O/0483/26

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS**

**IN THE MATTER OF APPLICATIONS**
**NOS. UK00003839078 AND UK00003839095**
**BY ODIN SPACE LIMITED**
**TO REGISTER:**

# ODIN Space

# Odin Space

**(SERIES OF TWO)**

**AND**

**(SERIES OF TWO)**

**AS TRADE MARKS IN CLASSES 9, 12, 35 AND 42**

**AND**

**IN THE MATTER OF THE OPPOSITIONS THERETO**
**UNDER NOS. 439399 AND 439400**
**BY ODINE INTERNATIONAL HOLDING UK LLP**

## BACKGROUND AND PLEADINGS

1. On 14 October 2022, ODIN Space Limited ("the applicant") applied to register the trade marks shown on the cover page of this decision, in the UK. The applications were accepted and published in the Trade Marks Journal on 25 November 2022 in respect of the following goods and services:[1]

> **Class 9:** *Satellites; Satellite processors; Satellite apparatus; Satellites for scientific purposes;* ***Recorded data files; Data recorded electronically; Data collection apparatus; Data processing systems; Data processing software; Data processing equipment; Data storage programs; Data processing programs; Apparatus for recording data; Risk detection software; Operational risk management software; Software; Software applications; Computer software; Industrial software; CAE software; Interactive software; Optimisation software; Science software; all the foresaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid being a remote-operated, counter-UAV or Targeted Electronic Interference integrated detection apparatus to mitigate air, land and sea threats in military operations; none of the aforesaid being computer programs or computer software for network management, network visualisation, fraud detection or voice management****.*
>
> **Class 12:** *Space vehicles; Vehicles (Space -); Air and space vehicles; Parts and fittings for air and space vehicles; all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations.*
>
> **Class 35:** ***Collection of data; Business risk management services; Risk management consultancy [business]; Business risk assessment***

[1] The specification in classes 9 and 35 was restricted following the opposition but as the opponent did not reply to the official letter of 19 June 2025 to confirm whether the amendment would allow the oppositions to be withdrawn, the case was passed to the hearings team to await the decision being issued.

***services; all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations.***

**Class 42:** ***Scientific analysis; Scientific research and analysis; Scientific risk assessment; Software creation;*** *Technological consultancy in the field of aerospace engineering; Technical consultation in the field of aerospace engineering;* ***all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations; none of the aforesaid being services for network management, network visualisation, fraud detection or voice management.***

2. On 27 February 2023, the applications were opposed by Odine International Holding UK LLP ("the opponent") based upon Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The opposition is partial, being directed against the goods and services in classes 9, 35 and 42 highlighted in bold.

3. Under Section 5(2)(b), the opponent relies on the following trade mark:

| UK00909896242[2]<br>ODINE<br>Filing date: 14 April 2011<br>Registration date: 16 September 2011<br><br>The opponent relies on some of the goods and services for which the mark is registered, namely: |
|---|

[2] The opponent's mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing IRs designating the EU. These comparable marks enjoy the same filing and registration dates as their European counterparts.

**Class 9:** *computer software; computer programmes for use in telecommunications; telecommunications equipment and devices; computer networks; computer programmes and programming languages; computer accessories; data recorded magnetically, electronically, or optically; instructional material relating to data, all recorded magnetically, optically or electronically.*

**Class 38:** *Telecommunications and broadcasting; providing telecommunications connections to the Internet and databases; telecommunications services on the world wide web; electronic communications services; communications services provided over the Internet; telephone services; computer aided transmission of messages, information and images; information, advisory and consultancy services in relation to all the aforesaid.*

**Class 42:** *Research, development and testing services relating to computer software and hardware, interactive communication design services; computer consultancy; advisory services relating to computer software; consultancy relating to computer software; consultancy services for analysing information systems; consultancy services relating to computer networks; consultancy services relating to computer programming; consultancy services relating to computer systems; consultancy services relating to information technology; consultancy relating to computer systems; software creation; computer software design; computer software consultancy; professional consultancy relating to data processing; development of computer software; computer software design; computer software development; computer software programming services; conducting feasibility studies relating to computer software; configuration of computer software; custom design of software packages; development of computer software application solutions; installation and maintenance of computer software; installation of computer software; leasing of computer software; software development; updating of computer software; writing of computer software; design of telecommunications apparatus and installations; research relating to telecommunication techniques; advisory, consultancy and information services in relation to all the aforesaid.*

4. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an "earlier mark" in accordance with Section 6 of the Act. The opponent's earlier mark

had been registered for more than five years at the filing date of the contested mark, and, as such, it is subject to the use conditions under Section 6A of the Act.

5. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are similar and the goods and services are identical or highly similar.

6. Under Section 5(4)(a), the opponent relies on the 2 signs shown below which it claims to have used throughout the UK since 2017 in relation *to Computer software; computer programs for use in telecommunications; telecommunications equipment and devices; software for telecommunications; computer accessories; telecommunications and broadcasting services; electronic communication services; research, development, testing, installation and updating of computer software; software as a service [SaaS]; platform as a service [PaaS]; voice transmission services; voice messaging and management software and services; telecommunications and computer integration software and services; fraud detection software; advice and information relating to all the aforesaid*:

ODINE

7. The applicant filed a defence and counterstatement in each opposition, denying the opponent's claims and putting the opponent to proof of use.

8. On 2 October 2024, the Registry directed under Rule 62 of the Trade Marks Rules 2008 that the proceedings be consolidated.

9. Both parties are represented, the opponent by Mathys & Squire LLP, the applicant by Dentons UK and Middle East LLP.

10. Only the opponent filed evidence during these proceedings. Neither party requested a hearing, but they both filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

**Relevance of EU Law**

11. 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**

12. The opponent's evidence came in the form of a witness statement from Firat Kerim Ersoy, a shareholder in the opponent's company, dated 2 December 2024. Mr Ersoy's witness statement is accompanied by 7 exhibits (being those labelled FKE1-FKE7).

13. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

**DECISION**

**Proof of use**

**Relevant statutory provision: Section 6A:**

> "(1) This section applies where
>
> > (a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

14. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union".

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:
(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

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

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

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation

has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

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

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

17. In *Awareness Ltd,* the Appointed Person said that:

"28. […] Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered […]."

18. The genuine use provision is not there to assess economic success or large-scale commercial use.[3] Further, an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[4]

19. Accordingly, the opponent can rely on its earlier trade mark only to the extent that the evidence filed establishes that it had been put to genuine use in the relevant territory in respect of the goods and services for which it is registered and which are relied upon within the five years leading up to the date on which the contested trade mark applications were filed. The relevant period in which the opponent must establish use of the earlier mark is **15 October 2017 to 14 October 2022.** Further, since the earlier mark is a comparable mark, the opponent can rely on genuine use in the EU

[3] *MFE Marienfelde GmbH v OHIM*, Case T-334/01.
[4] *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

until IP completion day (31 December 2020) whilst the UK is the only relevant territory from that date onwards.

20. The main criticism the applicant made in relation to the opponent's evidence is that *"there is no clear targeting whatsoever of customers in the UK".* The applicant also argues that the use shown does not relate to any of the goods and services relied upon here. Further, the applicant contends that even if invoices are provided there is no narrative or context, the only context being that the opponent allegedly provides highly specialised telecommunication goods and services, and it is not clear what goods or services have been sold. Other criticisms made by the applicant include that some of the evidence filed is outside the relevant period and/or does not relate to use within the relevant EU and UK territory.

21. Mr Ersoy provides the following evidence:

- The opponent is affiliated with a Turkish company called Odine Solutions Teknoloji Ticaret ve Sanayi A.Ş. (the "Turkish Company") and a UAE company called Odine Solutions FZ-LLC (the "UAE company").

- The earlier mark is used by the Turkish Company and UAE company with the consent of the opponent.

- The opponent specialises in telecommunications and provides goods and services relating to hardware and software, as well as design and maintenance of hardware and software, in the telecommunications field. The opponent's *"leading systems integration and software technology expertise delivers revolutionary solutions for Tier 1 SDN (software-defined networking), virtualization, and cloudification*". However, it is not explained what this means, and it is not clear from this statement what the opponent sells and who happens to be its customers.

- As the applicant correctly pointed out, aside from the reference to the opponent providing telecommunication services, Mr Ersoy's witness statement contains

no narrative which explains what goods and services the opponent markets under the earlier mark. Instead, Mr Ersoy exhibits various extracts from the opponent's website[5] which are meant to provide an overview of the opponent's business, leaving me to draw the relevant conclusions. However, the only conclusions I can reasonable reach are as follows:

(a) That the opponent's business target business users (I refer to the *text "we are working with leading organisations on cutting-edge projects transforming the industry"*).

(b) That the opponent provides some sort of cloud/migration services (I refer to the text "*Telco cloud journey: from network functions to holistic digital transformation*").

(c) That the opponent offers a service of digital transformation to businesses including the provision of cloud-based platforms and software including apps related to voice business management as shown by the extract I have reproduced below:

**Empowering your seamless digital evolution with...**

**Platforms**

We own and manage a private cloud infrastructure enabling PaaS/SaaS offerings for CSPs and Wholesale Voice Aggregators.

**Software**

We offer a suite of intelligent end-to-end wholesale voice business management applications.

[5] Exhibit FKE1-2

(d) Although the opponent provides the names of companies which are said to be among its customers (including UK consumers),[6] there is no information as to who has purchased the relevant goods and services during the relevant period or within the relevant territory. I say this because providing the names of customers does not establish what was sold to each customer and when.

- Mr Ersoy says that the opponent "*predominantly provides software in the telecommunications sector, to which access is provided to the opponent's customers for which* ***the customers are charged periodically****. In respect of this software, the opponent provides Platform as a [Software] services, and engineering services, such as a support and installation".* Extracts from the opponent's website at www.odine.com lists services such as network planning, implementation, integration and maintenance, network and IP design, migration services, cloud-based SMS platform, end-to-end wholesale voice Platform as a Service, legacy systems and network visualization as a service.

- Mr Ersoy says that goods and services sold by the opponent under the earlier marks have been sold in the UK and the EU since 2011.

- Mr Ersoy says that the opponent's goods and services are advertised and sold under or by reference to the earlier marks. He also says that the opponent's marks feature on, among other things: the opponent's website; invoices; the opponent's press releases and advertisements; documentation within the opponent's company including marketing reports; and in the general media, including in trade articles, online, and in magazines.

- Mr Ersoy says that the opponent's marks feature extensively on the opponent's website and that for the period November 2022-2024, there were 219,000 visitors to the website. Although this figure falls mostly within the relevant period, it is impossible to know what proportion of the total visitors were from the UK.

[6] Exhibit FKE2

- Mr Ersoy says that the opponent has invested heavily in the research and development of the opponent's goods and services offered under or by reference to the opponent's marks. Although Mr Ersoy provides details of the annual investment in research and development from 2017 until 2022 (which amounts to about $3.5million), there is no point in me repeating these details here. This is because whilst the evidence indicates that the opponent markets its goods and services outside the relevant UK and EU territory (including Pakistan, Türkiye and UAE)[7] it is not clear what proportion of this investment relates to goods and services which were marketed in the UK and EU.

- Mr Ersoy provides a selection of invoices.[8] He points out that a number of the opponent's clients are multinational corporations, and that whilst some invoices are issued to customers with head offices outside of the UK and EU, the goods and services provided extend to the opponent's clients' business offerings in the UK and EU. However, this point is not relevant here because all of the invoices which have been supplied are to UK consumers. There are 45 invoices in total, mostly dated within the relevant period for the following amounts (the amounts I list below count towards genuine use because they all come from invoices which fall within the relevant period): USD 33,000, USD 39,250, USD 38,500, USD 230,000, USD 60,000, USD 135,750, USD 46,331, USD 70,000, USD 8,000, USD 8,000, USD 7,000, USD 8,000, USD 8,000, USD 8,000, USD 4,000, USD 12,280, USD 5,555, USD 6,705, USD 7,280, USD 5,555, USD 6,705, USD 20,625, USD 6,705, USD 36,500, USD 36,500, USD 16,500, USD 27,500, USD 30,000, USD 30,000, USD 27,000, USD 27,000, USD 27,000, USD 27,000, USD 27,000, USD 27,000, USD 10,500, USD 10,500. This amounts to a total of USD 1,088,371 worth of goods and services sold in the UK within the relevant period.

  However, most of the goods or services on the invoices are not clearly identifiable. This is because they are described by terms that make no sense to me and there is nothing in the evidence which attempts to explain what they

[7] FKE1 page 13
[8] FKE4

are, for example *500vports-100047NEXT, 2000 DTMF 8 Audio Transcoding Sessions, Q21 Cluster with 2000 transcoding sessions HW & SW Support, Pelin Service fee May 2018, Burak Gokce - Service fee - December 2018, 7 days NOC & Technical Operations between 7AM and 10 PM UK time - March 2019.* I have no idea what these terms mean, and it is not my job to find out by going outside the evidence filed.

Nonetheless, some descriptions relate to terms which I clearly understand, such as *hardware, software, professional services, project management services, migration service assistance, network deployment design*, and *engineering services*.

- In terms of advertising, Mr Ersoy says that the opponent has exhibited at trade fairs in the UK and the EU during the relevant periods, including Capacity Europe (held in London in October 2021), GCCM London (14-15 March 2022), MWC 2019, Barcelona, all of which fall within the relevant period and were held in the relevant territory[9]. However, no further details are provided, in particular it is not said how many visitors attended those events or whether any of these participations resulted in the opponent gaining new contracts with UK or EU consumers.

- Details of UK and EU promotional spend are provided and are as follows:

| **Year** | **UK investment (US$)** | **EU investment (US$)** | **Total (US$)** |
|---|---|---|---|
| 2017 | 37,652 | 29,125 | 66,777 |
| 2018 | 44,783 | 32,458 | 77,241 |
| 2019 | 40,654 | 32,887 | 73,541 |
| 2020 | 34,899 | 30,477 | 65,376 |
| 2021 | 35,478 | N/A | 35,478 |
| 2022 | 142,548 | N/A | 142,548 |
| **Total** | **336,014** | **124,947** | **460,961** |

[9] Exhibit FKE5

- Details of UK and EU turnover are provided and are as follows:

| Year | UK sales (US$) | EU sales (US$) | Total (US$) |
|---|---|---|---|
| 2017 | 1,288,688 | 21,156 | 1,309,844 |
| 2018 | 1,346,315 | 13,711 | 1,360,026 |
| 2019 | 996,175 | 2,144 | 998,319 |
| 2020 | 1,377,272 | 86,484 | 1,463,757 |
| 2021 | 1,314,246 | N/A | 1,314,246 |
| 2022 | 1,503,068 | N/A | 1,503,068 |
| **Total** | **7,825,764** | **123,495** | **7,949,259** |

- Lastly, Mr Ersoy says that the opponent has won multiple awards, including "THE CLOUD INNOVATIVE AWARD" 2022 from CC Global Awards, being chosen by Deloitte as one of the most growing 50 companies in Turkey in 2020 and 2021, and listed as one of the best managed companies in Turkey in 2021.[10]

**Genuine use**

22. Whilst I bear in mind the applicant's criticisms, including that the opponent's website appears to be that of a Turkish telecommunication company and that *"there is no targeting of customers in the UK",* these criticisms are made redundant by the evidence about the invoices and the UK turnover and marketing figures (which is unchallenged). Given this evidence, which clearly shows a decent level of trade in the UK, the opponent did not have to provide specific evidence of targeting – the fact that the opponent is (or is affiliated with) a foreign company does not necessarily make the burden of proving use in the UK heavier.

23. In my view, whilst there are some issues around the nature of the goods and services sold to UK (and EU) consumers, the UK and EU level of turnover which is

[10] Exhibit FKE7

around USD 8 million (within the relevant period),[11] the UK and EU level of advertising which is around USD 400,000 (within the relevant period),[12] and the continuity of the use (all of which are unchallenged and supported by invoices, extracts from the website and marketing material), are such that the opponent has satisfactorily demonstrated genuine use of the earlier mark within the relevant period in the UK. However, the controversial point is, in my view, the notional fair specification, to which I now turn.

**Fair specification**

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

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

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

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in

[11] EU figures up to IP completion date
[12] EU figures up to IP completion date

relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

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

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

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

26. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the CJEU that that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

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

28. Although some descriptions of the goods and services which have been sold to UK consumers (as documented by the invoices) are opaque, the extracts from the opponent's website[13] are helpful insofar as they shed some light on what are the main goods and services which the opponent offers under the earlier mark. In this connection, I agree with the summary provided by the applicant in its submissions in lieu which sets out the opponent's main offering as being the following:

- Systems: **Systems integration** with a deep focus on Tier-1 Network Function Virtualization
- Platforms: **Private cloud infrastructure enabling PaaS/SaaS offerings for CSPs and Wholesale Voice Aggregators**
- Software: Intelligent end-to-end wholesale **voice business management applications**
- Experts: Outsourcing of **network planning, implementation and management**

29. In addition, the exhibits refer to the opponent's goods and services benefitting telecoms, which I understand are telecommunications companies. They also refer to tools and solutions for the international voice market, though I am not sure what this is. Another point which emerges from the exhibits is that the opponent integrates automation and AI into the consumer's technology architecture and provides services relating to virtualization (i.e. helping businesses to virtualise their offering), cloudification (migrating the consumer's services to a cloud) and network service consolidation (using hardware, software and cloud to connect the consumer's infrastructure).

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[13] FKE6

30. Lastly, the exhibits talk about the benefits of telecoms providers not outsourcing their entire network infrastructure but developing their own private cloud or hybrid network where public and private cloud co-exist. In this connection, the exhibits refer to the opponent helping telecoms to (a) orchestrating their own private and hybrid network architecture; (b) supporting digital transformation; (c) providing systems integration, technology and infrastructure, software development and innovation for the digital transformation of telecoms.

31. Further, the exhibits mention the wholesale market of telecoms which I understand refers to the sale of telecommunication services to Internet Service Providers (ISPs) and resellers, enabling them to offer high-speed internet, voice, and data services without the need to build their own networks.

32. Based on the above, I think it is reasonable to conclude that the main services offered by the opponent are network virtualisation and cloud-solutions for telecommunication companies.

33. Although the invoices and the website refer to the opponent's offering including software, Mr Ersoy states that the software is provided to the opponent's customers as a service because the customers are charged periodically and states "*in respect of this software, the opponent provides Platform as a Service services, and engineering services, such as a support and installation*". This means that the opponent does not sell software as goods (class 9) but provides it as a service (class 42).

34. Lastly, extracts from the opponent's website at www.odine.com lists services such as network planning, implementation, integration and maintenance, network and IP design, migration services, cloud-based SMS platform, end-to-end wholesale voice Platform as a Service, legacy systems and network visualization as a service.

35. I will now attempt to frame a fair specification based on the opponent's main offering, as painted by the evidence (as the turnover is not broken down by product).

**Class 9**

36. The opponent's mark in class 9 is registered for the following:

> **Class 9:** *computer software; computer programmes for use in telecommunications; telecommunications equipment and devices; computer networks; computer programmes and programming languages; computer accessories; data recorded magnetically, electronically, or optically; instructional material relating to data, all recorded magnetically, optically or electronically.*

37. First, in terms of goods in class 9, as I have explained, the evidence indicates that the opponent provides software as a service – this would fall in class 42 not in class 9. Accordingly, the opponent has not shown genuine use for any of the registered software goods in class 9.

38. Second, although the opponent's offering include support for businesses in relation to network virtualisation, this is not the same as providing *computer networks.* A computer network is a group of two or more independent computers and devices connected to share data, resources, and services. There is no evidence that the opponent sells computers or IT devices. But even if I am wrong, and the opponent actually provides these goods as part of its services, there is no evidence that the goods are sold under the earlier mark (in the same manner as an electrician who might build an electrical system might also supply the relevant cables, but the cables are manufactured by the electrician). Further, the turnover is not broken down by product, and, consequently, even if the opponent did provide *computer networks,* it is impossible to know what proportion of the turnover relates to it; in any event computer network does not appear to be the opponent's main offering (as opposed to the services of building or integrating the network).

39. As regards the other goods, namely *telecommunications equipment and devices; computer programmes and programming languages; computer accessories; data recorded magnetically, electronically, or optically; instructional material relating to data, all recorded magnetically, optically or electronically,* there is no evidence of use.

40. Accordingly, I find that the opponent cannot rely on any of the registered goods in class 9.

**Class 38**

41. The opponent's mark in class 38 is registered for the following:

> *Telecommunications and broadcasting; providing telecommunications connections to the Internet and databases; telecommunications services on the world wide web; electronic communications services; communications services provided over the Internet; telephone services; computer aided transmission of messages, information and images; information, advisory and consultancy services in relation to all the aforesaid.*

42. It is relatively clear that the opponent's main offering consists of helping telecommunication companies to modernise their digital infrastructure transforming their legacy or traditional networks into cloud-based, automated and software-based systems. The opponent also provides services consisting of designing, building and deploying these new architectures/infrastructures. This in my view equate to providing business to business telecommunication and network infrastructure services. Accordingly, a fair specification in class 38 is in my view as follows:

> *Telecommunication network services; information, advisory and consultancy services in relation to all the aforesaid.*

**Class 42**

43. The opponent's mark in class 42 is registered for the following:

> **Class 42:** *Research, development and testing services relating to computer software and hardware, interactive communication design services; computer consultancy; advisory services relating to computer software; consultancy relating to computer software; consultancy services for analysing information systems; consultancy services relating to computer networks; consultancy*

*services relating to computer programming; consultancy services relating to computer systems; consultancy services relating to information technology; consultancy relating to computer systems; software creation; computer software design; computer software consultancy; professional consultancy relating to data processing; development of computer software; computer software design; computer software development; computer software programming services; conducting feasibility studies relating to computer software; configuration of computer software; custom design of software packages; development of computer software application solutions; installation and maintenance of computer software; installation of computer software; leasing of computer software; software development; updating of computer software; writing of computer software; design of telecommunications apparatus and installations; research relating to telecommunication techniques; advisory, consultancy and information services in relation to all the aforesaid*

44. Turning to the services in class 42, since the opponent provides highly specialised IT services in relation to transformation of legacy systems as well as network virtualisation and cloud-solutions for telecommunication companies, it must also provide computer consultancy and IT design services in relation to them. Accordingly, I find that a fair specification in class 42 is as follows:

*computer consultancy; advisory services relating to computer software; consultancy relating to computer software; consultancy services relating to computer networks; consultancy services relating to computer systems; consultancy services relating to information technology; consultancy relating to computer systems; software creation; computer software design; computer software consultancy; development of computer software; computer software design; computer software development; computer software programming services; configuration of computer software; custom design of software packages; development of computer software application solutions; installation and maintenance of computer software; installation of computer software; leasing of computer software; software development; updating of computer software; writing of computer software; design of telecommunications apparatus and installations; advisory, consultancy and information services in*

*relation to all the aforesaid; all related to the provision of telecommunication network and cloud-solutions.*

**Section 5(2)(b)**

45. Section 5(2)(b) of the Act 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."

46. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

> (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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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**

47. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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."

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

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

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

49. 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 General Court ("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 that the responsibility for those goods lies with the same undertaking."

50. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited,* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

51. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

52. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

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

53. The competing goods and services are as follows:

| **The applicant's goods and services** | **The opponent's services** |
|---|---|
| **Class 9:** ***Recorded data files; Data recorded electronically; Data collection apparatus; Data processing systems; Data processing software; Data processing equipment; Data storage programs; Data processing programs; Apparatus for recording data; Risk detection software; Operational risk management software; Software; Software applications; Computer software; Industrial software; CAE software; Interactive software; Optimisation software; Science software; all the foresaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid being a remote-operated, counter-UAV or Targeted Electronic Interference integrated detection apparatus to mitigate air, land and sea threats in military operations; none of the aforesaid being computer programs or*** | |

| | |
|---|---|
| ***computer software for network management, network visualisation, fraud detection or voice management*.** | |
| **Class 35: *Collection of data; Business risk management services; Risk management consultancy [business]; Business risk assessment services; all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations.*** | |
| | **Class 38:** *Telecommunication network services; information, advisory and consultancy services in relation to all the aforesaid.* |
| **Class 42: *Scientific analysis; Scientific research and analysis; Scientific risk assessment; Software creation; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations; none of the aforesaid being services for network management, network visualisation, fraud detection or voice management.*** | **Class 42:** *computer consultancy; advisory services relating to computer software; consultancy relating to computer software; consultancy services relating to computer networks; consultancy services relating to computer systems; consultancy services relating to information technology; consultancy relating to computer systems; software creation; computer software design; computer software consultancy; development of computer software; computer software design; computer software development; computer software programming* |

| | |
|---|---|
| | *services; configuration of computer software; custom design of software packages; development of computer software application solutions; installation and maintenance of computer software; installation of computer software; leasing of computer software; software development; updating of computer software; writing of computer software; design of telecommunications apparatus and installations; advisory, consultancy and information services in relation to all the aforesaid; all related to the provision of telecommunication network and cloud-solutions.* |

**Class 9:** *Recorded data files; Data recorded electronically; Data collection apparatus; Data processing systems; Data processing software; Data processing equipment; Data storage programs; Data processing programs; Apparatus for recording data; Risk detection software; Operational risk management software; Software; Software applications; Computer software; Industrial software; CAE software; Interactive software; Optimisation software; Science software; all the foresaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid being a remote-operated, counter-UAV or Targeted Electronic Interference integrated detection apparatus to mitigate air, land and sea threats in military operations; none of the aforesaid being computer programs or computer software for network management, network visualisation, fraud detection or voice management.*

54. The closest comparison I can see here is between the applied-for software and the opponent's software related services in class 42. However, the software concerned in the respective specifications are different type of software, the opponent's software services relating to the provision of telecommunication network and cloud-solutions,

the applicant's software goods being for use in connection with space debris, meteorites, space weather and other space environmental conditions. Consequently, although the opponent's services relate to software, it is a different type of software compared to the applied-for software, plus, the software concerned are highly specialised and belong to completely different fields of activity (i.e. space debris, meteorites, space weather and other space environmental conditions versus telecommunication network and cloud-solutions). Hence, the nature, purpose and method of use of the goods and services are different, the uses and users of the goods and services are different, the goods and services will be distributed through different trade channels and are neither complementary nor in competition**.** These goods and services are **dissimilar.** The opponent's case is even worse in relation to the other goods in class 9 which are not software goods.

**Class 35:** *Collection of data; Business risk management services; Risk management consultancy [business]; Business risk assessment services; all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations.*

55. The same goes for the applied-for services in class 35 which are business services for use in connection with space debris, meteorites, space weather and other space environmental conditions. These services have nothing to do with the opponent's services in class 38 which are telecommunication network services, and 42 which are computer and software consultancy, design and development services related to the provision of telecommunication network and cloud-solutions. The nature, purpose and method of use of the goods and services are different, the uses and users of the goods and services are different, the goods and services will be distributed through different trade channels and are neither complementary nor in competition. These services are **dissimilar.**

**Class 42:** *Scientific analysis; Scientific research and analysis; Scientific risk assessment; Software creation; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations; all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions;*

*none of the aforesaid being services for network management, network visualisation, fraud detection or voice management.*

56. First, although the parties' services are both in class 42, the limitation *all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions* (in the applications) means that these services belong to a different field of activity compared to the opponent's class 42 services which are restricted to the field of telecommunication network and cloud-solutions.

57. Second, the applied-for *Scientific analysis; Scientific research and analysis; Scientific risk assessment* being restricted to space debris, meteorites, space weather and other space environmental conditions cannot include services provided in connection with the development and design of computer systems, network and software (which is what the opponent's fair specification in class 42 covers). These services are dissimilar, as the nature, purpose and method of use of the services is different, the services target different users, have different uses, do not share trade channels and are neither complementary nor in competition. These services are **dissimilar.**

58. This leaves *software creation*. Whilst I recognise that the opponent's *software creation* relates to a type of software that is different from that of the applied-for *software creation*, the respective services being restricted to different fields by virtue of the limitations *all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions* (in the applications) and *all related to the provision of telecommunication network and cloud-solutions* (in the opponent's fair specification), nonetheless, the services share the same nature, all being software creation services. Further, whilst the users of the opponent's services are in the real world limited to telecommunication companies, this is not reflected in the fair specification I devised, so there could theoretically be a scenario whereby a company operating in the field of space would seek both software creation in respect of its field of activity (i.e. the applied for software creation) and software creation to upgrade its network architecture (i.e. the opponent's software creation), which means that the users might coincide. In addition, a company specialising in software creation is likely to have the competences for creating different types of software, so the trade

channels might coincide. Overall, I consider these services to be similar to **a low to medium degree.**

**Conclusion on the similarity of the goods and services**

59. As some degree of similarity between the respective goods and services is a prerequisite for assessing the likelihood of confusion under the present ground,[14] a finding of no similarity means the opposition must fail in relation to the goods and services in class 9, 35 and 42 which I have found to be dissimilar.

**Average consumer**

60. 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: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

61. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average

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

consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

62. The average consumer of the class 42 services at issue will be a business user.

63. The services are likely to be selected from websites and advertising or promotional materials. Consequently, visual considerations will dominate the selection process. However, since the nature of the services demands personal dealings between the consumer and the provider of the service, I do not discount an aural component to the purchase.

64. Given that the level of investment required is likely to be significant, and that the services at issue are highly technical and specialised, the level of attention to the selection of the provider of the services at issue will be medium to high.

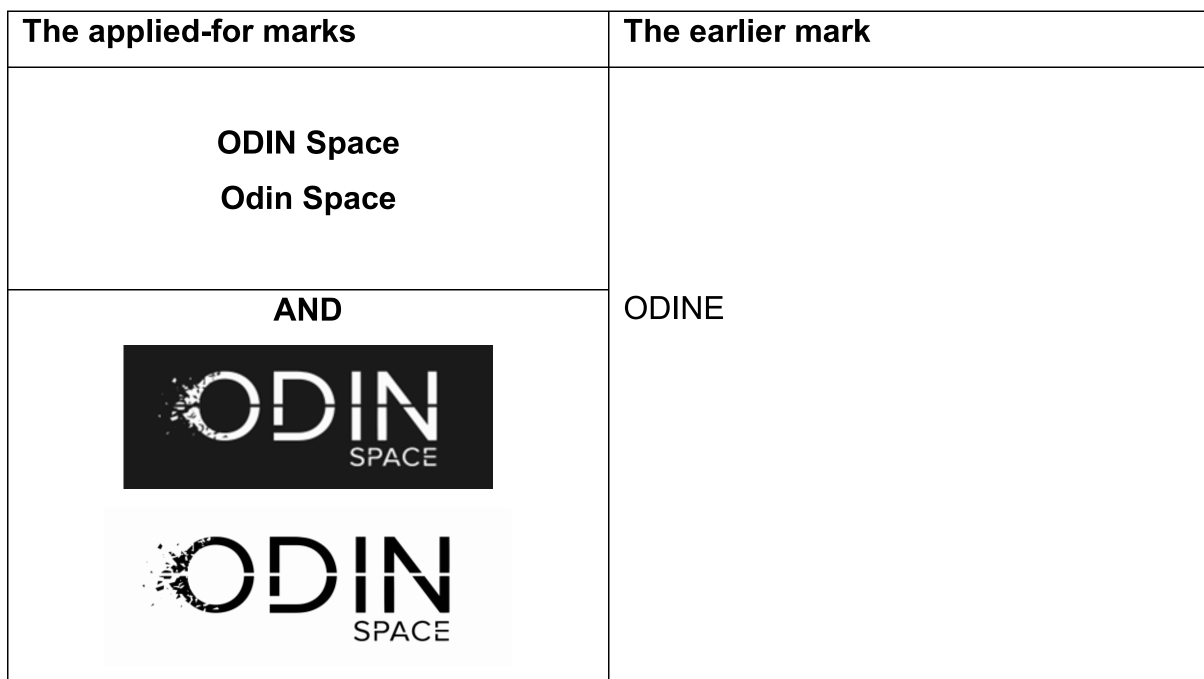
**Comparison of marks**

65. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

66. 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. The respective marks are shown below:

| **The applied-for marks** | **The earlier mark** |
| --- | --- |
| **ODIN Space**<br>**Odin Space** | ODINE |
| **AND**<br> | |

67. The earlier mark consists of the word 'ODINE' presented in capital letters in a standard font. As it is the only element of the mark, it is where the distinctiveness of the mark resides.

68. The marks in the contested first series consists of the words 'ODIN' and 'Space', in a standard font. The word 'ODIN' is the first element of the mark where consumers attention tends to focus; it is also more distinctive than the word 'Space' due to it being an invented word. However, although the word 'Space' is descriptive for the services at issue, it is not invisible and will still contribute to the overall impression but to a much lesser degree.

69. Similar considerations apply to the contested second series, the only difference being that the word 'ODIN' is even more prominent due to its size and placement above/on top of the smaller word "SPACE". In this connection, whilst the letter 'O' in 'ODIN' is slightly stylised it is still perfectly legible and the effect of the horizontal line cutting through the letters is nearly negligible.

**Visual similarity**

70. Visually, comparing the opponent's 'ODINE' mark and the applied-for 'ODIN Space' first series of marks, both marks are word-only marks and therefore, notional use of them covers presentation in all casing and fonts. The only difference between the word 'ODIN' in the application and the word 'ODINE' in the opponent's mark is the presence of the last letter 'E' in opponent's mark. The marks coincide in four out of five letters and their position. Bearing in mind that consumers attention tends to focus on the beginning of the marks (or words) and that the only difference between the words 'ODINE' and 'ODIN' is placed at the end of 'ODINE', these words are visually similar to a very high degree. The word 'Space' is a point of visual difference, but it is descriptive and so will be given little or no weight. Overall, I consider these marks to be visually similar to a medium to high degree.

71. Turning to the second series, the stylisation adds a small difference which is counterbalanced by the size of the shared element 'ODIN' which is bigger. Overall, I consider these marks to be still visually similar to a medium to high degree.

### Aural similarity

72. Aurally, the word 'ODIN' and 'ODINE' are both invented. I think that a significant proportion of the average consumer will drop the final 'E' when pronouncing 'ODINE' so that these elements of the marks will be pronounced identically. I also think that an equally significant proportion of the consumers will articulate the final 'E' in 'ODINE' in which case 'ODIN' and 'ODINE' are similar to a very high degree. The word 'Space' is a point of aural difference, but it is descriptive in relation to the applied-for services (which are for use in connection with space debris, meteorites, space weather and other space environmental conditions). If the descriptive element 'Space' is pronounced[15] these marks are aurally similar to a medium to high degree, whereas if it is omitted,[16] they are aurally similar to a very high degree (or identical if 'ODIN' and 'ODINE' are pronounced identically).

### Conceptual similarity

73. Conceptually, both words 'ODIN' and 'ODINE' are invented words with no meaning. Consequently, a conceptual comparison based on these elements is not possible. However, although the word 'Space' in the applications introduces a conceptual difference insofar as it has no counterpart in the earlier mark, it is not a distinctive one.

### Distinctive character of the earlier mark

74. 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

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[15] Purity Hemp Company Improving Life as Nature Intended BL-O/115/22
[16] Enrich Learning BL-O/0006/26

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)."

75. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

76. The word 'ODINE' in the earlier mark will be perceived as invented and highly distinctive. Whilst there is some evidence of turnover, marketing and use in the UK, it is far from showing that the distinctiveness of the earlier mark has been enhanced to any material degree. I say this because whilst a UK turnover of USD 7.8million is not insignificant it is spread over a 6 year period and given the high cost of the services as shown by the invoices, the turnover appears to be low, plus there is no indication of market share and the use shown does not appear particularly long standing the first measurable and documented use being the turnover from 2017.

**Likelihood of confusion**

77. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

78. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

79. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in Cheeky Italian Ltd v Sutaria (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

80. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

81. Earlier in this decision I found that:

- The applicant's mark and the opponent's earlier mark are visually similar to a medium to high degree, aurally identical or similar to a medium to high degree. Conceptually there is difference but is a non-distinctive one. However, the shared elements 'ODIN' and 'ODINE' are visually very highly similar and aurally

identical or very highly similar, whilst being invented words they cannot be compared conceptually.

- *Software creation* in class 42 is similar to a low to medium degree to the opponent's services.

- The average consumer will select the services mainly visually, with a medium to high degree of attention.

- The earlier mark is inherently distinctive to a high degree. The evidence filed by the opponent is insufficient to establish that the distinctiveness of the earlier mark has been enhanced to any material extent.

82. In my view, the similarity between the shared elements 'ODIN' and 'ODINE' in the respective marks is sufficiently strong to warrant a finding of direct confusion when similar services are involved. I say this because (1) the presence of the limitation *all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions* to the class 42 services means that the word 'SPACE' in the applications is wholly descriptive and would be easily overlooked and (2) the letter "E" at the end of the opponent's mark would be easily misremembered or mis-recollected due to the effect of imperfect recollection. Hence, in those circumstances, it would be easily foreseeable for the consumer to directly confuse the marks. If I am wrong and the consumer will not overlook these elements, imperfect recollection is still likely to cause the average consumer misremembering or mis-recalling the elements 'ODIN/ODINE' and perceiving the differences between the marks as indicating a brand variant rather than having independent trade mark significance, giving raise to indirect confusion.

83. There is a likelihood of confusion in relation to the objected *software creation* services in class 42.

**Section 5(4)(a)**

84. 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".

85. 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."

86. 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)."

87. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation[1] among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source[2] or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant Date

88. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O/410/11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, 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.' "

89. Since there is no evidence filed to show any earlier use of the applications as such, the relevant date for the purposes of the opponent's claim under the Section 5(4)(a) ground is the application date, being 14 October 2022.

**Goodwill**

90. The first hurdle for the opponent is to show that it had the necessary goodwill in its signs at the relevant date and that the signs relied upon were distinctive of or associated with that goodwill.

91. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

> "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 custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

92. Under this ground, the opponent relies upon two signs, one which is identical to the earlier word mark, and one that incorporates the word 'ODINE' in a logo format.

93. I can deal with this ground very briefly. For the same reasons I found that the earlier mark has been genuinely used, I find that the opponent has established a sufficient goodwill in the UK to sustain an action for passing off for some of the services relied upon, namely *telecommunications network services; research, development, testing, installation and updating of computer software; software as a service [SaaS]; platform as a service [PaaS]; voice transmission services; voice messaging and management software and services; telecommunications and computer integration software and services.* However, similarly to what I found under Section 5(2)(b), the services in relation to which goodwill subsists are related to the provision of telecommunication network and cloud-solutions. I find that these services are essentially identical to those for which I have found genuine use and so the comparison of goods and services I have conducted under Section 5(2)(b) equally

applies here. In terms of the marks, the figurative mark the opponent relies upon under this ground is further apart from the word-only mark which is also relied upon under Section 5(2)(b) so it adds nothing to the opponent's case.

94. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

> "… if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."

95. Although this was an infringement case, the principles apply equally under Section 5(2): see Soulcycle Inc v Matalan Ltd, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that *"a substantial number"* of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises,* it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. Accordingly, the opposition based on Section 5(4)(a) succeeds to the same extent as that under Section 5(2)(b).

**OUTCOME**

96. The oppositions have been partially successful. The contested marks UK00003839078 and UK00003839095 will proceed to registration for the following goods and services which are either not objected, or have survived the oppositions:

**Class 9:** *Satellites; Satellite processors; Satellite apparatus; Satellites for scientific purposes; Recorded data files; Data recorded electronically; Data collection apparatus; Data processing systems; Data processing software; Data processing equipment; Data storage programs; Data processing programs; Apparatus for recording data; Risk detection software; Operational risk management software; Software; Software applications; Computer software; Industrial software; CAE software; Interactive software; Optimisation software; Science software; all the foresaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid being a remote-operated, counter-UAV or Targeted Electronic Interference integrated detection apparatus to mitigate air, land and sea threats in military operations; none of the aforesaid being computer programs or computer software for network management, network visualisation, fraud detection or voice management.*

**Class 12:** *Space vehicles; Vehicles (Space -); Air and space vehicles; Parts and fittings for air and space vehicles; all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations.*

**Class 35:** *Collection of data; Business risk management services; Risk management consultancy [business]; Business risk assessment services; all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations.*

**Class 42:** *Scientific analysis; Scientific research and analysis; Scientific risk assessment; Technological consultancy in the field of aerospace engineering; Technical consultation in the field of aerospace engineering; all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations; none of the aforesaid being*

*services for network management, network visualisation, fraud detection or voice management.*

97. However, the contested marks UK00003839078 and UK00003839095 will be refused for the following services in relation to which the oppositions have been successful:

**Class 42:** *Software creation; none of the aforesaid for use in the mitigation of air, land and sea threats in military operations; all the aforesaid for use in connection with space debris, meteorites, space weather and other space environmental conditions; none of the aforesaid being services for network management, network visualisation, fraud detection or voice management.*

**COSTS**

98. Although the applicant has achieved a larger measure of success, I consider that the awards of costs should not be measured on the basis of the number of terms in relation to which each party has been successful. Accordingly, I order each party to bear their own costs.

**Dated this 8th day of June 2026**

**TERESA PINTO**
**For the Registrar**