

O/0273/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003899209
BY AMADEO SYSTEMS LTD TO REGISTER:**



AS A TRADE MARK IN CLASSES 6, 7, 9, 37 & 42

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 442345 BY
AMADEUS IT GROUP, S.A.**

BACKGROUND AND PLEADINGS

1. On 11 April 2023, Amadeo Systems Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The application was published for opposition purposes on 5 May 2023 and registration is sought for the goods and services set out in **Annex 1** of this decision.
2. On 4 August 2023, the applicant’s mark was partially opposed by Amadeus IT Group, S.A. (“the opponent”). The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the section 5(2)(b) and 5(3) grounds, the opponent relies on the following international registration:

AMADEUS

International registration (designating the UK) no. 1321806

International registration date: 22 June 2016

Date designation was sought in the UK: 22 June 2016

Date protection in the UK was granted: 25 April 2017

Relying on some goods and services, being those set out in **Annex 2** of this decision.

(“the opponent’s mark”).

3. As above, the opposition is only partial and I note that it is aimed against the following goods and services of the applicant only:

Class 9: Wireless locks; wireless locking mechanisms; electronic locking systems access control devices; access control units (automatic -);access control systems (automatic -); biometric access control systems; access control installations (automatic -);access control apparatus (automatic-); access control systems (electric-); computer programs for the enabling of access or entrance control; computer programs for enabling access or entrance

control; electronic access control system for buildings; electronic access control systems for interlocking doors; access security apparatus (automatic-); software to control building environmental, access and security systems; computer software for application and database integration; software; integrated software packages; operating system software; computer operating system software; computer software for use in migrating between different computer network operating systems; electronic control systems; cloud servers; cloud server software.

Class 37: Installation of Access Control as a Service (ACaaS) hardware.

Class 42: Access Control as a Service (ACaaS); installation of access control as a service (ACaaS) software; monitoring of computer systems by remote access; installation, repair and maintenance of computer software; computer software integration; computer systems integration services; design and development of operating software for cloud computing networks; development, updating and maintenance of software and database systems; software as a service; computer security system monitoring services; design and development of electronic data security systems.

4. Under the section 5(2)(b) ground, the opponent claims that the marks are highly similar and that the goods and services being opposed are identical or highly similar to the opponent's goods and services. As such, the opponent claims that there is a likelihood of confusion in respect of the marks at issue on the part of the public, including a likelihood of association.
5. Under the section 5(3) ground, the opponent claims that as a result of having continuously used its earlier mark in connection to the goods and services relied

upon, it has acquired a reputation in connection with the same. As a result of this reputation and the similarity between the marks, the opponent claims that use of the applicant's mark will result in the relevant public recalling the earlier mark and assuming that they are linked. It is claimed that this link will result in the applicant gaining an unfair advantage from the opponent's reputation and will ultimately cause detriment to the reputation and/or distinctive character of the earlier mark.¹

6. Under the section 5(4)(a) ground, the opponent relies on the unregistered sign 'AMADEUS' which it claims to have used throughout the UK since 1989. Under this ground, the opponent claims that it has used its earlier sign for the same goods and services relied upon under the above grounds. As a result of the opponent's continuous use of its sign, it claims that it has acquired significant goodwill. The claimed similarity between the marks is such that any use of the applicant's mark would constitute a misrepresentation that is likely to confuse or deceive the relevant public into believing that the goods and services of the applicant are those of, or associated with, the opponent. Accordingly, the opponent claims that this is likely to result in damage being caused to the opponent's business.
7. The applicant filed a counterstatement wherein it denied the claims against it. Further, the applicant requested that the opponent provide proof of use for the mark relied upon.
8. The applicant is represented by Palmer Biggs IP, Solicitors and the opponent is represented by Mansouri & Son Solicitors. Both parties filed evidence in chief with the opponent also filing evidence in reply. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

¹ In respect of the section 5(3) pleading, it is noted that at Q3 of Section B of the opponent's notice of opposition, it did mention detriment to distinctive character. However, when asked to provide more information on this point at Q6, it left the field blank. I will discuss this further below if necessary.

9. 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.

EVIDENCE

10. The opponent's evidence in chief came in the form of the witness statement of Mr Jean-François Cases dated 15 January 2024. Mr Cases is the IP Director of the opponent and has filed his evidence in order to demonstrate that the opponent has (1) used its mark during the relevant period and (2) accrued the claimed reputation and goodwill in its mark/sign. His evidence is accompanied by 30 exhibits, being those labelled JFC1 to JFC30.
11. The applicant's evidence in chief came in the form of the witness statement of Ali Aydan dated 15 March 2024. Ali Aydan is a Director and shareholder of the applicant. Their witness statement is accompanied by nine exhibits, being those labelled AA01 to AA09, and was adduced to demonstrate the applicant's own use of its mark and to prove that there is no association between the parties.
12. The opponent's evidence in reply came in the form of the witness statement of Luca Sarlo dated 22 May 2024. Mr Sarlo is Legal Counsel of the opponent. His statement is accompanied by five exhibits, being those labelled LS1 (which includes two exhibits marked A and B) to LS4, and was adduced in order to respond to the applicant's evidence.
13. I do not intend to summarise the evidence filed in full here (or the submissions of the opponent, for that matter). However, I confirm that I have taken all filed

documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

15. Section 6A is also relevant. It reads:

“(1) This section applies where:

(a) an application for registration of a trade mark has been published,

- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

16. Section 100 of the Act is also relevant. It reads:

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

17. Given the earlier designation date of the opponent’s mark, it qualifies as an earlier trade mark under the above provisions. The opponent’s mark was granted protection in the UK over five years prior to the filing date of the applicant’s mark. As set out above, the applicant requested that the opponent provide proof of use in respect of the same. Therefore, the opponent’s mark is subject to the proof of use assessment.

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax*

Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I-9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 Ferrari SpA v DU [EU:C:2020:854].

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

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

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

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

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed

to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

19. Section 6A of the Act (cited above) confirms that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant’s mark, being 11 April 2023. The relevant period is, therefore, 12 April 2018 to 11 April 2023 (“the relevant period”).

20. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”² because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Evidence of use

21. The opponent’s evidence sets out that it set up a UK subsidiary company in the UK, being *Amadeus IT Services UK Ltd*, on 13 July 1988. A printout from Companies House is provided that confirms this incorporation date.³ On this point, I remind myself that, as per section 6A(3)(a) of the Act (reproduced above), genuine use may still be demonstrated if said use is with the consent of the proprietor. Therefore, I accept that insofar as any use in the UK is by this subsidiary

² *Jumpman* BL O/222/16

³ JFC1

company then it is clearly with the requisite consent of the opponent itself and is capable of being relied upon in these proceedings. For the purposes of this assessment, I will continue to refer to any use by this company as use by the opponent.

22. In respect of its UK presence, the opponent confirms that it presently owns offices at Gatwick Airport and in Middlesex, the latter being the key research and development centre of the opponent. The opponent confirms that it held these offices since well before the relevant period and has provided a printout from its website which shows these office locations.⁴

23. In respect of the goods and services the opponent offers in the UK, the opponent has provided printouts from its website highlighting the products it offers to its customers.⁵ The printouts show the UK as the highlighted location. These printouts are noted but they are undated so it is no possible for me to determine that the services highlighted within them, such as the provision of 'Amadeus Hotels' and an 'Amadeus Margin Manager for Business Travel Agencies', were provided during the relevant period.

24. The evidence then turns to awards that the opponent has achieved during the relevant period. The first being 'TTG's Technology Provider of the Year' award. Coverage of this award is provided in evidence and I note that the article is dated 1 October 2019.⁶ In discussing the award, the evidence sets out that the opponent's technology is used by travel agents and brings together airlines, accommodation, rail, ground transport and in-destination content in one place. It is referred to as 'a one-stop shop for advanced travel retail'. Lastly, I note that the provider of the award, being TTG, is confirmed as being a travel trade magazine that is provided in the UK and Ireland. A second award is discussed and this is

⁴ JFC2

⁵ JFC3

⁶ JFC4

'Globe Travel Awards 2022' which, in revealing its short list in November 2021, listed the opponent's brand as one of the 'Best Technology Providers'. A printout of the shortlist is provided in evidence.⁷ This same award body, in 2023, awarded the opponent the 'Best Technology Provider' under the category of 'Serving the Industry'.⁸ While the latter awards are referred to as 'Global' and some awards relate to global experiences (such as referring to 'Walt Disney World Resort' in Orlando, USA as well as 'Destination Canada', for example), there does appear to be a focus on the UK as I note that in the printouts provided, the events took place in London and, further, some award categories were clearly focused on the UK (being 'Best UK Holidays Operator' and 'Best UK Airport'). In addition to these awards, the opponent has provided an article from 'Travolution' (being confirmed in the narrative evidence as a weekly UK publication in the travel industry) which discusses the latter most award being given to the opponent. In this article, the opponent is referred to as 'the UK travel trade's favourite technology company'.⁹

25. In terms of the opponent's customer base, the opponent claims that it offers its services to different types of customers including airlines, hotels, tour operators, insurers, car rental and railway companies, ferry and cruise lines, travel agencies and also individual travellers directly.¹⁰ In respect of the latter point, this is noted but there does not appear to be anything in the evidence of goods or services being provided directly to individual travellers. Further, I note that the opponent has not directed me to any such goods or services either in its own evidence or in submissions.

26. In respect of its airline customers, the evidence confirms that the opponent provides services to over 100 global airlines, with British Airways being among its largest clients. By way of example, the opponent has provided a number of articles

⁷ JFC5

⁸ JFC6

⁹ JFC7

¹⁰ On this point, I note that the opponent confirms, at paragraph 7 of Mr Sarlo's evidence in reply, that the services offered direct to consumers make up a much smaller degree of its business.

showing that the opponent's services were used by UK based airlines, Flybe, British Airways, EasyJet and Virgin Atlantic during the relevant period, as well as by the airports London Heathrow and London Gatwick.¹¹

27. The evidence includes information as to the opponent's market presence and its market share. This information is provided by way of a Statista (being a company that specialises in gathering and providing statistical data)¹² report which shows the opponent's distribution platform market share of global air travel distribution systems between 2010 and 2019.¹³ Having considered this report, I note that the opponent's market share went from 36.7% in 2010 to 44% in 2019. While the market within which the opponent operates is likely to be very a niche one that is unlikely to have a wide range of competitors (in the same way the clothing market would, for example), a share in this range is clearly indicative of a large global business operation in the relevant sector.

28. While on the topic of Statista, it is noted that a second report is provided that shows the opponent's global revenue between 2010 and 2022.¹⁴ This stood at 3.44 billion US dollars in 2010, a figure which steadily rose until 2019, when it reached 6.25 billion dollars. While there was a significant dip in 2020 and 2021, these years were those clearly impacted by the COVID-19 pandemic and its effects on the travel industry. As was the case above, this is clearly indicative of a large global operation.

29. While there is no evidence provided in respect of the opponent's marketing or advertising spend, it has provided evidence regarding its attendance at the 'Business Travel Shows' for the years 2020, 2021 and 2022. Press releases from the opponent's website confirming its attendance at these events is provided in

¹¹ See JFC8 to 11, JFC21 and FC23. Additionally, a press release is provided at JFC12 which discusses the relationship with British Airways in further detail.

¹² Evidence in respect of Statista is provided at JFC15 and JFC16.

¹³ JFC13

¹⁴ JFC14

evidence.¹⁵ I note that, for these years, the event took place in London. The show is described as one where “travel buyers, procurement, and bookers from across Europe go to start, improve or benchmark their travel programmes” and that it is one that focuses solely on business travel. In respect of this event, I note that the evidence confirms that in 2019, it attracted 8,804 attendees, being just one percent off the figures from the previous year.¹⁶ While there is nothing to suggest that the opponent actually attended the 2019 event, I consider it reasonable to infer that these figures are likely to be representative of the attendance levels for the years it did attend. All of this being said, there is nothing before me to suggest that opponent’s actual presence at these events or how many of the attendees interacted with or visited the opponent’s booths.

30. Lastly in respect of the opponent’s evidence in chief, I note that the opponent has provided a range of screenshots from its website from within the relevant period.¹⁷ These have been obtained from the internet archive facility, the Wayback Machine. I do not intend to discuss the entirety of the websites provided; however, I note that the first pages of each printout (all being in the relevant period) confirm that the opponent works with business travel agencies, airlines and ground handlers. There are also a range of products shown on these printouts that confirm that the opponent offers effective and cost-efficient business travel management and that its products can be used to analyse and centralise the user’s operations with a fully graphical user interface. These services are shown as being offered to corporations and airlines, respectively. In addition, other products listed are shown as being offered to those within the hospitality sector, airports, ground handlers and travel media.

31. I note that the applicant sought to argue that the opponent’s main business was aimed at booking and sales of holidays, flights and hotel accommodation. In its

¹⁵ JFC25 to 27

¹⁶ Confirmation of this is provided at JFC29 via a printout from the event’s own website.

¹⁷ JFC30

evidence in reply, the opponent accepted that it does mainly target the travel, hospitality and tourism sectors, however, it denied that this was the main focus of its business. On this point, the opponent argued that the solutions and services it offered dealt with other business and marketing aspects of companies active in the travel, tourism and hospitality sectors. Additionally, the opponent set out the following at paragraph 6 of its evidence in reply:

“The Opponent offers a wide range of services and solutions that are not just focussed on bookings and sales of holidays, flights and hotel accommodation. The solutions offered by the Opponent also deal with different business functions, such as analytics and business intelligence and business management, hotel management, such as hotel housekeeping management, software solutions concerning check-in for hotels, flights, solutions to deal with revenue management, increasing of sales and visibility of Opponent’s customers. The range of solutions offered by the Opponent and the industries it mainly targets are summarised on its website at <https://amadeus.com/en> under the “solutions” tab (a copy of which is exhibited hereto as **LS1B**.”

32. It is noted that the printout referred to at LS1B is undated and I have nothing to suggest how, for example, its ‘Innovation’ and ‘Mobile’ topics (being two of those shown on the printout) are meant to be construed.

Assessment of the evidence

33. While the opponent has not provided specific turnover or market share figures for the UK (being the relevant territory for this decision), I note that the global figures and market share evidence are at a large scale. In light of the fact that the opponent clearly operates in the UK, I consider it reasonable to infer that a proportion of this global use can be attributable to the UK market. In support of this inference, I remind myself that the evidence confirms that the opponent has (1) won awards from UK publications and (2) attended trade shows based in the UK. Further, the

opponent clearly has a focus on the UK due to its physical presence in Gatwick Airport and in Middlesex, being its research facility. Lastly, there is clearly an online presence focused on the UK by way of the existence of printouts from the opponent's UK website during the relevant period.

34. All of the above being said, it has not been possible for me to determine the precise level of use in the UK. While I have been willing to infer that there is some use, I am not willing to infer that its UK use is at a comparable scale to its global use. For example, the figures are provided in US dollars so it could just as reasonably be inferred that the bulk of said revenue relates to the US market with only a slither relating to the UK. Again, I have nothing to suggest the actual level of use in the UK so this determination has been left entirely up to me and, on this point, I consider it reasonable to suggest that the opponent should have provided more targeted revenue/market share details for the UK.

35. Overall, I am content to conclude that the opponent used its mark in the UK during the relevant period though, again, I am unable to determine the precise level of use. In any event, having taken all of the above into account, I consider it reasonable to infer that the use in the UK during the relevant period would have been at a sufficient level in order to be determined genuine. That being said, I do not consider it appropriate to extend this finding to all of the goods and services relied upon. Therefore, I will now proceed to discuss a fair specification in order to reflect the opponent's actual use.

Fair specification

36. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there

has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

37. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

38. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

39. The opponent’s specification is broad and is reproduced at Annex 2 of this decision. In respect of the nature of the evidence before me, I note that it does not offer any real focus when it comes to the actual of the goods and services provided.¹⁸ I also note, for example, that no breakdown is provided as to how the revenue can be said to relate to the different range of goods and services relied upon or the various claimed sectors to which it markets its services. In respect of the latter point, I am of the view that the evidence I have discussed at paragraphs 21 and 32 above have not been fully particularised in any real detail. Instead, it appears that the opponent has simply made broad claims as to what sectors it

¹⁸ In its evidence in reply, at LS1B, the opponent has sought to point to the industries and topics that its business covers, however, the printout confirming this is undated and I have nothing to suggest how, for example, its ‘Innovation’ and ‘Mobile’ topics are meant to be construed.

targets and what type of consumer it targets without actually attempting to specifically describe how this equates to the specification relied upon.

40. In addition to the above, I am of the view that the same lack of focus applies to the submissions filed as I note that in its written submissions in lieu of a hearing, the opponent has simply set out, at paragraph 89, that it has filed evidence which confirms the earlier mark has been put to use in the UK in respect of all of the relied upon goods and services during the relevant period. Aside from this blanket claim, the opponent has made no attempt to substantiate how the evidence provided relates to the goods and services relied upon. In short, I have nothing to guide me on what the evidence is purported to show outside a number of vague references to technical goods or services aimed at airline operations or travel agents, for example. In light of the technical nature of the goods, the sprawling and unfocused evidence as well as the lack of any directed submissions, it has been left to me to determine the fair specification without any guidance from the opponent whatsoever.¹⁹

41. Given what I have said above, I do not consider it necessary or appropriate to conduct a full and detailed fair specification assessment in respect of each and every term relied upon by the opponent. To do so would, in my view, be prejudicial to the applicant as it would, essentially, involve me seeking to formulate the opponent's case on its behalf. Instead, bearing in mind the opponent's clear focus on the travel industry in its evidence, I will simply list those goods and services below that I consider to cover the actual use of the opponent. It is these goods and services that I consider reflect a fair specification of the use shown in evidence and it is these goods and services that the opponent may proceed to rely upon:

¹⁹ In respect of this point, I remind myself of the comments of Mr Daniel Alexander Q.C. in *Awareness Limited v Plymouth City Council*, Case BL O/236/13 which sets out that the burden of proving genuine use lies on the proprietor of the mark at issue. Additionally, Mr Alexander Q.C. set out that a tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. See also paragraphs 21 and 22 of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13 and, generally, section 100 of the Act.

Class 9: Communications software, including communications software for connecting computer network users, for enabling the transmission of communications from mobile devices, enabling data exchange between airlines, airports and ground crews including via a shared platform, and to allow customers to access bank account information and perform banking transactions; utility programs for managing computer files; computer software for controlling self-service terminals and self check-in counters; interface software; computer software for importing, collecting, managing and centralizing data and data sets for calculating and distributing information concerning the availability, prices and tariffs in the transport, travel, hotels, restaurants, sports, cultural and entertainment sectors; computer software for booking and sale of tickets and seats in the transport, travel, hotels, restaurants, sports, cultural and entertainment sectors; computer software for managing all means of passenger transportation by air, land, water or rail, including multimodal and shared means, tour packages, travel arrangements, travel itineraries; computer software for managing cruises; computer software for flight management, for passenger, cargo and luggage tracking, for cargo and luggage handling; computer software for controlling check-in counters and for enabling passenger boarding, registration and check-in, including validation of passengers' check-in status and travel documents; computer software for managing travel agencies.

Class 35: Updating and maintenance of data on an on-line computer database in the field of airline and travel booking, flight scheduling, departure control services, passenger check-in, ticket sales, pricing and invoicing;

Class 38: Telecommunications services relating to operations and processes for the airline, airports, tourism and travel industries; information and advice relating to the foregoing services.

Section 5(2)(b): legislation and case law

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

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

(a) [...]

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

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

43. Section 5A of the Act states as follows:

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

44. 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 Office for Harmonization in the Internal Market*

(*Trade Marks and Designs*), Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

45. The opposed goods and services of the applicant can be found at paragraph 3 above. The opponent's goods and services, being those subject to the proof of use assessment I have undertaken, can be found at paragraph 41 above.

46. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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".

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

48. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

49. I have submissions from the opponent as to the identity or similarity of the goods and services. However, these submissions relate to the opponent's specification as it initially appeared at the outset of these proceedings. Given that this specification has been limited, I do not consider that those submissions are directly applicable here. That being said, I have given them due consideration as, undoubtedly, some goods and services have remained.

50. While on the topic of the submissions of the parties, I note that in its counterstatement, the applicant argues that the parties operate in different sectors. On this point, I note that the opponent has, in its own submissions, mentioned the fact that the applicant has filed evidence of its own website that sets out that the applicant offers its security goods and services to hotels and airports.²⁰ The opponent therefore argues that the parties' goods and services are offered within the same sectors and target the same market. In respect of this issue, I wish to make two points.

51. Firstly, when considering the likelihood of confusion under section 5(2)(b), the assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods and services based on the specifications before me, not the goods and services effectively provided by the parties.²¹ Therefore, the relevant market or sectors of the goods and services at issue will only come into play insofar as they can be said to be reflected in the wording of the actual terms before me.

52. Secondly, I am not convinced that the evidence of the parties means that the parties operate in the same markets. It does not follow that just because a hotel or an airport would implement security measures that this is the same sector or

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²¹ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

market as that used by those same hotels and airports when it comes to implementing software for booking rooms or flights for example. By analogy, hotels and airports both have bathrooms that will source goods such as toilet paper and soap from various suppliers but that in no way means that the providers of said goods operate in the same sector/market as the provider of the specific software that enables those hotels or airports to operate.

Class 9

53. In respect of the applicant's class 9 goods, the following comparison will be based on the opponent's class 9 goods. While registered for additional services, I am of the view that the opponents' class 9 goods offer the opponent its best case. For the avoidance of doubt, where I find dissimilarity between the parties' class 9 goods, the same will apply to any comparison with the services of the opponent also.

Wireless locks; wireless locking mechanisms; electronic locking systems access control devices; access control units (automatic -); access control systems (automatic -); biometric access control systems; access control installations (automatic -); access control apparatus (automatic-); access control systems (electric-); electronic access control system for buildings; electronic access control systems for interlocking doors; access security apparatus (automatic-); electronic control systems.

54. While the opponent's specification includes goods in class 9, these all cover to software goods that relate specifically to the travel industry, be that travel agents or airport/airline operators. None of these goods can be said to even remotely relate to locks, locking systems, control units or control systems. In my view, there exists no overlap in nature, method of use, purpose, trade channels or user. Additionally, the goods are not competitive or complementary. They are, therefore, dissimilar goods.

Computer programs for the enabling of access or entrance control; computer programs for enabling access or entrance control; software to control building environmental, access and security systems; computer software for application and database integration.

55. The above goods of the applicant are all items of software for specific purposes. None of these purposes can reasonably be said to cover, or relate to, the travel industry or airline/airport operation.²² So while the goods may share some overlap in that they are items of software, I do not consider this alone to be sufficient to warrant a finding of similarity between them. If it were the case that goods being software was sufficient by itself to give rise to such a finding, this would offer far too broad a scope of protection for such goods. Plainly, this cannot be the case. In considering the present terms, I consider that they all differ in method of use, purpose, trade channels and user. On this point, I have nothing to suggest otherwise. Lastly, the goods are not complementary or competitive in nature and I, therefore, find that they are dissimilar.

Computer software for use in migrating between different computer network operating systems.

56. While I appreciate that the above software is not specifically for access control, it is a term that has a specific purpose that, like those discussed in the preceding paragraph, does not overlap with the opponent's class 9 goods. Therefore, following the same reasoning set out in the preceding paragraph, I find that the above term is dissimilar to the opponent's class 9 goods.

²² On the latter point, I appreciate that an airport will have security controls but, as I have discussed above, this does not necessarily mean that the applicant's goods are for the operation of an airport.

Software.

57. The above term of the applicant is so broad that it can be said to cover software for any and all purposes, including those covered by the opponent's class 9 goods. As such, this term encompasses all of the opponent's class 9 software goods. As such, they are identical under the principle outlined in *Meric*.

Integrated software packages; operating system software; computer operating system software.

58. The above terms are not limited to any specific purpose or any industry. As such, I consider it reasonable to suggest that they are goods that can be used in the travel industry or by airline/airport operators. For example, airports may use their own operating system software to integrate all of the different airlines schedule departures/arrivals. While I do not consider that the above goods describe the same goods as those covered by the opponent's class 9 goods, I do consider that they are similar. I say this because they are software goods that will be used in the same way and can cover the same purposes, i.e. to allow for the operation of airports or travel booking. Therefore, these goods overlap in nature, method of use and purpose. Further, the goods are likely provided by the same undertakings and sought by the same consumer meaning that there are overlaps in trade channels and users. Taking all of this into account, I find that these goods are similar to a high degree with the class 9 goods in the opponent's specification.

Cloud server software.

59. The above goods of the applicant are those that allow for the storage of data or information on the cloud, as opposed to storing them on physical hard drives. While the user of the various software covered by the opponent's class 9 goods are also likely to store data or information on the cloud, I do not consider this sufficient to give rise to a finding of similarity. I say this because whilst both parties' goods may

cover types of software, their method of use and purposes differ. Further, I do not consider that their trade channels overlap and neither are the goods complementary or competitive with one another. Overall, I do not consider the fact that the goods are types of software that may be used by the same consumer is sufficient to give rise to a finding of similarity between them. As such, I consider them to be dissimilar.

Cloud servers.

60. I consider that the above term describes the actual server itself, and not the software used to operate it. In light of this and given what I have said in the preceding paragraph, it follows that I also consider that the above term is dissimilar with the goods of the opponent.

Class 37

Installation of Access Control as a Service (ACaaS) hardware.

61. The above term is an installation service and I note that the opponent has no counterpart service in its specification. While I note that it does have “updating and maintenance of data on an on-line computer database in the field of airline and travel booking, flight scheduling, departure control services, passenger check-in, ticket sales, pricing and invoicing” in class 35, this is not similar to the applicant’s term. I say this because one service is for the installation of hardware whereas the other is for the updating and maintenance of a database. As such, the services clearly differ in nature and method of use. Further, the services are for different purposes. Additionally, there is nothing to suggest that the provider of the opponent’s services would also provide the applicant’s so I am unwilling to find an overlap in trade channels. Lastly, in respect of user, I do not consider that the services will be aimed at the same consumer. Even if it could be said that an airport

operator would use both services, this does not warrant a finding that they share a sufficient degree of similarity. As a result, I find that these services are dissimilar.

Class 42

Software as a service.

62. The above term covers the provision of software over the internet, which is commonly accessed via a web-browser as opposed to the user actually needing to download the software to their computer. While not identical to software in class 9 due to their different natures and methods of use, I consider that they are similar. On this point, I note that the opponent's class 9 goods include a range of different types of software all for specific purposes. While that may be the case, the applicant's term is unlimited meaning that it is capable of covering software as a service for the same purposes as the opponent's terms. As such, there is a degree of overlap in the purpose of the opponent's class 9 goods and the above services. Additionally, the trade channels overlap as I consider it likely that the provider of software as a service is also likely to provide downloadable software in class 9. As for user, I consider that these goods and services will be targeted at the same group of consumers. In respect of the latter point, I appreciate that if the user does not overlap directly then these goods and services are competitive in nature on the basis that a user may choose to own software for the specific purposes covered by the opponent's goods or to enter into an arrangement for the provision of software as a service which, again given its unlimited nature, may cover software services for the same purposes. Taking all of this into account, I find that the above services are similar to a medium degree with the opponent's class 9 goods.

Access Control as a Service (ACaaS); installation of access control as a service (ACaaS) software; monitoring of computer systems by remote access; computer security system monitoring services.

63. As has been the case throughout this comparison, I appreciate that the opponent's specification includes software goods, however the specific nature of the same does not mean that they are similar to any type of software or software as a service, for that matter. The above services all relate to security and access control and not the specific purposes of the opponent's software goods. As such, I see no reason why these goods and services would share any overlaps in nature, method of use, purpose, trade channels or user. As a result, I find that these goods and services are dissimilar.

Development, updating and maintenance of software and database systems.

64. I note that the opponent's specification includes the term "updating and maintenance of data on an on-line computer database in the field of airline and travel booking, flight scheduling, departure control services, passenger check-in, ticket sales, pricing and invoicing" in class 35. While in separate classes, I consider that the opponent's term can technically be said to fall within the applicant's term (on the basis that 'database systems' covers the specific databases of the opponent's term), rendering them identical under the principle outlined in *Meric*. Alternatively, if I am wrong to find identity on the basis that the services are in different classes, then I find that they would still be similar to a high degree on the basis that they overlap in nature, method of use, purpose, trade channels and user.

Installation, repair and maintenance of computer software.

65. The above term is unlimited and can, therefore, be said to be for the maintenance of software for any purpose, including software in the field of airline and travel booking. While the maintenance of databases (being the opponent's class 35 term, "updating and maintenance of data on an on-line computer database in the field of airline and travel booking, flight scheduling, departure control services, passenger check-in, ticket sales, pricing and invoicing") is not the same as the maintenance of computer software, I do consider that there is some overlap. I appreciate that

the nature and method of use of the services will differ, however, the purposes overlap in that both parties' terms aim to maintain some form of computer application (be that software or an on-line database). Further, I consider that the provider of such services is likely to overlap and that the services will be aimed at the same users. Taking all of this into account, I find that these services are similar to a medium degree.

Design and development of operating software for cloud computing networks; design and development of electronic data security systems.

66. While relating to software or systems that may be run on a computer, I do not consider that the above services share any degree of similarity with the opponent's goods or services. At best, a provider of the above services may also design and develop other types of software outside of software for cloud computing networks or electronic data security systems, including those covered by the specific class 9 terms in the opponent's specification. While this may result in an overlap in trade channels, I do not consider this alone is sufficient to give rise to a finding of similarity. In short, these goods and services differ in nature, method of use, purpose and user. Further, they are not complementary or competitive and I, therefore, find that they are dissimilar.

67. In respect of the above services, I have also given consideration as to whether there is any overlap with the opponent's class 35 service, being "updating and maintenance of data on an on-line computer database in the field of airline and travel booking, flight scheduling, departure control services, passenger check-in, ticket sales, pricing and invoicing". I accept that the provider of the applicant's term may also seek to update and maintain the software they design and develop, however, the opponent's term is not for the update or maintenance of computer software. Further, the purposes covered by the terms are considerably different. In short, I see no obvious reason as to why such services would share any overlap in the relevant factors. Therefore, I also consider these services to be dissimilar.

Computer software integration; computer systems integration services.

68. The above term describes a service that is offered to customers in order to connect their different items of software to one another so that they may share information and data without the need to enter said information/data in manually. I appreciate that this service can be used to integrate any type of software, including the specific software of the opponent. However, I see no reason why this means that they are similar. Firstly, the goods and services differ in nature, method of use and purpose. In respect of trade channels, the above services are likely to be provided by a third party undertaking as opposed to the provider of the software itself. I say this because it appears to me that the above service aims to integrate different software goods that may not necessarily be compatible to one another, thereby suggesting the software to be integrated comes from different undertakings. On this point, I will say that I consider it likely that software provided by the same undertaking is likely to include features that share data, meaning that integration is not required. Lastly, I appreciate that the goods and services may be targeted at the same user, however, I do not consider that this alone is sufficient to give rise to a finding of similarity between the goods and services. As a result, I find that these services are dissimilar to any of the goods and services in the opponent's specification.

Conclusion of goods and services comparison

69. Where there is no similarity between goods and services, there can be no likelihood of confusion under section 5(2)(b) grounds.²³ In light of my findings of dissimilarity above, it follows that the present ground of opposition fails against said goods and services. However, the opposition will proceed against those goods or services found to be identical or similar. For ease of reference, the goods and services against which this ground of opposition may now proceed are as follows:

²³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

Class 9: Software; integrated software packages; operating system software; computer operating system software.

Class 42: Software as a service; development, updating and maintenance of software and database systems; installation, repair and maintenance of computer software.

The average consumer and the nature of the purchasing act

70. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

71. The opponent submits that the average consumer for the goods and services at issue will be the business user, operating in several trades. The opponent also submits that while the visual component will play a role in the selection process, the goods and services will mostly be aural selections coming via word-of-mouth recommendations, presentations and direct communications with sales representatives. Additionally, the opponent submits that although business users

tend to have a higher degree of attention than members of the general public, the level of attention of the consumers in the present case will not be more than average.

72. To some degree, I agree with the opponent's submissions insofar as it relates to the identity of the average consumer. This is because of not only the specific nature of the goods and services in the opponent's specification but the broad nature of terms in the applicant's specification such as "software" and "software as a service" (which inevitably can cover goods/services for the same specific purposes of the opponent's terms). For such goods/services, it is clear that the consumers will be business users that operate across several specific trades. While that may be the case, the applicant's terms are also broad enough to cover goods and services for a variety of purposes. As such, I cannot discount that the marks will be viewed on general goods such as downloadable software for mobile devices, for example. In light of this, I consider that the consumer base will also be made up of members of the general public at large.

73. Regardless of the identity of the consumer, I do not agree that the aural component will dominate the selection process. Firstly, the broader goods and services will be selected mostly via visual means. For example, "software" at large can cover software downloaded on mobile devices which will be selected after the consumer sees an image of it on a mobile app store. On this point, I appreciate that the aural component may still play a role via word-of-mouth recommendations, for example. Further, even where some of the goods and services are specialist in nature (which I accept will likely attract discussions with sales assistants), the consumer will still view the goods at issue or consider the services available on lists, pamphlets or placards. The visual element will, therefore, remain a key element in the selection process. As such, I am of the view that the selection process for the specialist goods and services will be both visual and aural, with each component playing an equal role.

74. Turning to the level of attention paid, I accept that some goods and services will attract, generally, an average (or medium) degree of attention. I say this because, as above, some software goods covered by the applicant's specification will be ordinary consumer goods such as computer game software or downloadable applications that will not be particularly involved selections. As for the more specific goods and services, I disagree that the level of attention paid will be no more than medium. By its own admission, the opponent states that business users tend to pay a higher degree of attention. In light of the nature of the specialist goods and services at issue here, I see no reason why this would not be the case. For example, the opponent's goods in class 9 are specialist in nature and the business user (which can include one that operates airports or airlines) would consider the selection of software that assists in the operation of said business will be a highly considered selection as it will be a very important part of that user's business. The specialist nature of the goods and services at issue is such that I am unable to determine the precise factors that will be considered when selecting them. However, I am of the view that the selection process will attract a relatively high degree of attention, though I appreciate that this will not be at the highest level.

Comparison of the marks


75. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

76. 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.”

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

78. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
AMADEUS	

79. I have comments from both parties in respect of the similarities of the marks at issue. I can confirm that I have given them due consideration before making the following comparison. However, I do not intend to reproduce them in full here but will, where necessary, refer to them below.

Overall impression

80. The opponent's mark is a word only mark that consists solely of the word 'AMADEUS'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

81. As for the applicant's mark, this is a figurative mark made up of three separate word elements, all of which are presented in the same standard typeface and in green, albeit in different sizes. The three words are stacked on top of each other, beginning with the letter 'A' which sits at the top of the mark and is presented in a significantly larger typeface than the remaining words. Below this sits the word 'AMADEO' which is presented in a smaller bold typeface. At the bottom of the mark sits the words 'Beyond Access', presented in a regular typeface and slightly smaller than the word above it. While 'A' is the largest element of the mark, it is the word 'AMADEO' that will play the greater role in the overall impression of the mark. I say this because the letter 'A' is just one letter that will simply be viewed as standing for 'AMADEO', being the word immediately underneath it. As for the words 'Beyond Access', the opponent argues that this is a descriptive term. I disagree that it is descriptive. However, I appreciate that in some circumstances it will be allusive to the fact that the applicant's goods and services may relate to 'access' or the granting thereof (covering software goods for the control of access, for example). However, where the goods or services at issue do not cover such purposes,²⁴ 'Beyond Access' will not be allusive in the same way. However, it will be seen merely as a tagline so regardless, it will still play a lesser role. To confirm, I find that the word 'AMADEO' plays the greater role in the applicant's mark with both 'A' and 'Beyond Access' playing lesser roles (which I consider to be equal to one another).

²⁴ On this point I remind myself that the applicant's specification covers broad terms and in light of the fair and notional assessments I must make throughout this decision, it follows that the mark can also be viewed on goods or services that have no connection to access or the granting thereof.

Visual comparison

82. Visually, the marks share an identical letter string, being 'A-M-A-D-E'. This forms five of the seven letters that make up the sole element of the opponent's mark and five of the six letters that make up the stronger element of the applicant's mark. The marks differ in the letters that follow this shared element, being the letters 'U-S' in the opponent's mark and the letter 'O' in the applicant's. The marks also differ in the presence of the letter 'A' at the top of the applicant's mark and the words 'Beyond Access' at its bottom. These points have no counterpart in the opponent's mark. While they play lesser roles in the applicant's mark, they are still points of visual difference and given the size of the letter 'A', I consider this to be a rather significant point of difference. Taking all of this into account and bearing in mind the overall impressions of the marks, I find that they are visually similar to a medium degree.

Aural comparison

83. The opponent submits that the letter 'A' and the words 'Beyond Access' will not be pronounced. I agree. In doing so, I appreciate that just because an element of a mark may be descriptive, it does not mean it is aurally invisible.²⁵ While this principle does not necessarily only apply to descriptive elements,²⁶ I consider that it can be distinguished from here. I say this because 'A' simply stands for 'AMADEO' and 'Beyond Access' will be viewed as a tagline. I do not consider that consumers ordinarily seek to articulate such elements within trade marks. This leaves the aural comparison as being between the words 'AMADEUS' and 'AMADEO'. 'AMADEUS' will be pronounced as 'AM-UH-DAY-US' and 'AMADEO' will be pronounced as 'AM-UH-DAY-OH'. The first three syllables in the marks are identical and while the last syllable differs, I remind myself that consumers tend to

²⁵ *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22)

²⁶ It can equally apply to allusive elements, for example.

focus on the beginnings of marks.²⁷ As such, I find that the marks are aurally similar to a high degree.

Conceptual comparison

84. The opponent submits that the marks at issue are conceptually identical because 'AMADEO' and 'AMADEUS' are the same name in different languages, being Italian/Spanish and Latin/German, respectively. Alternatively, the opponent submits that 'AMADEO' derives from the name 'AMADEUS' and they could both be perceived as references to a historical King of Spain. The applicant disagrees with this and, on the other hand, submits that 'AMADEUS' will be associated with the renowned composer (while not expressly stated, it is presumed this is a reference to the Austrian composer, Wolfgang Amadeus Mozart). As for its own mark, the applicant submits that it is more likely to be associated with the Arabic name 'AHMADIO' or 'AHMADIOHA' being the Arusi or Agbara of thunder and lightening of the Igbo people of southeastern Nigeria.

85. While the submissions of both parties are noted, they do not factor in the letter 'A' and the words 'Beyond Access' in the applicant's marks. In any event, insofar as it applies to 'AMADEUS' and 'AMADEO', I do not agree that either of the parties' submissions apply here. I say this because there is nothing before me to suggest that the average consumer in the UK would be aware that (1) AMADEO and AMADEUS meant the same names but in different languages, (2) 'AMADEUS' was the name of a King of Spain or (3) 'AMADEO' was associated with the Arabic/Igbo meanings suggested by the applicant. The best case, in my view, lies in the association between 'AMADEUS' and the famous composer, being Mozart. That being said, I have no evidence before me that a significant proportion of consumers in the UK would be aware that Mozart's full name included Amadeus. As such, I do

²⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

not consider that a significant proportion of consumers would connect the opponent's mark to the Austrian composer.

86. All of the above being said, I am of the view that 'AMADEUS' would be understood as a foreign language name. As for 'AMADEO', I do not consider that the same applies and, instead, it will simply be understood as a made-up or foreign language word with no obvious meaning. These elements are not capable of conceptual comparison and, therefore, are conceptually neutral. That being said, I cannot discount the additional elements in the applicant's mark, being the letter 'A' and the words 'Beyond Access'. The 'A' will clearly be understood as standing for 'AMADEO'. 'Beyond Access' will be understood as a phrase in relation something being out of reach or limits, i.e. 'being beyond access'. The words 'Beyond Access' will, therefore, be viewed as the only element of the marks that have any real meaning to the UK consumer. Given its dissimilarity to anything in the opponent's mark, I find that the marks are conceptually dissimilar.

Distinctive character of the opponent's mark

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

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

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

88. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced through use and, on this point, I note that the opponent has filed evidence of use and, in its submissions, has claimed that its mark benefits from an enhanced degree of distinctiveness. I will, therefore, consider whether this evidence is sufficient to give rise to a finding that the distinctiveness of the opponent’s mark has been enhanced through use. Before doing so, I will consider the inherent position.

89. The opponent submits that, inherently, its mark enjoys a high degree of distinctive character because it does not have any meaning in relation to the goods or services relied upon. While I accept that marks that have no descriptive or allusive qualities may enjoy a high degree of distinctiveness character, this ordinarily applies to words that are perceived as invented. This is not the case here. Instead, as I have discussed above, the average consumer will understand the opponent’s mark as a reference to a foreign language name. I appreciate that this name is by no means a common name in the UK, however, it will still be understood as a name. So while it may not be descriptive or allusive in respect of the opponent’s goods and

services, I do not consider that it is particularly remarkable from a trade mark perspective. As a result, I find that the opponent's mark enjoys a medium degree of inherent distinctive character.

90. I turn now to the evidence and whether it is sufficient to give rise to a finding of an enhanced degree of distinctive character. I have summarised the opponent's evidence at paragraphs 21 to 32 above. I do not intend to reproduce that evidence here but remind myself that, globally, the opponent operates a large brand which enjoyed between a 36.7% and 44% share of its relevant market between 2010 and 2019. Further, the opponent's turnover during this time was large, peaking at \$6.25 billion in 2019. All of this being said, this is evidence regarding global use and while I was willing to infer that this level of use was attributable to a level of use in the UK sufficient to be deemed genuine, I was not willing to infer that this use was at any substantial level. The reasons for this were set out at paragraphs 33 to 35 above and I rely on that same finding here.

91. In considering the present assessment, I remind myself that the test for proving an enhanced degree of distinctiveness is significantly more onerous than that for genuine use.²⁸ I accept that the opponent has focused on the UK, maintains a number of large airlines as its customers and has won a number of awards given by travel industry publications. However, the assessment I must make has been rendered difficult by the lack of any real clarity or precision in respect of the actual use made of the mark in the UK or its exposure to consumers. Given this lack of clarity, I consider that it would be inappropriate for me to infer that simply because the opponent operated a large global business, its mark would be well-known to consumers in the UK. As a result, I find that the inherent position applies, namely that the opponent's mark is distinctive to a medium degree.

²⁸ I say this on the basis that use need not be quantitatively significant in order for it to be genuine. On the contrary, a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods/services as originating from a particular undertaking.

Likelihood of confusion

92. 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 and services 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and 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 they have retained in their minds.

93. I have found the goods at issue to be either identical or similar to varying degrees. In respect of the consumer, I have found that the average consumer base is formed of members of the general public and business users. The former group will select the goods and services via visual means (though I do not discount an aural component playing a role) whereas the latter group will select the goods and services via visual and aural means. In respect of the level of attention paid, I have found that this will either be medium or relatively high depending on what goods/services are being selected. I have found that the marks are visually similar to a medium degree, aurally similar to a high degree and conceptually dissimilar (with the dominant elements being conceptually neutral). Lastly, I have found that the opponent's mark is distinctive to a medium degree.

94. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I consider that the average consumer, upon being confronted by the parties' marks, would be able to accurately recall or remember which mark was which. I say this because whilst the parties' marks all share an identical letter string, being 'AMADE', the points of difference would not be overlooked. On this point, I appreciate that the letter 'A' and the words 'Beyond Access' play lesser roles in the applicant's mark, their visual impacts on that mark are such that they will not be overlooked outright. Further, I appreciate that the marks are aurally similar to a high degree and that the aural component plays an equal role in the selection process (for some goods and services). However, in the scenario where the aural component plays such a role, the consumer will pay a relatively high degree of attention. As a result, the consumer will look to assess the marks in more detail thereby enabling them to remember/recall them with accuracy. Lastly, I found that the marks are conceptually dissimilar as wholes which, in my view, is sufficient to offset any visual or aural similarity between them.²⁹ Even ignoring the conceptual impact of the marks as wholes, I consider that the conceptual neutrality between the dominant elements of the marks, being 'AMADEO' and 'AMADEUS', is such that consumers will be able to differentiate between them. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks, even on identical goods.

95. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the

²⁹ On this point, see the case of *The Picasso Estate v OHIM*, Case C-361/04 P wherein the CJEU set out that conceptual differences may offset visual and aural similarities.

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'.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

96. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

97. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 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.

98. In its submissions, the opponent sets out that a likelihood of indirect confusion arises because a significant number of consumers would think that the software related goods and services provided by the opponent are sold under licence from the opponent or pursuant to some other collaboration between the parties. While noted, this argument is not particularly supported by any further submissions. In the absence of such, I do not see how this is applicable to the present case. I see no reason why consumers would believe that an undertaking that operates under ‘AMADEO’ would licence use of the same from ‘AMADEUS’ and neither do I consider that they would think that ‘AMADEO’/‘AMADEUS’ were indications of a brand collaboration.

99. In considering indirect confusion generally, I do not consider that the shared element, being the five-letter string of ‘AMADE’, is so strikingly distinctive that average consumers would consider that only one undertaking would use it. In any event, the distinctiveness of the opponent’s mark lies in the word ‘AMADEUS’ as a whole, not those shared letters. Therefore, even if ‘AMADEUS’ was strikingly distinctive, I see no reason why this would benefit the opponent for the purposes of the present assessment. Further, I see no reason why a consumer, even upon overlooking the other points of difference between the marks, would consider the change from ‘AMADEUS’ to ‘AMADEO’ as a logical indicator of a sub-brand or brand extension. In short, I do not consider that consumers would believe that an

undertaking that refers to a foreign language name, being 'AMADEUS', would change its mark so that it altered its concept to refer to a made-up or foreign language word with no meaning. For the avoidance of doubt, I consider that this same finding applies if the consumer was to be confronted by the applicant's mark before the opponent's.³⁰ Consequently, I do not consider that there exists a likelihood of indirect confusion between the marks, even on identical goods.

100. The present ground fails in its entirety. I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

101. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

102. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L'Oreal v Bellure, Case C-323/09, Marks and Spencer*

³⁰ In respect of this point, see *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, at paragraphs 75-84. In that case Kitchin LJ explained that “right way round” or “wrong way round” confusion may be a consequence of nothing more meaningful than the order in which the consumer happened to come across the mark and the sign.

v Interflora, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that

this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and the court's answer to question 1 in *L'Oreal v Bellure*).

103. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar.³¹ Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public.

³¹ As per my comparison of the marks under the section 5(2)(b) ground above, this condition has been satisfied.

Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

104. As the issue of genuine use is as equally applicable to section 5(3) grounds as it is to section 5(2)(b), my findings above in respect of genuine use and a fair specification apply here. As a result, the present ground may only proceed in respect of those goods and services for which I have found genuine use.

105. In considering this ground, I am of the view that I can deal with it relatively briefly. The evidence provided by the opponent has been summarised at paragraphs 21 to 32 above and I rely on that same summary here. In considering whether there exists a reputation, I am of the view that my findings in respect of an enhanced degree of distinctive character can be said to apply equally here (being those at paragraphs 90 and 91 above). I say this because whilst the tests are technically different, the conclusions are commonly the same and I am of the view that this is the case here. This is on the basis that the test for reputation and the test of enhanced distinctiveness in the present case are aimed at the same relevant date, cover the same relevant territory and are aimed at the same set of goods and services. As a result, I consider that everything I said at paragraphs 90 and 91 above is equally applicable to the issue of a reputation. I do not intend to repeat those points in full but remind myself, briefly, that the evidence of the opponent is not focused on the relevant territory and no turnover or advertising spend is provided that can be said to solely relate to the UK and, even so, the opponent's

reference to its goods and services is vague and imprecise. While I have accepted that the global use is on a large scale, I consider that it would be unreasonable for me to make an inference that a significant part of the relevant public in the UK would be aware of the opponent's mark simply because the opponent operates a large global business.

106. As a result, I find that the present ground fails at the first hurdle as in order for there to be a link and subsequent damage, there must first exist a reputation. I will now proceed to the final ground of this opposition, being that brought under section 5(4)(a) of the Act.

Section 5(4)(a)

107. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

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.”

108. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

109. In considering the present ground, I remind myself of the case of *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, wherein Lewison LJ cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in considering the Court of Appeal’s later judgment in *Comic Enterprises* (cited above), it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.³² This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

110. I am of the view that even if the opponent did enjoy a protectable level of goodwill in its sign, there would be no misrepresentation. I say this because the principle set out in *Comic Enterprises*, namely that the test for misrepresentation is unlikely to produce a different outcome than the one for a likelihood of confusion, is applicable here. Therefore, given that I have found no likelihood of confusion under the section 5(2)(b) ground above, it follows that there exists no misrepresentation under the present ground. Without misrepresentation there can be no damage and I therefore find that this ground fails in its entirety.

³² Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

CONCLUSION

111. The opposition fails in full and, subject to any successful appeal of my decision, the applicant's mark is permitted to proceed to registration for all goods and services applied for.

COSTS

112. The applicant has succeeded in full and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £850 as a contribution towards its costs. The sum is calculated as follows:

Considering the notice of opposition and filing a counterstatement:	£250
Filing evidence and considering the evidence of the opponent:	£600
Total:	£850

113. I hereby order Amadeus IT Group, S.A. to pay Amadeo Systems Ltd the sum of £850. The above sum should 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 21st day of March 2025

A COOPER
For the Registrar

ANNEX 1

Class 6

Metal keys for locks; Locks and keys, of metal; Locks of metal; Bicycle locks; Spring locks; Metal locks for doors; Keys (Metal -) for opening locks; Metal locks for windows; Metal sash locks; Bolts (Lock -); Lock bolts; Cylinder locks of metal; Locks of metal for vehicles; Non-electric locks of metal; Locks of metal, other than electric; Locks [other than electric] of metal; Metal security lock cylinders; Lock bolts of metal; Striking plates of metal for locks; Metal bolts for locking doors; Spring locks of metal, other than electric; Padlocks; Non-electric locks made of metal; Lock parts of metal; Metal locks [non electric]; Metal locking mechanisms; Latches (Metal -) being fittings for doors; Metal door latches; Keys; Keys of metal; Metal rings for keys; Rings of metal for keys; Metal bump keys for locksmithing; Keys (Rings of common metal for -); Rings of common metal for keys; Metal key blanks; Key blanks of metal; Key hole plates of common metal; Key tags of common metal; Ironmongery; Metal ironmongery; Ironmongery of metal for building; Door fittings of metal; Fittings of metal for doors; Door hardware (Metal -); Common metals; Alloys of common metals; Small items of metal hardware; Metal lock boxes; Lock boxes of metal; Locksets of metal; Metal locksets; Safes; Safety fittings of metal for doors; Door fittings, of metal; Door hinges of metal; Door knockers; Knockers (Door -); Electronic safes; Safes, electronic; Non-metal safes; Door knockers of metal.

Class 7

Key cutting machines; Key making machines; Tool cutting machines; Tools (Machine -) for cutting; Cutting machines; Metal cutting tools [machines].

Class 9

Biometric locks; Fingerprint door locks; Electric deadbolt locks; Wireless locks; Electrical locks; Smart door locks; Electronic locks; Locks, electronic; Electric locks; Smart locks; Electronic door locks; Door locks (Electric -); Digital door locks; Electromagnetic locks; Locks [electric] with alarms; Biometric fingerprint door locks;

Radio-frequency controlled locks; Locks (electric) for bicycles; Metal locks [electric]; Electric locks for vehicles; Combination locks (metal -) [electric]; Combination locks (non-metallic -) [electric]; Mechanical dialling locks [electric]; Card operated electronic locks; Wireless lock assemblies; Radio operated door lock controls; Electronic locking mechanisms for safes; Mechanical locks [electric, metal]; Mechanical locks [electric, non-metallic]; Electronic lock assemblies; Fingerprint padlocks; Wireless locking mechanisms; Smart padlocks; Electronic locking systems; Access control devices; Access control units (Automatic -); Access control systems (Automatic -); Biometric access control systems; Access control installations (Automatic -); Access control apparatus (Automatic -); Remote controls; Access control systems (Electric -); Computer programs for the enabling of access or entrance control; Computer programs for enabling access or entrance control; Electronic access control system for buildings; Access control units (Electric -); Access control installations (Electric -); Electrical access control apparatus; Access control apparatus (Electric -); Remote controls for controlling electronic products; Electronic access control systems for interlocking doors; Programmable controls; Universal remote controls; Remote controls for electronic products; Access control cards [encoded or magnetic]; Remote controls for multimedia systems; Multifunctional remote controls; Access security apparatus (Automatic -); Software to control building environmental, access and security systems; Remote control apparatus (Electronic -); Connecting modules for electric controls; Keys (Encoded -); Electronic keys for vehicles; Electronic keys for automobiles; USB web keys; Electronic key cards; Encoded key cards; Keypads; Radio-frequency identification (RFID) tags; Radio-frequency identification (RFID) readers; Electronic security tags; Electronic chip cards; Electronic ID cards; Bracelets (Encoded identification -), magnetic; Encoded identification bracelets, magnetic; Identification bracelets (Encoded -), magnetic; Locks, electric; Computer software for application and database integration; Software; Integrated software packages; Operating system software; Computer operating system software; Computer software for use in migrating between different computer network operating systems; Electronic control systems; Mortise gauges; Padlocks, electronic; Electronic doorlocks; Cloud servers; Cloud server software.

Class 37

Repair of locks; Installation of locks; Locks (Repair of security -); Repair of security locks; Installation of wireless locks; Installation, changing, replacement and repair of locks; Installation of lock fittings; Lock repair services; Alarm, lock and safe installation, maintenance and repair; Installation of physical access control; Installation of access control systems; Maintenance and repair of physical access control; Installation of Access Control as a Service (ACaaS) hardware; Repair of ironmongery; Installation of door fittings; Installation of doors; Installation of safes; Installation of gates; Installation of bolts; Installation of door openers; Installation of security system; Installation of security systems.

Class 42

Access Control as a Service (ACaaS); Installation of Access Control as a Service (ACaaS) software; Monitoring of computer systems by remote access; Installation, repair and maintenance of computer software; Computer software integration; Computer systems integration services; Design and development of operating software for cloud computing networks; Development, updating and maintenance of software and database systems; Software as a service; Computer security system monitoring services; Design and development of electronic data security systems.

ANNEX 2

Class 9

Electronic self check-in counters; computer software; data processing programs and software; application software; insurance software; compiler software; scanning software; printing software; website development software; software and applications for mobile devices; downloadable cloud computing software; communications software, including communications software for connecting computer network users, for enabling the transmission of communications from mobile devices, enabling data exchange between airlines, airports and ground crews including via a shared platform, and to allow customers to access bank account information and perform banking transactions; search engine software; computer software for businesses; utility programs for managing computer files; computer software for controlling self-service terminals and self check-in counters; interface software; face [] recognition software; computer software for data processing, including searching, capturing, analyzing, storing, sharing, transferring and displaying data or complex data sets for optimizing business efficiency; computer software for importing, collecting, managing and centralizing data and data sets for calculating and distributing information concerning the availability, prices and tariffs in the transport, travel, hotels, restaurants, sports, cultural and entertainment sectors; computer software for booking and sale of tickets and seats in the transport, travel, hotels, restaurants, sports, cultural and entertainment sectors; computer software for managing all means of passenger transportation by air, land, water or rail, including multimodal and shared means, tour packages, travel arrangements, travel itineraries; computer software for managing cruises; computer software for providing geographical maps, information and recommendations on travel routes, travel and driving guidance, travel news, city directories and listings, travel guidebooks, shared and multimodal transport; computer software for managing travel agencies; computer software for travel expenses; computer software for hotel management and property management for use in the hotel industry, including computer software for scheduling and managing hotel rooms and functional spaces, for inventory and stock management, for coordinating reception

functions, for automating employees' tasks, for managing maintenance, for managing catering services, for housekeeping in rooms and for energy management; computer software for managing meetings and events in the hotel industry, including identifying suitable venues for meetings and events, establishing and controlling logistics for meetings and events, resource requirements, use of installations, availability, preparation of accounts and reports on events and cost tracking; computer software for use in the hotel industry to display the general design of hotels, temporary accommodation and meeting rooms and facilities; computer software for restaurant management, including computer software for inventory and stock management, for automating employees' tasks, for managing maintenance, for managing catering, and for managing parking facilities; computer software for use in automating and managing business processes; computer software for the management of airports, airlines and crews, airport and airline operations, aircraft maintenance planning and fuel management, for flight planning, programming, preparation, navigation, monitoring and analysis; computer software for flight management, for passenger, cargo and luggage tracking, for cargo and luggage handling; computer software for controlling check-in counters and for enabling passenger boarding, registration and check-in, including validation of passengers' check-in status and travel documents; computer software for issuing, redeeming and exchanging vouchers for providing targeted offers, vouchers, discounts, special promotions and promotional information and for customer relations management; computer software for advertising, marketing and content management, namely, for collecting, managing and publishing information in all forms or means; computer software for the management of human resources and personnel management, including placement planning, human resources allocation and use of personnel; computer software for payment services, including electronic payment processing and credit card services, for the safeguarding of financial transactions and the detection and management of fraud; computer software for accounting, financial management and invoice management; computer software for acquisitions management and analysis; computer software for managing security risks; computer software for revenue management, including for calculating, comparison, cost analysis and optimization, pricing, price comparison and sales

tracking; downloadable electronic publications, including publications in the field of computing, repair of computer systems, computer programming, in the transport, travel, hotels, restaurants, sports, cultural and entertainment sectors; downloadable electronic operation and user manuals; downloadable electronic instructional manuals for computer hardware and software; downloadable electronic instructional and teaching materials; downloadable electronic periodical publications, including newsletters and journals.

Class 35

Computerized business file management; compilation and systemization of data and information on computer databases; compilation of statistical information; updating and maintenance of data on an on-line computer database in the field of airline and travel booking, flight scheduling, departure control services, passenger check-in, ticket sales, pricing and invoicing; on-line marketing services, namely, providing links to third-party websites featuring goods and services relating to travel, transportation and tourism; direct electronic on-line marketing services, advertising and promotional services for hotels, airlines, cruise lines, car rental companies, train operators and service providers in the travel, transportation and hotel industries, for third parties; business management and administration, namely, providing on-line services for buyers and suppliers in the conference, events and hotel industries for the interactive planning of meetings and to book facilities via local, national and global computer networks; retail sale of computer software; business mediation in purchasing and sales, import and export, and wholesale and retail sale of software, software packages and Web applications;

Class 38

Providing access to computer networks and to computer databases, electronic and online; providing access to data, information and computer software on computer networks; telecommunications services relating to operations and processes for the airline, airports, tourism and travel industries; information and advice relating to the foregoing services.

Class 42

Engineering services for third parties, including software engineering; scientific and technological services, as well as research and design related thereto; design and development of computer hardware and software; consultancy services in computer software; computer engineering; programming, configuration, testing, repair, maintenance, customization, duplication, rental, research and computer software support; installation, testing, updating and duplication of computer software; technical consultancy and advisory services relating to computer hardware, software and peripherals; cloud computing network hosting; provision of information relating to the design and development of computer software, systems and networks; development and testing of computing methods, algorithms and software for processing telecommunication and navigation signals; computerized data storage services; hosting of servers; hosting of computer database; hosting of e-commerce platforms on the Internet; provision of search engines for the Internet; design, development, programming, rental and providing temporary use of on-line non-downloadable software for inventory management; design, development, programming, rental and providing temporary use of on-line non-downloadable communication software, computer search engine software and computer interface software; design, development, programming, rental and providing temporary use of on-line non-downloadable computer software for business purposes, for file management for face [] recognition, for processing, import, collection, management and consolidation of data and data sets, for bookings and sales of tickets and seats in the transportation, travel, hotels, restaurants, sports, cultural and entertainment sectors, for handling passenger transportation by all means of transport by air, land, water or rail, for making travel arrangements, for travel itineraries, for providing travel information for cruises, for managing travel agencies, travel expenses, for managing hotels and property in the hotel industry, for managing meetings and events in the hotel industry, for managing restaurants, for parking facility management, for managing airports, airlines and crews, for flight management, for passenger tracking, for monitoring and management of cargo and luggage, for advertising, marketing and content

management, for issuing, redemption and exchange of vouchers, for providing targeted offers, vouchers, discounts, special offers and promotional information, for managing customer relations, for managing human resources and personnel, for payment services, for safeguarding financial transactions, for managing fraud and for use in automating and managing business processes; hosting and maintenance of software online communicated by interface with a variety of distribution systems, travel organizers and property management systems enabling reservation and booking to be conducted in real time, room inventory management and collection and processing guest information, all in relation to the hotel industry; technical support services for computer software, including on-line support for troubleshooting computer software problems; design and development of electronic data security systems; consultancy and provision of information relating to the foregoing services.