O/0498/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. 3668640

BY

PRAXIS42 LTD

AND OPPOSITION THERETO UNDER NO. 430604

BY

SHINEVISION LTD

AND

IN THE MATTER OF TRADE MARK REGISTRATION NO. 2563951

IN THE NAME OF SHINEVISION LTD

AND

AN APPLICATION FOR REVOCATION THEREOF UNDER NO. 504481

BY

PRAXIS42 LTD

AND

IN THE MATTER OF TRADE MARK REGISTRATION NO. 3420149

IN THE NAME OF PRAXIS42 LTD

AND AN APPLICATION FOR INVALIDATION THEREOF UNDER NO. 505266

BY

SHINEVISION LTD

Background and Pleadings

1. There are three sets of actions involved in these consolidated proceedings namely (i) an opposition brought by ShineVision Ltd ("Shinevision") against trade mark application no. 3668640, filed by Praxis42 Ltd ("Praxis"); (ii) an application for revocation brought by Praxis against trade mark registration no. 2563951 owned by Shinevision; and (iii) an application for invalidation brought by Shinevision against trade mark registration no. 3420149 in the name of Praxis.

*(i) The opposition (*430604*) against Praxis's trade mark application no. 3668640*

2. On 14 July 2021, Praxis applied to register the trade mark application no. 3668640 for the word SHINE ("the '640 mark") in the UK. The application was published for opposition purposes on 29 October 2021. Registration is sought for services in class 42, which will be outlined in full later in my decision.[1]

3. On 28 January 2022, Shinevision filed opposition proceedings based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). For the purposes of its opposition under section 5(2)(b), Shinevision relies upon the following trade marks:

(i) UKTM no. 3186713 ("the '713 mark")

shineVision

Filed on 20 September 2016 and registered on 23 December 2016 for goods and services in classes 9 and 42.

(ii) UKTM no. 2563951 ("the '951 mark")

shine

Filed on 11 November 2010 and registered on 4 March 2011, for goods and services in classes 9 and 42.

[1] After the hearing, Praxis filed an amended specification by way of form TM21B initially dated 28 January 2024 and further amended on 11 March 2024 limiting its class 42 services to relate to the fields of education and training. Shinevision did not consider that this restriction made any material difference to the opposition given the broad nature of the terms and the opposition/invalidation actions were maintained. This is the relevant specification under consideration.

4. Both these marks stand registered for the same list of goods and services namely:

Class 9: Health and Safety, Risk Management software packages, products, programmes and applications.

Class 42: Software creation, design, development, installation, maintenance and computer programming in the area of Health and Safety, Risk Management.

5. Under section 5(2)(b), Shinevision contends that the respective marks are similar and the goods/services are either identical or similar such that would lead to a likelihood of confusion.

6. For the purpose of its opposition under section 5(4)(a), Shinevision relies upon its unregistered sign SHINE which it claims it has used throughout the UK since 2009 for "*the provision of software, advisory services, IT services, consultancy and training services in the field of health and safety, risk management and compliance*."[2] Shinevision claims that use by Praxis of the '640 mark would amount to passing off.

7. Praxis filed a defence and counterstatement denying the grounds of opposition and putting Shinevision to strict proof of its claims as well as requesting that it show proof of use of its '951 mark.

(ii) *The application for revocation (504481) of Shinevision's '951 mark*

8. On 6 January 2022, Praxis filed an application seeking to revoke Shinevision's '951 mark (as set out above) on the grounds of non-use under section 46(1)(b) of the Act, for the period 4 January 2017 to 4 January 2022[3] with an effective date of revocation sought from 4 January 2022.

9. Shinevision filed a defence and counterstatement defending use of its mark. It does not accept that the use was suspended for an uninterrupted period of 5 years as claimed.

[2] See paragraph 17 of its statement of grounds.
[3] Strictly speaking the end date of the relevant period should have been pleaded as 3 January 2022, however, this makes little difference given that Praxis sought revocation from 4 January 2022.

(iii) *application for invalidation (505266) of Praxis' trade mark registration number 3420149*

10. On 22 July 2022, Shinevision issued invalidation proceedings against Praxis' trade mark as set out below:

> UKTM no. 3420149 ("the '149 mark")
>
> SHINE
>
> Filed on 9 August 2019.
>
> Registered on 8 November 2019.
>
> Class 41: Provision of online training; Training services.

11. Shinevision's invalidation action was brought under sections 47 and sections 5(2)(b) and 5(4)(a) of the Act, relying on its '713 and '951 marks and its unregistered sign SHINE as aforesaid and for the same reasons as advanced in its opposition.

12. Praxis filed a defence and counterstatement denying the claims, putting Shinevision to strict proof and requesting that it provide proof of use of its '951 mark.

13. The revocation and opposition proceedings were consolidated on 6 June 2022 and the invalidation action was consolidated to the two other proceedings on 10 February 2023.

14. The trade marks upon which Shinevision relies for the purposes of its opposition and invalidation actions qualify as earlier marks pursuant to section 6 of the Act. In so far as the opposition proceedings are concerned, given that its '951 mark completed its registration process more than 5 years before the filing dates of the '640, it is subject to the proof of use requirements under section 6A of the Act. Shinevision's '713 mark, however, is not subject to the proof of use requirements in the opposition proceedings and therefore Shinevision may rely on all the goods and services of this registration in these proceedings without having to show what use it has made of this mark. For the purpose of the invalidation action, strictly speaking, the '713 mark is subject to the proof of use requirements under section 47(2B), as it was registered more than five years before the date the invalidation action was commenced (although not the filing date of the application itself). Praxis did not require Shinevision to demonstrate use of its '713 mark, however.

Representation

15. Praxis is represented by Birkett Long LLP and Shinevision is represented by Ward Hadaway LLP. Both parties filed evidence and submissions during the evidence rounds. A hearing was requested which was heard before me on 17 January 2024, via video conference. Mr Ian Silcock (counsel), instructed by Birkett Long LLP, appeared for Praxis and Ms Kendal Watkinson (counsel), instructed by Ward Hadaway LLP, appeared on behalf of Shinevision.

Evidence and Submissions

16. Shinevision's evidence in chief consists of the witness statements of:

i. Lee Taylor dated 27 May 2022 accompanied by six exhibits marked LT1-LT6.

ii. Mathew Curran dated 1 June 2022 accompanied by three exhibits marked MC1-MC3.

iii. Richard Dunigan dated 27 May 2022 accompanied by one exhibit marked RD1.

iv. Mathew Mixture dated 26 May 2022 accompanied by one exhibit marked MM1.

v. Second witness statement of Lee Taylor dated 4 August 2022 accompanied by thirteen exhibits marked Exhibits LTA-LTM.

17. These statements were accompanied by written submissions dated 8 August 2022.

18. The purpose of Shinevision's evidence is to show the use of its '951 mark and the goodwill and the enhanced distinctive character it claims to hold. It also serves to refute the challenges made by Praxis to its evidence. I shall return to assess this evidence at the appropriate stage of my decision.

19. Praxis's admitted evidence in chief consists of the witness statement of Tom Paxman dated 20 January 2023 accompanied by ten exhibits marked A-J. His statement was accompanied by written submissions of the same date.

20. The main purpose of Mr Paxman's statement is to challenge Shinevision's claim that it was using the '951 mark or the word Shine solus after 2016. Included within his statement is a report conducted by Praxis' representative investigating Shinevision's social media and internet activity (or as claimed, the lack thereof).[4] It claims that Shinevision had abandoned its use of the word SHINE solus (either in plain text or in its figurative form). To support this contention, a great number of screenshots are produced taken from Shinevision's website, social media accounts and searches on other media platforms which it is said have generated nil results of any activity under the '951 mark. Over a hundred pages of screenshots taken from Shinevision's Facebook and Twitter accounts are produced under the handles 'ShineVision' and '@shinevisionnow' and as follows:[5]

21. In so far as Shinevision's Twitter account is concerned, Mr Paxman states that he has produced every single tweet made by Shinevision since January 2017 and upon reviewing each and every post, he can find no instances of either 'shine' or shine being used or referred to. The screenshots do, however, show use of 'shineVision' in plain text and in its figurative form throughout. I shall return to the assessment of genuine use and whether the form in use is acceptable at the appropriate stage of the decision.

22. Both parties filed evidence in reply. Shinevision's evidence consisted of the third witness statement of Lee Taylor, dated 12 June 2023, accompanied by thirty six exhibits marked LT1-LT36. Praxis' evidence in reply consisted of the second witness statement of Tom Paxman, dated 11 May 2023, accompanied by three exhibits marked TP1-TP3.

23. Both parties filed skeleton arguments prior to the hearing. Whilst I do not propose to summarise the statements or submissions in full here, I have taken them all into

[4] Exhibit C.
[5] Exhibit H.

account when coming to my decision and shall refer to any salient points at the appropriate stage of my decision.

Relevance of EU Law

24. 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.

Preliminary issues

Praxis' evidence

25. Whilst Praxis pleaded a defence of honest concurrent use in its TM8 form, it withdrew reliance on this defence at the hearing. Mr Silcock explained that the evidence of use relating to its '640 mark since 2019 had been submitted, in order to show that no confusion had occurred between the parties over the period that both had been using their respective marks. I shall return to this position later in my decision.

Excess Evidence

26. When Praxis originally filed its evidence, it exceeded the 300 page allowance as set out in Tribunal Practice Notice 1/2015 ("TPN"). Praxis was directed to reduce its evidence and a Case Management Conference ("CMC") was requested to challenge this decision. The decision to refuse the request was upheld and a letter was sent subsequent to the CMC confirming that decision with reasons. I adopt those reasons here.

Change of name from Msycdo Ltd to Shinevision Ltd

27. In so far as the change of name of the company is in issue, whilst Praxis accepted that the name of the company had changed in 2016, it says that it was not until 22 January 2022 that it registered the change of name with the Registry. This it says is evidence that Shinevision had abandoned the mark. This argument has little merit, however, given that despite the change of name the legal entity responsible for the

trade mark is the same with no suggestion that there has been an assignment or a break in the chain of corporate responsibility. There is no obligation on a proprietor to notify the registry of a change of corporate name within a certain deadline. I shall proceed to assess the evidence of use shown by Shinevision which will include any use under the name Msycdo Ltd.

Decision

My Approach

28. Due to the overlap in issues for which Shinevision filed evidence, it seems appropriate to start my assessment by considering whether Shinevision can show genuine use of the '951 mark. Consequently, I shall start with the revocation action first. However, for the avoidance of doubt even if the revocation action is successful, technically Shinevision will still be able to rely on its '951 mark as an earlier right. This is because if revoked the '951 mark will still be deemed a valid registration up until the effective date of revocation.

Revocation

29. Section 46 of the Act states:

> "46. - (1) The registration of a trade mark may be revoked on any of the following grounds-
>
> (a) […]
>
> (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
>
> (c) […]
>
> (d) […]
>
> (2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) […]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.

30. Section 100 is also relevant, which reads:

"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."

General Principles

31. 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]."

32. Proven use of a mark which fails to establish that the commercial exploitation of the trade mark is real because the use would not be viewed as warranted in the economic sector concerned to create or maintain a market for the goods and services at issue is, therefore, not genuine use.[6] In making the required assessment, I am required to consider all relevant factors, including:

a. The scale and frequency of the use shown;

b. The nature of the use shown;

c. The goods and services for which use has been shown;

d. The nature of those goods/services and the market(s) for them;

e. The geographical extent of the use shown.

Relevant Period

33. The revocation action is directed against the '951 mark only. The period of non-use claimed in so far as section 46(1)(b) is concerned is between 4 January 2017 and 3 January 2022, with an effective date of revocation being sought as 4 January 2022.

[6] *Nike Innovate CV v Intermar Simanto* (*Jumpman*) O/222/16 Daniel Alexander sitting as the Appointed Person on appeal.

Shinevision's evidence of use

34. The evidence of use comes, predominantly, from Mr Taylor. Mr Taylor is the managing director of Shinevision with the overall responsibility for the management and administration of the company, a position he has held since 2009.

35. Mr Taylor provides background information as to the history of the company which he states provides health and safety, risk management and compliance software, the purpose of which is to maintain "compliance with legislation guidance and regulatory change" across a wide range of areas.[7] He states that Shinevision's customer base comprises organisations from a variety of sectors including housing, transport, real estate and infrastructure, healthcare and higher education. Its clients include local government bodies, project management companies, housing associations, hauliers, surveyors, universities and NHS trusts.

36. It is said that Shinevision provides software under the 'shine' brand as well as training, advisory and consultancy services to its customers, both in connection with the use, development and implementation of Shinevision's software products and in the field of health and safety, risk management and compliance in general.

37. Mr Taylor states that since 2009 the 'shine' mark has been widely used and displayed on advertising, marketing and publicity material. In support of this statement he produces copies of a small selection of invoices, marketing brochures sent to actual and prospective clients, promotional material in terms of images confirming attendance at an Exposition in 2011, articles published in trade publications and local press, social media activity and letters from three of its customers confirming the provision of goods and services by Shinevision.[8] A great deal of Mr Taylor's evidence focusses on the provision of automated email notifications sent to Shinevision's clients and third parties, with an explanation as to how these function in terms of the software and services it provides.

38. Mr Taylor confirms that Shinevision "currently" (which I take to mean the date the statement was completed and signed, namely on or about 22 May 2022) has "24 live

[7] Paragraph 5 - 2nd witness statement.
[8] The authors of the letters also provided witness statements.

'client domains' that contain over 10,000 users, which are serviced by approximately 1,000 email notifications per month from [its] software".[9]

39. Evidence is produced from three of Shinevision's customers.[10] The first is from Mathew Mixture who is the Asbestos Manager of London Borough of Hackney Council ("Hackney council").[11] The second is from Mr Richard Dunigan who is the Deputy Estates Health and Safety Manager at University of Edinburgh ("UE")[12] and the third is from Mathew Curran, the Head of Health and Safety (Housing) at Westminster City Council ("Westminster council").[13] Mr Mixture confirms that Hackney council has been using the 'shineAsbestos' software under license since March 2020. He states that the core functionality of the software is "automatic email notifications that provide technical and compliance updates to the council and their external supply chain user community." He states that this software has 299 active users generating approximately 65,000 monthly transactions on the audit trail and that the software sends out circa 3,000 monthly email notifications. Mr Mixture produces an undated screenshot indicative of the type of email notification that Hackney council receives, through the use of the 'shine' software, namely:

shine

Work Request Approved

Dear User,

Work Request Reference: [redacted]
Work Request Type: [redacted]
Block Reference: [redacted]
Property Reference: [redacted]
Property Name: [redacted]
Property Postcode: [redacted]

This is a courtesy email from London Borough of Hackney Council to inform you that [redacted] is now been approved.
Technical activity will now begin.

Kindest Regards,

London Borough of Hackney Council

This email was automated by London Borough of Hackney Council and sent from an unmonitored mailbox, please do not reply.
If you have any questions please contact the London Borough of Hackney Council Asbestos Management Team.

[9] Paragraph 8.
[10] These statements confirm information already produced by Mr Taylor in letters exhibited to his first witness statement. I shall only refer to the information once.
[11] See letter dated 5 May 2022 Exhibit LT3 and witness statement dated 26 May 2022.
[12] See letter dated 5 May 2022 Exhibit LT5 and witness statement dated 27 May 2022.
[13] See letter dated 5 May 2022 Exhibit LT4 and witness statement dated 1 June 2022.

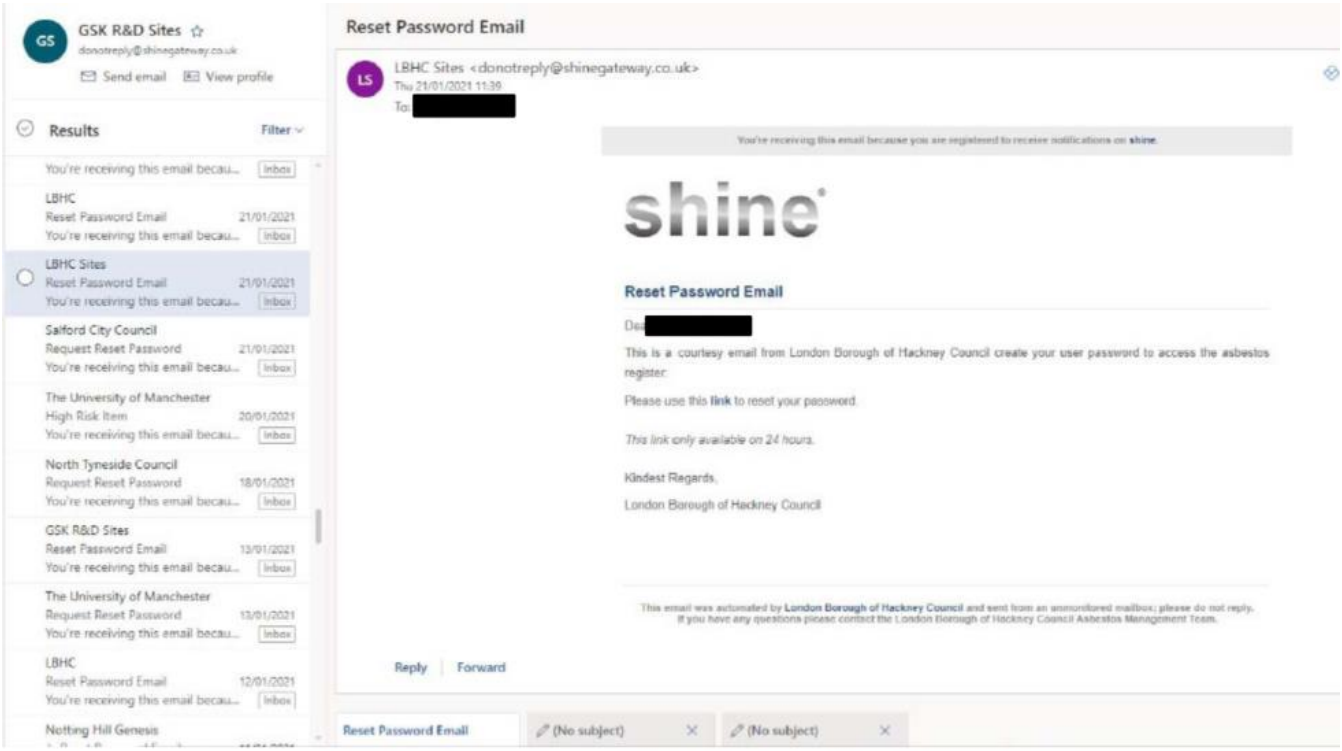
40. Similar information is provided by Mathew Curran (Westminster Council) and Richard Dunigan (UE). Richard Dunigan (UE) confirms that the university has been using the 'shineAsbestos' software since April 2012 previously under licence from Msycdo. It has 201 active users, generating circa 9,000 monthly transactions with the software sending out 700 monthly email notifications. It has received email notifications since 2012 and particularly between 4 January 2017 and 3 January 2022. Mr Curran confirms that Westminster council has used the 'shineAsbestos' and 'shineCompliance' software under licence since June 2019. It has 538 active users of the software, generating circa 80,000 monthly transactions. Approximately 4,000 email notifications are sent out each month.

41. Mr Curran also confirms that he attended a fire risk assessors webinar provided by Praxis on 5 May 2021 and produces a certificate showing completion of the training and an email received from Praxis showing that they offer health and safety courses under the 'SHINE' brand. It appears that this evidence is provided merely to show his awareness of Praxis and that they operate and provide training in the same sector, rather than as an example that he was confused.

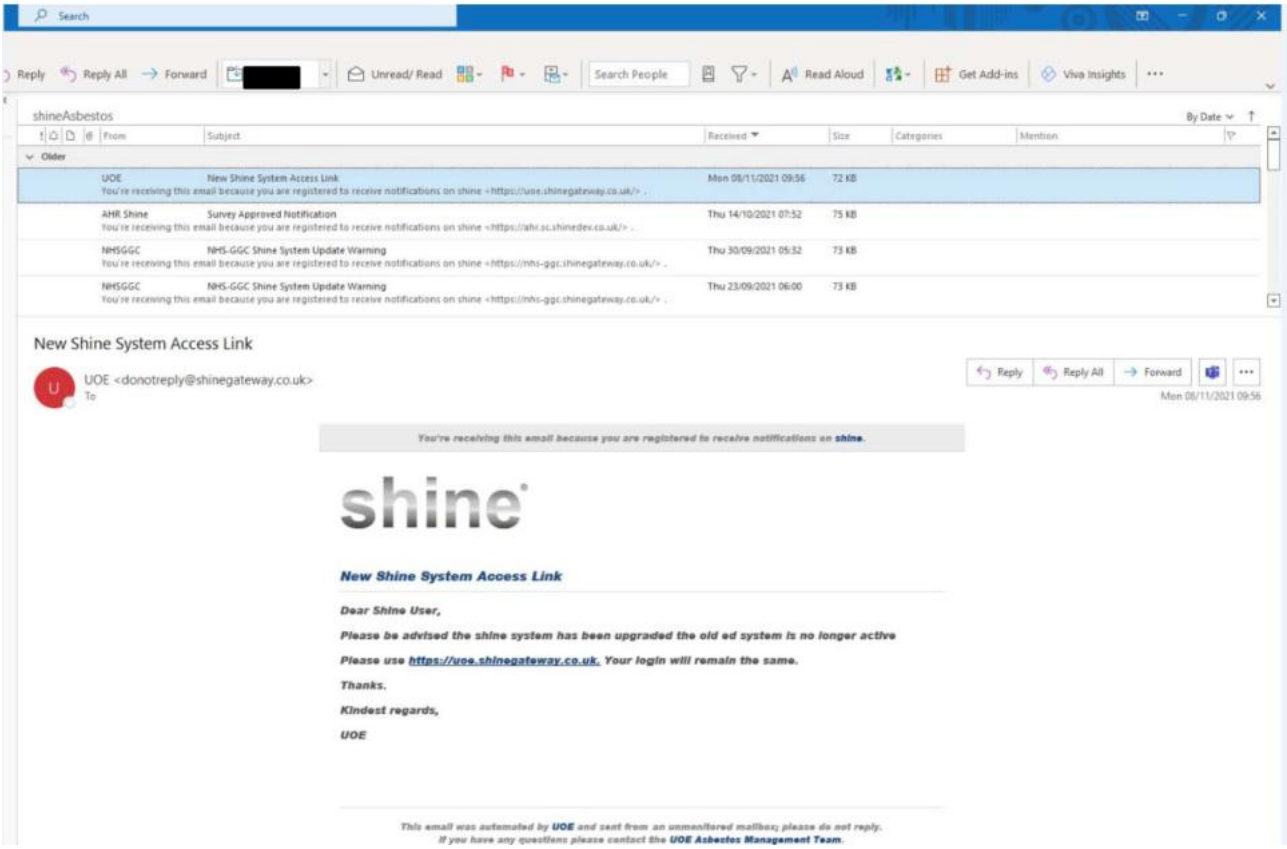
42. Regarding the email notifications, Shinevision is said to have used the '951 mark on these, which are issued regularly to its customers and their users. Two examples are produced by way of illustration (reproduced below) sent on 21 January 2021 and 8 November 2021.[14] Furthermore a series of email audit logs are produced dated between 31 March 2021 and 30 September 2021 said to show the recipients and the dates on which these email notifications of this type were sent.[15] These are said to be a sample of the total email notifications sent throughout the relevant period. Whilst the emails are automated from the individual customers, they appear to be generated from the shinegateway URL domain address '@shinegateway.co.uk' which is the server via which Shinevision provides its "domain and database hosting services" by reference to "shineVision Support Services".[16]

[14] See Exhibit LT1.
[15] See Exhibit LT2.
[16] Marketing Brochure dated 2016/2017.

Email notification - 21 January 2021



Email notification - 8 November 2021



43. Mr Taylor explains that the recipients of these email notifications include direct customers of Shinevision, who have licensed its software, as well as those customers' active users who include consultants, contractors and surveyors.[17] I note the email addresses of some of these recipients as shown in the audit logs (dated 2021) include '*nhg.org.uk', 'tersusgroup.uk', 'hackney.gov.uk', 'westminster.gov.uk', 'quay-consultancy.co.uk', 'hounslow.gov.uk', 'gsk.com', 'pagroupuk.com', 'kcsasbestos.co.uk'* and '*ggc.scot.nhs.uk*'.

44. In response to criticisms made by Praxis that the email notifications do not demonstrate genuine commercial use, because they only show internal use sent to a closed circle of users, Mr Taylor provides an explanation that the emails cover user account management, project tendering, project and document management and risk register updates. All email notifications are said to be a 'call to action' with the user required to take a specific action. They are closely monitored by the respective organisations as they form part of the audit trail for the Health and Safety Executive. Mr Taylor confirms that between February 2021 and January 2022, 11,368 email notifications were sent.[18] Further, the email notifications are managed by Shinevision's developers via its shinegateway hosting server and produces an image from its systems log to verify this.[19]

45. A further selection of bespoke email notifications, designed specifically for individual clients, are produced dated between 11 December 2020 and 25 August 2021 and include those sent to Hackney council, Westminster council, GSK and Quay Consultancy.[20] An invoice dated 22 July 2020 is produced issued to Hackney council for 'shineAsbestos software development' totalling £8,064, in payment for the creation of a bespoke email notification.[21]

46. Mr Taylor states that the 'shine' mark has been used solus and in combination with other words to create related brands and sub brands e.g. 'shineVision', 'shineAsbestos', 'shineFire', 'shineWater' and 'shineGas' etc, which are all said to be the names of individual modules for Shinevision's software.

[17] Paragraph 10.
[18] Exhibit LT-K.
[19] Exhibit LT-L.
[20] Third statement Exhibits LT2-LT6, LT9-LT12.
[21] Third statement Exhibit LT7.

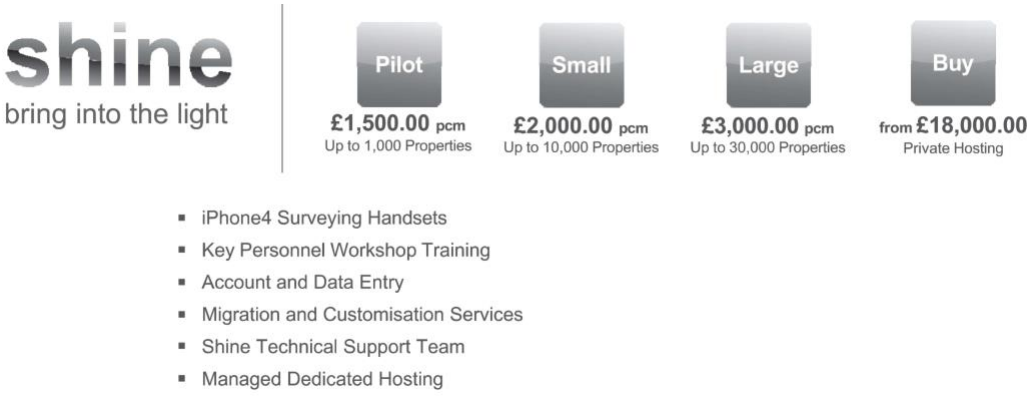
47. Mr Taylor produces a report entitled 'Asbestos Management Plan: 2017-2018' which appears to have been produced by UE showing use of the mark.[22] Throughout the report reference is made to the word Shine in plain text, i.e. the "Shine system"[23] or the "shineAsbestos system". The shineAsbestos system is described as an "online, live asbestos management system which contains the asbestos registers for the estate. The shine system is updated and maintained by the Health and Safety management team populated by [various means to include]…management surveys, updates after remediation and re-inspections."[24] The 'shine system' is said to provide 'live' information, updated or modified as required by the Health and Safety Team.[25]

48. Mr Taylor sets out Shinevision's promotional and marketing activity. This includes attendance at the 'Safety and Health Expo 2011' held at the National Exhibition Centre in Birmingham in May 2011 to launch its 'shine' software.[26] This was said to be an industry wide event aimed at businesses in the health and safety sector. In support of this statement, undated photographs are produced showing the '951 mark, as well as in the variant form 'shineAsbestos', branded on the display stand and lecterns. Other variants are displayed, but I am unable to decipher these from the photographs.

49. Shinevision is also said to have promoted its brand in trade and industry publications. An extract taken from an article published in '*The Safety & Health Practitioner's'* website ("SHP") is produced, dated 25 May 2011.[27] The article makes reference to Msycdo launching the 'Shine' software as a management software system which "takes the headache out of complying with asbestos regulations."

50. Further examples of its marketing efforts are produced in the form of a "slide deck" presentation given to Capita Symonds by Msycdo, believed to be dated in or about February 2011.[28] Use of the '951 mark is shown throughout and also as '**shine**Arc', '**shine**Light', '**shine**Reflect'. Page 33 of this presentation shows use of the '951 mark and refers to the available costs packages, as follows:

[22] See Exhibit LT6.
[23] Inter alia sections 3.1.4, 3.5.2 and 8.3.
[24] See para 8.2 page 16 of the report.
[25] See para 8.5 page 18 of the report.
[26] See paragraph 6 of LT's 2nd witness statement.
[27] The website was accessed on 3 August 2022.
[28] Exhibit LT-C.



51. Three invoices are produced addressed to Capita Symonds or Capita Property and Infrastructure Ltd (CPI) [29] as follows:

(i) An Invoice addressed to Capita Symonds, dated 4 January 2010, for £9,000 as 'Part Payment for the Asbestos Re-Inspection Database License (Shine)'.[30]

(ii) An invoice, dated 31 May 2017, issued to CPI for £640 for "8 hours support for '2017 Capita Support on Shine'".[31]

(iii) A purchase order, dated 26 July 2022, issued from CPI for 'Shine Hosting September 2022' services in the sum of £1,053.[32]

52. Mr Taylor states that Shinevision "continues to issue invoices similar to the one produced at (ii) above to its other customers".

53. A further selection of marketing and introductory brochures is produced which were sent to prospective clients. It is to be noted that other than Hackney council, those organisations listed below did not ultimately engage the services of Shinevision:

- September 2017 to GLH hotels.[33]
- September 2017 NHS Fife.[34]
- October 2019 NHS Grampian.[35]
- January 2020 to Hackney council.[36]

[29] A subsidiary and part of the Capita Group.
[30] Exhibit LT-H.
[31] Exhibit LT-I.
[32] Exhibit LT-J.
[33] Exhibit LT16.
[34] Exhibit LT18.
[35] Exhibit LT20.
[36] Third statement Exhibit LT15.

54. Of note within the Introductory Brochure to Hackney council, dated January 2020, is a reference to shineAsbestos software supporting 'high profile clients' throughout the UK, although there is no indication of when these goods/services were provided. These are listed as *Barnet London Borough Council, Bath and North East Somerset Council, Blackburn and Darwen Borough Council, Capita, GSK, London Borough of Hounslow Council, NHS Ayrshire and Arran, NHS Greater Glasgow and Clyde, North Tyneside Council, Oxfordshire County Council*[37]*, Notting Hill Genesis, Salford City Council, University of Edinburgh, Manchester University, University of Brighton* and *City of Westminster*.

55. Shinevision is said to also promote its brand via social media. A screenshot of a post, dated 2 March 2016, is produced, taken from its Twitter (now X) account under the handle '@msycdo'.[38] The screenshot shows the use of the '951 mark and reference to '#shineAsbestos'. No other details are provided by Shinevision. Surprisingly, in an attempt to show Shinevision's limited social media and online activity/presence and abandonment of the '951 mark, Mr Paxman, on Praxis' behalf, produces hundreds of screenshots taken from Shinevision's Twitter account, Facebook page and website dated between 2016 and 2022.[39] The screenshots show posts under the handle 'ShineVision' and '@shinevisionnow' and use of a circular logo which includes the word shinevision together with the letters SV (a selection of which are reproduced below). Screenshots over the same period are also produced taken from Shinevision's website 'shinevision.co.uk' using the wayback machine archive tool.[40] It is contended that of the hundreds of posts/screenshots made by Shinevision during this period, not a single one shows use of the word Shine solus or in the form as registered.[41] Of note, however, are screenshots of:

- Posts describing Shinevision as a "leading risk management software company providing duty holders with risk management software…";

[37] Confirmed in LT's third statement at paragraph 18 as organisations Shinevision act for.
[38] Exhibit LT-E.
[39] Exhibits G and H.
[40] Exhibit F.
[41] Paragraph 10.

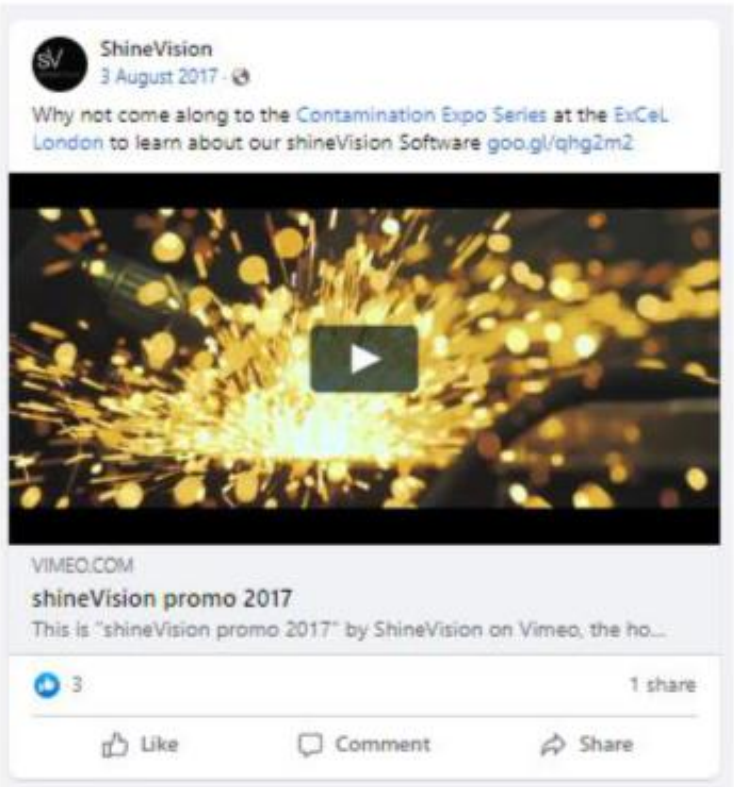
- A post outlining Shinevision's partnership with OHS to "develop and upgrade both the laboratory and air testing functionality within the shineAsbestos module";[42]
- Screenshots dated 2019, 2020, 2021 and 2022 taken from its website confirming its clients as those listed in paragraph 54 and additionally iES, urbanvision (July 2017), Fergusons Transport, Cabot thermals Ltd;
- Text within the website screenshots describing Shinevision as an independent leader in risk management software development;
- Screenshots describing Shinevision's services as those that relate to the provision of 'stakeholder training', 'dedicated hosting' and 'incremental back up cycle support' and 'problem management'.

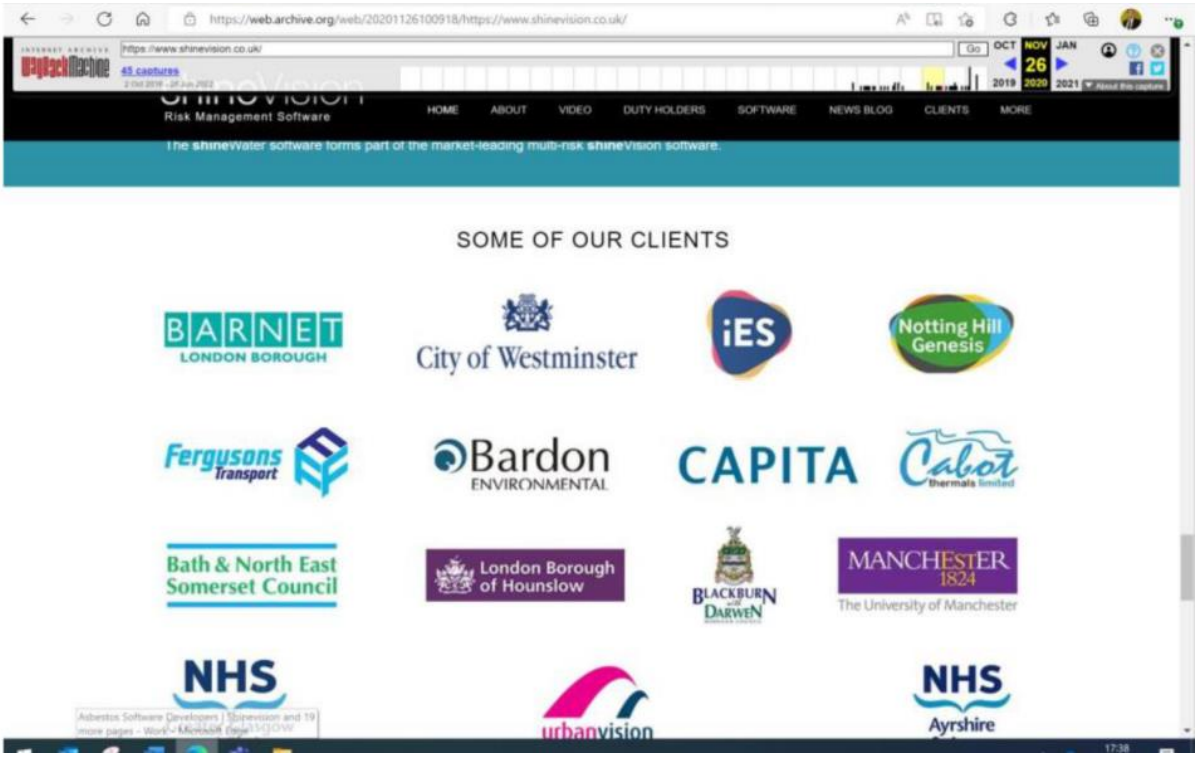
[42] Post dated 3 February 2022.


shineVision
433 Tweets
Follow
shineVision
@shinevisionnow
Leading UK Risk Management Software Company providing Duty Holders with Risk Management Software that supports their Asbestos, Fire, Water and Gas Compliance.
NE15 6UN
shinevision.co.uk
Joined August 2016
2,746 Following
952 Followers
Tweets
Tweets & replies
Media
Likes
shineVision @shinevisionnow · 20 Nov 2019
Has it really been 10 years? Thank you very much for your support down through the years here's to the next 10
#happydays


ShineVision
21 July 2017
ShineVision would like to welcome Urban Vision to its shineAsbestos Client Portfolio. Urban Vision is a Joint Venture Partnership between Salford City Council, Capita and Galliford Try - we look forward to supporting you with your Asbestos Compliance
urbanvision
shineVision
4
3 shares
Like
Comment
Share


ShineVision
3 August 2017 ·
Our Managing Director Lee Taylor has been announced as a Guest Speaker at the Contamination Expo Series Land Remediation Expo at the ExCeL London on the 27th & 28th of September - why not come along? goo.gl/3aDA6v
LEE TAYLOR
WEDNESDAY | 12.00
THEATRE 9
MANAGING HEALTH & SAFETY COMPLIANCE WITH ANTIQUATED SYSTEMS
With antiquated systems no longer being an effective method of working, duty holders have found it increasingly difficult to manage their health and safety compliance in the wake of recent legislative and financial pressures. During this workshop, Lee will identify and share common issues before exploring better processes and procedures.
23
5 comments 7 shares
Like
Comment
Share


ShineVision
3 August 2017 ·
Why not come along to the Contamination Expo Series at the ExCeL London to learn about our shineVision Software goo.gl/qhg2m2
VIMEO.COM
shineVision promo 2017
This is "shineVision promo 2017" by ShineVision on Vimeo, the ho...
3
1 share
Like
Comment
Share



56. I note from Praxis' evidence that the Twitter account was active from August 2016, and one of the posts dated 20 November 2019 refers to Shinevision's 10 year anniversary. The account has 952 followers and it made 433 tweets as at this date. In so far as Shinevision's Facebook page is concerned, several screenshots of posts are also produced by Praxis dated in 2016 and 2017 as follows:

"ShineVision" being used at Contamination and Geotech Expo 2016.

57. Praxis' evidence confirms that Shinevision attended the 'Contamination and Geotech Expo' in 2016, the 'Land Remediation Expo' in September 2017 and was nominated as a finalist for the Innovative Supplier Award (Asbestos Award) at the 'CONTAMINATION EXPO SERIES 2017', but it is argued that these were done under the rebranded '713 mark and not "under the word shine solus or the graduated silver

logo". I note that all the screenshots filed by Praxis are dated throughout the relevant period.

58. Mr Taylor also states that Shinevision promotes its brand by "attendance at local business and networking events".[43] One example is given of Shinevision's attendance at the North East Business Awards held in Sedgefield on 27 April 2017, where it was one of three finalists shortlisted for the Best Creative Company Award. In support of this statement, an undated photograph, invitation and twitter post are produced. An article published in the *Chronicle Live,* dated 21 April 2017, refers to Shinevision's nomination, where it is described as a "cloud based software provider which supports stakeholders in the management of asbestos, fire, gas and water compliance". Within the article "Shine software" is described as "…the leading compliance software in the UK".

59. Additionally, Mr Taylor states that Shinevision provides 'advisory, consultancy and training services in the field of health and safety, risk management and compliance'[44] under the sign SHINE, which is relevant to its section 5(4)(a) claim dealt with later in my decision. Mr Taylor gives evidence that the company provides these services "*to its customers in relation to the use, development and implementation of its software products*".[45] He states that Shinevision have developed a series of e-learning training videos to assist its user community with using its software and that the "e-learning resources are an integrated part of [its] software products and enable customers to more effectively use the software, as well as allowing customers to enhance their internal compliance controls, by enabling records to be kept in relation to the completion of training among their users." Customers are also said to be signposted to other training providers in the field of health and safety.

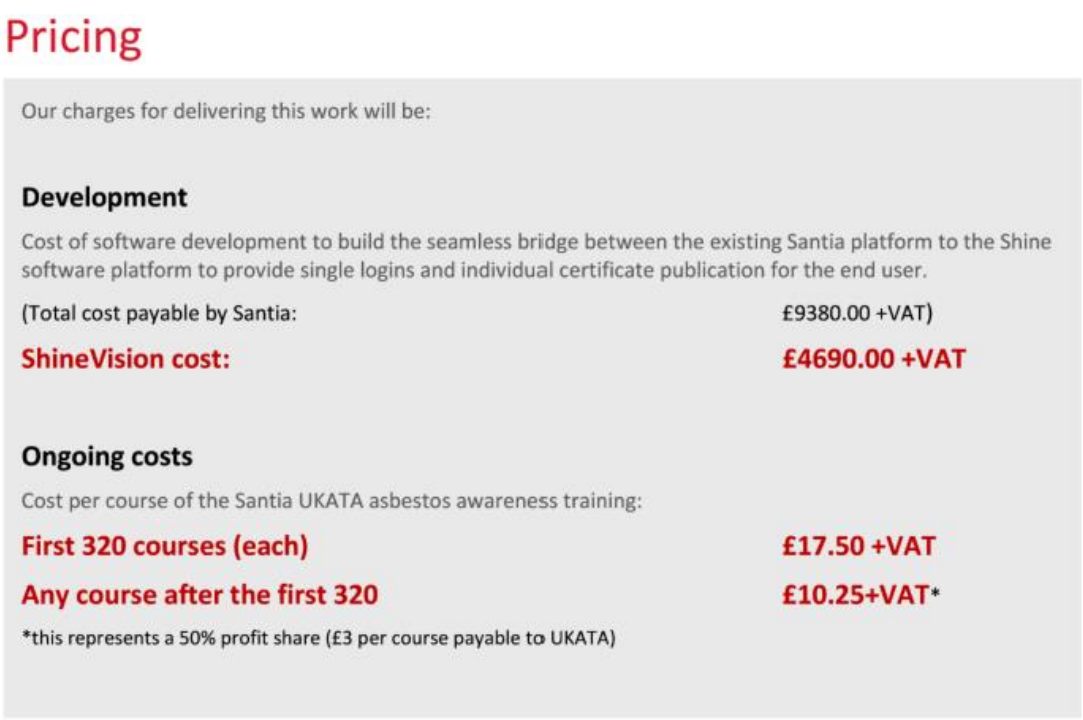
60. In support of this statement Mr Taylor states that Shinevision arranged with a third party provider to link training content from its software. In March 2019 Shinevision developed an application programming interface link (API link) with Santia Asbestos Management Ltd so that one of its customer, namely GSK, could conduct a UKATA accredited asbestos training course through GSK's version of the shineAsbestos software. It is said that this training course sat alongside its existing shineAsbestos

[43] Paragraph 10 second witness statement.
[44] In support of its section 5(4)(a) ground claim.
[45] Paragraph 5 of Mr Taylor's 2nd witness statement.

software e-learning training videos. A link was created to allow users to conduct the training on the Santia training portal. Santia invoiced Shinevision and sent a certificate to GSK. This is said to demonstrate the provision of training through its software (albeit via a third party contractor). It is said that this arrangement continued for a period of approximately 12 months.

61. The following documents are produced in support:

- An email dated 11 January 2019 between Santia and Mr Taylor said to demonstrate "agreeing the commercials of this arrangement."[46] The email itself appears to be no more than a proposal and highlighting difficulties experienced with the proposed delivery timescale. It is suggested by Santia that as an alternative the training is provided directly on their system or via a classroom-based situation.
- A quotation document (an extract of which is produced below) dated 11 March 2019 in connection with Santia offering UKATA asbestos courses through Shine software.[47] The services quoted are for the provision of "'a 'bridge' between the Santia platform and Shine software's portal to allow a single login access to the end user".



Pricing

Our charges for delivering this work will be:

Development

Cost of software development to build the seamless bridge between the existing Santia platform to the Shine software platform to provide single logins and individual certificate publication for the end user.

(Total cost payable by Santia:	£9380.00 +VAT)
ShineVision cost:	**£4690.00 +VAT**

Ongoing costs

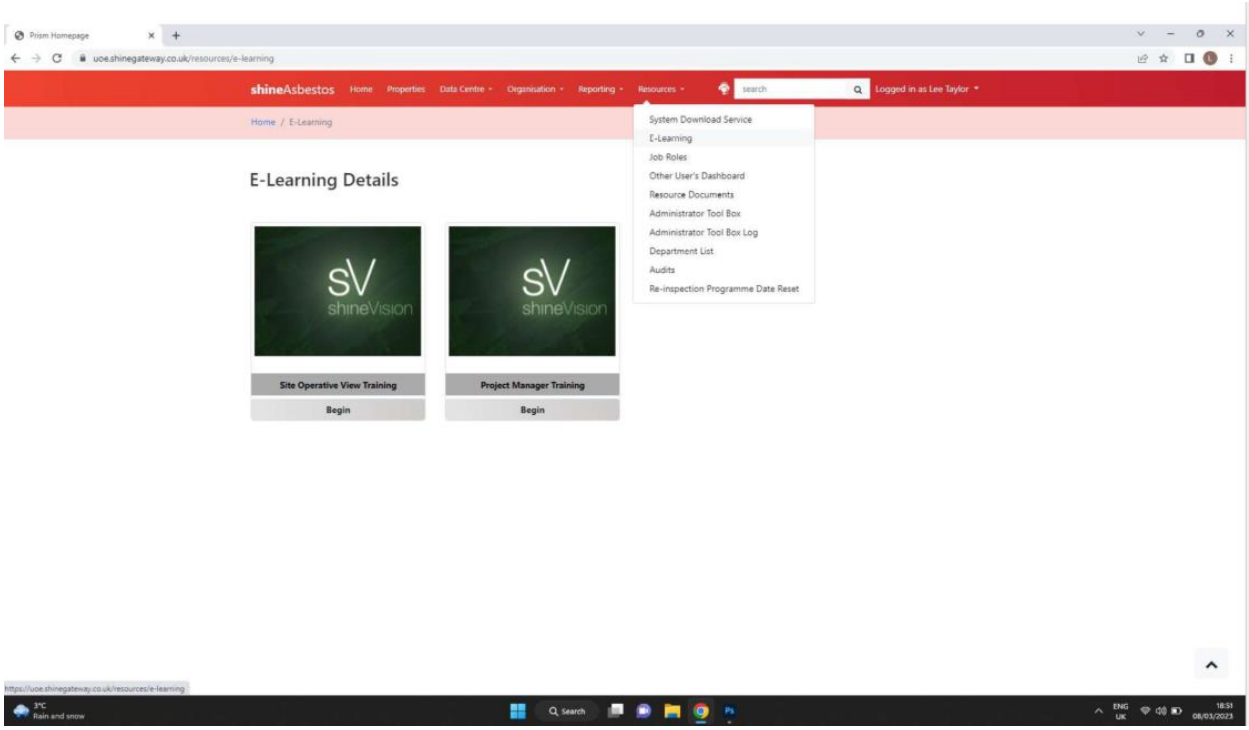
Cost per course of the Santia UKATA asbestos awareness training:

First 320 courses (each)	**£17.50 +VAT**
Any course after the first 320	**£10.25+VAT***

*this represents a 50% profit share (£3 per course payable to UKATA)

[46] Paragraph 30 and Exhibit LT27
[47] Exhibit LT28

- An invoice dated 20 March 2019,[48] issued by Shinevision to GSK Ltd in connection with 'UKATA Asbestos Awareness Training supported by Santia'; 'Additional SLA: Removing Room/ Location Replication'; 'Site Operative and Project Managers e-learning Videos'. The fee claimed is for just over £15,000.
- Copy undated screenshots are produced of what appears to be a mock up showing how the access/bridge link would look on the ShineAsbestos system.[49]
- Screenshots (an example of which is reproduce below) of undated stills of its eLearning training videos taken from 'uoe.shinegateway.co.uk' accessed in March 2023.[50]



- An example of its training literature and user guides produced for UE, in the form of 'A User Guide Training Manual' dated November 2014.[51] The mark is displayed on the front cover as '**shine**Asbestos'.
- Further undated stills of UE's 'in house asbestos training course power point'. Reference is made to the shine software system within the literature.

[48] Exhibit LT29
[49] Exhibits LT31-33
[50] Exhibit LT33
[51] Exhibit LT34

Praxis' evidence

62. As stated, Praxis' evidence comes from the witness statements of Mr Paxman who is its Director of Sales and Marketing, a position he has held since 2018. He states that Praxis is a '*Health and Safety Consultancy and eLearning provider'*.[52] He states that the company offers a software platform to its customers under the name SHINE which comprises a series of tools for the delivery of courses and the archiving/storing of information and training records. It is said that Praxis launched its SHINE platform in November 2018 and first used the name in June 2019. For the most part, the evidence focusses on criticising Shinevision's purported lack of use of the word SHINE solus and the results of investigations it has conducted into Shinevision's activities. Mr Paxman accepts that Shinevision is a software web-based business who have attended trade shows.[53] However, he states that his investigations show that the company stopped using the mark 'shine' solus in early 2016 across all platforms. Thereafter, following a rebranding, it is the use of '**shine**vision' that is made. The focus of Praxis' investigations has been directed at showing non-use of the word 'shine' but in doing so, it has produced vast amounts of evidence showing use of the word shine in combination with other words, which I will discuss further below.

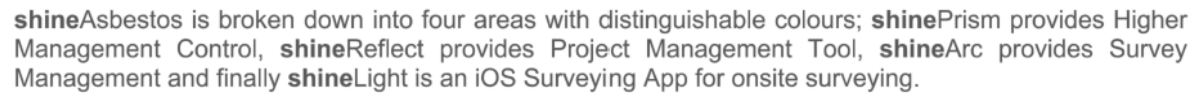
Use of the mark as registered or in a variant form

63. Before I consider whether the evidence constitutes sufficient use of the '951 mark, it is necessary to address the marks shown in use and determine whether this is either use of the mark as registered and/or use of an acceptable variant of the same.

64. Where Shinevision has used the earlier mark in the form in which it is registered, then clearly this will be use upon which it may rely. Its evidence, however, also includes the use of the word 'shine' in plain text. In my view, the stylisation is not greatly distinctive as it merely reflects the meaning of the word. Since the word 'shine' is clearly identifiable within the figurative form, it is the word that indicates trade origin. Consequently, the use of the plain word 'shine/Shine' can be relied on interchangeably as use of the '951 mark as registered and is an acceptable variant.

65. The mark is also shown in the following forms in evidence:

[52] Paragraph 2.
[53] Paragraph 9.



66. It is settled law that use of a trade mark includes its independent use and its use as part of a composite mark, provided that it continues to be indicative of the origin of the product.[54]

67. Further in *Lactalis McLelland Limited v Arla Foods AMBA*,[55] Mr Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said (emphasis added):

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is,

[54] *Colloseum Holdings AG v Levi Strauss & Co*., Case C-12/12
[55] BL O/265/22.

the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable just use and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

68. The question I must ask, therefore, is where the mark is used as part of a composite mark or when used with matters added and/or with the addition of descriptive/non distinctive elements, this alters the distinctiveness of the mark at issue. I have already found that the word only ‘shine’ in standard text is an acceptable variation of the ‘951 mark. Where the word ‘shine’ appears with a suffix and these suffixes are descriptive or lowly distinctive in nature, I do not consider that they alter the distinctive character of the mark, following the fourth example as outlined by Mr Johnson in *Lactalis.* Consequently, the use of the word ‘shine’ together with either the words Asbestos, Water, Gas, Fire, Light, Compliance, Arc and Reflect are all acceptable variants, since the additional words either describe the subject matter to which the software and the services relate or are non/less distinctive elements. The way in which the word ‘shine’ is presented in emboldened font (and even where it is presented in colour) means that it is the dominant element, even when used in combination with other words. Consequently, in all these aforementioned forms the addition of the additional elements to the word shine will not impair its ability to indicate trade origin. I find that use in all these forms qualify as acceptable variations.

69. In so far as the word ‘shine’ is used in combination with the word ‘Vision’, (and in its stylised form where the tittle is omitted from the letters ‘i’) I do not consider that the word Vision can be regarded as the addition of a descriptive element as per the examples discussed above. In this variation, however, I consider that it is use of the mark as part of a composite mark as per *Colloseum.* The presentation of the word ‘Vision’ with a capital letter separates it from the word ‘shine’ but the meaning of the word ‘shine’ is not altered by its use in combination with the word ‘Vision’. The presentation of the two words has all the hallmarks of two marks used side by side. On this basis the aforementioned use of the word ‘shine’ in combination with the word ‘Vision’ is also an acceptable variation.

70. For the same reasons, the same would apply in relation to the use of ‘shineVision’ in combination with the SV logo in a co-affixing sense as per *Colloseum* and would therefore also be an acceptable variation. This would not extend to the use of the SV logo or SV letters solus, however, as the omission of the words shine/shineVision and replacing them with letters alters the distinctive character of the mark and it loses its ability to indicate trade origin.

Assessment of evidence

71. There are clearly issues with Shinevision's evidence in terms of sufficiency and quality. For instance, one would normally expect to see revenue/turnover figures, sales, advertising expenditure and market share figures produced in a case of this kind, in order to counter a revocation for non-use action. None of these are provided. Praxis particularly calls into question the value of the email notifications on which Shinevision appears to focus, as a means for demonstrating use in the market, during the relevant period.

72. What the evidence does show is that Shinevision licenses a software management system in the health and safety and risk management sectors and its customers include large organisations and institutions including councils and the NHS, located throughout the country. Three of its customers have provided unchallenged witness statements to confirm the use by their organisations of shineAsbestos software and related services since 2012, 2019 and 2020 respectively. Two of which confirm the licensing of software within the relevant period. The Asbestos Management Plan document produced by UE is dated 2017/2018 and makes clear reference to the shine/shineAsbestos software system. The fact that it is described as a 'live' system monitored and supported by the host, suggests that it involves some ongoing support services. Mr Taylor states that Shinevision currently has 24 live client domains as at May 2022 and I accept that at least a good proportion of these would have been live during the relevant period, which is supported by the marketing brochure sent to Hackney council in 2020 and the website screenshots produced by Praxis. Whilst 24 customers is not an extensive number, I take particular note of the fact that they are not individuals but rather large institutions and organisations who employ thousands of members of staff.

73. The financial evidence is not without its difficulties. For example, the financial details produced consist of a cost summary as included in the 'slide deck' presentation to Capital Symonds, but this is dated 2011. Of the invoices/purchase orders produced by Mr Taylor, only two are dated within the relevant period, albeit that I am told that one of the invoices dated in 2017 to CPI is indicative of those it sends to its other customers. The article in Chronicle Live in 2017 describes SHINE as the "leading compliance software in the UK" but the evidence filed does not support that claim. I

have no indication as to the size of the market or Shinevision's position within that market, and therefore I am unable to determine with any certainty that it is a leader in its field as claimed. Limited use was shown by Mr Taylor of Shinevision's promotional activity and social media presence, and a great number of the material produced was dated outside the relevant period; for example, its attendance at the Birmingham Expo and the article published in SHP was dated 2011, both of which appear to coincide with the initial launch of the product.

74. The main focus of Shinevision's evidence, as its primary source of showing genuine use of the '951 mark, appears to be the sending of email notifications. Thousands of automated emails are sent out per month. The users of the software and those receiving the emails are said to be directly employed by the organisations and institutions themselves and third parties who are contracted to undertake work on their behalf. Praxis submits that "labelling a system update email and sending it to a closed, private mailing list does not count as trade mark use. Even if [it] did meet generally accepted notions of what genuine use was (i.e. that it referred to the company or a product, or that it was public), it still would not be use relative to any of the goods and services for which it is registered."[56]

75. At the hearing Mr Silcock, suggested that these emails form part of the automated process generated when the original software was purchased/licensed fulfilling its original obligation under pre-existing contracts, rather than showing use within the relevant period. In response, Mr Taylor provides a lengthy explanation as to the purpose and functionality of the email system and produces sample emails and audit logs, a good proportion of which were branded with the '951 mark and sent during the relevant period often via the 'shinegateway' URL address. The explanation Mr Taylor provides as to the part these emails play is not entirely clear to me and I am alive to the fact that these emails may show nothing more than being part of an automated process started well before the relevant period and that's all Shinevision is doing in sending these emails is fulfilling the obligation it had under its pre-existing contracts that were entered into before the start of the relevant period. Further in so far as its 24 live client domains, I accept there is no indication as to when these started and it is not inconceivable that the contracts were entered into before the beginning of the

[56] Para 22 Tom Paxman's first statement.

relevant period. However, on balance, I am prepared to accept that the emails whilst forming part of the functionality of the software management system itself, also show the provision of ongoing software support and design services provided through the server '@shinegateway.co.uk'. In so far as use overall, there is clear evidence of two actual sales of software goods/services at different times during the relevant period to different clients both of whom are large organisations (Westminster council and Hackney council) as well as two invoices referring to support services of some description indicative of the type of invoices it sends to its customers. I accept that a portion of the support services offered to its customers, would include the management, updating and development of the email notifications; a service carried out by its developers.

76. Shinevision's evidence of use was strengthened to some extent by Praxis' evidence. It produced a large number of screenshots of Shinevision's social media activities and its website use during the relevant period and confirmed attendance at two further Expos in 2016 and 2017. Whilst the primary reason for filing this evidence was to show that it had not shown use of the mark at issue or an acceptable variant, (which I have already addressed), in reality this evidence merely bolstered Shinevision's position.

77. Despite the deficiencies in the evidence, I remind myself that the assessment for genuine use is to look at the evidence as a whole and not whether each individual piece of evidence shows use by itself.[57] Further there is no minimum threshold. The test for me to apply when assessing the evidence is whether looking at the scale, frequency and the geographical extent of the use, a real attempt has been made to create and preserve a market for the goods/services under the mark.

78. Clearly, Shinevision is a small business, but its customers constitute large organisations and institutions rather than individuals. Whilst there is no evidence of turnover, advertising spend or market share, its marketing efforts to at least two NHS trusts and a hotel group and actual sales of software systems to Westminster and Hackney councils make it clear that it is trying to carve out a market for the goods and services it offers. The evidence of use of the '951 mark, or in an acceptable variant, in its marketing material and in the email notifications, as well as third party evidence

[57] *New Yorker SHK Jeans GmbH.*

from actual clients, means that I am satisfied that the '951 mark was used during the relevant period to create or maintain a market for its software goods and related services. Whilst the evidence is not without its faults and could have been better expressed, when taken as a whole, I am satisfied that it is more than token use and not only use to preserve the trade mark. The fact that it has made greater use of shineAsbestos or shineVision does not undermine this conclusion.

79. For the reasons outlined, I find that Shinevision has sufficiently shown genuine use of the '951 mark for all the goods and services of its registration in classes 9 and 42 and the application for revocation fails.[58]

80. As will become relevant later in my decision, in relation to Shinevision's claim under section 5(4)(a), I do not find that it has shown genuine use for *training services in the field of health and safety, risk management and compliance,* under the sign SHINE or an acceptable variant as claimed. Producing a user guide/instruction manual and videos on how to use its software system, is not the same as creating or preserving a market for the provision of the services to third parties. What it actually provides is an ancillary service which is part of the provision of its software. The evidence relating to its collaboration with Santia for GSK was also no more than the provision of a bridging link to access a third party course via its portal and does not demonstrate the provision of training services under the sign. Even if I am wrong and this evidence could be regarded as constituting use, the actual evidence produced is so limited that it does not go anywhere close to crossing the threshold for establishing use, even accepting that there is no minimum threshold.

Opposition

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because-
>
> (a) ….

[58] At the hearing, Mr Silcock accepted that were I to find genuine use of the '951 mark and in the differing forms shown in evidence, Praxis did not challenge that the use shown would encompass all the goods and services as specified in the registration. It has therefore been unnecessary for me to undertake a fair specification assessment.

(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."

82. Section 5A of the Act reads as follows:

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Case Law

83. 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 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 to mind the earlier mark, 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.

Proof of Use

84. For the purposes of its opposition, only the ‘951 mark is subject to proof of use. The relevant period is between 15 July 2015 and 14 July 2021. Although the relevant periods for the revocation action and opposition are not the same, given the degree of overlap, I do not consider the differences in the relevant periods materially affect the overall picture. Consequently, for the reasons already given, my findings in relation to genuine use in the revocation action means that Shinevision has provided proof of use

sufficient to satisfy section 6A of the Act. Consequently, it may rely on the '951 mark for the purposes of its opposition.

Comparison of the goods/services

85. When conducting a goods/services comparison, all relevant factors should be considered as per the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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".

86. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

> (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."

87. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

88. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

"365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

89. Praxis seeks registration for the following services:

Class 42
Computer system analysis in the fields of education and training; Computer system design in the fields of education and training; Computer systems design in the fields

of education and training; Computer design and programming services in the fields of education and training; Computer programming and software design in the fields of education and training; Software development, programming and implementation in the fields of education and training; Computer programming in the fields of education and training; Computer software design in the fields of education and training; Computer software development in the fields of education and training; Updating of computer software in the fields of education and training; Computer software consultancy in the fields of education and training; Creating and maintaining websites for others in the fields of education and training; Maintenance of computer software in the fields of education and training; Software development services in the fields of education and training; Hosting services, software as a service, and rental of software in the fields of education and training; Hosting computer sites [web sites] in the fields of education and training; Rental of computer software in the fields of education and training; Software as a service [SaaS] in the fields of education and training; IT services in the fields of education and training; Advisory and information services relating to computer software in the fields of education and training; Computer consultancy and advisory services in the fields of education and training; Computer advisory services in the fields of education and training; Information technology [IT] consulting services in the fields of education and training; Computer and information technology consultancy services in the fields of education and training; Information technology services in the fields of education and training; Software as a service [SAAS] services in the fields of education and training; Software as a service [SaaS] featuring software for machine learning in the fields of education and training; Software development in the fields of education and training; Computer software design and development in the fields of education and training; Computer software development for others in the fields of education and training; Developing and updating computer software in the fields of education and training; Development of virtual reality software in the fields of education and training; Research and development of computer software in the fields of education and training; Design, development and programming of computer software in the fields of education and training; Design, maintenance, development and updating of computer software in the fields of education and training; Computer systems development in the fields of education and training; Creating, maintaining and

hosting the websites of others in the fields of education and training; Consultancy relating to computer systems in the fields of education and training; Computer system design and development in the fields of education and training; Design services relating to computer systems in the fields of education and training; Development services relating to computer systems in the fields of education and training; Consultation services relating to computer systems in the fields of education and training; Consultancy services relating to computer systems in the fields of education and training; Developing computer software for others in the fields of education and training; Development of computer game software in the fields of education and training; Development of interactive multimedia software in the fields of education and training; Development and testing of software in the fields of education and training; Development of computer software application solutions in the fields of education and training; Design, development and implementation of software in the fields of education and training; Development and maintenance of computer software in the fields of education and training; Design and development of virtual reality software in the fields of education and training; Consultancy relating to software design and development in the fields of education and training; Development services relating to computer software application solutions in the fields of education and training; Research relating to the development of computer software in the fields of education and training; Research, development, design and upgrading of computer software in the fields of education and training; Advice and development services relating to computer software in the fields of education and training; Design and development of computer software for others in the fields of education and training; Product development in the fields of education and training; Research relating to the development of computer programs and software in the fields of education and training; Product development consultation in the fields of education and training; Consultancy relating to the design and development of computer software programs in the fields of education and training; Design and development of software in the field of mobile applications in the fields of education and training; Designing and implementing web sites for others in the fields of education and training; Updating and maintenance of computer software and programs in the fields of education and training; Installation and maintenance of computer programs in the fields of education and training; Rental of computer

software and programs in the fields of education and training; Creation, updating and adapting of computer programs in the fields of education and training; Design, creation and programming of web pages in the fields of education and training; Computer and software consultancy services in the fields of education and training; Computer software rental in the fields of education and training; Renting computer software in the fields of education and training; Computer software installation in the fields of education and training; Computer software (Design of -) in the fields of education and training; Leasing of computer software in the fields of education and training; Writing of computer software in the fields of education and training; Computer software advisory services in the fields of education and training; Design of computer software in the fields of education and training; Consulting services in the field of software as a service [SaaS] in the fields of education and training; Platform as a Service [PaaS] in the fields of education and training; Design and development of computer software in the fields of education and training; Updating and upgrading of computer software in the fields of education and training; IT project management in the fields of education and training; Design and testing of new products in the fields of education and training; Design and testing for new product development in the fields of education and training.

90. I have already set out Shinevision's goods and services at paragraph 4, but for ease of reference they are as follows:

Class 9: Health and Safety, Risk Management software packages, products, programmes and applications.

Class 42: Software creation, design, development, installation, maintenance and computer programming in the area of Health and Safety, Risk Management.

91. After the hearing, Praxis limited its software services to "the fields of education and training". Prior to this limitation being filed it was accepted by Mr Silcock that all of Praxis' services, as originally applied for, were either identical or similar.[59] However Mr Silcock argued that once the limitation was applied, none of the respective services

[59] Skeleton argument paragraph 39

remain to be similar because they are in different fields. In support of this position, he referred me to the first instance decision of *Rostrum Solutions Ltd v iRsotrum*[60] where it was found that amongst other matters *computer software goods providing online auction platforms* were not similar to *call/contact centres management programmes and software*, because in essence despite being software products, the fields in which the goods operated were completely different. Mr Silcock submitted that I should follow the same approach, arguing that the mere fact that the services relate to 'software packages' for example is insufficient to justify a finding of similarity.[61]

92. Firstly, given that the decision is a first instance decision it is not binding on me. Secondly, the assessment relating to that decision differs to the issues in suit. This is because at their core, Praxis offers software related services 'in the field of education and training' where the terms education and training are drafted in broad terms and do not specify the particular category to which they relate. This would mean that they cover education and training in any field including those related to health and safety and risk management/compliance. In fact, both Praxis and Shinevision have filed evidence which shows that this is in fact what Praxis do. Therefore, whilst the limitation may be sufficient to counter any claim as to identity, it does not go far enough to provide distance between the respective specifications in terms of assessing similarity.

93. I remind myself that in order to interpret the scope of the terms, I must not lose sight of the class headings in which Praxis' services appear.[62] Praxis' services fall within class 42 of the Nice classification guide, which relates to the provision of scientific and technological services, even though their end purpose is in the provision of education and training. I shall bear these matters in mind when undertaking the comparison.

My Approach

94. Praxis' services can broadly be described as software and computing related services for the purposes of education and training under the sub-headings software creation, design and development services; support and maintenance services;

[60] O/290/14 at [39-42]
[61] Skeleton argument paragraph 40.
[62] *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA)

consultancy and advisory services; rental, hosting and SaaS services and generic IT services. I shall group Praxis' terms into these general categories.[63]

Software creation, design and development services

Writing of computer software in the fields of education and training; Computer programming in the fields of education and training; *Computer system design in the fields of education and training; Computer systems design in the fields of education and training; Computer design and programming services in the fields of education and training; Computer programming and software design in the fields of education and training; Computer software design in the fields of education and training; Computer software design and development in the fields of education and training; Design, development and programming of computer software in the fields of education and training; Design, maintenance, development and updating of computer software in the fields of education and training; Computer system design and development in the fields of education and training; Design services relating to computer systems in the fields of education and training; Design, development and implementation of software in the fields of education and training; Design and development of virtual reality software in the fields of education and training; Research, development, design and upgrading of computer software in the fields of education and training; Advice and development services relating to computer software in the fields of education and training; Design and development of computer software for others in the fields of education and training; Consultancy relating to the design and development of computer software programs in the fields of education and training; Design and development of software in the field of mobile applications in the fields of education and training; Designing and implementing web sites for others in the fields of education and training; Design, creation and programming of web pages in the fields of education and training; Computer software (Design of -) in the fields of education and training; Design of computer software in the fields of education and training; Design and development of computer software in the fields of education and training; Design and testing of new products in the fields of education and training; Design and testing for new product development in the fields of education and training*; *Software development, programming and implementation in the fields of education and training;*

[63] *Separode Trade Mark* (BL O/399/10)

Computer software development in the fields of education and training; Software development services in the fields of education and training; Software development in the fields of education and training; Computer software development for others in the fields of education and training; Developing and updating computer software in the fields of education and training; Development of virtual reality software in the fields of education and training; Research and development of computer software in the fields of education and training; Computer systems development in the fields of education and training; Development services relating to computer systems in the fields of education and training; Development of computer game software in the fields of education and training; Development of interactive multimedia software in the fields of education and training; Development and testing of software in the fields of education and training; Development of computer software application solutions in the fields of education and training; Development and maintenance of computer software in the fields of education and training; Development services relating to computer software application solutions in the fields of education and training; Research relating to the development of computer software in the fields of education and training; Product development in the fields of education and training; Research relating to the development of computer programs and software in the fields of education and training; Product development consultation in the fields of education and training; Developing computer software for others in the fields of education and training.

Maintenance and Installation

Installation and maintenance of computer programs in the fields of education and training; Computer software installation in the fields of education and training; Maintenance of computer software in the fields of education and training; Updating and maintenance of computer software and programs in the fields of education and training; Updating of computer software in the fields of education and training; Updating and upgrading of computer software in the fields of education and training;

95. To my mind Praxis' services relate to designing and developing education software for things like interactive or online learning programmes whereas Shinevision's services relate to the design and creation of software which would cover things like accident reporting and risk register management. Even though each party's terms are limited to a particular field of activity and so they will have a different purpose the

respective services are similar in that they are both at their core services relating to the design, development, installation and maintenance of the software rather than the provision of education/training or health and safety/risk management services. I consider that the respective users and those providing the services would overlap as would trade channels in so far as those that require health and safety risk management software may also require the ability to provide online or interactive training on the subject and request a bespoke package for their needs. Therefore, an undertaking in the business of designing and developing software or in providing maintenance and installation software services would be supporting the user in the functionality of the software itself usually creating a bespoke package to suit their needs. Overall, I consider that the aforementioned services are similar to between a low to medium degree to Shinevision's *Software creation, design, development, installation, maintenance and computer programming in the area of Health and Safety, Risk Management* services in the same class.

Consultancy and advisory services

Consultancy relating to software design and development in the fields of education and training; Computer software consultancy in the fields of education and training; Computer consultancy and advisory services in the fields of education and training; Computer and information technology consultancy services in the fields of education and training; Consultancy relating to computer systems in the fields of education and training; Consultancy services relating to computer systems in the fields of education and training; Computer and software consultancy services in the fields of education and training; Information technology [IT] consulting services in the fields of education and training; Consultation services relating to computer systems in the fields of education and training; Consulting services in the field of software as a service [SaaS] in the fields of education and training; Advisory and information services relating to computer software in the fields of education and training; Computer advisory services in the fields of education and training; Computer software advisory services in the fields of education and training.

96. Taking the ordinary meaning of the term consultancy would mean the giving of advice. Whilst consultancy and advice services would not necessarily include design and development services it may include advice about the design and development of

the software and IT services because an undertaking providing consultancy and advisory services in relation to software would be advising on the most suitable software package for the business user, which would also include advice about designing and developing the software itself to ensure it is fit for purpose and meets the consumer's requirements/criteria. I envisage that those that create a bespoke software programme in the area of health and safety risk management may also include advice as to accessing education and training services for the same areas, due to the regulatory nature of the sector. I consider that there would be an overlap in user and trade channels. On this basis these aforementioned services are similar to a low degree to Shinevision's *software creation, design and development …in the area of Health and Safety, risk management.*

Rental Hosting services and Software as a service

Hosting services, software as a service, and rental of software in the fields of education and training; Hosting computer sites [web sites] in the fields of education and training; Rental of computer software in the fields of education and training; Rental of computer software and programs in the fields of education and training; Computer software rental in the fields of education and training; Renting computer software in the fields of education and training; Leasing of computer software in the fields of education and training; Software as a service [SaaS] in the fields of education and training; Software as a service [SAAS] services in the fields of education and training; Software as a service [SaaS] featuring software for machine learning in the fields of education and training; Platform as a Service [PaaS] in the fields of education and training; Creating and maintaining websites for others in the fields of education and training; Creating, maintaining and hosting the websites of others in the fields of education and training.

97. Without any particular evidence or submissions to the contrary I see no obvious similarity between these hosting services and any of Shinevision's goods/services other than they are all related to computer software and IT. Given that the parties have not addressed me on the extent of similarity other than providing broad statements, I find no obvious similarity between Praxis' rental hosting services/software as a service and any of Shinevision's goods/services. The software that Shinevision provides appear to be downloads at best and its services in class 42 do not appear to cover Software as a Service. I do not consider that risk register software would be required

to rent educational software or to host an online learning platform, consequently I see no obvious complementary relationship other than on a high level of generality that their respective services are in the field of computers and IT. The provision of hosting, or renting of a website or software as a service for delivering educational content is unlikely to be important or indispensable in the design and development process of risk management software. Without any specific evidence/submissions to the contrary, I do not find that the services overlap. If I am wrong, then I consider that the respective goods/services would be similar only to a very low degree overlapping in provider and user at best.

Generic IT services

IT services in the fields of education and training; Information technology services in the fields of education and training; Computer system analysis in the fields of education and training; IT project management in the fields of education and training;

98. These services are non specific IT services in the field of education and training. In order to provide these generic services I accept that these systems would need software. But, given that Shinevision's services are specific to health and safety and risk compliance I do not consider that there is sufficient overlap to find that they are similar to any of Shinevision's goods/services. In absence of any specific submissions or evidence to the contrary and having in mind the decision in *Skykick*, I see no obvious similarity between these goods and those of Shinevision's goods/services. It is not enough to submit that because these are all computer related services that they are similar. Consequently, there is no overlap between the respective goods/services.

The average consumer and the purchasing process

99. As the case law indicates one of the global factors to be taken into account is an assessment as to whom the goods/services are directed and the manner in which they are likely to be selected. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods and services in question.[64]

[64] *Lloyd Schuhfabrik Meyer*, case C-342/97.

100. 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 was then) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

101. Praxis considers that the average consumer is more akin to a procurement officer whereas Shinevision when pressed at the hearing considered that the average consumer of the respective services overall was a professional/business user. I do not consider that the parties are much apart, although I do not consider that the average consumer is confined only to procurement officers as alleged by Praxis, although certainly it would include this group. The users of the services will more likely be businesses and organisations wishing to acquire, develop and maintain bespoke software services. Engaging an undertaking in providing such services will involve significant expenditure and will be an important decision for their business/organisation. Usually, this type of service is client specific, provided to match a specific set of criteria as requested by the consumer and may also involve a bidding/tendering process, with considerations such as price, reputation and suitability being taken into account in the selection process. For these reasons, I consider that an above average (between medium and high) level of attention will be undertaken in the selection process.

102. In so far as the selection process itself is concerned, the services will be selected from websites or brochures or following a tendering process where bids are submitted to the organisations in question. Therefore, visual considerations will dominate although I do not discount aural aspects following enquiries over the telephone or recommendations.

Comparison of the trade marks

103. 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."

104. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider 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 trade marks.

105. The respective trade marks are as follows:

Applied for mark	**Earlier marks**
'640 mark SHINE	'951 mark shine '713 mark shineVision

106. I do not propose to repeat all the oral and written submissions advanced by the parties in so far as the similarity of the marks is concerned, but I have taken them into account in my deliberations.

Overall impression

107. The applied for mark is for the word SHINE presented in an unremarkable font in upper case. The overall impression resides in the totality of the word.

108. The '951 mark is also for the word 'shine', presented in lower case in a grey/silver graduated font. Praxis argues that the stylisation dominates the mark rather than the word itself. I do not agree. The stylisation, whilst contributing, makes a lesser contribution to the mark and does not detract from the word itself. The overall impression predominantly resides in the word.

109. The '713 mark is for the figurative mark shineVision. Whilst consumers normally perceive marks as wholes, this does not prevent them from identifying the elements which resemble words that they recognise. Therefore, despite being presented as one word and presented absent the tittles above the letters 'i' the '713 mark will be recognised as simply the words 'shine' and 'vision' conjoined. Neither party has argued that the '713 mark would be seen otherwise. This perception of being two words is reinforced by the emboldening of the word shine and the capitalisation of the letter V in vision. The overall impression lies in the words shine and Vision in combination.

Visual and Aural comparison

Comparison between the '640 mark and '951 mark

110. The difference in casing between the respective marks will have no impact on the comparison, since application/registration of a word-only mark allows it to be presented in upper, lower or title case.[65]

111. Both marks are for the identical word shine. The difference between them is in the stylisation of the '951 mark. They are visually highly similar. Since the stylisation will not affect how the marks are pronounced, they are aurally identical.

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

Comparison between the ‘640 mark and ‘713 mark

112. There is visual and aural similarity between the respective marks as a result of the shared word shine/SHINE, presented as the first element of the ‘713 mark and the totality of the ‘640 mark. They differ with the inclusion of the word Vision and the stylisation in the ‘713 mark, there being no counterpart in the ‘640 mark. The absence of dots above the letters ‘i’ are likely to go unnoticed by the average consumer, therefore, will have little impact. Given that beginning of marks tend to have greater aural and visual significance, the shared use of the word shine will mean that the respective marks are visually and aurally similar to a medium degree.

Conceptual comparison

113. All three marks share the identical concept in so far as the element shine is concerned which includes the meanings ‘to give out a bright light’, ‘to glow’, ‘to excel at’. The ‘640 and ‘951 marks are, therefore, conceptually identical. In so far as the ‘713 mark is concerned, the addition of the word ‘Vision’ does not alter the meaning of the word shine to create a new easily graspable concept. The average consumer is likely to see the words shine and vision in the mark but not take any particular meaning from the combination of words over and above the ordinary meaning of each individual word ie ‘shine’ as aforesaid and ‘vision’ meaning sight, image or aims of the business. The inclusion of the word vision gives rise to a point of conceptual difference and therefore overall, the ‘640 and ‘713 marks are conceptually similar to a medium degree.

Distinctive character of earlier marks

114. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

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

115. Registered trade marks possess varying degrees of inherent distinctive character, from those suggestive or allusive of a characteristic of the goods and services on offer, to those with high inherent distinctive character such as invented words which have no allusive qualities. The degree of distinctive character is a factor in the consideration as to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

116. Whilst Shinevision filed evidence which was sufficient to satisfy the threshold for genuine use, in so far as enhanced distinctive character this is a measure as to how strongly the mark identifies the goods/services of a single undertaking. Enhanced distinctiveness requires recognition of the mark by the relevant public, and in this regard, it has not satisfied that requirement. Whilst the article published in the Chronicle Live described the Shine software as a leader in its field, this statement is not borne out by the evidence. No evidence was filed as to turnover, sales or advertising expenditure that would support such an impression. Shinevision's promotional activity as shown in evidence is limited to attending Expos, two articles, a handful of marketing/introductory brochures being sent to prospective customers which are directed predominantly to the date of its launch in 2011. In so far as customer engagement is concerned, no information is given as to the number of visitors that visited its website, the footfall at the Expos or the number of visitors that attended Shinevision's stand, or the total number of brochures circulated. Shinevision

is only shown to have a limited social media presence and following on Twitter and Facebook, with posts generating very little reaction or comment. I am not satisfied that Shinevision has produced evidence of a sufficient quality or cogency to demonstrate any sort of level of enhanced distinctiveness or recognition amongst a significant proportion of the relevant section of the public beyond the inherent characteristics for either of its '951 or '713 marks. I shall proceed, therefore, on the basis of inherent characteristics only.

117. In so far as distinctiveness of the earlier marks is concerned, Praxis submits that the word (whether as a word only or as a figurative mark) is laudatory and has a very low level of distinctive character. Further, it filed state of the register evidence, which Mr Silcock argued at the hearing demonstrated the distinctive character of the word shine was weakened by the use of the word by other undertakings. The evidence it filed, however, was limited to screenshots taken from the IPO's register and tells me nothing as to how these signs were used in the market or the extent to which UK consumers were exposed to them. I am not persuaded by Praxis' arguments in this regard, therefore.

118. The '951 mark contains the word 'shine' in a stylised graduated silver font with no connection to the goods or services. Whilst the stylisation contributes, it is not so distinctive that it enhances the distinctiveness of the mark beyond the word itself. The '951 mark possesses an average (medium) degree of inherent distinctive character.

119. Similarly, the '713 mark also has no connection to the goods or services. The inherent distinctive character resides in the two dictionary words in combination. The stylisation is not particularly striking and therefore the mark as a whole is inherently distinctive to an average (medium) degree.

Likelihood of confusion

120. In determining whether there is a likelihood of confusion between the marks I must consider whether there is direct or indirect confusion. Direct confusion is where one mark is mistaken for the other, whereas indirect confusion is where the average consumer recognises that the marks are not the same, but due to the similarities between the marks and the respective services, believes that they originate from the same or a related source.

121. There are a number of factors in the global assessment to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods/services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing/selection process. In doing so, I must consider that the average consumer rarely has the opportunity to make side by side comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

122. In so far as Mr Silcock's argument that no actual confusion has occurred between the entities despite Praxis launching its SHINE platform in November 2018 and first using the name in June 2019, this argument is of little or no significance to the assessment. This is because the absence of evidence of actual confusion does not necessarily reflect the actual position regarding whether the average consumer would be aware of the respective marks on the market nor whether they have been consistently exposed to them side by side in comparable market environments.[66] The absence of confusion is unlikely to be a determinative factor, as it may be as a result of differences extraneous to the earlier mark.[67] The likelihood of confusion assessment must be based on an objective test of all the relevant factors.

123. Earlier in my decision I made the following findings:

> i. The '951 mark was visually similar to a high degree to the '640 mark, and the respective marks were conceptually and aurally identical. The '713 mark was visually, aurally and conceptually similar to a medium degree.
>
> ii. The earlier marks were overall inherently distinctive to an average (medium) degree.
>
> iii. I found some of the contested services to share no obvious similarity with the earlier marks, whilst the remainder were similar in varying degrees ranging between low and medium.

[66] *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41
[67] *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283

iv. The average consumer was a professional/business user. The level of attention undertaken in the selection process was above average (between medium and high) with the goods/services primarily selected by visual means, but with aural considerations not being discounted.

124. Dealing first with the assessment based upon the '951 mark. Both marks are for the identical word shine, the only difference is the stylisation of the earlier mark. Bearing in mind the principle of imperfect recollection and the fact that marks are not compared side by side, consumers are unlikely to recall the difference created by the stylisation of the graduated silver font, focussing on the word itself. Consequently, taking into account the interdependency principle, the stylisation used in the earlier mark is insufficient to counteract the identity of the word itself for all the goods and services I found to be similar and even for those services which I found to be similar only to a low degree. Despite an above average (between medium and high) degree of attention being paid in the selection process, I do not consider that the stylisation is sufficient to distinguish between them particularly given that marks are rarely compared side by side. There is sufficient aural, visual and conceptual similarity between the marks and the goods/services for consumers to mistake or imperfectly recall the marks one for the other. I consider that the '640 mark will be directly confused with the '951 mark.

125. Moving on to assess the contested mark against the '713 mark, the differences between the marks that I have already identified, are in my view, factors which prevent the marks being mistaken one for the other, especially by consumers paying an above average level of attention. I do not find that there would be direct confusion between the marks.

126. In so far as indirect confusion is concerned, the difference between direct and indirect confusion was explained by Mr Iain Purvis Q.C., (as he was then) as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc.*, as follows[68]:

"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

[68] BL O/375/10

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)."

127. I bear in mind that the examples set out by Mr Purvis in *L.A.Sugar* (above) are not exhaustive and that they are only intended to be illustrative of the general approach.[69] Furthermore, in *Liverpool Gin,* Arnold L.J. pointed out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where

[69] *Liverpool Gin Distillery Limited v Sazerac Brands, LLC & others* [2021] EWCA Civ 1207

there is no likelihood of direct confusion. In order for indirect confusion to occur the relevant public must believe that there is an economic connection between the two entities as a result of the shared common element. Whilst a shared common element alone does not necessarily lead to a likelihood of confusion it is important to note the aspects of the other elements within the respective marks and the part they play.

128. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion v Thomson.* The judge said:

> "18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
>
> 20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the

components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

129. It was argued by Mr Silcock that the combination of the words shine and vision created an unit with a different meaning in combination as opposed to their meanings when taken separately. Consequently, it was said that the word shine does not play an independent distinctive role within the mark when used in combination with the word vision and therefore it would not lead to confusion based on this common element alone. I do not agree. In my view the two words do not create a new word with a different meaning in combination to their individual meanings when taken separately. The two words merely sit alongside each other, but do not change the meaning of the other word. Each word plays an independent distinctive element by itself. For those consumers already accustomed to Shinevision's goods/services and vice versa, when coming across the later mark they will consider that it is the same or an economically linked undertaking that is responsible for the provision of the services under the shine/SHINE brand. Conversely it would also seem entirely plausible that someone who has seen Praxis' services under the mark SHINE would assume that the '713 mark was another mark used by the same entity as a house mark/sub-brand combination. I come to this conclusion despite having found that some of the goods/services are similar only to a low degree. There is sufficient similarity between the marks aurally, visually and conceptually for confusion to arise, particularly in relation to a mark which is inherently distinctive to an average (medium) degree. I consider that these factors would lead consumers to indirectly confuse the two marks.

Section 5(2)(b) Conclusion

130. I consider that there will be direct confusion in relation to the '951 mark and indirect confusion in relation to the '713 mark. The opposition under section 5(2)(b) succeeds in relation to all the contested services where I found there to be similarity

as set out in paragraphs 94 to 96 and fails in relation to the remaining services where I found no similarity, namely:

Class 42:

Rental Hosting services and Software as a service

Hosting services, software as a service, and rental of software in the fields of education and training; Hosting computer sites [web sites] in the fields of education and training; Rental of computer software in the fields of education and training; Rental of computer software and programs in the fields of education and training; Computer software rental in the fields of education and training; Renting computer software in the fields of education and training; Leasing of computer software in the fields of education and training; Software as a service [SaaS] in the fields of education and training; Software as a service [SAAS] services in the fields of education and training; Software as a service [SaaS] featuring software for machine learning in the fields of education and training; Platform as a Service [PaaS] in the fields of education and training; Creating and maintaining websites for others in the fields of education and training; Creating, maintaining and hosting the websites of others in the fields of education and training.

Generic IT services

IT services in the fields of education and training; Information technology services in the fields of education and training; Computer system analysis in the fields of education and training; IT project management in the fields of education and training;

Section 5(4)(a)

131. Moving on to the section 5(4)(a) claim, Shinevision relies upon its unregistered sign SHINE which it claims it has used throughout the UK since 2009 for *the provision of software, advisory services, IT services, consultancy and training services in the field of health and safety, risk management and compliance.*

132. 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".

133. 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."

134. 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)."

135. 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

136. In order for Shinevision to succeed under section 5(4)(a) it must demonstrate goodwill, misrepresentation and damage. It must establish that it had the requisite goodwill with UK consumers as at the relevant date, which in this case was accepted by both parties as the application date of 14 July 2021. Whilst Praxis filed evidence that it had used its mark prior to this date, it filed very limited evidence of prior use. Mr Silcock accepted, at the hearing, that in light of this, he was not asking for an earlier date to be considered as it would not make any material difference to the assessment and, therefore, I shall consider the claim of passing off as at the application relevant date.

Goodwill

137. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

138. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*,[70] Mr Thomas Mitcheson Q.C., sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph

[70] BL O/304/20

52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After doing so, he concluded that:

> "34. ... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

139. Shinevision must show that it had goodwill in its business at the relevant date and that the sign relied upon, in this case the word SHINE, is associated with or distinctive of that business. Goodwill arises out of trading activities which must be considered in the context of its revenue figures, promotional activity and customers in the UK, and which it must have established to more than a trivial degree. Whether goodwill to more than a trivial degree is found, is shown by the case law to be fact specific. Even a small or localised goodwill has been deemed to be sufficient to found a claim of a protectable goodwill.[71]

140. I have already summarised Shinevision's evidence in relation to genuine use (both for the revocation action and proof of use) acknowledging that an assessment of genuine use is, however, not the same thing as an assessment of goodwill.

141. Shinevision's claim under section 5(4)(a) is wider than its claim under section 5(2)(b) since it also relies upon *training services in the field of health and safety, risk management and compliance'*. However, in relation to these services for the reasons already outlined earlier in my decision,[72] I did not find that it had sufficiently demonstrated genuine use. At its height, the evidence given by Mr Taylor merely demonstrated ancillary training to its customers in the functionality of its software, and the creation of a link for one of its customer's to be able to access online training provided by a third party. The evidence was insufficient to show that it had created or preserved a market for training services and so it follows without being able to establish use, no goodwill could accrue to Shinevision in the provision of such services.

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[71] See *Smart Planet* ibid and *Lumos Skincare Ltd v Sweet Squared Ltd and others* [2013] EWCA Civ 590.
[72] See paragraph 80.

142. Returning to the remainder of the services it relies upon, I have already outlined the shortcomings in Shinevision's evidence. Nevertheless, the evidence does demonstrate small amounts of use over a long period, with repeat custom. Further, there is clear evidence that the business has operated since 2009/2010 and it continues to trade, as evidenced by its social media posts, one in particular in 2019 showing that had celebrated its 10 year anniversary. The provision of the services are directed to large institutions and organisations such as councils, universities and NHS trusts. I also have direct uncontested evidence from three of its customers that their organisations have used Shinevision's software systems since 2012 previously under licence from Msycdo. There is suggestion that there has been a renewal of the licence under Shinevision's ownership although not clear when. There is also evidence that the business has continued to trade up to the relevant date which is supported by the evidence of sales in 2019 and 2020.

143. Whilst the evidence regarding the size and intensity of the business is rather thin, on balance, I find that it is sufficient to show a small but protectable goodwill at the relevant date primarily in relation to the *provision of software and IT services in the field of health and safety, risk management and compliance* but also I consider that it can be inferred to extend to *advisory and consultancy services,* in the same fields. The 2017 invoice to CPI, which it is said is indicative of the invoices it issues, shows that Shinevision creates bespoke software for its customers, and it is inevitable that part and parcel of this process would include consultation regarding the customers' requirements and the imparting of advice to ensure amongst other things its customers' processes comply with Health and Safety regulations. I am satisfied that Shinevision has demonstrated a small but protectable goodwill to more than a trivial extent under the sign SHINE in relation to *the provision of software, advisory and consultancy services, IT services, in the field of health and safety, risk management and compliance.*

Misrepresentation

144. I note that the test for misrepresentation requires a substantial number of members of the public to be deceived and that this test differs to the one undertaken for a likelihood of confusion where it necessitates that the average consumer is

confused.[73] However applying the different legal tests is unlikely to result in different outcomes. For those goods and services that I found to be similar under section 5(2)(b) then I consider that it follows that any use by Praxis of a highly if not identical mark for similar services (even those I found were only similar to a low degree) would mislead a substantial number of members of the public into purchasing those services believing that they are Shinevisions'. This gives rise to a misrepresentation and damage is easily foreseeable.

145. However earlier in my decision, I did not find that all of Praxis' services shared similarity with Shinevision's goods/services. That was a finding made under the established caselaw pertinent to the section 5(2)(b) ground of opposition. Whilst such considerations are relevant under section 5(4)(a), they do not prevent a finding of misrepresentation and damage. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

> "There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd*. (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego case Falconer* J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the

[73] *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

> '…whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant':

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd. [1984] R.P.C. 501 Slade L.J.* said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

> 'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to

> show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case *Stephenson L.J*. said at page 547:

> '…in a case such as the present the burden of satisfying Lord Diplock's requirements in the Advocaat case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the Advocaat case, be substantial.' "

146. Both parties are in the business of providing computer software systems. Shinevision provides risk management software in relation to amongst other things asbestos compliance which to my mind would include such things as accident reporting tools and risk registers and services related thereto. Praxis is a health and safety consultant and software provider of e-learning platforms, enabling the creation, management and delivery of courses and training programmes over the internet also in relation to Health and Safety .

147. In considering whether there is, or could be, an association, between the field of activity of Shinevision and the field of activity of Praxis, I bear in mind that wondering if there is a connection between the businesses is not enough: there must be an assumption for misrepresentation to occur amongst a substantial number of Shinevision's customers (or potential customers).[74] It is also Shinevision's customers who must be deceived, not Praxis'.

148. Taking all these factors into account, I consider that there is sufficient overlap in the parties' fields of activity for a misrepresentation to occur, given that both companies are software providers operating in the health and safety sector. I consider that there will be a misrepresentation for a substantial number of Shinevision's

[74] *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd [2007] RPC 5*.

customers being large institutions and organisations, if Praxis' mark was used in relation to its services. I find at the relevant date Shinevision is entitled to prevent the use of Praxis' mark under the law of passing off in relation to those services as applied for because such use would be damaging to Shinevision's goodwill. Damage could arise in a number of ways such as the belief that the services offered by Praxis was a collaboration with Shinevision or that it had obtained a licence from Shinevision in order to use the mark in the provision of those services.

149. I am fortified in this view given that whilst its specification is outlined in broad terms, in reality the provision of its services is in the Health and Safety/risk management sector, which is the same field of activity in which Shinevision operates. Further it was shown in evidence to have directed its Health and Safety courses to at least one of Shinevision's customers.

150. Consequently, I consider that Shinevision's claim of damage has been made out and the opposition based upon section 5(4)(a) of the Act succeeds in full.

Invalidation

151. Shinevision's invalidation action is directed at Praxis' '149 mark for the word SHINE in relation to the *provision of online training, training services* in class 41. Shinevision relies on the same grounds, marks/sign and the identical specifications as it did for the purpose of its opposition. As with the opposition, Praxis required it to show genuine use for the '951 mark but not its '713 mark (although strictly speaking due to the date the invalidation action began it was subject to proof of use).

152. Section 47 of the Act reads as follows:

> "47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).
>
> […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasonsfor non-use.

(2C) 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.

(2E) 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.

(2F) 66 Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

[…]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor. (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

153. I have already outlined the evidence of use earlier in this decision. Whilst there is a difference in the period over which evidence of use has to be shown for the invalidation action as opposed to the opposition/revocation, there is sufficient overlap in the dates for the same findings to apply. For the same reasons, I am satisfied that Shinevision has shown genuine use of its '951 mark in order to have created a market for its goods and services as relied upon, both in the five year period leading up to the filing date of the '149 mark and in the five year period prior to the date the invalidation action was filed.

Section 5(2)(b)

154. Earlier in my decision, I outlined the applicable sections of the Act and the caselaw/relevant principles.

155. I shall begin by assessing the comparison of the respective goods services.

156. Praxis' '149 mark stands registered for '*provision of online training; training services'* in class 41 whereas for both its '951 and '713 marks Shinevision relies upon '*Health and Safety, Risk Management software packages, products, programmes and applications'* in class 9 and '*software creation, design, development, installation, maintenance and computer programming in the area of Health and Safety, Risk Management'* in class 42.

157. Notwithstanding that earlier in my decision (in the opposition) I found that mostly Praxis' software services in the field of education/training were similar to Shinevision's software services in the field of health and safety and risk management, this was because at their core the nature of the services were technical computing services. However, Praxis' training/provision of online training services in class 41 are different in nature and purpose to Shinevision's goods/services as they are the provision of educational services as opposed to technical services. The method of use is different, and the respective services are not in competition. I also do not find that the respective services are complementary to each other as they are not essential or important for one another in terms of the caselaw. The fact that there may be an overlap in user, at a very general level, is insufficient a basis alone for a finding of similarity to be made. I do not find similarity between Praxis' services and those goods/services relied upon by Shjnevision.

158. In order for a ground brought under section 5(2)(b) to succeed there must be similarity between the goods/services, the absence of which means that this ground fails at the first hurdle.

159. The invalidation action under section 5(2)(b) of the Act fails.

Section 5(4)(a)

160. As set out earlier, despite having found that the section 5(2)(b) ground does not succeed, because I found on a national basis that the goods and services were not

similar, under section 5(4)(a) there is no necessity for similarity between the respective goods and services as aforesaid.

161. Given the overlap in the considerations to be determined and my earlier findings in so far as Shinevision's claim to a goodwill is concerned, my earlier findings apply equally here. Although the relevant date is different, Shinevision has sufficiently established that it had goodwill in relation to the sign SHINE at the filing date of 9 August 2019 and the date of filing of its invalidation action as at 22 July 2022. For the same reasons, I find that Shinevision has a small but protectable goodwill in relation to the *provision of software, advisory and consultancy services, IT services, in the field of health and safety, risk management and compliance*.

162. In so far as misrepresentation and damage even though for the purposes of section 5(2)(b) I found that the *provision of online training, training services* were not similar to those goods and services relied upon by Shinevision I nevertheless find that there is sufficient nexus between the parties' fields of activity for the same reasons as I set out earlier in my decision in the opposition, for misrepresentation and damage to follow. The respective marks are identical and the services are not sufficiently distinct from each other for Shinevision's customers or potential customers not be deceived. Shinevision's customers would believe that Praxis is using the mark under licence or that there is a collaboration between the undertakings which would inevitably lead to damage being suffered by Shinevision.

163. Consequently, the invalidation action succeeds and the '149 mark shall be invalidated.

Overall outcome

164. Subject to appeal:

1. Praxis' revocation action against Shinevision's '951 mark is unsuccessful. Shinevision's trade mark registration number 2563951 shall remain registered for all the goods and services of its registration.

2. Shinevision's opposition has succeeded. Praxis' application for trade mark number 3668640 shall be refused registration in its entirety.

3. The invalidation action against Praxis' '149 mark succeeds under section 5(4)(a). The trade mark registration number 3420149 shall be invalidated and is deemed never to have been made.

Closing remarks

165. Regarding my refusal to allow Praxis to file evidence beyond the 300 page allowance, even if I had allowed the evidence to be admitted to its full extent, this would not have assisted Praxis. The evidence as originally filed, for the most part was ill focussed, with a great deal of it being repetitive and focussing on the use of the word 'shine' in combination with other words. The additional material would not have placed Praxis in any stronger position.

Costs

166. Shinevision has succeeded in its action overall and is therefore entitled to a contribution towards its costs, based upon the scale published in TPN 2/2016.

167. In so far as any costs incurred by Shinevision for attending the CMC dealing with Praxis' excess evidence, I invited the parties to file submissions after the hearing. Whilst ultimately the challenge to the Tribunal's preliminary view in refusing the additional material over the 300 page allowance was upheld, I do not consider that the challenge by Praxis to this decision was unreasonable and which would warrant off scale costs being awarded to Shinevision. Ultimately the issue was a matter between the Tribunal and Praxis and whilst it was right and proper for Shinevision's representatives to attend the CMC, the claim of costs submitted is in my view excessive and not justified, particularly in light of the issue to be determined and its lack of complexity. Therefore, having taken its submissions into account I consider that an appropriate award would be £200 as a contribution towards its costs for attendance at the CMC and any preparation time associated to it. Taking account of the scale, and the number of sets of proceedings, I award costs to Shinevision as follows:

Preparing Notices, Statement of Grounds and a Counterstatement in the revocation:	£600
Preparing evidence and considering and	

commenting on Praxis' evidence:	£1500
Attendance and preparation costs related to the CMC:	£200
Preparing for and attending a hearing:	£1000
Official fee (x2):	£400
Total	**£3,700**

168. I order Praxis42 Ltd to pay Shinevision Ltd the sum of £3,700 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 2nd day of June 2025

Leisa Davies

For the Registrar