BL O/0473/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3924244
BY WEB3 LABS LTD

TO REGISTER THE TRADE MARK:

CHAINLENS

IN CLASSES 9, 36 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 443507
BY SMARTCONTRACT CHAINLINK LIMITED SEZC

BACKGROUND AND PLEADINGS

1. On 19 June 2023, Web3 Labs Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision ("the contested mark") in the UK. The application was published for opposition purposes on 7 July 2023, in respect of goods and services in Classes 9, 36 and 42.[1]

2. On 9 October 2023, the application was opposed by SmartContract Chainlink Limited SEZC ("the opponent") based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act").[2] The opposition is directed against all the goods and services in the application. The opponent relies upon the following UK trade mark ("UKTM"):

UKTM no. 3735058 ("the earlier mark")
Filing date: 20 December 2021;
Priority date: 24 June 2021;[3]
Registration date: 25 March 2022;
Relying upon all the services in Class 42 for which the mark is registered.[4]

3. The opponent claims that the parties' marks are visually, aurally, and conceptually similar on the basis that the dominant word in the earlier mark only differentiates from the applicant's mark by two letters; and that the respective goods and services are highly similar in Class 42, and at least complementary in Classes 9 and 36, resulting in a likelihood of confusion and association on the part of the public.

4. The applicant filed a counterstatement denying the grounds of opposition.

[1] See Annex
[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. See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.
[3] UNITED STATES OF AMERICA (US) 90793516.
[4] See goods and services comparison.

5. The opponent's mark qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested marks, it is not subject to the use provisions contained in section 6A of the Act. Consequently, the opponent may rely upon all of the services for which the earlier mark is registered without having to establish genuine use.

6. On 7 June 2024, the applicant filed a TM21B requesting a limitation to all the goods and services claimed in the application.[5] On 24 June 2024, having reviewed the limitation the opponent confirmed its intention to continue with the opposition.

7. Both parties filed evidence and both parties chose to file written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them below as necessary.

8. The opponent is represented by Withers & Rogers LLP, and the applicant is represented by Panoramix Limited.

EVIDENCE AND SUBMISSIONS

9. The opponent's representative, Mark James Caddle, a Chartered Trade Mark Attorney and Partner of Withers & Rogers LLP, filed evidence on behalf of the opponent in the form of a witness statement, dated 2 May 2024, together with exhibits MJC01 to MJC10. The purpose of the evidence is to demonstrate that the earlier mark has acquired an enhanced degree of distinctiveness as a result of its extensive use in relation to all the services relied upon in Class 42.

10. The applicant's evidence came in the form of the witness statement of Conor Svensson, dated 7 June 2024, along with exhibits CS1 to CS7. Mr Svensson is the owner and director of the applicant, a position held since the company's incorporation on 23 May 2017.

[5] See goods and services comparison.

11. The applicant's evidence contains:

- examples of uses of the term "chain", "on-chain" and "off-chain/offchain" by the blockchain industry and blockchain media outlets;[6]

- extracts from the UK Register showing examples of multiple registered marks containing the string "Chain" for products and services relating to blockchain technology along with the accompanying respective 'Google' search results for each registered mark, showing that they are in use in business in the UK;[7]

- Whitepapers originating from the opponent showing multiple uses of the terms "chain", "off-chain" and "on-chain" to refer to the blockchain;[8]

- dictionary definitions of the words "link", "bridge", "connect", "node", "integrate" and "lens";[9] and Companies House incorporation documents for the applicant.[10]

12. The applicant's evidence appears to have been adduced in order to, *inter alia*, demonstrate the coexistence of similar marks and similar themed marks in the relevant marketplace, and to show that the word 'chain' is commonly used in relation to the goods and services at issue, both on the register and in the marketplace.

13. In response to the applicant's evidence Mr Caddle filed further evidence on behalf of the opponent in the form of a witness statement, dated 2 August 2024, along with exhibits MJC14 to MJC20. The additional evidence has been filed, to demonstrate, *inter alia*, use of the earlier mark in the UK[11] and to show that the 'lens' element of the applicant's mark is used within the 'blockchain' sphere in the UK.[12]

14. On 12 September 2024 the applicant filed written submissions in lieu of a hearing. The opponent filed written submissions in lieu of a hearing on 16 September 2024.

[6] Exhibit CS1
[7] Exhibit CS2(1)-(24)
[8] Exhibit CS3
[9] Exhibits CS4, CS5(1)-(4) and CS6
[10] Exhibit CS7
[11] Exhibit MJC14-MJC19
[12] Exhibit MJC19-MJC20

15. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

PRELIMINARY ISSUES

16. The applicant has raised points in its submissions,[13] that I intend to address as preliminary issues. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, the points raised will have no bearing on the outcome of this opposition.

State of the register

17. The evidence filed on behalf of the applicant includes a reasonable number of screenshots of trade marks in various classes including Classes 9, 36 and 42 which feature the word 'CHAIN' for products and services relating to, amongst other things, blockchain technology. This information was retrieved by the applicant following a search on the United Kingdom Intellectual Property Office register. In addition, the applicant also included Google search results for each of the registered marks showing use of the marks in the UK.[14]

18. I deduce that the main purpose of this evidence is to try and demonstrate that the 'CHAIN' element of the opponent's mark is of low/weak distinctiveness due to the existence of other marks on the register and in the marketplace made up of, or incorporating the word; to demonstrate the relevant consumer's knowledge of the relevant marketplace; and to show the successful coexistence of often closely similar marks in the relevant marketplace. However, with regards to the level of distinctiveness of the earlier mark, by virtue of the fact that the mark is registered means that it is assumed that it has at least some distinctive character.[15]

[13] Submissions in lieu, filed on 12 September 2024.
[14] Exhibit CS2(1)-(24)
[15] *Formula One Licensing BV v OHIM*, Case C-196/11P

19. Furthermore, it is important to recall that the state of the register is not evidence of how many of such trade marks are effectively used in the market, nor does it establish that the distinctive character of the elements in question has been weakened because of their frequent use in the field concerned.

20. In considering this issue further, I refer to the case of *Zero Industry Srl v OHIM*, Case T-400/06, wherein the General Court ("GC") stated that:

> "73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71)."

Previous UK IPO opposition and appeal decisions

21. In its written submissions,[16] the applicant states:

> "I refer to the decision of the UK IPO in Case number O/0823/23 and the appeal thereto in Case no. BL O/0293/24. These cases concerned the same Opponent as in the current proceedings, SmartContract Chainlink Limited, which based its opposition on its registered trade marks for "CHAINLINK" (UK trade mark no. UK00801398642) and "CHAINLINK LABS" in Classes 9 & 42 for the same

[16] Written submissions in lieu, filed on 12 September 2024.

goods and services. The opposition was directed against UK applications for the mark “LINK” and “LINK (stylised)” in Class 42 […].

[…]

The appeal supported and upheld the Hearing Officer’s decision in full.

Since they deal with the Opponent’s word mark “CHAINLINK” that contains identical wording as the word element of its logo mark no. UK00003735058, and a similarly structured application mark that consists of one element of the Opponent’s mark, “LINK”; these decisions are highly analogous to the current case.”

22. Whilst the above cited cases are noted, they relate to proceedings where the present opponent opposed the marks “LINK” and “LINK” (stylised), which clearly differ from the contested mark in the current proceedings. These previous decisions were based on their specific facts and as such, cannot bind me in any way in evaluating the likelihood of confusion in this case where the contested mark is different. Furthermore, it is well established that previous decisions, are not binding on the Registrar. Therefore, the decision I make in these proceedings must be stringent and must not consist of the mere repetition of comparable decisions. Accordingly, the previous opposition and appeal decisions referred to are not relevant to these proceedings, and their existence will have no bearing on whether, in this instance, there is a likelihood of confusion, or not, between the contested mark and the earlier mark.

The opponent’s evidence is not sufficient to show genuine use of its mark in the UK

23. In its submissions[17] the applicant states that the evidence of purported use provided by the opponent is not sufficient to show *genuine use* of their mark in the UK. However, the earlier mark is not subject to the use provisions under section 6A of the Act. Accordingly, the opponent may rely upon all the services identified in its pleadings without having to prove it has made *genuine use* of the mark in the UK. Moreover, it

[17] Written submissions in lieu [paragraph 4], filed on 12 September 2024.

is important to acknowledge that the opponent's evidence has been submitted in support of its claim that the earlier mark has acquired *an enhanced* degree of distinctiveness as a result of its extensive use in relation to the Class 42 services relied upon.

DECISION

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

24. Sections 5(2)(b) of the Act states that:

> "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."

25. 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

26. Section 60A of the Act provides:

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

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

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

27. 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*:[18]

- the physical nature of the goods or acts of service;
- their intended purpose;
- their method of use / uses;
- who the users of the goods and services are;
- the trade channels through which the goods or services reach the market;

[18] 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

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

  or
- whether they are complementary to each other. Complementary means *"there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".*[19] I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[20]

28. When interpreting the terms in a specification I bear in mind 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 in question"*.[21]

29. The competing goods and services are as follows:

The applicant's specification (as amended)

Class 9

Business technology software; Software (Computer-), recorded; Software and applications for mobile devices; Software applications; Software applications for mobile devices; Software compiling tools; Software development kit [SDK]; Software development programmes; Software development programs; Software development

[19] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82
[20] *Kurt Hesse v OHIM*, Case C-50/15
[21] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11-12

tools; Software downloadable from the internet; Software for Smart Contracts; Software for computers; Software for the integration of artificial intelligence and machine learning in the field of Big Data; Software for the processing of business transactions; Software testing software; Software; Business technology software; Downloadable cryptographic keys for receiving and spending cryptocurrency; all the aforesaid goods being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data.

Class 36

Financial transactions via blockchain; all the aforesaid services being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data.

Class 42

Design and development of new technology for others; Development of new technology for others; Blockchain as a Service [BaaS]; Software as a service; Software as a service [SAAS] services; Software as a service [SaaS]; Software design; Software design and development; Software development; Software development, programming and implementation; Software engineering; Professional consultancy relating to technology; Research in the field of information technology; Research relating to technology; Computer and information technology consultancy services; Computer technology consultancy; Consultancy and information services in the field of information technology; Consultancy and information services in the field of information technology architecture and infrastructure; Consultancy and information services relating to information technology; Consultancy services relating to information technology; Expert advice relating to technology; Expert opinion relating to technology; Information technology [IT] consultancy; Information technology consultancy; Information technology support services; all the aforesaid services being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data.

The opponent's specification

Class 42

Computer data services, namely computer software as a service, for use within computer communications network which provided connection to external data sources.

30. With regard to the similarity of the goods and services, in its written submissions in lieu,[22] the applicant states the following:

> "The goods and services at issue are highly sophisticated and specific in functionality within the very wide blockchain sphere.
>
> The Opponent's services are limited to software as a service "for use within computer communications network which provided connection to external data sources".
>
> This limited functionality of the Opponent's services is backed up by its evidence of use Exhibits which all state and imply that the software and services provided under the Opponent's Mark are primarily for linking data between blockchains and on /off- chain data for the purposes of smart contracts.
>
> The Applicant's goods and services have now been limited to cover only goods/services that are "being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data."
>
> This amended specification supports the fact that the function of the Applicant's goods and services is to provide a sophisticated and intuitive user-interface for looking at, searching for and monitoring data residing on blockchains and is not concerned with the control of digital contracts or "linking" digital contracts to external data sources.

[22] Filed on 12 September 2024 [paragraphs 20-27].

The fact that the Opponent's and the Applicant's goods and services are both software-related does not mean that they ought to be found to be similar, otherwise there would be similarity every time competing specifications concerned software, even if the functions and services belonged to completely different fields of activity.

[…]

In the current case, the only aspect in common is that the respective goods and services are related to blockchains. However, the application of blockchains is immense and it is likely that many different software products and services would be required to achieve different functions within this field. Within the blockchain arena, the Opponent's and Applicant's products and services have quite specific and unrelated functions and are not in competition and at best would only be loosely complementary in that both relate to blockchain usage.

This would be obvious to the relevant consumer who would be the software user or developer or business user that operates in the blockchain industry. All will be familiar with blockchain technology and are likely to have a financial interest at stake in their interactions with the goods and services, personally or through their clients. The relevant public's level of attention will therefore be high."

31. In its written submissions in lieu,[23] the opponent states:

"The applied for services in Class 42 are highly similar to those registered under the Opponent's Mark as they share the same intended purpose, method of use, nature and, they can also be in competition with each other as they are all software-related services.

Moreover, there is a specific focus on data in each of the specifications. As such, they are similar.

[23] Dated 16 September 2024, [paragraphs 43-47].

The applied for goods in Class 9 are, at least, complementary to the Opponent's Services as it is established that software related products (which have been applied for) will use and commonly are provided alongside software-services. What is more, to enable software products to function properly and be formulated, there is a need for software-services. Therefore, one cannot be said to operate without the other and so they are complementary.

The applied for services in Class 36 are, at least, complementary to the Opponent's Services as they will be used in connection with each other as it is not possible for financial transactions on the blockchain to operate software-services.

Again, due to the Opponent's Services being used to connect to external data sources, the Applicant's goods and services are clearly complementary to these as a result of being used as an external data source."

Class 9 of the contested application

Business technology software; Software (Computer-), recorded; Software and applications for mobile devices; Software applications; Software applications for mobile devices; Software compiling tools; Software development kit [SDK]; Software development programmes; Software development programs; Software development tools; Software downloadable from the internet; Software for Smart Contracts; Software for computers; Software for the integration of artificial intelligence and machine learning in the field of Big Data; Software for the processing of business transactions; Software testing software; Software; Business technology software; all the aforesaid goods being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data.

32. Broadly speaking the above contested *software* goods are a collection of instructions, data, or computer programs, etc., that enable computers/mobile devices, etc., to perform specific tasks. The opponent's services in Class 42 are *computer data services, namely computer software as a service, for use within computer*

communications network which provided connection to external data sources. In general terms, *computer software as a service* (SaaS) is concerned with *software* that is rented or licensed, etc., rather than purchased outright. Accordingly, rather than buying software and paying for periodic upgrades, etc., the SaaS services tend to be subscription based, meaning that any updates/upgrades are delivered automatically during the subscription period. The above contested *software* goods may include the same type of software provided through the opponent's SaaS services. As such, the goods and services may overlap in trade channels, with the same undertaking providing both the goods and services. There may also be an overlap in user, who will assume that the goods and services originate from the same undertaking, especially as they are important and indispensable to one another (the opponent's services cannot be provided without *software*). Consequently, I consider that the respective goods and services are complementary. I also consider that, to some extent, the goods and services may be in competition, with the user electing to either access their software via the internet, or alternatively choosing to purchase the equivalent software as goods. Therefore, taking all of the above into account, I find the goods and services at issue to be similar to a medium degree. Whilst the limitation in the contested goods is noted, I do not consider that it has an impact on my finding.

Downloadable cryptographic keys for receiving and spending cryptocurrency; all the aforesaid goods being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data.

33. In general, a cryptographic key comprises a string of data, usually numbers or letters, that is stored in an electronic file. This information is used to encrypt and decrypt information. As such, a cryptographic key acts like a lock and key, permitting only those with the correct key to access or understand the data. Accordingly, cryptographic keys can be used to, *inter alia*, secure communications, protect sensitive data and verify the authenticity of messages, etc. Whilst cryptographic keys are not in themselves a type of software, they are essential for software-based encryption used in conjunction with cryptographic algorithms. Accordingly, as cryptographic keys are essential for software-based encryption, I find there to be a degree of similarity between the contested goods and the opponent's *computer data services, namely computer software as a service, for use within computer communications network*

which provided connection to external data sources, on the basis that the *computer software as a service* (SaaS) may include software-based encryption where the use of cryptographic keys would be essential. Therefore*,* the respective goods and services may overlap in trade channels and in user, who may assume that the goods and services originate from the same undertaking, especially as they may be important and indispensable to one another. Accordingly, I consider that there exists an element of complementarity between the goods and services. As such, I find the goods and services at issue to be similar to a low degree. Whilst the limitation in the contested goods is noted, I do not consider that it has an impact on my finding.

Class 36 of the contested application

Financial transactions via blockchain; all the aforesaid services being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data.

34. *Financial transactions* are agreements or communications between a buyer and seller to exchange/transfer, *inter alia,* goods, services, or assets for payments, etc; a *blockchain* is a digital ledger database system used for storing records of financial transaction, using digital currencies (cryptocurrencies), that can be simultaneously accessed and shared within a publicly accessible network of linked computers. Therefore, broadly speaking, the contested *financial transactions via blockchain* concern the transactions, transfers and exchange of cryptocurrency assets through blockchain electronic technologies. Whilst the services essentially facilitate financial operations, they depend on technology to function. Accordingly, I find that there is a degree of similarity between the contested services and the opponent's *computer data services, namely computer software as a service, for use within computer communications network which provided connection to external data sources* on the basis that the opponent's services could include blockchain Software as a Service. To this extent there is a complementarity between the services at issue since the opponent's services can provide the necessary software and infrastructure that enables the contested *financial transactions via blockchain* services. Moreover, they may overlap in, for example, fintech companies, and may target the same users, such as banks or e-commerce platforms, or the public at large. Therefore, I find the

respective services to be similar to a low degree. Whilst the limitation in the contested services is noted, I do not consider that it has an impact on my finding.

Class 42 of the contested application

Design and development of new technology for others; Development of new technology for others; Research relating to technology; Research in the field of information technology; all the aforesaid services being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data

35. The above services concern the design, development and research of new technology/technology and information technology. These broad terms can relate to many things, such as innovations, systems, devices and new processes, including where the new processes involve computer software. Furthermore, new technology/technology will often include, or will be enabled by software, and new technological advances may be realised through software, which can, for example, be updated to take advantage of any advancements, etc. Furthermore, software updates can, for example, add new features, improve performance, and fix bugs, etc. As such, I am of the view that there is a degree of similarity between the above contested services and the opponent's broad term *computer data services, namely computer software as a service, for use within computer communications network which provided connection to external data sources.*

36. I say this on the basis that the same businesses that offer the opponent's *computer software as a service,* may also be involved in the design, development and research of new technologies that directly involve computer software or computer software as a service. Whilst I acknowledge that the parties' services will differ in terms of their specific purposes, and will provide different functions, etc., they may overlap in producers, users and channels of trade. As such, I do not consider it unreasonable for the consumer to believe that the services at issue derive from the same or related undertakings. Accordingly, I find there to be a low degree of similarity between the respective services. Whilst the limitation in the contested services is noted, I do not consider that it has an impact on my finding.

Software design; Software design and development; Software development; Software development, programming and implementation; Software engineering; all the aforesaid services being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data

37. The above services are concerned with the design, development, programming, implementation and engineering of *software.* Whilst I acknowledge that these services are not contained in the opponent's specification, I am of the view that there is a degree of similarity between the above contested services and the opponent's *computer data services, namely computer software as a service, for use within computer communications network which provided connection to external data sources.* I say this on the basis that the same businesses that offer the opponent's *computer software as a service,* may also be involved in the design, development, programming, implementation and engineering of *software.* Whilst I acknowledge that the parties' services will differ in terms of their specific purposes, and will provide different functions, they may overlap in producers, users and channels of trade. As such, I do not consider it unreasonable for the consumer to believe that the services derive from the same or related undertakings. Overall, I find there to be a low degree of similarity between the respective services. The limitation in the contested services does not impact on this finding.

Software as a service; Software as a service [SAAS] services; Software as a service [SaaS]; all the aforesaid services being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data

38. Broadly speaking, software as a service (SaaS) is software that is rented or licensed rather than purchased outright. Accordingly, rather than buying software and paying for periodic upgrades, etc., SaaS is subscription based and upgrades are delivered automatically during the subscription period. It is noted that the above contested SaaS services are limited for use in relation to *the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data*. The opponent's specification also contains SaaS services, which are limited for use within *computer communications network which provide connection to external data sources*. I am of

the view that the respective services overlap and as such, find that they are identical in line with the principle set out in *Meric*. However, if I have given too much weight to the identity of the services, then I consider there to be an overlap in users, nature, purpose and channels of trade, such that I find the services to be similar to a high degree. I do not consider that the limitation in the contested services has an impact on my finding.

Blockchain as a Service [BaaS]; all the aforesaid services being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data

39. In general, Blockchain as a Service [BaaS], is a category of cloud computing that allows users to create and manage cloud-based distributed databases of a continuously growing list of ordered records ('blocks'). BaaS is a form of 'Software as a Service'. As such, I compare the contested services with the opponent's *Computer data services, namely computer software as a service, for use within computer communications network which provided connection to external data sources.* I note that the parties' services will differ in terms of their specific purposes and functions, and whilst I do not consider that the respective services to be in competition or complementary, I find that the services may coincide in providers, users and channels of trade. Accordingly, I find that the services are similar to a medium degree. Whilst the limitation in the contested services is noted, I do not consider that it has an impact on my finding.

Professional consultancy relating to technology; Expert advice relating to technology; Expert opinion relating to technology; all the aforesaid services being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data

40. Broadly speaking, the above contested services relate to the process of advising businesses, for example, on how best to use technology to benefit their business, etc. These services will be provided by specialists, such as technology consultants. On balance, I consider there to be a level of similarity between the contested services and the opponent's *computer data services, namely computer software as a service, for*

use *within computer communications network which provided connection to external data sources* in Class 42. I find that there is a complementary relationship between the competing services on the basis that the technical consultancy, for example, could be important/indispensable to the opponent's services, and as such, may lead consumers into believing that the services at issue originate from the same undertaking. Whilst the competing services overlap in nature (both being services), they do not overlap in method of use and purpose as the contested services could be provided via various routes, such as online FAQs, live webchat, or telephone, as opposed to the earlier services which will be provided in the form of software. However, I consider that they will share the same trade channels. Also, such services are frequently bundled and offered to the same consumers. Thus, I find a medium degree of similarity between the services. I do not consider that the limitation in the contested services impacts on my finding.

Computer and information technology consultancy services; Computer technology consultancy; Consultancy and information services in the field of information technology; Consultancy and information services in the field of information technology architecture and infrastructure; Consultancy and information services relating to information technology; Consultancy services relating to information technology; Information technology [IT] consultancy; Information technology consultancy; Information technology support services; all the aforesaid services being for use in relation to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data

41. In general, I interpret the above consultancy and support services to cover services usually aimed at businesses to identify, for example, the information/computer technology needs of an organisation, and to analyse the costs and benefits of such technology in order to improve the IT efficiency of the business, etc. These services will be provided by specialists, such as IT specialists, who are able to provide advice regarding a wide range of computer-based technology, such as providing technical support in regard to software products, for example, installation assistance and remote troubleshooting, etc. On that basis, I consider that there is a level of similarity between the contested services and the opponent's *computer data services, namely computer*

software as a service, for use *within computer communications network which provided connection to external data sources* in Class 42.

42. I find that there is a complementary relationship between the competing services on the basis that information technology consultancy and support services, for example, could be important/indispensable to the opponent's services, and as such, may lead consumers into believing that the services originate from the same undertaking. Whilst the competing services overlap in nature (both being services), they do not overlap in method of use and purpose as the contested services could be provided via various routes, such as online FAQs, live webchat, or telephone, as opposed to the earlier services which will be provided in the form of software. However, I consider that they will share the same trade channels. Also, such services are frequently bundled and offered to the same consumers. Thus, I find a medium degree of similarity between the services. I do not consider that the limitation in the contested services impacts on my finding.

The average consumer and the nature of the purchasing act

43. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97.

44. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

> "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

45. The opponent's Class 42 services have not been qualified as anything other than *for use within computer communications network which provided connections to external data sources*, whereas the applicant's goods and services in Classes 9, 36 and 42 are clearly qualified as all being for use in relation *to the exploration, searching, monitoring, viewing, analysing and reporting of blockchain data*.

46. Accordingly, I find that the average consumer of the goods and services at issue is likely to include members of the general public as well as business and professional users. The goods and services will mainly be available via retailers, being both general retailers and more specialist ones, and their online or catalogue equivalents. At the retailers' physical premises, the goods will be displayed on shelves and in cabinets and will be self-selected by the consumer. A similar process will apply when the goods and services are selected online or via catalogues, in that a consumer will select them after seeing an image, on, for example, a webpage or in a catalogue. In my view, while the visual component will play a significant role in the selection process of both the goods and services, I do not discount an aural component playing a part. Moreover, I find that in relation to some of the services, such as *Consultancy services relating to information technology; Expert advice relating to technology; Expert opinion relating to technology;* etc, the aural component will likely contribute to an equal degree. I say this in light of the specialist nature of the services which, in my view, means that the selection process will involve at least some discussion with salespersons.

47. Given the wide-ranging goods and services at issue, the price and frequency of purchase will vary depending on their nature and type. In this regard, when selecting the goods and services at issue, the average consumer is likely to pay at least a medium degree of attention.

Comparison of the marks

48. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details.

The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM*, that:

> "34. […] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

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

Opponent's mark	**Applicant's mark**
	CHAINLENS

51. With regard to the similarity of the marks, in its written submissions in lieu,[24] the applicant states the following:

> "The only element in common between the respective marks is the string "CHAIN". The Opponent has no monopoly in the string 'CHAIN'. It is in common use in industry as a shorthand way of referring to the 'blockchain' since a

[24] Filed on 12 September 2024, paragraphs 6 and 8-11].

blockchain database stores data in blocks that are linked together in a chain. Thus the word ‘CHAIN’ has a low level of distinctiveness in relation to goods and services relating to blockchain technology, as covered by the Contested Mark and the Opponent’s Mark.

[…]

The marks have only a low degree of aural similarity since the pronunciation of the words ‘LINK’ and ‘LENS’ is quite different, with ‘LINK' ending on a hard ‘k’ sound and ‘LENS’ ending with a soft “ns” sound and containing the different vowel sounds of “i” and “e”.

Visually, the two words start with ‘CHAIN’ and are the same length. However, even though the elements ‘LINK’ and ‘LENS’ both start with the letter “L”, these elements are visually quite different, containing different vowels and ending with very different letters. So the marks are only visually similar to an average degree.

Furthermore, the Opponent’s mark consists of a logo device, which fully embodies the word aspects of the mark. In fact, since the words CHAIN LENS *[sic]* are simply presented inside the logo on one side of the three visible, decorated sides of the cube device, it is submitted that they are not a dominant aspect of the logo as a whole. The words “CHAIN LINK” are shown at an angle in the device and require some initial effort to read. Indeed, as other illegible wording is also depicted on the cube device, it gives the impression that the wording on the cube is not particularly important. The blue hexagon device is more prominent and immediately eye-catching and is more likely to be perceived by the relevant public as the brand identifier.

The marks are conceptually different, with 'LENS' and ‘LINK' not being at all synonymous.”

52. With regard to the similarity of the marks, in its written submissions in lieu,[25] the opponent submits:

> "Whilst the word element CHAIN in each of the respective marks may allude to the blockchain, given its positioning of the CHAIN element within the respective marks, namely being the initial word element within each of the respective marks, and its use in conjunction with elements that also have a meaning and use within the blockchain it would be considered the distinctive and dominant element and what will be recalled by the average consumer.
>
> […]
>
> As well as potentially alluding to the Blockchain, the CHAIN element of the respective marks is used in everyday language by the average consumer and it's other ordinary meaning may also be considered.
>
> As to the end elements of the respective marks, despite the Applicant's submissions that LENS does not have a meaning and is not used for the blockchain, as is evidenced in Exhibits MC19-MJC20, it does and is. Per Exhibit MJC19, the LENS protocol is "designed to empower creators to own the *links* between themselves and their community ..." [our emphasis added].
>
> As to the LINK element within the Opponent's Mark, per the Applicant's earlier submissions when considered for the Opponent's Services, it alludes to there being a connection or bridge between resources, data and/or information.
>
> The Opponent submits that the LINK and LENS elements are also common words used in everyday language by the average consumer, and their other ordinary meanings may also be considered.
>
> […]

[25] Filed on 16 September 2024, [paragraphs 14, 18-21, 26-38].

Furthermore, whilst the CHAIN element may be considered to have a low level of distinctiveness in view of the allusiveness to the Blockchain, this is also the case with the LENS and LINK elements of the respective marks as discussed above. In view of this, the Opponent again asserts that as a result of each of the respective elements having a lower level of distinctiveness, it is resultantly the initial element that will be recalled and considered the more distinctive and dominant element by the average consumer.

The figurative elements within the Opponent's Mark have no meaning and will not be given a meaning by consumers and will therefore no *[sic]* impact the meanings discussed above.

The Opponent's Mark and the Applicant's Mark are conceptually similar.

The Applicant's Mark is nine letters in length, as is the word element of the Opponent's Mark. The first six letters are identical, CHAINL-. The Applicant's Mark and the Opponent's Mark also both contain the letter 'N' as the second to last letter. Overall, seven of the nine letters within each of the respective marks are positioned in the same place.

As the average consumer will not be afforded the opportunity to review the respective marks side-by-side and due to their imperfect recollection, having such a large proportion of the word elements of respective marks sharing the same letters and being positioned within the same place within the marks, the consumer is likely to misread or misremember the two differing letters.

Also, contrary to the Applicant's submissions, the end elements of the respective marks are not "quite different". The letters L and N are positioned in the same order within the respective marks. What is more, the E and I are both vowels and positioned in the same order within the respective marks.

Moreover, as is established, the initial word element of a mark is considered the most distinctive and memorable in the mind of the average consumer, as

such, given the first six letters are identical, it is clear that this is what will predominantly be recalled by the average consumer.

Whilst the Opponent's Mark does contain figurative elements, with the words CHAINLINK *[sic]* being positioned on the top face of a cube, with one of the side faces of the cube displaying lines of various lengths and symbols, and the other containing a blue hexagon. Given the shapes and symbols are basic and will be readily known to consumers, they create very small visual differences between the respective marks and, contrary to the Applicant's submissions, they are not more "prominent" or "immediately eye catching", nor will they be considered by the consumer to be the "brand identifier" given they are basic and well-known shapes.

Moreover, as is well-established, the word elements within a combination mark that will be predominantly recalled as it is what will be said when discussing a brand, not the figurative elements.

The respective marks are visually similar.

For the reasons above, the respective marks are also aurally similar.

Furthermore, the word elements in the Opponent's Mark and the Applicant's Mark are two syllables in length, with the respective marks/elements being pronounced CHAIN-LINK and CHAIN-LENS.

The figurative elements within the Opponent's Mark do not need to be considered aurally as they will not be spoken by the consumers when recalling the Opponent's Mark. What will be spoken is the word element: CHAINLINK.

Also, given the average consumer's imperfect recollection, when discussing the products and the brand, they will recall the dominant and distinctive elements which, as discussed above, would be the initial element of the respective marks,

namely CHAIN, given it is the initial element and as a result of the lower levels of distinctiveness afforded to the separate elements of the respective marks. The Applicant's Mark and the Opponent's Mark are aurally similar.

The Application and the Opponent's Mark are visually, aurally and conceptually similar. Overall, the respective marks are similar."

Overall impression

53. The opponent's mark is figurative featuring a white three-dimensional cube. Three faces on the cube are visible. The top face features the words 'CHAIN LINK', placed in order, one on top of the other. Both words are depicted in a standard black uppercase typeface. I am of the view that neither of the words dominate and therefore the overall impression of the words resides in their combination; the bottom left face features black figurative elements consisting of five straight lines of differing lengths, and the symbols '< / >' are positioned both above and below these lines; the bottom right face features a blue hexagonal-shaped device.

54. Due to the figurative cube element being much larger in size when compared to the words 'CHAIN LINK' and the additional figurative elements present in the mark, I find that the eye is initially drawn to the actual cube device, and then immediately to the words 'CHAIN LINK'. I keep in mind the findings in *MigrosGenossenschafts-Bund v EUIPO*, T-68/17, where it was stated that:

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

55. Slightly less dominant are the additional figurative elements present in the bottom left and right faces of the cube. However, I am of the view that these elements still contribute to the overall impression of the mark.

56. The applicant's trade mark consists of the conjoined words 'CHAINLENS'. The overall impression of the mark lies in the combination of these words.

Visual comparison

57. Visually, the marks overlap in that the first word in both is 'CHAIN'. They differ in that the second word of each mark is different ('LINK' in the opponent's mark and 'LENS' in the applicant's mark). However, I note that both begin with the letter 'L' and contain the letter 'N', in the same positions. Furthermore, the words in the opponent's mark are presented as two separate words, i.e. 'CHAIN LINK', whereas the two words in the applicant's mark are conjoined, i.e. 'CHAINLENS'. In addition, the opponent's mark contains a white cube device, along with additional figurative elements, none of which are replicated in the applicant's word only mark. Taking into account the similarities, whilst bearing in mind the differences, overall, I find the marks to be visually similar to a between a low to medium degree.

Aural comparison

58. Aurally, the opponent's mark will be pronounced in the same way as the dictionary words 'CHAIN', 'LINK' or 'CHAIN-LINK'. The applicant's mark will be pronounced in the same way as the dictionary words 'CHAIN' and 'LENS'. The figurative elements in the opponent's mark will not be articulated. In my view, the marks are aurally similar to a medium degree.

Conceptual comparison

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

60. In my view the ordinary dictionary words 'CHAIN LINK' in the opponent's mark when considered in combination, may be perceived by the average consumer as *inter alia*, reference to a type of woven wire fence, or a link intended for/or forming part of

a chain. However, if the ordinary dictionary words are considered individually the word 'CHAIN' may simply be perceived as reference to a series of links connected together; and the word 'LINK' may be perceived as reference to, *inter alia*, a relationship between two things and/or a ring or loop in a chain.

61. That said, given that both parties have stated in their submissions that in terms of the respective goods and services at issue, the word element 'CHAIN' in each of the respective marks may be perceived as alluding to 'blockchain', I am of the view that when considered in combination the 'CHAIN' and 'LINK' elements, present in the opponent's mark are likely to be perceived by a significant proportion of relevant consumers as simply alluding to 'blockchain' since a blockchain database stores data in blocks that are '*linked'* together in a '*chain'*. However, for those consumers who give the words their ordinary dictionary meaning, while the words in the opponent's mark will readily be understood, they are not obviously descriptive in terms of the services at issue.

62. With regards to the applicant's mark, 'CHAINLENS', I am of the view that the average consumer will perceive the mark as an invented word with no immediate concept. Whilst I note that the mark consists of the conjoined words 'CHAIN LENS', the overall impression of the mark lies in the combination of these words. As such, I consider it unlikely that the average consumer would break the mark down in this way. However, even allowing for that possibility, the mark would still, in my view, send a meaningless concept overall. This is because the word 'chain' does not naturally combine with the word 'lens' being, *inter alia* a thin curved piece of glass or plastic used in, for example, spectacles, in order to make things look larger, smaller, or clearer.. That said, I note the opponent's comments that:[26]

> "…despite the Applicant's submissions that LENS does not have a meaning and is not used for the blockchain, as is evidenced in Exhibits MC19-MJC20, it does and is. Per Exhibit MJC19, the LENS protocol is "designed to empower creators to own the *links* between themselves and their community ..."

[26] Written submissions in lieu [paragraph 19].

63. However, I am of the view that this evidence alone is insufficient to demonstrate that the word ‘LENS’ is sufficiently well-known within the blockchain industry. Neither exhibit refers to the term ‘LENS’ solus, but rather refers to ‘The Lens Protocol / Lens Protocol’. Furthermore, it is important to recall that the applicant’s mark is actually one word, namely ‘CHAINLENS’, and there is no mention of this word within the said exhibits. As such, the mark remains meaningless as there is nothing before me to suggest that the applicant’s mark ‘CHAINLENS’ would be perceived as descriptive or allusive in terms of the goods and services as issue.

64. With regard to the figurative elements in the opponent’s mark, these will have no clear relationship with the words ‘CHAIN LINK’ and will not, in my view, convey any particular message to the consumer.

65. Accordingly, in view of the above, I find the marks at issue to be conceptually dissimilar.

66. However, in the event that a proportion of relevant consumers perceive the applicant’s mark as two separate dictionary words conjoined, namely ‘CHAIN’ and ‘LENS’, then there will be some degree of conceptual similarity between the marks due to the presence of ‘CHAIN’ in both marks. In this scenario there will also be a degree of conceptual difference arising from the presence of ‘LINK’ in the opponent’s mark and ‘LENS’ in the applicant’s mark. Accordingly, for those consumers who do perceive the applicant’s mark, although conjoined, as two separate dictionary words ‘CHAIN’ and ‘LENS’, the respective marks are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee,* paragraph 51)."

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

69. The distinctive character of a mark can be enhanced by virtue of the use made of it. The opponent has claimed that its mark enjoys an enhanced distinctive character in relation to all its Class 42 services relied upon. Before considering the position in respect of this claim, it is necessary to assess the inherent distinctive character of the mark.

70. The opponent's mark is figurative consisting of the words 'CHAIN LINK', along with numerous figurative device elements. As previously stated, whether considered as a

whole, or as two separate words, the words will likely be given their ordinary dictionary meanings and as such, will not be perceived as obviously descriptive or allusive in terms of the services at issue. That said, given that the opponent's evidence of use demonstrates that its services are concerned with, amongst other things, 'blockchain', the words 'CHAIN LINK' may be perceived by a significant proportion of relevant consumers as simply alluding to 'blockchain' since a blockchain database stores data in blocks that are '*linked'* together in a '*chain'*.

71. With regards to the figurative elements present in the mark, whilst I do not find them particularly striking, they cannot be overlooked. Moreover, they have no obvious meaning in respect of the services at issue. Accordingly, given the added figurative elements, I find the opponent's mark to be inherently distinctive to between a low to medium degree. However, where the services are not related to 'blockchain', I find the opponent's mark to be inherently distinctive to no more than a medium degree.

72. Turning now to consider whether the distinctiveness of the earlier mark has been enhanced through use.

73. In support of a claim of enhanced distinctiveness, in its witness statement,[27] Mr Caddle states the following:

> "The Witness Statement and corresponding Exhibits are facts and evidence that demonstrate that the mark has acquired an enhanced degree of distinctiveness as a result of its extensive use for the relied upon services in Class 42, namely:
>
> Computer data services, namely computer software as a service, for use within computer communications network which provided connection to external data sources.
>
> […]

[27] Dated 2 May 2024, [paragraphs 5-7].

The Opponent was founded in 2014 by Sergey Nazarov and Steve Ellis, both of whom have worked in the cryptocurrency/blockchain sector for over a decade.

The Opponent has used the mark  since 2017."

74. The opponent's evidence of use is summarised as follows:

- **Exhibit MJC01** - Wikipedia extract headed 'Chainlink (blockchain)' relating to the opponent, which includes information relating to the history of the opponent and its business. This document is undated.

- **Exhibit MJC01A** – contains information regarding the goods and services provided by the opponent, more specifically, the exhibit relates to its Web3 platform that enables various sectors and industries to access data on and of the blockchain. The document produced by the applicant was published on 25 January 2021 and updated on 23 March 2023, is headed 'What is Chainlink? It explains, *inter alia* that:

Chainlink is the industry-standard Web3 services platform that has enabled trillions of dollars in transaction volume across DeFi, insurance, gaming, NFTs, and other major industries. As the leading decentralized oracle network, Chainlink enables developers to build feature-rich Web3 applications with seamless access to real-world data and off-chain computation across any blockchain and provides global enterprises with a universal gateway to all blockchains.

Chainlink, a decentralized oracle network, was developed to allow smart contracts to automate the transfer of data between blockchains and outside systems in a highly secure and reliable manner. It uses a similar model to a blockchain in that there is a decentralized network of independent entities (oracles) that collectively retrieve data from multiple sources, aggregate it, and deliver a validated, single data point to the smart contract to trigger its execution, removing any centralized point of failure.

For example, Chainlink provides the USD price of Ethereum's native cryptocurrency ETH to blockchains via the ETH/USD Price Feed, which uses numerous independent oracle nodes and data sources to source and deliver the price data (pictured below). The ETH/USD price oracle can then be used by a blockchain application to get the current price of ETH when being used as collateral to obtain a loan or to settle a prediction made about the future ETH price.

Chainlink also provides multiple layers of security that go beyond decentralization to ensure users can trust the oracle network:

Another key use case of Chainlink is providing traditional systems like data providers, IoT networks, websites, and enterprises a way to make their data and services available to any blockchain network. Since the Chainlink Network is blockchain-agnostic, Chainlink oracles serve as an integration gateway for connecting current digital and data infrastructure to any/all blockchain networks. An industry-standard interoperability framework using oracle networks like Chainlink to connect traditional systems with blockchains was outlined in the recent World Economic Forum report co-authored by Chainlink Co-founder Sergey Nazarov titled Bridging the Governance Gap: Interoperability for Blockchain and Legacy Systems.

These are just some of the many capabilities Chainlink provides to allow smart contracts to interact with external data and systems with a high degree of security and reliability. The end result is the ability for blockchain-based smart contract applications to enable extensively more use cases across a more diverse set of markets.

- **Exhibit MJC01B** – contains various historic screenshots relating to the opponent's website, https://chain.link/, taken from the internet archive site 'Wayback Machine'. The screenshots are dated between July 2017 to April 2023 and demonstrate use of the earlier mark on the website's homepage in relation to the services of 'Chain Link', which include, *inter alia,* smart contracts, that enable access to real-world data and off-chain computation inherent to blockchain technology; and Web3 services platforms connecting people, businesses, and data.

- **Exhibit MJC02** – a printout obtained from 'ZDNET' (zdnet.com) concerning an article titled 'Chainlink launches Mainnet to get data in and out of Ethereum smart contracts' and relates to how CHAINLINK software and software services work and interact with smart contracts (smart contracts are programs that execute exactly as they are set up to by their creators on the Ethereum blockchain). The article is dated 30 May 2019.

- **Exhibit MJC03** – contains an article titled ‘What is a Blockchain Oracle?’ and relates to blockchain oracles, oracle networks and decentralised oracles. The article states, amongst other things, that blockchain oracles connect blockchains to external systems enabling smart contracts to be executed based upon inputs and outputs from the real world; oracle networks provide a way of decentralised Web3 ecosystem to access existing data sources, legacy systems and advance computations; and decentralised oracle networks enable the creation of hybrid smart contracts, where on-chain code and off-chain infrastructure are combined to support advanced decentralised applications that react to real-world events and interoperate with traditional systems. The article is dated 12 January 2024, which is outside the relevant period, i.e. 19 June 2023 (filing date of the contested mark). Furthermore, the source of the data has not been specified.

- **Exhibit MJC04** – contains details of the opponent’s products and services produced and supplied under the respective earlier mark. The information is provided via various historic screenshots relating to the opponent's website, https://chain.link/, taken from the internet archive site ‘Wayback Machine’. The screenshots are dated between November 2021 to October 2023 and demonstrate that the opponent’s services are provided in a variety of formats from data streams to cross-chains, to verifiable random functions (VRF’s) – a cryptographic random number generator; and the provision of assistance by the opponent in relation to the development of smart contracts.

- **Exhibit MJC04A** – contains an overview of the products and services provided by the opponent under the respective earlier mark. The information contains details on the benefits of using the opponent’s services, which include*, inter alia*, them being the most widely used blockchain oracle for data monetisation opportunities, by offering a large and growing market of data driven application while minimising development costs; provides a universal gateway for businesses to sell

data to applications on any blockchain network; offering users 'hyper-reliable' data; and provides a proven reliable infrastructure. The exhibit also demonstrates that the opponent's oracle services are being used by, amongst others, leading data providers in capital markets, decentralised finance, sports/esports, digital art and NFT's and news. The last page of the exhibit clearly shows that it was obtained from the opponent's website. However, the source of the data contained in the remaining pages is unknown, though I deduce that it was obtained from the opponent's website. The exhibit is undated.

- **Exhibit MJC04B** – contains 'use cases' showing that the opponent's products and services are used in a wide range of different sectors ranging from gaming to finance and from climate markets to insurance. The source of the data is not known though I deduce that it has been obtained from the opponent's website. The exhibit is undated, however, throughout the exhibit I note several instances of:

As such, I take this as an indication that the information contained in the exhibit was produced in 2024, which is outside the relevant period.

Furthermore, the American flag icon suggests that the document was produced in the US and/or was intended for US consumers. This is also reinforced by the use of '$' (dollar) amounts throughout the document, for example:

- In his witness statement Mr Caddle states that the opponent has written two white papers regarding the interplay between oracle networks and smart contracts and the future of Decentralised Oracle Networks. Mr Caddle states that both white papers are well regarded and industry leading when it comes to the blockchain, smart contracts and oracle networks sector. However, it is noted that owing to the length of the white papers, they have not been included as an exhibit. Furthermore, it is not clear from the evidence where the said white papers were distributed or, for example, what the circulation figures are, or what date the white papers were produced.

- Mr Caddle asserts in his witness statement that given the development and niche understanding that is required in order for the opponent's software to be used and operated successfully, the opponent has conducted many events, via online workshops as well as in-person events. Details of which are presented in **Exhibit MJC05**. However, I note that attendance information has not been provided with regards to how many people attended the events, nor has any circulation figures been provided, nor any information regarding where the events were advertised, etc.

  Examples of the events that have been held in the UK between 2020 and 2023 are as follows, however, notably those that took place in 2023 were all outside the relevant period:

  - Chainlink Constellation: London Workshop & Networking – November 8 2023
  - Chainlink Bootcamp: Mastering DeFi, NFTs and Cross-Chain - 3 Day Event – 23-25 October 2023
  - Blockchain Interoperability with Chainlink CCIP: A Workshop – 27 September 2023
  - Mastering Cross-Chain Development With Chainlink CCIP: A Workshop – (Online Event), 21 August 2023

- Web3 Startups: The Roadmap to Blockchain Success – (online event), 29 June 2023
- Fireside Chat with Stefan Rust of Truflation – 27 October 2022
- Innovation in Web3 - Building a Fair and Decentralised Future – 'Hackathon Event' with over 8,500 sign-up and 340 project submissions – 25 August 2022
- Chainlink 101. – 19 November 2021
- Chainlink Bath Hackathon Launch Party & Networking (Blockchain/Web3) – 22 October 2021
- 10 Critical Success Factors for a Blockchain Project w/ Cillian Leonowicz, Block – 23 June 2020
- Connected Smart Contracts Durham: Charles Holmes – Chainlink – April 2020
- Developing the Future of Smart-Contracts – 30 January 2020

- **Exhibit MJC06** – contains details regarding the opponent's 'Grant Program'. The 'CHAINLINK Grant Programme' was launched in 2020 and provides grants to assist and fund individuals and teams, enabling them to build a more functional, accessible and impactful smart contract community. However, whilst there are a number of recipients listed in the exhibit, it is not clear from the evidence before me, where the recipients are based. Furthermore, the contents of the exhibit are undated, however at the end of the exhibit the following is noted:

As such, I take this as an indication that the information contained in the exhibit was produced in 2024, which is outside the relevant period. Furthermore, the American flag icon suggests that the document was produced in the US and/or was intended for US consumers.

- **Exhibit MJC07** – contains examples of news articles written about the opponent relating to blockchain, smart contracts, oracle networks, and other products and services provided by the opponent. Four articles are included in the exhibit which are dated between 2017 and 2022. However, it is not clear from the exhibit where the authors of the articles are located or how many people read the articles and where they were based. That said, I note numerous incidences of financial amounts present in the exhibit being referred to in "$" (dollars) which would suggest that the information

contained in the exhibit was produced in the US and/or was intended for US consumers.

- **Exhibit MJC08** – contains a screenshot taken from 'Bloomberg TV's Youtube page relating to a broadcast of when the opponent's Sergey Nazarov appeared on 'Bloomberg TV' to discuss blockchain and AI. The clip is dated September 2023, which is outside the relevant period, i.e. 19 June 2023 (filing date of the contested mark). The evidence shows that it was viewed 10,000 times and received 202 'likes'. However, it is not clear if those who viewed and liked the clip were based in the UK.

- Additionally, also evidenced in **Exhibit MJC08** are details of two podcasts where the guest interviewee was the opponent's Sergey Nazarov. The first podcast by TechCrunch's Chain reaction is dated May 2023. The podcast clip is undated and whilst it states that the podcast had 830,000 views 2 years ago and has been 'liked' by 13,000 people, it is not clear if those who viewed and liked the podcast were based in the UK.

- In his witness statement, Mr Caddle states that as well as being mentioned and discussed in third party articles, the opponent also provides and makes available their own blog posts and articles for consumers to access, with the aim of providing a better understanding of the smart contracts, the blockchain and oracle networks. **Exhibit MJC09** contains examples of blogs and articles that are available at the opponent's website, 'https://chain.link/'. The blog examples contained in the exhibit are dated between 2019 and 2023. However, it is not clear from the exhibit how many users accessed the blog posts and articles and whether or not those users were based in the UK.

- **Exhibit MJC10** contains a selection of 'Tweets' taken from the opponent's 'X' page, a selection of posts taken from the opponent's Facebook page and a selection of screenshots from videos posted on the opponent's Youtube page.

The opponent's 'X' page shows that the opponent joined 'X' (previously known as 'Twitter') in June 2013, and during this time has amassed 1.1 million followers. However, it is not clear from the exhibit how many, if any of those 1.1 million followers are based in the UK.

The opponent's Facebook page shows that it has 13,000 followers, however, it is not clear when the opponent's Facebook page was created. Furthermore, I am not able to ascertain from the Facebook evidence if any of the 13,000 followers are based in the UK.

With regards to the Youtube evidence, the exhibit contains numerous screenshots relating to presentations and videos by the opponent. These screenshots are dated between 2019 and 2022. It is clear from the exhibit that the presentations and videos have been viewed and 'liked' thousands of times. For example, the presentation titled 'Global Markets will Interoperate via Hybrid Smart Contracts', dated January 2022 and received 78,175 views and 2,400 'likes'. However, I am not able to ascertain from the Youtube evidence whether those who viewed and liked the presentations and videos were based in the UK.

- Mr Caddle concluded his witness statement by stating that the opponent is a leading supplier of software-related services, which it provides under the earlier mark at issue (amongst others). He adds that in the course of the opponent's activities in the UK since 2017, as set out in the witness statement and as confirmed in the exhibits, the mark, has been substantially used, and as a result, has acquired an enhanced degree of distinctiveness.

75. In response to the opponent's evidence, the applicant filed a witness statement and evidence[28] along with written submissions.[29] In its written submissions it is noted that the applicant has submitted that the opponent has not claimed enhanced

[28] Dated 7 June 2024 [see paragraphs 10-12 of this decision].
[29] Written submissions, filed on 11 June 2024.

distinctiveness of its mark in the UK and in any case the opponent's evidence is insufficient to demonstrate any enhanced distinctiveness of its mark in the UK.

76. In response, Mr Caddle, on behalf of the opponent, filed a further witness statement,[30] along with seven further exhibits (Exhibit MJC14 to MJC20). In his witness statement, Mr Caddle disagrees with the applicant's assertions, stating that "the evidence presented in the previously submitted exhibits is clearly directed towards UK consumers, as well as US-based consumers and consumers in other countries".

77. With regards to the additional exhibits submitted, these relate to the following:

- **Exhibit MJC14** – contains an events page demonstrating that the opponent's products and services are directed at UK consumers, US-based consumers and consumers in other countries;

- **Exhibit MJC15** – contains details of the opponent's events group and booking page for the UK. There are over 2000 members of the UK group and 143 people confirmed their attendance to the event.

- **Exhibit MJC16** – contains examples of references made to the opponent and its mark throughout the opponent's White Paper (available at the opponent's website). The White Paper expands on the role of Decentralised Oracle Networks (DONs) in the blockchain ecosystem, laying out the key advancements for the Chainlink Network to power a suite of decentralised services for smart contracts on any blockchain. The opponent's mark is used 241 times throughout the White Paper.

- **Exhibit MJC17** – contains screenshots from the following websites demonstrating reference to the opponent and the inclusion of the opponent's White Paper:

  a) https://coinmarketcap.com/currencies/chainlink/

[30] Dated 2 August 2024.

b) https://www.a11cryptowhitepapers.com/chainlink-whitepaper/

c) https://en.wikipedia.org/wiki/Chainlink(blockchain)

d) https://www.smartcontractresearch.org/t/research-summary-chainlink-2- 0-next-steps-in-the-evolution-of-decentralized-oracle-networks/300

- **Exhibit MJC18** – contains screenshots and project details from https://www.chainlinkecosystem.com/ which demonstrates that the 'Chain link Ecosystem' has over 2000 projects from startups to large enterprises that use the opponent's decentralised oracle blockchain network, including 2123 projects and 2544 integrations as of June 18, 2024.

- **Exhibits MJC19** and **MJC20** – relate to the 'lens' element of the applicant's mark, and therefore these exhibits are not relevant with regards to the opponent's enhanced distinctiveness claim.

78. Although I am able to establish from the opponent's evidence, that there has been use of the earlier mark in the UK over a number of years this is predominantly only in relation to blockchain, smart contracts and oracle networks, and not in relation to the broad services as registered, i.e. *computer data services, namely computer software as a service, for use within computer communications network which provided connection to external data sources.*

79. Furthermore, the evidence before me does not sufficiently demonstrate that the earlier mark is known to consumers in the UK to such an extent that the mark's distinctive character has been enhanced above an average level. Notably, turnover and marketing figures have not been submitted, nor have I been provided with the market share of any of the services at issue. Furthermore, whilst I note that the opponent has conducted a number of 'CHAIN LINK' events, via online workshops as well as in-person events in the UK (Exhibit MJC05), between 2020 and 2023, there is nothing to substantiate the number of visitors to these events and how many of the online visitors were based in the UK. Likewise with regards to the various historic screenshots relating to the opponent's website (Exhibits MJC01B and MJC04) there

is nothing to substantiate the number of visitors to the website, the target audience of the website and how many, if any of the visitors were based in the UK.

80. Accordingly, I am of the view that the evidence before me does not sufficiently demonstrate that the earlier mark is known to consumers in the UK to such an extent that the mark's distinctive character has been enhanced above an average level through use, in relation to the services at issue.

Likelihood of confusion

81. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

82. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc,* Case BL-O/375/10. He said:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning - it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later

mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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).”

83. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

84. Earlier in this decision, I found that:

- the parties’ goods and services range between identical to similar to a low degree;

- the goods and services would be selected by predominantly visual means, although I did not discount aural considerations. I have identified the average

consumer to be members of the general public as well as business and professional users, who will pay at least a medium degree of attention during the selection of the goods and services at issue;

- the marks are visually similar to between a low to medium degree, aurally similar to a medium degree and conceptually dissimilar or similar to a medium degree (depending on how the marks are perceived);

- the earlier mark is inherently distinctive to between a low to medium degree, or no more than a medium degree, depending on the services at issue, although the evidence of use submitted by the opponent is insufficient to support that the distinctiveness has been enhanced through use.

85. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, and that the average consumer rarely has the opportunity to compare marks side-by-side, I am not convinced that the marks would be mistakenly recalled or misremembered for one another. While I appreciate that the word 'CHAIN' is identically present in the competing marks, I am of the view that the differences between the end of the marks, namely 'CHAIN LINK' and 'CHAINLENS' along with the figurative elements in the earlier mark, will allow the average consumer to correctly recall and remember the marks. I say this whilst also bearing in mind that the beginnings of marks tend to make more of an impact than the ends being where consumers tend to focus.[31] However, in this regard, despite the identical presence of the word 'CHAIN' at the start of the marks, I do not consider it likely that consumers would entirely forget the additional word elements 'LINK' and 'LENS' in the respective marks, due to their very different ordinary dictionary meanings, which will assist in distinguishing one mark from the other.

86. Accordingly, I am of the view that the additional word elements present in the marks and the figurative elements present in the earlier mark, will not be overlooked or disregarded by the average consumer upon a visual inspection of the marks, which is of heightened importance given that I have found the purchasing process to be

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

predominantly visual in nature. Due to the impact of the differences, I find that it is unlikely that consumers will mistake the marks for each other. Accordingly, even when factoring in the principles of imperfect recollection and interdependency, I do not consider there to be a likelihood of direct confusion.

87. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was) in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

88. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

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

90. In order to find indirect confusion in this case, it would be necessary to conclude that the average consumer will see in ‘CHAIN LINK’ and ‘CHAINLENS’ respectively, an element common between the marks, leading them to conclude that due to the presence of ‘CHAIN’ in the contested mark, that this is a brand of the owner of the earlier mark. I do not think this is likely. Whilst I keep in mind the similarities between the marks, I recognise that there are also considerable differences. In terms of the goods and services at issue, the word ‘CHAIN’ is not so distinctive that consumers would assume only one undertaking would use it in their mark, nor would the ‘LENS’ element present in the contested mark be seen as a logical brand extension or rebranding of ‘CHAIN LINK’, in the opponent’s mark. Accordingly, I find that there is no proper basis for a finding of indirect confusion. The average consumer will likely

put the presence of the common element ‘CHAIN’ in both marks down to coincidence rather than economic connection, and I can see no reason why consumers would believe that the marks originate from the same or economically linked undertakings. Consequently, I do not consider there to be a likelihood of indirect confusion.

91. For the avoidance of doubt, even if I had found there to be some enhancement to the distinctiveness of the earlier mark, I would have reached the same conclusion bearing in mind the differences between the marks and the level of attention being paid during the purchasing process.

Conclusion

92. The opposition under section 5(2)(b) of the Act has been unsuccessful and the contested mark may proceed to registration.

Costs

93. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice (TPN) 1/2023. In the circumstances, I award the applicant the sum of £850 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and preparing the counterstatement	£250
Considering the other side’s evidence	£200
Preparing written submissions and written submissions in lieu; and considering the other side’s submissions in lieu of a hearing	£400
Total	**£850**

94. I therefore order SmartContract Chainlink Limited SEZC, to pay Web3 Labs Ltd, the sum of £850. This should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the appeal proceedings.

Dated this 29th day of May 2025

Sam Congreve
For the Registrar

Annex

UKTM Application - UK00003924244 (prior to amendment)

Class 9 Business technology software; Software (Computer -), recorded; Software and applications for mobile devices; Software applications; Software applications for mobile devices; Software compiling tools; Software development kit [SDK]; Software development programmes; Software development programs; Software development tools; Software downloadable from the internet; Software for Smart Contracts; Software for computers; Software for the integration of artificial intelligence and machine learning in the field of Big Data; Software for the processing of business transactions; Software testing software; Software; Business technology software; Downloadable cryptographic keys for receiving and spending cryptocurrency; Downloadable cryptographic keys for receiving and spending cryptocurrency.

Class 36 Financial transactions via blockchain.

Class 42 Design and development of new technology for others; Development of new technology for others; Blockchain as a Service [BaaS]; Software as a service; Software as a service [SAAS] services; Software as a service [SaaS]; Software design; Software design and development; Software development; Software development, programming and implementation; Software engineering; Professional consultancy relating to technology; Research in the field of information technology; Research relating to technology; Computer and information technology consultancy services; Computer technology consultancy; Consultancy and information services in the field of information technology; Consultancy and information services in the field of information technology architecture and infrastructure; Consultancy and information services relating to information technology; Consultancy services relating to information technology; Expert advice relating to technology; Expert opinion relating to technology; Information technology [IT] consultancy; Information technology consultancy; Information technology support services.