the purpose of '*advertising*' I would expect that the average consumer would assume that the same undertaking could also provide the Holder's above services. I therefore consider them to be similar to a medium degree.

Business research, compilation of company information into computer databases, systemization of information into computer databases

24. I consider that the Opponent's broad terms '*Business assistance, management and administrative services*' in class 35 are intended to support and provide businesses and other commercial entities with the administrative tools to improve the efficacy, effectiveness and practical running of a business, including the management of business data.

25. The contested service '*Business research*' can be defined as a systematic inquiry or research undertaken in order to solve a business problem, acquire business knowledge or assist a business in some way i.e gathering business information in order to make it more profitable or improve business performance. I consider '*compilation of company information into computer databases*' and '*systemization of information into computer databases*' are intended to provide active help with the internal day-to-day operations of other undertakings that contract such services, including the administration and support services made up of administration and support personnel who are not client-facing. It is my view that '*compilation of company information into computer databases*', and '*systemization of information into computer databases*' can both be said to cover those which have the purpose of collating information or data. '*Information and company information*' could, I assume, be business information data. As I have been given no evidence or submissions to assist

me, I take the view, in line with *Avnet v Isoact*, that the core service being described is the compilation and organisation of this data into a business database⁹.

26. Both the Opponent's and Holder's services listed above are intended to help companies manage their business in this way. These services can be offered by the same specialised suppliers, and they target the same consumers, namely, professional business customers. Consequently, I find these services are therefore 'Meriç' identical.

27. In the event that I am incorrect, they overlap in nature, purpose, and users as the respective services are external and offered to businesses for the purpose of increasing or maintaining success. I also find it likely the services would share the same trade channels specialising in business services and will be aimed at the same users (business). Furthermore, whilst they are not complementary, they may well be in competition as the services will all be for the purpose of improving or increasing the performance of the business. As both the Opponent's and Holder's services have the same purpose, whilst they may not be indispensable to one another, it may be reasonable to expect a single undertaking to offer 'business assistance' in the Opponent's specification and the Holder's specialised undertakings, such as '*Business research, compilation of company information into computer databases, systemization of information into computer databases*' as part of 'business assistance', therefore, I find them similar to at least a medium degree.

marketing research

28. I consider 'Market research' in the Opponent's specification is self-evidently identical to 'marketing research' in the Holder's Class 35.

market intelligence services; market studies; marketing; targeted marketing

29. All of the above services are various types of marketing service aids and, therefore, fall within the scope of 'marketing and promotional services' in the Opponent's class 35 specification. These services are, therefore, identical under the principle outlined in *Meriç*.

⁹ *Avnet Incorporated v Isoact Ltd*, [1998] FSR 16

providing user rankings for commercial or advertising purposes; providing user reviews for commercial or advertising purposes; consumer profiling for commercial or marketing purposes.

30. I consider the provision of '*rankings*' and '*reviews*' for '*commercial or advertising purposes*' to be numerical or written ratings given by customers after a product or service is purchased in order to provide a satisfaction rating to increase and retain customers.

31. I consider '*consumer profiling for commercial or marketing purposes*' to be a marketing method that collects and analyses data in order to build a typical customer profile to increase and retain customers and build commercial profit. The aim of the above services is to promote and market services by way of customer rating and reviews, therefore, fall within the scope of '*advertising*' and '*marketing and promotional services*' in the Opponent's class 35 specification. These services are, therefore, identical under the principle outlined in *Meric*.

Services comparison class 42

software as a service [SaaS].

32. It is my understanding that '*Software as a service*', put simply, is software that is rented or licensed rather than purchased outright. Accordingly, rather than buying software and paying for periodic upgrades, etc., SaaS is subscription based and upgrades are delivered automatically during the subscription period. Software as a service [SaaS] is a type of service where a user pays a periodic license fee in order to access software that is hosted centrally by the provider.

33. The Opponent's term '*Software development, programming and implementation*' is very broad and will, in my view, encompass services including, inter alia, the creation, design and operation of software for computer systems, in short, activities which support the running of such systems. I consider these services to be the process used to create and develop software and programs which will be supplied to third parties. This, to my mind would include the process of installing and/or integrating the

software into an organisation and are mainly services provided by members of professions such as computer programmers for example.¹⁰

34. Accordingly, on that basis I find there to be a clear overlap between ‘*software as a service [SaaS]*’ and the Opponent’s ‘*Software development, programming and implementation*’ in Class 42. While I do not consider that these services overlap in method of use, their general nature and purposes coincide in that they are all services that relate to software. Further, it is possible that a user seeking software as a service may require that undertaking to write, design, update and maintain a bespoke type of software as a service meaning that these services may overlap in user. I also consider that they are complementary because the average consumer would consider that the writing, design and updating of the software is important and indispensable to the running of the software of the service. Therefore, the consumer would consider that the same undertaking is responsible for all of these services. The users are likely to coincide as it is possible that the software being rented/licenced has been developed for the same user. There are overlaps in nature, trade channel and purpose. Furthermore, the services may be in competition with each other, and the average consumer may expect them to come from the same undertaking. Overall, taking all the above factors into account, the services are highly similar.

Research in the field of artificial intelligence technology;

35. I understand ‘*Research in the field of artificial intelligence technology*’ to be a form of research into computer technology with the aim to replicate the ability and intelligence of a human mind.¹¹

36. The Opponent’s term ‘*Science and technology services*’ is very broad and will, in my view, encompass services including activities involving research and development relating to science and technology and therefore will be provided by specialist undertakings in science and technology. I find that they are identical in line with the principle set out in *Meric*.

¹⁰ See the explanatory note of Class 42 of the Nice Classification system.

¹¹ Collins dictionary definition – ‘artificial intelligence’ [ARTIFICIAL INTELLIGENCE definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/english-uk/dictionary/artificial-intelligence)

37. However, given the AI (Artificial intelligence) nature of the contested services, if I am wrong in my analysis, then I consider that they overlap in terms of nature and purpose compared to the Opponent's '*Science and technology services*'. These services would be offered to the same users in specialised fields and via the same trade channels. There may also be a degree of competition between the services and a complementary relationship between them as they are important or indispensable to one another to the extent that users would believe that they are derived from the same undertaking. Accordingly, on that basis, I find a medium degree of similarity between '*Research in the field of artificial intelligence technology*' in the Holder's specification and '*Science and technology services*' in the Opponent's specification in Class 42.

Average consumer and the purchasing act

38. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. It is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

39. In their counterstatement, the Holder states that the average consumer of the services applied for would be the 'specialised and non-general public, showing a high degree of attention'. They also state that the average consumer of the Opponent's services would 'target a specialised and non-general public' who would pay a 'high'

degree of attention, so much so that the consumer ‘will not confuse the respective Marks’.¹² I note that the Opponent has not addressed the average consumer in their statement of grounds and, as stated above, has not filed evidence or submissions.

40. I consider that the average consumer of the services at issue, for the most part, will likely be business users and professionals (and other comparable organisations) rather than the general public. The services are likely to be selected from websites, the premises of a specialist provider or after viewing information in marketing materials. In my view, while the visual component will play a primary significant role in the selection process of the services, I do not discount an aural component playing a part, as word-of-mouth recommendations may influence consumers’ decisions. Moreover, I find that in relation to some of the services at issue, such as ‘*providing commercial information and advice for consumers in the choice of products and services*’, and ‘*providing user reviews for commercial or advertising purposes*’ the aural component will likely contribute to an equal degree. Given the specialist nature of the services listed above, the selection process is also likely to involve discussions with salespeople regarding the consumer’s needs, for example. There will likely be an aural aspect to some purchases as many purchasers would discuss their business requirements with the seller first. For these reasons, I consider that the purchasing process for the most part will be predominantly visual, but for those services mentioned above, will be made by an equal contribution of aural and visual means.

41. The frequency of selection for the services will vary, so too will the cost. I say this because a user may only seek market research or software development on a one-off basis but some of the online storage services, for example – ‘*systemization of information into computer databases*’, ‘*consumer profiling for commercial or marketing purposes*’ or the use of ‘*software as a service (SaaS)*’, are likely to be the subject of frequent renewal. In addition, the terms ‘*marketing research*’ or ‘*business research*’ may be subject to differing levels of frequency depending on the nature of the user (be that a large business or smaller business). In respect of costs, I acknowledge that due to the nature of the services, for example, ‘*Business research*’, ‘*marketing research*’ and ‘*research in the field of artificial technology*’ are likely to be expensive as these tend to involve large scale projects. Similarly, services used for the purposes of

¹² Holder’s TM8 and counterstatement dated 1 September 2023.

advertising are likely to be costly. As mentioned above, a user may seek a service on a one-off basis, for example the provision of '*user rankings*' after a product or service has been purchased, which are likely to be less costly than a large-scale project.

42. Turning to the level of attention paid, it should come as no surprise that given what I have said above, I find that this will vary also. In relation to '*providing user rankings for commercial or advertising purposes; providing user reviews for commercial or advertising purposes*', the business consumer will consider ease of use and the tools offered to generate these rankings. The level of attention paid for such services will, in my view, be medium. However, for some of the more involved services that are sought by business users (such as instances where they are seeking to run large-scale marketing campaigns), my view is that they will pay a greater degree of attention as the selection will directly impact upon the operation and success of the business. I consider the level of attention for such services to be relatively high. Given the wide-ranging nature of the services, I am of the view that the level of attention being paid will range from a medium to a relatively high degree.

Comparison of marks

43. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

45. The respective trade marks are shown below:

Opponent's trade mark	Holder's trade mark
crealytics	Realytics

Overall impressions

46. The Opponent's mark is a word mark, consisting of the single word 'crealytics' in standard lowercase typeface. There are no other elements to contribute to the overall impression and so that is where the overall impression lies.

47. The Holder's mark is a word mark, consisting of a single word '*Realytics*', the first letter in uppercase and the remaining letters in standard lowercase typeface. I Again, there are no other elements to contribute to the overall impression.

Visual comparison

48. Visually, the competing marks overlap as they share nine letters, namely "realytics". The contested mark is entirely contained within the earlier mark. The only difference between the marks is the letter 'C' at the beginning of the Opponent's mark (or absence thereof).

49. The Holder submits that the marks are "*not highly similar*" as "*consumers generally pay greater attention to the beginning of a word Mark than to the end, meaning the difference in first letter will enable the respective Trade Marks to be visually distinguished*" and so "*the same reasoning can be applied to an aural comparison*". While the Opponent states that the only difference between the marks is "*the additional letter "c" making the marks visually and aurally similar to a high degree*". In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, it is noted that the beginning of

words tend to have more visual and aural impact than the ends so I find that it is unlikely that the letter 'C' in the Opponent's mark will be overlooked.

50. I take into consideration that the Holder's mark begins with a capital letter, whereas the Opponent's mark does not, however, as the Holder's mark is a word mark only it protects the word itself regardless of whether it's presented in upper/lower case and is 'irrelevant for the purposes of visual comparison'.¹³

51. Considering all of these factors, I find the marks to be visually similar to at least a medium degree.

Aural comparison

52. Aurally the Holder's mark consists of the syllables REE-AL-I-TICS. The Opponent's mark consists of the syllables CREE-AL-I-TICS. The competing marks share three out of four syllables, however, the additional letter 'C' at the beginning of the Opponent's mark creates a point of difference in the pronunciation and stress on the first syllable, between "REE" and "CREE". With this in mind, I conclude that they share a medium to high level of aural similarity.

Conceptual comparison

53. 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].¹⁴ The assessment must, therefore, be made from the point of view of the average consumer.

54. In respect of conceptual similarity, I remind myself that there is no "single meaning rule" in trade mark law under which the court had to identify one, and one only, perception amongst the relevant class of average consumer, and judge confusion accordingly.¹⁵ In the absence of evidence and/or submissions to the contrary, I consider that a significant proportion of average consumers will perceive the Holder's

¹³ *Present-Service Ullrich GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-66/11 at [57]

¹⁴ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

¹⁵ *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch)

mark as a portmanteau term consisting of the words 'Real' and 'analytics'.¹⁶ The average consumer will likely break down combined words into components that suggest a meaning, or resemble words known to him and, therefore, the word is capable of having a conceptual identity.¹⁷

55. I consider this to be similar in regard to the Opponent's mark in that a significant proportion of average consumers are likely to perceive the mark 'crealytics' as a blend of the words 'creative' and 'analytics'. As stated above, the first part of the Holder's mark would be recognised by a significant proportion of average consumers as the word 'Real'. In view of this, I find the 'Real'/'creative' or the first parts of the mark a point of conceptual dissimilarity that set the two marks apart.

56. As stated in the overall impression of the marks, any concept is to be derived solely from the word 'crealytics' in the Opponent's mark and 'Realytics' in the Holder's mark. I remind myself that the marks should be compared as they are presented; 'crealytics' and 'Realytics', both, on face value, invented words. I appreciate that, as per the case of EMILIANA,¹⁸ conceptual comparisons are usually undertaken without reference to the goods or services at issue. However, I am of the view that, in the present case, the composition of both marks in conjunction with the services at issue may subconsciously be recognised as a dictionary term such as 'analytics', even though neither mark incorporates analytics, in its entirety. As such, I find that 'crealytics' and 'Realytics' share an identical concept, that I perceive to be 'analytics'. I consider that the conceptual element of 'analytics' in both marks will likely conjure the idea of data science or the analysis of data or strategy. Where the marks diverge is in the notions of 'creativity' conveyed by the earlier mark, and 'real' conveyed by the Holder's mark. I find the marks to be conceptually similar to at least a medium degree.

Distinctive character of the earlier trade mark

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

¹⁶ See for example *Usinor v OHIM — Corus UK (GALVALLOY)*, T-189/05, para 65

¹⁷ *Vitakraft-Werke Wührmann v OHIM — Krafft (VITAKRAFT)*, Case T-356/02, para 51, and *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, Case T-256/04, para 57

¹⁸ Case BL O/052/22

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

58. 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).”

59. 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 services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities. The Opponent has not filed any evidence that the distinctive character has been enhanced by use, therefore, I have only the inherent position to consider.

60. I bear in mind that the average consumer will invariably break down an invented word into components that suggest a meaning, or resemble words known to him.¹⁹ The Opponent’s mark consists of the word ‘crealytics’, and, as above, the average consumer is deemed likely to perceive the mark ‘crealytics’ as a blend of the words ‘creative’ and ‘analytics’. I do not discount that should the average consumer perceive the mark this way then this may allude to some of the Opponent’s services, ‘business

¹⁹ *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)*, Case T-356/02, para 51, and *Mundipharma v OHIM*

assistance', for example, as analytics is often integrated as part of business assistance in that it can enable a business to assess performance or adapt their business strategy. However, as I have found the Opponent's mark, as a whole, which takes precedence in consideration, is an invented word that merges two dictionary words 'analytics' and 'creative', I consider that it is inherently distinctive to a to at least a medium degree in respect of all services.

Likelihood of Confusion

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. 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. The first 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/or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive 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 he has retained in his mind.

62. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the overall impression for both marks lies in the words themselves.
- I have found the marks to be visually similar to at least a medium degree and aurally similar to a medium to high degree.
- I have found the earlier mark to be conceptually similar to the Holder's mark to at least a medium degree.

- I have found the earlier mark to be inherently distinctive to at least a medium degree.
- I have identified the average consumer for the services for the most part to be a combination of business users and professionals paying a medium to relatively high level of attention. The purchasing process is likely to range from primarily visual, to an equal contribution of aural and visual means.
- I have concluded that the selection process for the relevant services will involve a medium to relatively high degree of attention on the part of the consumer and will be based upon specific requirements. I have found the Holder's services in class 35 range from being similar from at least a medium degree, to self-evidently identical and *Meric* identical.
- I have found the parties' services in class 42 range from being similar to a medium degree, similar to a high degree and *Meric* identical.

63. Taking all of the above factors into account, in particular the level of visual and aural similarity being at least medium, I consider that the average consumer will not overlook the marks' differences. Furthermore, the addition of the letter 'c' at the beginning of the Opponent's mark creates a point of difference in the pronunciation, thus reducing the risk of aural confusion. I note that the beginnings of marks can have more visual and aural impact.²⁰ The difference between the marks is the letter 'C' at the beginning of the Opponent's mark, and the absence of that letter in the Holder's mark which, to my mind, creates a memorable difference between the marks that the average consumer (paying a medium to relatively high level of attention) is likely to notice and sets it apart visually.

64. I recognise, as above that I have concluded the level of attention paid will vary from medium to relatively high depending on the service. Taking all factors into account, I do not consider there to be a likelihood of direct confusion, even on services that are identical and/or in instances where the consumer pays a medium degree of attention.

²⁰ El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02

65. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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’.

66. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

67. 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).”

68. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach. This was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands LLC and others* [2021] EWCA Civ 1207. Regarding the explanation given in *L.A. Sugar* about how indirect confusion arises, Arnold LJ said:

“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”

69. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark, this is mere association not indirect confusion.²¹

70. Turning to the examples above, I consider that the shared element, namely ‘realytics’, is not so strikingly distinctive that it would only be used by one brand. As mentioned above, I appreciate that, while both marks on face value are invented words, the average consumer will naturally search for meaning in the mark that I perceive to be ‘analytics’. As stated above the Opponent’s mark, to my mind will be perceived by the average consumer to be blend of the words ‘creative’ and ‘analytics’

²¹ *Duebros limited v Heirler Cenovis GmbH*, BL O/547/17

and the Holder's mark as a portmanteau term consisting of the words 'Real' and 'analytics'. As such I have found the Opponent's mark to be allusive in relation to some of the services, as above, for example '*business assistance*' and the 'analytics' element of both marks likely to conjure the idea of data science or the analysis of data or strategy. Therefore, I do not believe that 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; category (a) does not apply here.

71. There has not been an addition of a non-distinctive element to either mark as demonstrated in category (b). I have pointed out above that the addition of the letter 'c' in the Opponent's mark is likely to be perceived as a blend of the words 'creative' and 'analytics' as opposed to the Holder's mark being perceived as a portmanteau term consisting of the words 'Real' and 'analytics'. Therefore, I consider that this change in concepts of the mark is not a logical brand extension or sub-brand as per category (c).

72. As set out above, I appreciate that the examples set out in *L.A. Sugar* (cited above) are not exhaustive. However, the Opponent has not offered any alternative argument and neither can I see any other reason as to why the average consumer might naturally consider the marks to be economically linked or to originate from the same undertaking. Therefore, I consider there to be no likelihood of indirect confusion in respect of any of the services, including those which I have found identical.

Conclusion

73. The opposition fails in its entirety and, subject to any successful appeal, the application can proceed to registration for all services applied for.

COSTS

74. Awards of costs in opposition proceedings commenced after 1 February 2023 are based upon the scale as set out in Tribunal Practice Notice 1 of 2023. As the Holder has been successful, they are entitled to a contribution towards their costs. I therefore award the Holder the sum of £250, calculated as follows:

**Preparing a counterstatement and
considering the other side's statement**

£250

75. I therefore order **Crealytics GmbH** to pay **Realytics Corp Limited** the sum of £250. The above sum should be paid within twenty-one days of the expiry of the appeal period or, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 13th day of February 2025

Janeve Manca

For the Registrar