

O/0481/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003902012

BY BRAINWORX LIMITED

TO REGISTER THE TRADE MARK:

BRAINWORX

IN CLASSES 35 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 442972

BY SYMPHONIC MIND LTD

BACKGROUND AND PLEADINGS

1. On 18 April 2023, Brainworx Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 9 June 2023. The applicant seeks registration for the following services under the above application:

Class 35 Retail services in connection with printed matter in the field of psychology, occupational therapy, speech and language therapy, and education; retail services in connection with printed psychometric tests; retail services in connection with printed matter containing tests, quizzes and puzzles; psychometric testing for the selection of personnel.

Class 42 Providing online non-downloadable software for use in psychometric and psychological assessment, examination and testing.

2. The application was opposed in full by Symphonic Mind Ltd (“the opponent”) on 11 September 2023 based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act (“the Act”).

3. Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade mark:



Comparable UK trade mark (EU) registration no. UK00917912987¹

Filing date 6 June 2018; Registration 18 October 2018.

Relying upon all of the goods and services for which the earlier mark is registered, namely:

¹ Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

Class 9 Software; interface software; application software; software for remote diagnostics, monitoring and analysis; brain analysis software.

Class 42 Software design and development; software installation; software support and maintenance; technological research and analysis; technical data analysis.

Class 44 Healthcare services; mental health services; neurofeedback services; medical analysis services; behavioural analysis for medical purposes.

4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because there is a high degree of similarity between the marks and the services.

5. Under section 5(3), the opponent claims that it has used its mark “in relation to all the services registered in classes 9, 42 and 44 since 2011”, and as a result, the opponent has “accrued significant goodwill and reputation in the mark in the UK”. The opponent also claims that due to the similarity of the marks, registration of the applicant’s mark “is likely to give rise to the incorrect presumption amongst the relevant public that the respective parties are either economically linked or at least collaboration is in play”, and that the applicant will take an unfair advantage “as its marketing could be made easier by association with the opponent’s mark”. They also claim that detriment would be caused to their earlier mark, with it being harmed or tarnished as a result of a connection being made by the parties, and that “use of the applicant’s mark could cause dilution or blurring of the distinctive character of the opponent’s earlier mark”, weakening its ability to identify the goods and services as coming from the opponent.

6. Under section 5(4)(a), the opponent relies upon its  sign which it claims to have used throughout the UK since 2011 for software, interface software, application software, software for remote diagnostics, monitoring and analysis, brain analysis software, software design and development, software installation, software support and maintenance, technological research and analysis, technical data analysis, healthcare services, mental health services, neurofeedback services, medical analysis services and behavioural analysis for medical purposes.

7. The applicant filed a counterstatement admitting that the marks “have an identical prefix” and that the “suffixes of the marks have a small degree of similarity”. However, they denied the similarity of the goods and services, specifically denying that the class 42 services are identical or highly similar. The applicant also denied that the marks are sufficiently similar for a likelihood of confusion to arise. In regard to the section 5(3) and 5(4)(a) claims, the applicant submitted that without any evidence before them of reputation or goodwill, they are unable to admit or deny such a claim, but put the opponent to strict proof of the existence of the claimed reputation and goodwill.

8. The opponent is represented by Birketts LLP and the applicant is represented by Ansons. Both parties filed evidence in chief, and the opponent filed evidence in reply. Neither party requested a hearing but both parties filed submissions in lieu. This decision is taken following a careful perusal of the papers.

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

EVIDENCE

10. The opponent’s evidence includes the witness statement of James Roy dated 29 February 2024. Mr Roy is the Director of the opponent, a position he has held since 2009. Mr Roy’s statement is accompanied by 11 exhibits (JR1-JR11).

11. The applicant’s evidence includes the witness statement of John Clarke dated 18 April 2024 and the witness statement of Sarah Weinberg dated 20 April 2024. Mr Clarke and Ms Weinberg are the CEO and Global Distributions Manager for Multi-Health Systems Inc, and their statements have been filed to support the argument that the parties have never been confused for each other. I note that neither statement is accompanied by any exhibits.

12. The applicant's evidence also includes the witness statement of Mr Kevin Michael Twomey dated 29 April 2024. Mr Twomey is the founder and director of the applicant and his statement is accompanied by 10 exhibits (KMT1-KMT10).

13. The opponent's evidence in reply consists of the witness statement of Mr Roy dated 28 June 2024, and his statement is accompanied by 5 exhibits (JR12-JR16).

14. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

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

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

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

Section 5(2)(b) case law

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

- (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

18. The competing goods and services are as follows:

Opponent's goods and services	Applicant's services
<u>Class 9</u> Software; interface software; application software; software for remote diagnostics, monitoring and analysis; brain analysis software.	<u>Class 35</u> Retail services in connection with printed matter in the field of psychology, occupational therapy, speech and language therapy, and education; retail services in connection with printed

<u>Class 42</u> Software design and development; software installation; software support and maintenance; technological research and analysis; technical data analysis. <u>Class 44</u> Healthcare services; mental health services; neurofeedback services; medical analysis services; behavioural analysis for medical purposes.	psychometric tests; retail services in connection with printed matter containing tests, quizzes and puzzles; psychometric testing for the selection of personnel. <u>Class 42</u> Providing online non-downloadable software for use in psychometric and psychological assessment, examination and testing.
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19. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

20. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

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

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

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “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 the responsibility for those goods lies with the same undertaking.”

Class 35

Retail services in connection with printed matter in the field of psychology, occupational therapy, speech and language therapy, and education; retail services in connection with printed psychometric tests; retail services in connection with printed matter containing tests, quizzes and puzzles.

23. The opponent in its submissions in lieu states that although its registration does not cover retail services, the “applicant’s retail services are in the same field as the opponent’s”. Whilst this submission is not particularly clear, I find it reasonable to infer that they believe the subject of the printed matter overlaps with the opponent’s class 44 services which are medical in nature. However, I find that this approach fundamentally overlooks what the applicant’s services are, that being retail services connected with printed matter.

24. Therefore, I find that the opponent’s class 44 health and medical services do not overlap in nature, method of use and purpose with the applicant’s retail services. The services do not overlap in trade channels, as the applicant’s services will be provided by retail establishments such as book stores and the opponent’s services will be provided by medical bodies and healthcare professionals. They are also neither in competition, nor complementary, in the way described by the case law cited above. I also find that whilst the services may overlap in user, this is not enough on its own to establish similarity. I therefore find that the parties’ services are dissimilar.

Psychometric testing for the selection of personnel.

25. In its submissions in lieu, the opponent draws my attention to paragraphs 6 and 7 of Mr Roy’s witness statement in reply, which states the following:

“Mr Twomey states that the psychometric tests and tools the applicant supplies are not physical tests but rather question-based tests. In fact, just as the applicant does, [the opponent] provides a question-based psychological test of its own design [...]

We supply this question-based subjective test to professionals who use our equipment as part of their purchase. While [the opponent’s] offerings are more substantial than those offered by the applicant, crucially, the questionnaire component is an identical service.”

26. Moreover, in its submissions in lieu, the opponent states that “psychometric tests are complementary” to all of the opponent’s class 44 services, as “these tests are used

to provide the ultimate and psychological assessment provided by the opponent". Nonetheless, how the parties' services are used and sold in practice is not relevant to my assessment. I have to carry out a notional assessment based upon the specifications before me (how the services within the parties' specifications could be used and sold), and all the circumstances in which the mark applied for might be used if it were registered.²

27. Firstly, whilst the opponent's "healthcare services", "mental health services" and "behavioural analysis for medical purposes" may all use or incorporate medical based psychometric tests to help with diagnosing, treating and monitoring a patient's health/mental health, this does not automatically result in a finding of similarity between the parties' services. Secondly, the applicant's psychometric testing services are specifically used in the "selection of personnel", meaning that they are used in recruitment processes. I therefore find that the services do not overlap in nature, method of use or purpose. I also find that the trade channels will not overlap as the applicant's services will be provided by specialist undertakings that create tests and tools which will measure a candidate's suitability for a role or organisation, whereas the opponent's services will be provided by medical bodies and healthcare professionals. They are also neither in competition, nor complementary, in the way described by the case law cited above. Lastly, whilst the services may overlap in user, this is not enough on its own to establish similarity. Therefore, taking all of the above into account, I find that the parties' services are dissimilar.

Class 42

Providing online non-downloadable software for use in psychometric and psychological assessment, examination and testing.

28. In its submissions in lieu, the opponent submits that its "software design and development" and "software installation" services are similar to the applicant's above services. I note that non-downloadable software is software which is accessed online without the need for installation or downloading to a device. Therefore, I find that the

² *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66.

opponent's strongest comparator is with its "software design and development" services. I consider that these services overlap in trade channels, with undertakings which specialise in software providing all of the aforementioned services, to the same users. I also find that the nature and purpose of the services overlap, as they all pertain to, and provide the user with, software. There may also be a degree of competition with the opponent's "software design and development" services and the applicant's services, as the user may choose to design its own software, or purchase the applicant's services which provides them with non-downloadable software which is already designed. On this basis, I find that the services are similar to a medium degree.

29. It is a prerequisite of section 5(2)(b) that the services be identical or at least similar. The opposition will, therefore, fail in respect of the services that I have found to be dissimilar.³ The opposition under section 5(2)(b) fails for the following services:

Class 35 Retail services in connection with printed matter in the field of psychology, occupational therapy, speech and language therapy, and education; retail services in connection with printed psychometric tests; retail services in connection with printed matter containing tests, quizzes and puzzles; psychometric testing for the selection of personnel.

The average consumer and the nature of the purchasing act

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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

31. The average consumer for the services will be members of the general public, businesses and professionals that conduct psychological and psychometric testing. The cost of purchase is likely to vary, but it is not likely to be at the very highest end of the scale. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. Various factors will be taken into consideration such as suitability for the user’s particular needs, ease of use, reliability and the reputational standing of the provider. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

32. The services are likely to be purchased from specialist software undertakings and their websites. Alternatively, the services may be purchased following perusal of advertisements. The purchasing process is, therefore, likely to be predominantly visual. However, I do not discount that there may also be an aural component to the purchase through advice sought from software designers and developers, or via word-of-mouth recommendations.

Comparison of the trade marks

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

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

35. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	BRAINWORX

36. The opponent's mark begins with the single word “brainworks”. I note that the beginning “brain” element is presented in a standard bolded brown typeface, followed by the word “works” in a standard brown typeface. This is followed by a device element, which consists of multiple waved lines of blue and yellow. The opponent has not provided submissions on what the device depicts or represents, and neither has the applicant. However, I find that as the word element of the opponent's mark begins with the bolded word “brain”, the average consumer will likely see the device as a depiction of brain waves, which reinforces this concept. I also bear in mind that the eye is naturally drawn to the element of the mark that can be read. On this basis, I find that the word “brainworks” at the beginning of the mark plays a greater role in the overall impression of the mark, with the brainwave device playing a lesser role.

37. The applicant's mark consists of the word “BRAINWORX”. For reasons I will come to discuss in the conceptual comparison, I consider that the average consumer will also see the word “BRAIN” at the beginning of the applicant's mark, followed by the

word “WORX”. I note that there are no other elements to contribute to the overall impression which lies in the word itself.

38. Visually, the applicant concedes that the prefix of the parties marks, being the word “brain”, is identical in both marks. I also note that this element is followed by the identical letters W, O and R in both marks. These all act as visual points of similarity. I also note that these elements appear at the beginning of the marks, a position to which the average consumer pays more attention.⁴ However, the opponent’s word element within the mark ends in the letters “k” and “s”, followed by the brainwave device, whereas the applicant’s mark ends in the letter “X”. While these act visual points of difference, I bear in mind that the letters “k” and “X” are visually similar, as they both share the two diagonal lines on the right-hand side of the letters. I therefore find that the marks are visually similar to between a medium and high degree.

39. Aurally, in its submissions in lieu, the applicant states that “it cannot be denied that the verbal element of each of the trade marks being considered “brainworks” and “brainworx” are highly similar since they share the first eight letters in the same sequence”. However, I agree with the opponent who submits that the marks are aurally identical. The pronunciation of the word “BRAIN” at the beginning of the parties marks are clearly aurally identical, and the pronunciation of the words “WORKS” and “WORX” in the parties’ marks are also aurally identical. The brainwaves device will not be articulated in the opponent’s mark, and therefore, as a whole, I find that the parties marks are aurally identical.

40. Conceptually, both of the parties marks begin with the ordinary dictionary word “brain”. The applicant’s submits that the “WORX” element at the end of “BRAINWORX” has no meaning in the English Language and that the Board of Appeal of the CJEU in case 03/06/2020, R 1838/2019-5, Greenworks/Worx, in paragraph 41 stated that:

“The vast majority of the public in the European Union will perceive the earlier mark ‘WORX’ as a fanciful term without any meaning. This applies even to a part of the English-speaking consumers. There are no indications that ‘WORX’

⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

is a commonly used misspelling like ‘lite’ (instead of ‘light’) or ‘xpert’ (instead of ‘expert’).”

41. However, firstly, this Tribunal is not bound by decisions of the EUIPO, and, secondly, I bear in mind that in *Usinor SA v OHIM*, Case T-189/05, the GC found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57).

42. As noted above, I find that both the words “WORKS” and “WORX” in the parties’ marks are aurally identical. I therefore consider that due to its pronunciation, the average consumer is likely to assign the meaning of the word “WORKS” to the invented word “WORX”. On this basis, I find that the word “BRAINWORX” as a whole would be understood by the average consumer as meaning the “works of the brain”. This concept is identically conveyed by the word “brainworks” in the opponent’s mark, and, to some extent is reinforced by the brainwaves device (albeit this element also conveys the concept of brain waves). Therefore, taking all of the above into account, I find that the marks are conceptually similar to a high degree.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the

goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of 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)."

44. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

45. I will begin by assessing the inherent distinctive character of the opponent's mark. As highlighted above, the mark includes the word "brainworks" which will be understood as meaning the "works of the brain". This element is presented alongside a brainwaves device.

46. For the opponent's services that I have found to be similar to the applicant's, being "software design and development", I find that the word "brainworks" and the brainwaves device is allusive of the software that is being designed and developed, that being software that can assess the works of the brain. On this basis, I find that the opponent's mark is inherently distinctive to between a low and medium degree.

47. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing enhanced distinctiveness is the UK market.

48. Mr Roy states that the opponent “was among the first neurofeedback practices in the UK”, and in 2013 they launched the world’s first remote neurofeedback service, and that this has “since been refined and perfected through continuous development of [their] bespoke remote training software” for their psychometric testing for both professionals and individuals.

49. In his witness statement, Mr Roy states that the opponent is a leader in the field of psychometric testing, which is “evidenced by [their] presence in the UK press”, examples of which are contained in **exhibit JR2**. This exhibit contains 3 undated screenshots of the opponent’s website (brainworksneurotherapy.com) which has 19 links to third party articles, such as the Daily Mail and the BBC. Only the title of the article and a small summary of it is shown within the screenshots, but it does not provide the date of the articles nor does it contain any reference to the opponent within the summaries. However, **exhibits JR3 to JR5** contains the following third party articles:

- a) A Sunday Times Style Magazine dated 27 January 2013. It is noted that only two paragraphs are contained within the screenshot, which refers to the opponent’s “Loreta system” which is a low-resolution electromagnetic tomography which is a type of neurofeedback which records electrical activity from the scalp.
- b) A Daily Mail article dated 31 March 2013. The title refers to neurofeedback as being the “latest therapy that manipulates brainwaves to alter mindsets”. The article also states that the journalist visited the opponent in London, which is “one of the few places in Britain to offer the latest version of the therapy” and “has the most advanced array of neurofeedback equipment in the UK”. I note that it also includes the following photo of the journalist using the opponent’s neurofeedback service and equipment:



- c) A Tatler article dated October 2012 which refers to the journalist enrolling at the opponent for the “QEEG technique, which maps your brainwaves”. It details the process as sitting on a chair in front of a TV, with the user wearing a cap on their head, watching a series of what they described as “games”. The article also states that the machine records brainwaves and the information “can be interpreted and used by experts as a clinical tool to evaluate brain function”.

50. To support the above, **exhibit JR6** contains screenshots detailing the readership for the above third party articles:

- 1) The Sunday Times readership is 1,504,000 in print, but the screenshot from where this information was taken is not dated.
- 2) The Daily Mail sells 683,530 copies per day which increases to 1.3 million on Saturday as recorded in 10 March 2023.
- 3) Tatler’s readership figures was 101,000 as recorded in May 2022.

51. The above readership figures pertain to the years 2022 and 2023. Therefore I am unable to determine how many UK consumers would have been exposed to the **exhibit JR3 to JR5** articles when they were published, that being 2012 and 2013.

52. **Exhibit JR7** contains a screenshot and weblink for the BBC’s “All Hail Kale” podcast which featured the opponent on 22 January 2019. Whilst the exhibit confirms that the opponent is mentioned at 13 minutes and 28 seconds on the podcast, the

exhibit and Mr Roy does not provide any explanation of what is specifically discussed on the podcast in relation to the opponent. Moreover, as highlighted by the Trade Marks Manual, section 4.8.4, I am unable to click on the weblink as this amounts to independent research which I cannot undertake. **Exhibit JR8** also contains a screenshot and weblink for the BBC's "Daisy Maskell: Insomnia and Me" programme, with the screenshot showing the subtitles "a neurofeedback therapist at Brainworks' home clinic". Mr Roy confirms in his witness statement that Ms Maskell used the opponent's "brain mapping services to get to the bottom of her insomnia". However, Mr Roy has not provided any information as to how many UK consumers would have been exposed to the BBC podcast and programme.

53. Mr Roy has provided the following annual sales made under the opponent's mark:

YEAR	SALES (GBP)
2023	425,920
2022	604,523
2021	599,780
2020	431,721
2019	336,855

54. He has also provided the opponent's following advertising figures:

YEAR	SALES (GBP)
2023	36,482
2022	3,540
2021	1,567
2020	1,872
2019	896

55. To support the above, a screenshot of the opponent's Google Analytic results for its website shows that between 9 February 2011 and 15 February 2024, its website has had 4.4 million page views. In his witness statement, Mr Roy also states that "in addition to this, in 2020 [they] duplicated the equipment sales off to [their] other website www.homeneurofeedback.com totalling another 7,101 visits".

56. Lastly, Mr Roy provides a screenshot of its Facebook page in **exhibit JR10**, however, this is undated and therefore I am unable to determine how many followers it had at the relevant date.

57. In Mr Twomey's witness statement in reply to the above evidence, he states that he looked up the opponent on the UK company register and also the "associated company" Brain Works Neurotherapy Limited, and submits that the accounts do not appear to match the amount of use suggested by Mr Roy above. Mr Twomey provides financial statements for the year ending 31 December 2022 in **exhibit KMT10** to support this. In reply to his, in Mr Roy's second witness statement, he confirms that Brain Works Neurotherapy Limited is a dormant company,⁵ but also clarifies that there are 3 companies trading (which all share common directors)⁶ using the opponent's mark and the opponent's aforementioned website.⁷ He also provided the latest filed accounts for the year ending 31 December 2022, for all three trading entities, in **exhibit JR16**. I note that the turnover for all three entities when added together for the years 2021 and 2022 reflects the turnover figures contained in the table in paragraph 53 above.

58. Taking the above into account, the opponent's evidence encounters significant deficiencies. Firstly, I am unable to determine how many UK consumers were exposed to the third party article evidence, the BBC programme and the BBC podcast. Whilst the sales figures Mr Roy provides are notable, with the opponent's turnover for 2019 to 2022 amounting to £1,972,879,⁸ I have not been provided with any supporting invoice evidence, or submissions, to clarify whether all of these sales pertain to the UK, and what services this revenue was generated from. I am therefore unable to determine what proportion of these sales were made in relation to "software design and development" services, which are the services I have found to be similar to the applicant's. Nevertheless, I also find that the evidence has only shown use of the mark on neurofeedback services. Whilst the opponent may use a bespoke remote training software it has developed and refined in order to deliver its neurofeedback services, the evidence does not show that the opponent has in fact provided software services; that being the design and development of software for third parties. Consequently, it

⁵ **Exhibit JR12**

⁶ This is evidenced in **exhibit JR13** which shows the names and directors of the trading companies.

⁷ This is reflected in the websites terms and conditions, screenshots of which are contained in **exhibit JR15**.

⁸ Whilst the table in paragraph 51 sales figures are provided for 2023, I note that the relevant date in these proceedings is the 18 April 2023, and therefore, the majority of the sales for this year will fall after this date.

cannot assist the opponent in demonstrating enhanced distinctiveness for the services that I have found to be similar to those in the application.

No evidence of actual confusion and honest concurrent use

59. The witness statements of Mr Clarke and Ms Weinberg state that they have never been confused between the goods and services provided by the parties, and that the reason for not confusing the two is because of the “different nature of the products offered and the differing needs of prospective users”.

60. Mr Twomey has also provided the following information within his witness statement and exhibited evidence in regard to the applicant’s use of its mark:

- a) The applicant has used its mark since 2005, and is used to identify the applicant as a supplier of psychometric tests and tools in Ireland and the UK.
- b) Their website domain was registered on 22 February 2005 as evidenced by **exhibit KMT1**.
- c) The applicant was incorporated in Ireland on 13 August 2008 as evidenced by **exhibit KMT2**.
- d) The applicant has provided wayback machine screenshots dated 18 November 2007 of its website in **exhibit KMT3**. It specifically shows a picture of their stand at a Psychology Society of Ireland conference hosted in Derry, Northern Ireland.
- e) Mr Twomey states that the applicant is the leading supplier of psychometric tests and tools to allied health professionals and educators in Ireland and the UK, and that these tests aid in assessing and diagnosing clinical and educational disorders.
- f) Mr Twomey states that the applicant does not sell to the general public, and that they have refused sales to them (such as parents who wished to have their child tested). He confirms that they only sell to professionals and specialists.
- g) **Exhibit KMT4** contains the applicant’s 2009 catalogue which lists a variety of tests for children, youths and adults, all of which have a “qualification code”.
- h) **Exhibit KMT7** contains 8 sample of invoices dated between 24 May 2007 and 5 April 2023. The invoices are address to customers based in Nottinghamshire,

Upavon, London, Liverpool, Edinburgh, Dorset, Inverness and Birmingham.⁹ They show the sale of different types of tests, with the price of the invoices varying between £58.68 and £755.40. I also note that all of the invoices are headed as “BRAINWORX”.

61. Mr Twomey also states that the applicant does not supply neurotherapy products or offer neurotherapy services. He also confirms that a psychometric test is an assessment to measure an individual’s cognitive ability, personality, or behaviours, while neurotherapy, in particular the opponent’s services, “assess a user’s brainwave activity and then attempts to help the user control their brain functions through brain training”. He confirms that the applicant does not interact with the person being assessed, they just simply supply the tools and tests to professionals and educators such as psychologists, occupational therapists, speech and language therapists and special education teachers. Their tests are emailed to an assessor’s online account to their client, who then returns the completed test to the assessor by e-mail.

62. I appreciate that in proceedings before the Tribunal, such evidence is capable of being used to support a defence that there has been honest concurrent use of the marks at issue and, as a result, any likelihood of confusion may be diminished. However, taking all of the parties’ evidence above into account, I do not consider that the exceptional circumstances outlined in *Budejovicky Budvar NP v Anheuser-Busch Inc*,¹⁰ and those factors in *Victoria Plum Ltd v Victorian Plumbing Ltd*¹¹ are present in the case before me. I also note that in *Budejovicky Budvar*, paragraph 82 makes reference to the “long period of honest concurrent use between the marks”, and in *Match Group, LLC & Ors v Muzmatch Ltd & Anor*¹² Arnold LJ held use which was initially infringing could eventually cease to be infringing if the trade mark proprietor took no action, there was substantial parallel trade for a long period, and as a result the trade marks came to be understood by the relevant class of consumers as denoting

⁹ In his first witness statement, Mr Roy refers to **exhibit JR11**, which contains a screenshot of the applicant’s website stating that they are an “Irish distributor” and he states that it appears to him that the applicant has only operated in the Republic of Ireland. However, these invoices all show sales to the UK and therefore I find this exhibit does not assist the opponent.

¹⁰ Case C-482/09, EU:C:2011:605

¹¹ [2016] EWHC 2911

¹² [2023] EWCA Civ 454 at [115] to [117]

the goods/services of more than one trader. I also bear in mind that in *Roger Maier and Another v ASOS*¹³ Kitchen L.J. (as he then was) said:

“..the absence of actual confusion despite **side by side** use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion.” **(My emphasis)**

63. The evidence provided by the parties shows that the applicant has used its mark since 2005 and the opponent has used its mark since 2013. I find that this could amount to longstanding use, however, I also bear in mind that the opponent has not provided any evidence of use for the years 2014 to 2018. Furthermore, I do not find that the evidence shows that the marks have been used side by side, or in other words, they have not used in the same comparable market. Whilst very broadly speaking, the parties services all provide a type of testing, the opponent's evidence clearly shows they provide neurofeedback services, testing their users in clinics, using neurofeedback equipment (such as the cap and TV depicted and explained within the article evidence). The applicant's evidence confirms that they supply different types of psychometric tests to professionals, and that this is done all online. Additionally, there is no evidence that demonstrates that the marks at issue ever came into conflict during this time. For example, I have not been provided with evidence that that the services of the parties were made available to consumers via the same trade channels to give rise to circumstances where they would be viewed alongside each other. Lastly, I note that the aforementioned evidence does not relate to either of the parties' class 42 software services that I have found to be similar to each other earlier in this decision. The evidence is, therefore, of no assistance in supporting a defence of the existence of honest concurrent use. As a result, the applicant's reliance upon this defence is dismissed.

Likelihood of confusion

64. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the

¹³ [2015] EWCA Civ 220

average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

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

- I have found the marks to be visually similar to between a medium and high degree.
- I have found the marks to be aurally identical.
- I have found all the marks to be conceptually similar to a high degree.
- I have found the earlier mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer as members of the general public, businesses and professionals that conduct psychological and psychometric testing, who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' class 42 services to be similar to a medium degree.

66. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

67. Taking all of the above into account, considering the principle of imperfect recollection, and bearing in mind that both marks begin with the same first 8 letters (B, R, A, I, N, W, O and R), a position which tends to make more of an impact than the ends, I consider that there is a likelihood of direct confusion. Whilst the end of the marks differ (“ks” vs “X”), I note that the letters “k” and “X” are visually similar, as they both share the two diagonal lines on the right-hand side of the letters. This furthermore highlights that they could be easily mistakenly recalled or misremembered as each other. I also find that as the brain wave device element in the opponent’s mark plays a lesser role in the overall impression, it may be easily misremembered. Moreover, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the between a medium and high degree of visual similarity between the marks will lead the average consumer to mistake one mark for the other, especially as the purchasing process is predominantly visual. Even where aural considerations apply, the aural identity between the marks will have the same result. I also note that both marks evoke the meaning of the “works of the brain” (which is reinforced by the brain wave device in the opponent’s mark), meaning there is no significant conceptual hook to differentiate them. Consequently, I find that there is a likelihood of direct confusion.

68. The opposition under section 5(2)(b) partially succeeds.

Section 5(3)

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

“5(3) A trade mark which –

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

70. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

71. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

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

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

72. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's marks must be identical or similar. Secondly, the opponent must show that its earlier mark has achieved a level of knowledge/reputation amongst a significant

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

73. The relevant date for the assessment under section 5(3) is the date of application of the applicant's mark i.e. 18 April 2023.

Reputation

74. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

75. In determining whether the opponent has demonstrated a reputation for the goods and services in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods and services. In reaching this decision, I must take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.”

76. I can deal with this ground relatively swiftly.

77. Earlier in my decision, I found that the distinctive character of the opponent’s mark earlier mark had not been enhanced through use. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments. My reasoning for not finding enhanced distinctive character was partially based upon the fact that the evidence filed by the opponent did not relate to the services that I had found similar to the applicant’s services under section 5(2)(b). However, I did find that the evidence had shown use of the mark on “neurofeedback services”, a term which is relied upon by the opponent under section 5(3). Nevertheless, I still consider that the opponent’s evidence is insufficient to establish a reputation in the UK.

78. The strongest evidence provided by the opponent is its turnover figures for 2019 to 2022, which amounted to £1,972,879. It is also reasonable to infer from the evidence that the majority of this turnover pertains to the sale of its neurofeedback services. However, Mr Roy does not confirm whether all of these sales were made in the UK. I also note that in paragraph 6 of Mr Roy’s witness statement he states that the opponent has “202 psychometric testing units internationally in the field, 22 of which are in the UK”. Therefore, I find it is reasonable to infer that not all of the opponent’s turnover is likely to pertain to the UK only. Nevertheless, even if all of the sales did pertain to the UK, the opponent has not provided me with any invoice evidence to support the above sales figures. I am therefore unable to determine the geographical spread of the mark in the UK.

79. Whilst the google analytics evidence shows that between 9 February 2011 and 15 February 2024, the opponent’s website has had 4.4 million page views, I find that over

a period of 13 years, this figure is not significant. The opponent has also not confirmed how many of these views resulted in sales, and the opponent's website is a .com site. This means it can be accessed worldwide, and, therefore, it is reasonable to assume that the 4.4 million views are not all from the UK.

80. Whilst the opponent has provided me with third party article evidence, I am unable to determine how many UK consumers were exposed to it when it was published in 2012 and 2013. Whilst the evidence shows that the opponent was also mentioned on a BBC programme and podcast, I have not been told to what extent the opponent was discussed, or in what capacity. I am also unable to determine how many UK consumers were exposed to these broadcasts. The social media evidence provided by the opponent is all undated, and therefore I am unable to determine how many followers the opponent had at the relevant date. Lastly, albeit I have been provided with advertising figures for 2019 to 2022, which amounted to £7,848, again, Mr Roy does not confirm whether these figures pertain to the UK. I also find that this advertising figure is relatively low.

81. Taking all of the above into account, I find that the opponent's evidence does not establish a reputation in the UK, and, without having found a reputation, the opposition based upon section 5(3) fails.

Section 5(4)(a)

82. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

83. Subsection (4A) of section 5 of the Act states:

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

84. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

85. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-

410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

86. The prima facie relevant date is the date of application in issue i.e. 18 April 2023. However, it is also necessary to consider what the position would have been at the start of the behaviour complained about.

87. In *Smart Planet Technologies, Inc. v Rajinda Sharma*, Case BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, pointed out that “the start of the behaviour complained about” is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when first offer was made to market the relevant goods or services under the mark. However, it could also be the date the first public facing indication was made that sales were proposed to be made under the mark in future. In this case, I find that the first public facing use of the applicant’s mark is the Wayback machine screenshot of the applicant’s “brainworx” website dated 18 November 2007.¹⁴

88. As a result of the above and bearing in mind the comments of Mr Alexander Q.C. in the case of *Advanced Perimeter Systems* (cited above), I will proceed to consider the position in respect of goodwill on 18 November 2007 (“the earlier relevant date”).

¹⁴ I also bear in mind that the case of *CASABLANCA*, Case BL O/349/16 makes it clear that it is not necessary for the applicant to have actually acquired goodwill in order for there to be an earlier relevant date.

In the event that goodwill exists, I will proceed to consider whether the position as at the filing date of the applicant's mark, being 18 April 2023 ("the later relevant date"), was any different. However, in the event that no goodwill existed as at the earlier relevant date, the opponent's claim will fail.

Goodwill

89. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start."

90. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence

must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

91. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

92. The first hurdle for the opponent is that they need to show that they had the necessary goodwill in the sign relied upon at the earlier relevant date. I remind myself that the opponent claims to have accrued significant goodwill in their mark “through continuous and consistent use since 2011”. However, the earliest evidence of use that the opponent has provided is the Tatler article evidence dated October 2012. Therefore, at the relevant date of 18 November 2007 (which is the first public-facing use of the applicant's mark), I do not have any evidence of the opponent using its mark on the relied upon goods and services listed in paragraph 6 above. On this basis, the opponent has failed to establish that they enjoyed any goodwill in their business at the earlier relevant date, and the opponent's reliance upon 5(4)(a) of the Act fails as, without goodwill, there can be no misrepresentation or damage.

CONCLUSION

93. The opposition is partially successful under section 5(2)(b) in respect of the following services, for which the application is refused:

Class 42 Providing online non-downloadable software for use in psychometric and psychological assessment, examination and testing.

94. The application can proceed to registration in respect of the following services for which the opposition has been unsuccessful:

Class 35 Retail services in connection with printed matter in the field of psychology, occupational therapy, speech and language therapy, and education; retail services in connection with printed psychometric tests; retail services in connection with printed matter containing tests, quizzes and puzzles; psychometric testing for the selection of personnel.

COSTS

95. In these proceedings, the applicant has enjoyed a slightly greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £550 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£150
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Considering the opponent's evidence and preparing and filing evidence	£250
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Preparing and filing submissions in lieu of a hearing	£150
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Total	£550
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96. I therefore order Symphonic Mind Ltd to pay Brainworx Limited the sum of £550. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 29th day of May 2025

L FAYTER

For the Registrar