BL O/0300/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3789040
BY DXS INTERNATIONAL PLC
TO REGISTER THE TRADE MARK:

Aios

IN CLASS 9

-AND-

THE OPPOSITION THERETO UNDER No. 437621
BY ATOS SE

Background and pleadings

1. On 17 May 2022, DXS International Plc (**"the Applicant"**) applied to register the word-only mark 'Aios' in the UK. The application was accepted and published for opposition purposes in the Trade Marks Journal on 19 August 2022. Registration is sought for the following goods in Class 9:[1]

> *Computer software relating to the medical field; Software as a medical device [SaMD], downloadable; Collaboration software platforms [software]; Workflow software; Publishing software; Software applications; Computer software; AI software; Communication software; Bioinformatics software; Artificial intelligence software; Content management software; Data management software; Health monitoring software; all the aforesaid relating to healthcare systems only.*

2. On 21 November 2022, ATOS SE (**"the Opponent"**) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (**"the Act"**).[2] The opposition is directed at all of the applied-for goods.

3. The Opponent relies on its UK trade mark registration for the word-only mark 'ATOS', trade mark registration number 3797071, which was filed on 9 June 2022 and became registered on 4 November 2022. It is registered in respect of goods and services in Classes 9, 35, 36, 38, 41, 42 and 45. However, in its Form TM7 statement of grounds (dated 21 November 2022) the Opponent stated that it was only relying on some of its Class 9 goods and some of its Class 42 services.

4. Notwithstanding the filing date of the Opponent's trade mark post-dates the filing date of the contested trade mark application, the Opponent's trade mark claimed a priority date of 31 March 2022 from its EU trade mark number 18680874 (**"the '874' registration"**).

[1] As amended in accordance with the Applicant's Form TM21B 'Change of details to an application', filed on 16 November 2022.

[2] 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.

5. On 1 February 2023 the Applicant filed a defence and counterstatement denying the claims made. In its counterstatement it contested the Opponent's priority claim on the basis of non-compliance with the first filing principle,[3] noting that the Opponent is also the proprietor of EU trade mark registration number 497016/ UK comparable trade mark registration number 900497016 (**"the '016' registration"**), which has a filing date of 26 March 1997 and is registered in respect of a variety of goods and services including goods in Class 9 and services in Class 42. The Applicant claimed that the '016' registration is the first Convention application in relation to the Opponent's Class 9 and 42 goods and services relied on and not the '874' registration from which it claims priority. Consequently, it submitted that the priority claimed under UK3797071 is invalid and the Opponent's rights run from the date of registration of the mark relied on, namely 9 June 2022 (meaning that the mark relied on could not be an earlier mark within the meaning of section 6 of the Act).

6. The Registry invited submissions from the parties on this issue. Applying the relevant law in relation to the 'first filing principle', the Registry concluded that the '016' registration covered Class 9 and Class 42 goods and services that were identical (including identical under the principles of *Meric*[4]) to the subsequent '874' registration, and that those 'identical' terms in turn encompassed all of the Class 9 goods relied on for the purposes of the opposition, as well as some of the Class 42 services relied on. As the '016' registration had not been withdrawn, abandoned or refused at the date of filing the subsequent '874' registration, the trade mark relied on as a basis for the opposition did not have a valid priority claim from the later '874' registration in relation to those specific 'identical' goods and services.

7. Consequently, on 12 July 2023, the Registry issued a preliminary view that a valid claim of priority only exists in relation to the revised list of Class 42 services set out

[3] i.e. in accordance with the Paris Convention for the Protection of Industrial Property 1883 (as revised or amended from time to time), and section 35 of the Act, any filing in a Convention country ('Convention country is defined in section 55 of the Act) which is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority and the priority period shall start from the date of filing of the first Convention application. The priority must be claimed six months from the date of filing of the first such application. A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall only be considered as the first Convention application (of which the filing date is the starting date of the period of priority), if at the time it was filed, the said previous application had been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it had not yet served as a basis for claiming a right of priority.

[4] *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05

below.[5] Neither party challenged the preliminary view and it was therefore subsequently confirmed. The Opponent accordingly amended its Form TM7,[6] removing the entirety of the list of Class 9 goods originally relied on, and included the revised list of Class 42 services relied on which claim a valid priority date of 31 March 2022 from its '874' registration:

> *Software as a service [SaaS]; platforms for artificial intelligence as Saas; computer platform as a service [PaaS]; platforms for artificial intelligence as Saas [Software as a Service]; software programming; providing cloud computing services; providing private, public or hybrid cloud services; providing computer programs for Artificial Intelligence; services for software as a service [SaaS] featuring software for automatic learning; services for software as a service [SaaS] featuring software for automatic teaching, profound learning and profound learning networks; providing artificial intelligence computer programs in data networks; Computer services concerning electronic data storage; user authentication services using single sign-on technology for online software applications; Cloud storage services for electronic data and files; cloud computing and artificial intelligence.*

8. The Class 42 services listed in my paragraph 7 above are therefore the services on which the Opponent relies for the purposes of this opposition. By virtue of the priority date, the trade mark upon which the Opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act in relation to those Class 42 services. As it had not been registered for more than five years at the filing date of the contested application, it is not subject to the use conditions set out in section 6A of the Act. As such, the Opponent may rely on all those Class 42 services without having to show any use at all.

9. In its revised pleadings the Opponent claims that the applied-for Class 9 goods are highly similar to the Class 42 services on which it relies, and that the Applicant's mark is similar to its mark thus giving rise to a likelihood of confusion. In addition, the Opponent claims that the distinctive character of its mark has been enhanced as a

[5] These services were not covered by the '016' registration, thus the '874' mark was the first Convention application in relation to the revised list and could serve as a basis for claiming a right of priority for those services.
[6] With the final version being filed on 25 August 2023.

result of the use made of it throughout the UK, and as a consequence the likelihood of confusion would be increased.

10. The Applicant was allowed time to file an amended defence and counterstatement to reflect the amended grounds claimed. The Applicant duly filed its amendments on 12 September 2023, although fundamentally it maintained its denial of the claims made. In its counterstatement it also put the Opponent to proof of its claim that the distinctiveness of the earlier mark has been enhanced, specifically it requested the Opponent prove that it has used the earlier mark in relation to all the Class 42 services relied on *"to a level sufficient to enhance the distinctive character of the mark ATOS, and increase the risk of confusion"*.

11. The Opponent subsequently filed evidence to support its claim of enhanced distinctiveness, although it elected not to file submissions during the evidence rounds to accompany the evidence filed. The Applicant elected not to file any evidence, and it also elected not to file submissions during the evidence rounds, therefore it did not comment on the Opponent's evidence during the evidence rounds of the proceedings. At the conclusion of the evidence rounds, neither party requested a hearing, rather, both parties filed concurrent written submissions in lieu of a hearing. This decision is therefore taken following a careful consideration of the papers before me.

12. In these proceedings the Opponent is represented by Marks & Clerk LLP and the Applicant is represented by Dolleymores.

EVIDENCE

13. The Opponent's evidence is provided in the Witness Statement of Yann Dietrich dated 9 January 2024, with fifteen exhibits, labelled YD1 to YD15. Mr Dietrich identifies himself as the Group Head of Intellectual Property at ATOS SE, a position he has held since May 2019.

14. As to the purpose of his evidence, Mr Dietrich states that:

> "27. All of the […] information and evidence demonstrates that Atos has built up a significant reputation in the UK in respect of its goods and services and that consumers have been educated to associate the Atos mark with their goods and services exclusively since the name was first used in 1997.

28. The evidence also serves as proof that the Applicant's goods including software applications, computer software, AI Software and data management software are similar to Atos' class 42 services."

15. The Opponent prepared the following index of the exhibits which provides a useful reference for the evidence materials filed – I note that Exhibit YD7 is a collection of eight separate video files comprising of little under 15 minutes of footage in total:

Exhibit No.	Content	No. of pages	Page Numbers
N/A	Witness Statement of Yann Dietrich	7	1-7
Exhibit YD1	Further information on Atos' operations and history	5	8-12
Exhibit YD2	Atos three pillars	6	13-18
Exhibit YD3	Examples of Atos' current range of products and services	9	19-27
Exhibit YD4	Financial reports of the Atos Group between 2018 and 2022	27	28-54
Exhibit YD5	Examples of invoices for the sale of services provided by Atos	26	55-80
Exhibit YD6	Marketing materials, opinion papers and podcasts	38	81-118
Exhibit YD7	USB Stick - Video advertisements	N/A	N/A
Exhibit YD8	Atos' Market Share	5	119-123
Exhibit YD9	Website extracts and web traffic	51	124-174
Exhibit YD10	Social media	4	175-178
Exhibit YD11	News articles	38	179-216
Exhibit YD12	Awards	9	217-225
Exhibit YD13	Events and conferences	15	226-240
Exhibit YD14	Partnerships	38	241-278
Exhibit YD15	UKIPO Decision – Classes 9 and 42	21	279-299
	TOTAL:	**299**	**299**

16. I have taken the Opponent's evidence into consideration and I shall refer to it in my decision to the extent that is necessary.

DECISION

Legislation and Case Law

17. Section 5(2)(b) the Act states:

"5(2) A trade mark shall not be registered if because-

[...]

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

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

18. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

19. In *Meric*, the General Court ("GC") held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa (this principle equally applies to services).

20. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:[7]

(1) the physical nature of the goods or acts of service;
(2) their intended purpose;
(3) their method of use / uses;
(4) who the users of the goods and services are;
(5) the trade channels through which the goods and services reach the market;

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

(6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

(7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);
or

(8) whether they are complementary to each other.

21. Complementary means *"there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking"*.[8] Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[9]

22. When interpreting the terms in a specification I bear in mind:

(1) that it is *"necessary to focus on the core of what is described* [... and that] *trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise",* although *"where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods* [and services] *in question"*;[10]

(2) where *"the words chosen may be vague or could refer to goods or services in numerous classes* [of the Nice classification system]*, the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services"*;[11]

(3) the following applicable principles of interpretation:

[8] *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82
[9] *Kurt Hesse v OHIM*, Case C-50/15 P
[10] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12
[11] *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

"(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."[12]

23. I also note that section 60A(1)(a) of the Act provides that goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification.

24. The goods and services to be compared are shown in the table below.

Opponent's Class 42 services	**Applicant's Class 9 goods**
Software as a service [SaaS]; platforms for artificial intelligence as Saas; computer platform as a service [PaaS]; platforms for artificial intelligence as Saas [Software as a Service]; software programming; providing cloud computing services; providing private, public or hybrid cloud services; providing computer programs for Artificial Intelligence; services for software as a service [SaaS] featuring software for automatic learning; services for software as a service [SaaS] featuring software for automatic teaching, profound learning and profound learning networks; providing	Computer software relating to the medical field; Software as a medical device [SaMD], downloadable; Collaboration software platforms [software]; Workflow software; Publishing software; Software applications; Computer software; AI software; Communication software; Bioinformatics software; Artificial intelligence software; Content management software; Data management software; Health monitoring software; all the aforesaid relating to healthcare systems only.

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

artificial intelligence computer programs in data networks; Computer services concerning electronic data storage; user authentication services using single sign-on technology for online software applications; Cloud storage services for electronic data and files; cloud computing and artificial intelligence.	

25. The Opponent's submissions on the comparison of the respective goods and services is that they are highly similar on the premise that there is significant overlap between them when applying the relevant assessment criteria; and on the basis that notwithstanding the Opponent provides various software services including 'software as a service' (software provided in non-downloadable form) and the Applicant provides software goods (in downloadable form), the respective goods and services should nonetheless be considered as being highly similar notwithstanding the limitation on the Applicant's goods because its services have no such limitation.

26. Although the Opponent's goods are not subject to any limitation, the Opponent has produced evidence that it provides its services to the medical sector in the UK, including the National Health Service (NHS). For example:

(1) Exhibit YD3 contains information about 'Atos' delivering technology enabled transformation of healthcare in England through the creation of an NHS Collaboration Platform – a digital platform of resources to transfer vital knowledge to healthcare providers, enabling them to give their staff the technology needed to improve outcomes for patients.[13]

(2) The Opponent's financial reports state that healthcare is one of the industries the UK segment of the 'Atos group' operates in.[14]

(3) In 2021 'Atos' was ranked third in the UK's top 10 list of software and IT services suppliers in the health subsector, which grew by 21% in 2021 to be worth

[13] Exhibit YD3, pages 26-27.
[14] Exhibit YD4, page 34.

£2.6bn.[15] In 2022 the Opponent was one of the top 5 providers of IT Services to the healthcare market in the UK, holding 5.1% of the market share.[16]

(4) In July 2023 the Opponent was awarded a 5-year contract by 'The Royal Marsden NHS Foundation Trust' (which delivers care to nearly 60,000 NHS and private patients every year) to modernise its communications infrastructure by installing new hybrid cloud-based technologies.[17] The Opponent's press release announcing the contract states that the deal underlines Atos' healthcare sector expertise and builds on its successful track record working with healthcare organisations to accelerate and secure their digital journeys, and that the work delivered under the new contract will help define the future digital ecosystem for NHS organisations and lead the way for technology innovation, including new working delivery practices for other NHS Trusts. Speaking about the contract, the Senior Vice President of 'Atos UK' is quoted saying it *"is a significant milestone in the work by Atos to drive innovation in healthcare"*.[18]

27. With regard to the Applicant's submissions, firstly I note that the Applicant contends that its software *"is for use in GP surgeries, hospitals and other care providing settings"* and that *"the purpose of the goods is so that the medical professionals working in surgeries, hospitals or other care facilities can optimise and standardise the clinical management of their patients"*.[19] However, the applied-for goods are not limited to their use in a particular setting and/or by a particular customer base (and it would be arbitrary and artificial to limit them in such a way anyway[20]). To clarify, the limitation is confined to "healthcare systems only" (a 'healthcare system' refers to organisations and institutions that deliver healthcare to people), not who is using those systems nor the setting in which they are being used and not the way in which they are being used either. Essentially the Applicant's submissions ignore notional and fair use of its specification and notwithstanding the limitation, the scope

[15] Exhibit YD5, page 76.
[16] Witness Statement of Yann Dietrich, paragraph 15 and accompanying Exhibit YD8.
[17] Whilst this evidence is dated after the filing date of the contested mark, I nonetheless consider it has relevance because the contract would have likely involved negotiation and planning before its announcement date in 2023, thus it would likely relate to negotiations conducted before the filing date.
[18] Exhibit YD11, pages 202 – 203.
[19] Applicant's submissions in lieu, dated 16 April 2024, paragraphs 27 and 28.
[20] See Quartz BL O/090/04 at paragraph 26.

of the applied-for services is much broader than the Applicant's submissions would lead me to consider.

28. Secondly, in its submissions in lieu, the Applicant notes that the Opponent considers that its services such as *"software as a service; software programming"* encompass all services within the healthcare field and that the Opponent therefore considers the respective goods and services to be similar on the basis that *"the Applicant is selling a finished product which can be downloaded into the healthcare providers existing computer system,* [whilst] *the Opponent can write and tailor a software, that provides the same function, for use by that consumer, the healthcare provider."*[21]

29. Even though the Applicant acknowledges that *"the goods covered by the Application and the services provided by the Opponent are similar in some respects, as ultimately they involve software,"*[22] it rejects that they are similar, submitting that *"it is still important to consider the trade channels through which these goods and services move and who the end consumer is"*[23] and that:[24]

> "From the evidence filed by the Opponent it can be seen that the Opponent provides consulting services and back-office support for their customers IT operations, processes and functions. From the evidence it is understood that the Opponent addresses a problem their customer has, or an outcome their customer wants to achieve and the Opponent then works with them to tailor a complete package, including back office support, to address the problem or achieve the result. The Applicant however delivers a software package under their mark."

30. The Applicant's submissions pigeon-hole the broad nature of the Opponent's services, and the Applicant is essentially arguing that the Opponent's evidence shows use in a certain way, thus that is the way their services should be interpreted. Again, I disagree with the Applicant's rationale, this is because the Applicant's submissions

[21] Applicant's submissions in lieu, paragraphs 29 and 30.
[22] Ibid., paragraph 31.
[23] Ibid.
[24] Ibid., paragraph 32.

ignore notional and fair use of the Opponent's specification, which requires a consideration of the full breadth of the specification.

31. In *Quartz* (a case involving 'software' goods),[25] an appeal was made to the Appointed Person by the trade mark applicant against the Hearing Officer's decision that the competing goods and services were similar. The applicant contended that the Hearing Officer had misunderstood the nature of its software. Central to the applicant's attack on the Hearing Officer's findings as to users and trade channels was that it contended it did not sell its products directly to the public and that its software was embedded within the products it sold. At [25] Professor Ruth Annand, sitting as the Appointed Person, noted that *"such arguments fail to take into account notional and fair use by the applicant within the terms of its specification"*. The applicant also disputed the Hearing Officer's findings as to complementarity because it contended the respective products had different functionalities and purposes. At [26] Prof. Annand noted that that criticism was linked to the limitation on the applicant's specification which she had already found to be of arbitrary effect (notwithstanding the fact that the limitation had been accepted by the Registry during ex officio examination). Ultimately, she found that the applicant's criticisms were unjustified.

32. Fundamentally, the assessment of likelihood of confusion requires a consideration of all the circumstances in which the mark applied for might be used if it were registered.[26] This requires me to make an assessment based on a notional and fair use of the terms in the competing specifications against the potential or intended uses of those goods and services, and not necessarily just the ones currently being used by either party in their trade. Nor is it a relevant consideration that, at present, the parties are trading in what the Applicant regards as discrete business sectors, instead I must consider notional use of the Applicant's mark at a level where direct competition between the parties could take place (i.e. hypothetically where the contested application is used in respect of applied for goods which are similar to the services which the earlier mark is registered for).

[25] BL O/090/04
[26] See *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66.

33. I now proceed with comparing the respective goods and services and for the purposes of making the comparison, I have grouped the goods and services together where the same reasoning applies.[27]

34. With regard to the limitation applied to the Applicant's specification, I can deal with this point rather swiftly. Whilst the Applicant's goods are all relating to *"healthcare systems only"*, the Opponent's services are not limited in such a way, therefore even if no evidence were provided showing provision of its services to the NHS for example, under the principles of fair and notional use, the Opponent's services could also relate to "healthcare systems". Ultimately the Applicant's limitation does not represent a point of distinction between the competing specifications. Therefore, I proceed with the comparison having taken this into account.

35. As to interpretation of the term 'software' (being a term which the competing specifications have in common), I note that 'software', whether it be downloadable or non-downloadable, is a collection of instructions, data, or computer programs that are used to operate computers and execute specific tasks i.e. it is a set of instructions or commands that tell a hardware device what to do.

"Software applications; Computer software; Computer software relating to the medical field; Collaboration software platforms [software]; Workflow software; Publishing software; Content management software; Communication software; Data management software; bioinformatics software; health monitoring software; software as a medical device [SaMD], downloadable."

36. The above applied-for goods are all downloadable software goods used to operate hardware devices enabling devices to perform specific tasks for the user. They range from being broad software goods which notionally enable a plethora of tasks relating to healthcare systems and the medical field (i.e. *"Software applications; Computer software; Computer software relating to the medical field"*), to software with specific tasks (relating to healthcare systems) which can, for example:

- enable the user to work collaboratively with their colleagues from any location (*"collaboration software platforms [software]"*);

[27] See *Separode Trade Mark* BL O/399/10, paragraph 5, with regard to grouping goods and services together.

- help manage and automate repetitive processes and tasks (*"workflow software"*);
- create layouts for publishing in either print or digital formats (*"publishing software"*);
- create, edit, and publish digital content (*"content management software"*);
- allow users to exchange files and text, audio, and video messages via the cloud or local network from various devices (*"communication software"*);
- control, store, organize, maintain, govern and analyse data (*"data management software"*);
- store and process biochemical information/data (*"bioinformatics software"*);
- enable the tracking, monitoring and management of health data of an individual (*"health monitoring software"*) as well as being able to monitor chronic conditions, and/or enable the user to analyse and process data for diagnostic purposes and provide treatment recommendations to patients (*"software as a medical device [SaMD], downloadable"*).[28]

37. The Opponent's specification contains the broad term *"software as a service [SaaS]"*. This is a cloud-based software delivery model. It relates to the provision of non-downloadable software that is hosted on the cloud and used over an internet connection. The software accessible via this cloud-based system could therefore notionally encompass software which could perform all the specific tasks listed above. The only real difference is the delivery system of that software – the one is downloadable for the purchaser to own and the other is non-downloadable where use of the software is usually dependent on the payment of a subscription to the software provider i.e. the consumer essentially rents the software instead of buying it. Therefore, the cloud-based model would typically grant the user access to the software through an account rather than them having to install the software on their individual hardware devices. The 'SaaS' provider is responsible for operating and maintaining the software whereas the purchaser of the downloadable software is typically responsible for its maintenance.

[28] SaMD being downloadable software with a medical purpose for use with a general purpose computing platform (such as PCs, smartphones, tablets etc.) i.e. it is not software already part of an actual hardware medical device.

38. Bearing in mind the foregoing interpretations and having regard to the principles of notional and fair use, I consider the Opponent's *"software as a service [SaaS]"* overlaps in purpose and use with the Applicant's goods listed under the above heading. They may also share the same user and share the same trade channels. There may also be a degree of competition between them since a consumer may choose a cloud-based subscription service instead of purchasing software to download onto their hardware devices which they are then responsible for maintaining. I find the respective goods and services to be similar to a high degree.

"AI software; Artificial intelligence software."[29]

39. The Opponent's specification contains the following services related to the provision of artificial intelligence as 'software as a service':

> *"platforms for artificial intelligence as Saas; platforms for artificial intelligence as Saas [Software as a Service]"*

40. To the extent that the Opponent's services provide AI platforms as 'SaaS', I consider them to be similar to the Applicant's AI software. This is because they may overlap in purpose and use; they may also share the same user and share the same trade channels. There may also be a degree of competition between them since a consumer may choose a cloud-based platform for AI software instead of purchasing the software to download. I find the respective goods and services to be similar to a high degree.

The average consumer and the nature of the purchasing act

41. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the services in question. It is therefore necessary to determine who the average consumer of the respective services is, and how the consumer is likely to select them.

42. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word "average" merely denotes that the person is

[29] 'AI' stands for 'Artificial Intelligence'.

typical,[30] which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.[31]

43. The Opponent's services at play have a wide scope of average consumer, for example, a consumer of 'SaaS' could be a business or other form of organisation/undertaking, such as a medical practice, wanting a cloud-based software for health monitoring of patients, or they could simply need communications software for their medical practice in order to place voice and video calls. The average consumer of the Opponent's services could also be a member of the general public who is a home PC user wanting cloud-based software for word processing for example. Although the Applicant's goods are limited to 'healthcare systems', the goods are not all necessarily highly specialist because of that and could therefore simply encompass communications software a medical practice could use to place voice and video calls.

44. Bearing in mind the sector in which both parties' goods and services would notionally intersect i.e. a healthcare system, the average consumer is more likely be professional users although I cannot discount that members of the public using a healthcare system may access software made available to them by their healthcare provider, for example 'health monitoring software' (be it downloadable or available through an online portal) to perhaps track their heart rate, insulin levels etc.

45. Whilst in general terms the average consumer's level of attention is likely to vary according to the category of goods and services in question,[32] such that the average consumer can be deemed to demonstrate a low degree of attention when selecting certain categories of goods and services for instance, given the nature of the goods and services at hand, I do not consider any of them fall into that 'low level of attention' category.

46. Rather, the relevant average consumer (whether they are members of the general public, a professional, or a business, organisation/undertaking) is at the very least, likely to pay a medium level of attention when selecting some of the respective goods

[30] *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), paragraph 60
[31] *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98
[32] *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV*, Case C-342/97

and services. Where the goods and services are of a specialised nature, then the level of attention paid by the relevant average consumer is only likely to increase, such that the level of attention paid would be high – this is true whether the consumer of those goods and services is a member of the general public or a business/ professional user.

47. I consider the goods and services will be predominantly selected visually following perusal of brochures and websites for example, whereby the consumer will be presented with an image of the respective marks. I do not completely rule out an aural selection although given the nature of the goods and services it is unlikely that the relevant consumer would select them orally. Even if an order were made orally, the consumer is still likely to have viewed the marks first before placing their order.

Comparison of marks

48. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM*,[33] 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."

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

50. The marks being compared are shown below:

Earlier mark	Contested mark
ATOS	Aios

[33] Case C-591/12P, at paragraph 34.

Overall impression

51. Both are word-only marks, therefore, the overall impression of the marks rest solely in those words.

Visual comparison

52. Although 'ATOS' is presented in capital letters, whereas only the 'A' in 'Aios' is capitalised, this does not provide a point of visual distinction between the two, this is because a word mark protects the word itself and therefore its protection is not limited by any features such as capitalisation or the typeface which appears on the Register.[34]

53. The competing marks are both comprised of only four letters. They share the identical first letter 'A' and the identical third and fourth letters, 'OS'. They only differ in relation to the second letter, being 'T' in the one and 'i' in the other.

54. I consider the marks to be visually similar to a high degree on the basis of the identical first letter 'A' and the identical 'OS' ending. This visually similarity is further reinforced by the fact that the letters 'T' and 'I' or 't' and 'i' are visually similar as they are similar in their anatomies, this is because both are inherently comprised of a single, tall vertical stem (it is not like comparing the letters 't' and 'x' for instance which have completely disparate anatomies).

Aural comparison

55. Both marks are seemingly invented words (there being nothing to suggest to the contrary – and I note that the parties are in agreement that they are invented words), therefore they have no standard prescribed pronunciation and I therefore take into account what the likely pronunciation of the words could be.[35] I consider the marks could consequently be pronounced in a number of ways. For example: the 'A' could have a short or elongated sound (i.e. short like the 'A' in 'cat'; or elongated like the 'A' in 'cake'), but whichever way the 'A' is pronounced, it would be identical for both; the

[34] See the comments of Iain Purvis KC, sitting as the Appointed Person in the following two cases: *Groupement Des Cartes Bancaires v China Construction Bank Corporation,* Case BL O/281/14, paragraph 21; and *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22, paragraph 37.

[35] In its submissions in lieu the Applicant referred with agreement to the decision of *Kaul v OHIM,* Case T-402/07, at [81], in which the CFI stated to the effect that the Court *"cannot be criticised"* for basing its decision on the 'likely' pronunciations of an invented word, because an invented word does not correspond to any existing word in a given language.

'OS' combination of letters in both marks would likely be pronounced as 'OSS' (with a short 'O' like the 'O' in 'toss'), but whichever way the two letter combination is pronounced, it would be identical for both. Therefore they could be pronounced as 'AH-TOSS' and 'AH-YOSS' (with a short 'A') or 'AY-TOSS' and 'AY-OSS' (with an elongated 'A') for example.

56. Notwithstanding the presence of the sound provided by the letter 'T' and the letter 'I', I consider the marks to be aurally similar to a high degree overall, this is because those letters would not alter the way the letter 'A' nor the 'OS' sequence are pronounced.

Conceptual comparison

57. As to conceptual similarity, both marks are invented words and therefore they are conceptually neutral. The parties are in agreement that they are conceptually neutral.

Distinctive character of the earlier trade mark

58. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion.[36]

59. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

60. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,[37] the CJEU stated that (my emphasis):

> "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

[36] *Sabel v Puma*.
[37] Case C-342/97.

(see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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)."

61. Absent any evidence to the contrary, and as I have already found when dealing with the comparison of the marks, 'ATOS' is an invented word and as such it makes no descriptive or allusive reference to the relevant services. I therefore find that the earlier mark is inherently distinctive to a high degree.

62. The inherent distinctive character of a mark can be enhanced by virtue of the use that has been made of it and the Opponent has made a claim to that effect. The Applicant has put the Opponent to proof of its claim and therefore I make an assessment on enhancement of distinctiveness even though I already consider the inherent distinctiveness to be high.

63. From the outset I note that the evidence shows use of the mark either in plain text or as follows:

Use in the above stylised form does not alter the distinctive character of the earlier mark given that the word ATOS is readily identifiable, therefore it is considered to be use of the mark as registered.[38]

[38] *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22.

64. I note the following from the Opponent's evidence:

(1) By way of background, Mr Dietrich (the Opponent's witness), states that the Opponent is a global leader in digital transformation with over 105,000 employees and an annual revenue of 11 billion Euros. He states that the company is a *"European leader in cloud, digital workplace and high-performance computing and cybersecurity and provides tailored end-to-end solutions across a variety of industries in over 69 countries"*.[39]

(2) The Opponent was incorporated in 1997 and according to Mr Dietrich's narrative evidence, the Opponent has made continuous use of the ATOS name since the company's incorporation, in respect of *"software and platform solutions, software programming, consulting and systems integration services, production of high-performance computers and servers, cloud and cybersecurity services."*[40]

(3) In 2021 the Opponent was ranked number one worldwide in terms of revenue in relation the provision of digital security services to protect against sophisticated cyber threats (moving up a place from its second spot ranking in 2020).[41]

(4) 'Atos IT Services Limited' is the UK division of the Opponent's group who use the 'ATOS' mark under licence, providing a range of products and services including *inter alia*,[42] cloud hosting; a web console for developers to manage projects and deploy their applications;[43] secure digital cloud-based workplace platforms, providing a single point of access for employees to data and applications – enabling users to work from any device;[44] and assisting the NHS to deliver technology enabled transformation of healthcare systems.[45]

[39] This background information is largely transcribed from Exhibit YD1 which consists of website screenshots containing company profile information for the Opponent, all dated 20 December 2023.
[40] Witness Statement of Yann Dietrich, dated 9 January 2024, paragraph 2.
[41] See the press release dated 21 April 2022, pages 14-15 of Exhibit YD2.
[42] Witness Statement of Yann Dietrich, paragraph 5 and accompanying Exhibit YD3.
[43] Exhibit YD3, pages 21-25 – obtained from the UK Government website 'gov.uk'.
[44] Exhibit YD3, page 20.
[45] Ibid., pages 26-27.

(5) The Opponent's financial reports show that the 'Atos Group' had an annual revenue of circa 11 billion Euros in 2022.[46]

(6) The group's revenue is derived from its contracts for 'Infrastructure & Data Management', 'Application Management contracts included in Business & Platform Solutions, and 'Big Data & Cybersecurity'.[47] The UK segment of the group operates in the following industries: *"Manufacturing, Financial Services & Insurance, Public Sector & Defense, Telecom, Media & Technology, Resources & Services, in addition to Healthcare & Life Sciences."*[48]

(7) News articles are provided detailing contracts 'Atos' has won in both the public and private sectors to deliver various technology and digital transformation solutions (to help support migrations to cloud technologies for example) – the UK-based contracts mentioned are with HM Revenue and Customs, Northumbrian Water, Network Rail, Coventry Building Society and British Telecommunications (BT).[49] In 2022 it extended its long-standing relationship with BT (UK's leading provider of fixed and mobile telecommunications) until 2026.[50]

(8) Revenue *"for the Atos brand"* in the UK and ROI was in excess of 1.6 billion Euros in 2018 and 2019.[51] The financial reporting states that Europe and North America generated 93% of the Atos Group's total revenue in 2018 and 2019, with the UK and ROI representing 13% in 2018 and 14% in 2019 of the total global revenue.[52] The UK and ROI revenue was in excess of 2.7 billion Euros in 2020, in excess of 2.6 billion Euros in 2021 and in excess of 3.1 billion Euros in 2022.[53]

(9) A series of 12 redacted invoices dated from 2019 to 2021 and issued by Atos IT Services UK Limited are provided.[54] The invoices are issued to the following UK companies/ organisations: BBC; Network Rail; RS Components; and

[46] See the financial reports included in Exhibit YD4, page 54.
[47] Ibid., page 30.
[48] Ibid., page 34.
[49] Exhibit YD11.
[50] Exhibit YD11, pages 185 – 186.
[51] See Exhibit YD4 and Mr Dietrich's Witness Statement paragraph 7.
[52] Exhibit YD4 pages 30 and 33.
[53] See Exhibit YD4 and Mr Dietrich's Witness Statement paragraph 7.
[54] Exhibit YD5.

Aviva. Mr Dietrich's narrative evidence states that they are for the provision of *"software programming, consulting and integration services, and cloud computing services and hybrid cloud services".*[55] The total net value of the 12 invoices is in excess of 15 million GBP.

(10) Mr Dietrich states that *"As well as services provided within the Private Sector, Atos has supplied software programming, cloud computing services and hybrid cloud services to UK Governmental agencies including NHS England and NHS Scotland. Please find example invoices at Exhibit YD5."*[56] I note that no such invoices are provided in the evidence bundle.[57] That said, Exhibit YD5 includes details of the Opponent's revenue derived from the UK public sector, for example:

(a) 'Atos' earned £700 million in revenue from the public sector in the UK in 2014;[58]

(b) In 2021 'Atos' was ranked one of the UK's top three public sector software and IT services ('SITS') suppliers and retained its position as the lead SITS supplier to Central Government, having achieved growth of 3.9% in 2021; and 'Atos' was also ranked third in the Top 10 list of SITS suppliers in the health subsector, which grew by 21% in 2021 to be worth £2.6bn.[59]

(c) In 2012 'The Guardian' newspaper reported that 'Atos' sponsored the 2012 London Paralympic Games in a bid to help showcase *"its technology and project management capabilities"* – and that the revenue generated through the Olympic games was estimated to be £200 million; 'The Guardian' also reported that at that time 'Atos' held more than £3 billion worth of government contracts in the public sector through government

[55] Witness Statement of Yann Dietrich, paragraph 8.
[56] Ibid., paragraph 9.
[57] The pagination of Exhibit YD5 runs consecutively and there are no missing page numbers. This leads me to conclude that the public sector invoices were never included in the evidence bundle filed.
[58] Exhibit YD5, pages 77-79 - being a report published by the UK Government's 'House of Commons Committee of Public Accounts' in relation to 'Contracting out public services to the private sector' and the 'role of major contractors in the delivery of public services'.
[59] Exhibit YD5, page 76.

outsourcing initiatives, including contracts for medical assessments for benefit claims on behalf of the government.[60]

(11) Mr Dietrich states that 'Atos' is a member of a variety of UK trade associations and industry bodies and is an active voice in these networks, advocating for digital transformation as a driver of better, more streamlined services to businesses and the public sector, and as a part of this it has produced a number of opinion papers to advertise its knowledge and services in the fields of cyber security, cloud computing as well as data storage software and services.[61] Mr Dietrich also states that the Opponent advertises its expertise and services through podcasts on a range of topics including artificial intelligence, cloud, data and cyber security.[62]

(12) From 2018 to 2022, marketing expenditure for the 'ATOS' brand in the UK and ROI was in excess of 1 million GBP year on year.[63] Mr Dietrich states that *"Atos* […] *won various awards in* [2023] *for their activities in the UK. Including* [4 marketing awards] *in respect of the Healthcare Futures* [marketing] *campaign shown within Exhibit YD6"*.[64]

(13) Examples of marketing materials are included in Exhibits YD6 and YD7. Included in Exhibit YD6 are details about the Opponent's partnership with Google Cloud to *"accelerate the UK's digital journey"* with the objective of enabling fast and smooth adoption of artificial intelligence by organisations.[65] In 2018, as part of its partnership with Google Cloud, the 'London AI Innovation Lab' was launched (a move backed by UK ministers), to bring together experts in artificial intelligence and was made available to public and private sector organisations.[66]

[60] Ibid., page 80. Mr Dietrich also makes reference to the Opponent's Olympic Games sponsorship in paragraph 24 of his witness statement and makes reference to accompanying Exhibits YD7 and YD14.
[61] Witness Statement of Yann Dietrich, paragraph 12; and Exhibit YD6.
[62] Witness Statement of Yann Dietrich, paragraph 13 and accompanying Exhibit YD6.
[63] Witness Statement of Yann Dietrich, paragraph 10.
[64] Witness Statement of Yann Dietrich, paragraph 20.
[65] Exhibit YD6, page 104.
[66] Witness Statement of Yann Dietrich, paragraph 25 and accompanying Exhibit YD6, page 104; Exhibit YD11, page 180; and Exhibit YD14.

(14) With regard to market share, Mr Dietrich provides 'IT Services Market Share' data and states:

"14. Please find at Exhibit YD8 Atos' UK market share in the Application and Infrastructure Implementation and Managed Service markets within the United Kingdom for 2021 and 2022. For 2022 Atos held a 3.1% of the UK market share. The source of the data is the most recent global Gartner market share report issued in 2023.

15. Applying a filter to this data within the Healthcare Vertical Market, the results shows that Atos have a 5.1% market share and are one of the top 5 providers in the UK."

(15) The Opponent's evidence of online presence relates to use of its mark on its UK website (which had in excess of 300 thousand page views between 2016 and 2022); as well as accounts on the online platforms of 'YouTube', 'X' (formerly 'Twitter') and 'Instagram' – with a combined total of subscribers/ followers in excess of 55 thousand.[67]

(16) The 'Atos Group' gained the following recognitions in 2022:[68]

65. I note that the Applicant makes no submissions on the Opponent's evidence, rather, it confines its commentary to a single submission in its submissions in lieu that it *"disagrees"* with the Opponent's *"opinion"* that the 'ATOS' mark is distinctive in its

[67] Witness Statement of Yann Dietrich, paragraphs 16 – 18 and accompanying Exhibits YD9 and YD10.
[68] Exhibit YD4, page 49.

own right, and that its distinctiveness has been enhanced through use.[69] Contradictorily it makes this submission after having submitted that the earlier mark is an invented word.[70]

66. I consider the evidence presented to be sufficient to enhance the distinctive character of the earlier mark. Although the distinctive character of the earlier mark is already inherently high, the enhancement of its distinctiveness can only mean that any likelihood of confusion would be enhanced as a result and therefore it has been enhanced to the highest degree.

Conclusions on likelihood of confusion

67. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.[71] I must also consider the average consumer of the goods and services, the nature of the selection process and bear in mind that 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.[72]

68. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.[73] The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.[74]

69. Confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are

[69] Applicant's submissions in lieu, paragraph 45.
[70] Applicant's submissions in lieu, paragraph 14.
[71] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27
[72] *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17
[73] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81
[74] See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark.[75]

70. Before I move on to summarising my findings, I note that in its submissions in lieu the Applicant references a case of the GC, Case T-394/10 *Elena Grebenshikova v OHIM* ("the *'SOLVO'* case"). This case was not cited in its counterstatement and as the Applicant reserved any subsequent submissions to its submissions in lieu of a hearing, the Opponent did not have an opportunity to respond to this citation and accompanying submissions. The Applicant submits that:

> "43. The Average Consumer will be purchasing the Applicant's software or employing the Opponent's services, to address the business needs that they have. Great care and consideration will be taken when purchasing the goods or employing the services, as the decision ultimately will have an impact on their own business activities.
>
> 44. The expense involved in respect of the purchasing of the Applicant's goods or employing the Opponent's services is likely to be considerable and also is highly likely to involve the parties involved entering into a contractual arrangement. Neither the purchase of the Applicant's goods nor the employment of the Opponent's services will be rushed into. This point was referred to by the General Court, in the Case T-394/10 *Elena Grebenshikova v OHIM* . […]"

71. The Applicant's submissions in lieu then transcribe paragraphs 31 to 32 and 34 to 39 of *'SOLVO'*. However, the part of the decision where the 'expense' of the goods is mentioned is in relation to another case i.e. *'POLARIS'*.[76] It is important that these passages quoted from *'SOLVO'* are not read out of context. Whilst the GC in *'SOLVO'* noted *POLARIS,* it did so in reference to OHIM's argument that the goods in *'SOLVO'* would be selected **orally** during pre-negotiation discussions with the software provider.

[75] See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion

[76] Case T-79/07 *SHS Polar Sistemas Informáticos* v *OHIM – Polaris Software Lab (POLARIS)*

72. The GC decision in *'SOLVO'* involved a trade mark application for the following figurative mark in relation to logistics computer programs:

and an opposition thereto relying on the earlier mark 'VOLVO' registered for, inter alia, computer software.

73. The Board of Appeal agreed with the Opposition Division's decision that a likelihood of confusion existed. The nub of the appeal before the GC focused on the assessment of the marks and the selection process of the goods. OHIM had argued that the goods would likely be selected orally and that the visual dissimilarities between the signs at issue could not outweigh their phonetic similarities and therefore there was a likelihood of confusion. Having regard to *POLARIS* (which involved extremely specialised software that would be developed after many years of collaboration with the end consumer and aural considerations factored into the selection process), OHIM submitted that the trade mark at issue is likely to be referred to orally before the decision to purchase is taken.

74. The GC agreed with the Board of Appeal that the respective goods were identical, it agreed that the average consumer would be particularly attentive, and that the earlier mark had a high level of distinctiveness. However, contrary to what the Board of Appeal found, the GC considered that even if the initial information regarding the software is received orally during the negotiation discussions with the software provider, the selection process would ultimately be made visually as opposed to orally.

75. The GC concluded that as the visual dissimilarities between the figurative 'SOLVO' mark and 'VOLVO' outweighed their phonetic similarities, the Board of Appeal erred in finding that there was a likelihood of confusion, because the average consumer of the goods would not be confused between the marks when visually selecting the goods.

76. Whilst some of the findings in 'SOLVO' obviously echo the findings I have made in this instant case, fundamentally the assessment of the similarity of the marks is different and therefore 'SOLVO' is not on all fours with this present case, especially as I have found that the marks are visually highly similar.

77. I now move on to assessing my earlier findings. I have found that the applied-for goods are similar to the Opponent's services to a high degree and that the goods and services will predominantly be selected visually (although I have not discounted that there may be an aural element to the selection process). The average consumer will (depending on the specialist nature of the goods and services) be paying either a medium or high degree of attention when selecting the goods and services. Even where the average consumer is paying a high degree of attention, I cannot ignore the principle of imperfect recollection among that category of consumer – as they are, after all, still the **average** consumer of those goods and services i.e. they are not the top performers in the demonstration of being well informed, observant and circumspect.

78. With regard to the marks, they are both four letter words, sharing the identical first letter and sharing the identical two letter ending. The differentiating element is the second letter being 'T' in one and 'i' in the other. I have found that visually the letters 'T' and 'i' have similar anatomies and that the pronunciation of those letters does not significantly alter the way the marks sound. Therefore, whilst I bear in mind that where signs are shorter in length, differences can be more noticeable, the generally accepted rule of thumb derived from the GC in *El Corte Inglés,*[77] is that the first part of a word mark is the part which is likely to retain the consumer's attention. I also note that in *El Corte Inglés,* the GC held to the effect that the identity at the beginning can be reinforced by the presence of identical endings.[78] Moreover, the fact that marks share the same length can make an important contribution to the analysis of visual similarity. For example, the GC found significant visual similarity between 'OLTEN' and 'OFTEN' relying in part on their shared length for making such a finding.[79] Consequently, notwithstanding the difference owing to the second letter, I have found that the marks are visually and aurally similar to a high degree overall.

79. Although I have found the marks to be conceptually neutral, this finding does not neutralise the visual and aural similarities between the marks, especially when taking into account that I have found that the selection process of the goods and services is predominantly visual and may also have an aural element.

[77] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.
[78] *El Corte Inglés*, [81] to [83].
[79] *Inditex v OHIM*, Case T-292/08, paragraphs 76 and 78.

80. I have found that the earlier mark is inherently distinctive to a high degree and that the evidence sufficiently shows enhancement of the distinctive character of the mark to the highest degree, which is a factor that contributes to the greater possibility of a finding of likelihood of confusion.

81. Taking all the above factors into consideration, and allowing for imperfect recollection, whilst bearing in mind the principle of interdependency, I find that the average consumer, or at least a significant proportion thereof, who is presented with visually and aurally highly similar marks (where the earlier mark is highly distinctive) on highly similar goods and services, will likely mistake one mark for the other and be directly confused as to the origin of those goods and services.

OUTCOME

82. The opposition under section 5(2)(b) of the Act is successful in its entirety. Subject to any successful appeal, contested trade mark application number 3789040 shall be refused registration.

COSTS

83. The Opponent has been successful and is entitled to a contribution towards its costs based on the standard scale set out in Tribunal Practice Notice 2/2016. However, in light of the procedural issues with regard to the inaccurate priority claim, I consider it appropriate to adjust the costs award to a degree to recognise the Applicant's need to address this issue. I therefore award the Opponent the sum of **£1,300**. The sum is calculated as follows:

Official fee for filing Form TM7	£100
Preparation of the statement of grounds and considering the other side's counterstatement[80]	£200
Preparing evidence	£700
Preparing submissions in lieu of a hearing	£300
TOTAL	**£1,300**

[80] An 'on scale' award for the preparation of a statement of grounds and considering the other side's counterstatement starts from £200 according to TPN 2/2016. I would have awarded £300 without the adjustment.

84. I therefore order DXS International Plc to pay ATOS SE the sum of **£1,300**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 31st day of March 2025

Daniela Ferrari

For the Registrar