

O/0532/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. UK00003877430
IN THE NAME OF HI-IMPACT CONSULTANCY LIMITED
FOR THE TRADE MARK:**

HI-IMPACT

IN CLASSES 9, 35 & 41

**AND AN OPPOSITION THERETO UNDER NO. 441758
BY DR N ALI LTD**

AND

**IN THE MATTER OF REGISTRATION NO. UK00003480431
IN THE NAME OF
DR N ALI LTD FOR THE MARK:**



IN CLASSES 35 & 41

AND

**AN APPLICATION FOR A DECLARATION OF
INVALIDITY UNDER NO. 507174
BY HI-IMPACT CONSULTANCY LIMITED**

BACKGROUND AND PLEADINGS

1. This decision involves cross-proceedings between the parties DR N ALI LTD (“DNA”) and Hi-Impact Consultancy Limited (“HIC”). I will summarise the relevant proceedings below, beginning with DNA’s opposition on the basis that it was brought first.

DNA’s opposition

2. On 13 February 2023, HIC applied to register the first mark shown on the cover page of this decision in the UK, being that numbered 3877430 (“HIC’s mark”). HIC’s mark was published for opposition purposes on 21 April 2023, and registration is sought for the following goods and services:

Class 9: Computer programs for use in data base management and for use in the field of management consulting; Downloadable media; Downloadable educational media; Digital recording media; Media content; Media and publishing software; Media streaming software; Project management software; Recorded media; Website development software; Virtual reality software; Virtual and augmented reality software; Virtual reality software for simulation; Virtual classroom software; Virtual assistant software; Virtual reality software for education; Virtual reality software for telecommunications; Virtual reality software for providing tours; Virtual reality platforms.

Class 35: Retail services in relation to recorded content.

Class 41: Providing entertainment information via a website; Entertainment services for sharing audio and video recordings; Entertainment services provided by on-line streams; Providing multi-media entertainment via a website; Providing video entertainment via a website; Provision of entertainment information via television,

broadband, wireless and on-line services; Sound recording and video entertainment services; Video entertainment services.

3. HIC's mark was partially opposed by DNA on 5 July 2023. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is reliant upon the following trade mark:



UK registration no. 3480431

Filing date 9 April 2020; registration date 11 August 2020

Relying on all services, namely:

Class 35: Advertising and marketing; advertising services; online advertising and marketing services; business data analysis; promotional services; business networking; online service for connecting social network users with businesses; business monitoring and consulting services, namely, tracking users and advertising of others to provide strategy, insight, marketing guidance, and for analysing, understanding and predicting consumer behaviour and motivations, and market trends; presentation of goods on communication media, for retail purposes; price comparison services; commercial information and advice for consumers [consumer advice shop]; providing consumer product information; providing comparison shopping information ;sales promotion for others; compilation of information into computer databases; systemization of information into computer databases; data search in computer files for others; dissemination of advertising for others via an on-line electronic communications network; business data analysis; providing statistical business information.

Class 41: Educating and entertainment services, information and advice relating to lifestyle, physical health, diet, cooking, mental health, general interests, publishing of books, magazines, journals and texts; news reporting services, provision of news and current affairs ;publication of online information, namely, blogs featuring user-defined content in the field of social networking; health, diet, cooking, exercise, general well being, and general interests, providing a real-time information network relating to the latest stories, ideas, opinions, news and to information of personal interest (educational, entertainment ,health, cooking, diet, and cultural services); publication of online journals, namely, blogs featuring personal information and opinions in the field of health, physical fitness, ,education ,diet, cooking, general well being and general interest; information relating to all the aforesaid provided online from a computer database on the Internet; Providing information relating to a wide variety of topics for entertainment, education, personal interests, or cultural purposes; providing a website featuring blogs and non-downloadable text, video and audio files in the fields of entertainment, sports, education, health advice, dietary advice, culinary advice, celebrity and culture and news; entertainment services, providing images from the Internet; provision of information relating to entertainment; publication of periodicals; providing online electronic publications (not downloadable) information relating to all the aforesaid provided online from a computer database on the Internet; consultation, advisory and support services relating to all the aforesaid services.

("DNA's mark").

4. DNA's opposition is aimed only at some of the goods and services in HIC's mark. These are as follows:

Class 9: Downloadable media; Downloadable educational media; Media content; Project management software; Recorded media; Virtual classroom software; Virtual reality software for education.

Class 35: Retail services in relation to recorded content.

Class 41: Providing entertainment information via a website; Entertainment services provided by on-line streams; Providing multi-media entertainment via a website; Providing video entertainment via a website; Provision of entertainment information via television, broadband, wireless and on-line services; Sound recording and video entertainment services; Video entertainment services.

5. DNA claims that the marks at issue are 'essentially' identical and that the goods and services at issue are similar. As such, it is claimed that there exists a likelihood of confusion between the marks. In respect of the pleaded claim, I note that while identity is not relevant to section 5(2)(b) grounds which is based on the marks being similar rather than identical (and identity is more appropriate to section 5(1) or 5(2)(a)), the inclusion of the word 'essentially', to me, means that the claim is actually that they are very highly similar. As a result, I see no particular issue with the nature of this claim.
6. HIC filed a counterstatement wherein it denied the claims against it.
7. Both parties filed evidence in chief in respect of DNA's opposition. In addition, DNA filed submissions in reply.

HIC's application for invalidity

8. DNA is the proprietor of a trade mark, the details of which are set out at paragraph 3 above. On 21 March 2024, DNA's mark was subject to an invalidation application by HIC. The application is brought under section 47 of the Trade Marks Act 1994 and is based on section 5(4)(a) of the Act.

9. In bringing its claim, HIC relies on the unregistered sign 'HI IMPACT', which it claims to have been using throughout the UK since 2008 in respect of the following goods and services:

“Educational Services, digital and downloadable media, editing media, advertising and marketing, virtual tours of schools, streaming multimedia content, educational training, brand / brochure design services for schools, web design for schools, consultancy services to schools and exam boards.”

10. HIC's claim is that its business enjoys a protectable level of goodwill stemming from the use made of its sign. As a result of the similar nature of the mark and sign and the similar nature of the services at issue, HIC claims that use of DNA's mark constitutes a misrepresentation or a likelihood of misrepresentation or association between the parties. As such, HIC's position is that damage will follow by way of loss of sales, reputational damage or dilution of its rights.

11. DNA filed a counterstatement wherein it denied the claims against it.

12. In support of the cancellation application, HIC filed evidence in chief whereas DNA filed written submissions. HIC also elected to file evidence in reply.

13. The Tribunal consolidated the above proceedings in accordance with the powers vested in it by Rule 62 of the Trade Marks Rules 2008. The evidence rounds in the opposition were closed by the time these proceedings were consolidated, hence the separation of the evidence summaries above. The consolidation was communicated to the parties on 29 August 2024.

14. HIC is represented by BRIFFA whereas DNA is unrepresented. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.

15. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

EVIDENCE AND SUBMISSIONS

16. As set out above, the decision to consolidate these proceedings was made after the conclusion of the evidence rounds in the opposition. Therefore, it is necessary to discuss the evidence and submissions separately insofar as they relate to each set of proceedings.

The opposition

17. DNA's evidence came in the form of the witness statement of Dr N Ali dated 4 January 2024. While labelled as a witness statement, the content actually consists of submissions as opposed to evidence of fact.

18. HIC's evidence came in the form of the witness statement of Alan Thompson dated 4 March 2024. Mr Thompson is the managing director of HIC and his evidence is accompanied by six exhibits, being AT1 to AT6. While the exhibits filed are noted, the narrative evidence of Mr Thompson is made up mostly of submissions as opposed to evidence of fact.

19. In reply, DNA filed submissions in reply. These are dated 10 May 2024.

The invalidation application

20. HIC's evidence came in the form of the witness statement of Alan Thompson dated 29 October 2024. Mr Thompson's evidence is accompanied by one exhibit, being AT2 which, to avoid confusion with the exhibit included within the statement filed

in defence of the opposition, I will refer to it as 1AT2. This evidence was adduced in order to demonstrate that HIC's sign enjoys a protectable level of goodwill in the UK.

21. As above, DNA did not file evidence but did file written submissions dated 26 December 2024.

22. In reply, HIC filed the second witness statement of Alan Thompson dated 11 March 2025. This is accompanied by one exhibit, being AT3 which, again to avoid confusion with the exhibit included in the statement filed in defence of the opposition, I will refer to this as 2AT3. The primary purpose of the evidence in reply was to demonstrate use across the breadth of the UK, a point raised by DNA in its submissions.

23. I will refer to points from the evidence or submissions where necessary.

MY APPROACH

24. I will begin my decision by assessing HIC's invalidation application. I do so because any success of the same would have a direct impact on DNA's opposition. On this point, if HIC's application succeeds in full then DNA's mark will be declared invalid and deemed to have never been protected in the UK. This would mean that it would not qualify as an earlier mark for the purpose of DNA's opposition resulting in said opposition falling away. Further, if the application is only partially successful then the opposition will proceed but only based upon those services that remain. Lastly, in the event that the application fails outright, then the opposition will proceed on the basis of DNA's earlier mark as it stands registered (it not being subject to POU). If necessary, I will discuss the position with DNA's opposition at the conclusion of HIC's application.

DECISION

THE INVALIDATION APPLICATION

25. Section 5(4)(a) of the Act has an application in invalidation proceedings by virtue of section 47(2) of the Act, which states as follows:

“47. –

[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(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.

[...]

(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.”

Section 5(4)(a)

26. Section 5(4)(a) of the Act reads as follows:

“(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.”

27. Subsection (4A) of Section 5 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.”

28. 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).”

29. 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 reputation¹ 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 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

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

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

31. DNA’s mark does not have a priority date. DNA has not provided any evidence of any earlier use prior to the application that could be said to be the start of behaviour complained about. Therefore, the relevant date for the section 5(4)(a) assessment falls on the filing date of DNA’s mark, being 9 April 2020.

Goodwill

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

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

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

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends

to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

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

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

35. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of

property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge’s finding). Again that shows one is looking for more than a minimal reputation.”

36. The first hurdle for HIC under this ground is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the sign relied upon was distinctive and/or associated with that goodwill. I remind myself that HIC’s earlier sign is ‘HI IMPACT’ and it is claimed to have been used on the following:

“Educational Services, digital and downloadable media, editing media, advertising and marketing, virtual tours of schools, streaming multimedia content, educational training, brand / brochure design services for schools, web design for schools, consultancy services to schools and exam boards.”

37. Goodwill stems from trading activities. HIC’s evidence begins with a brief discussion surrounding its background. It sets out that the company was incorporated in 2008 as ‘HI-IMPACT PHOTOGRAPHY & CONSULTANCY LIMITED’ but changed its name to ‘HI-IMPACT CONSULTANCY LIMITED’ in April 2013. The evidence sets out that HIC began its business operation by being primarily focussed on photography services in Wirral but has grown significantly over the years and now provides a ‘wealth of services across the UK’. In addition,

in respect of its business operation, the evidence claims that since 2008, HIC has offered what is referred to as a 'wide range of services'.

38. I appreciate that an assessment of goodwill is to be made based on the evidence as a whole. However, the way in which HIC has provided its evidence is such that I consider it necessary to summarise it under the cover of separate sub-headings. This is because the bulk of the evidence stems from a range of invoices to UK-based customers¹ as well as ancillary documents that are specifically introduced to cover the range of different services that HIC claims to provide. For example, there is one set of invoices and documents relied upon in support of HIC's claim to have used its sign on advertising, marketing and promotional services and another set of invoices and documents to support its claim to have used its sign on a range of business services, and so on. As I will demonstrate below, there is some overlap between the documents as HIC seeks to rely on some invoices to cover multiple fields of services. On this point, I do consider it necessary to point out here that the categories used by HIC in its evidence cover services that are not relied upon under the present ground. For example, HIC relies on a range of services relating to businesses (such as those ordinarily proper to class 35). However, such services are not relied upon under the present ground. That being said, as will become obvious below, the services actually shown under these claimed categories are not actually the type of services that would ordinarily fall within the categories HIC has referred to in its evidence. As a result, I consider that in order to fully demonstrate the entire evidential picture, it is appropriate to summarise the entirety of HIC's evidence, even where the headers are not seemingly relevant to these proceedings.

39. Before proceeding to discuss the invoices and other documents, I will summarise what I consider to be the more general evidence of HIC, namely its turnover, press coverage and awards evidence.

¹ In respect of the invoices, it is noted that a number of them are from after the relevant date. Rather than discuss this at each point, I will simply state here that I will discuss only those invoices that are of assistance here.

40. Firstly, I consider it necessary to discuss the evidence that HIC filed in support of the opposition. I do so here because the evidence, whilst mostly made up of submissions, does make brief mention of HIC's clients which, on the face of it, assist in proving the existence of trading activities.² That being said, this evidence comes via an undated printout taken from the 'Partner Directory' of HIC's own website.³ As such, it is not possible for me to determine whether the customers shown were customers of HIC prior to the relevant date. Further, it offers nothing by way of what level of use or what actual services were provided to such customers. Whilst I have mentioned this evidence for the sake of completeness, and whilst it somehow supports HIC's claim as to the existence of a business with customers, it is not really helpful in establishing the level of trade prior to the relevant date. The remaining evidence filed in support of the opposition pertains solely to the opposition, so I see no reason to discuss it here.

41. In respect of its general claims to use, HIC has provided a table showing its revenue figures that it has accrued between 2008 and 2024. Whilst the year 2008 is noted, the table shows this information as being unknown and not available. Further, the figures for 2021 onwards are not relevant to these proceedings. Therefore, I will reproduce the figures from 2009 to 2020 only.⁴

Year	Revenue (£)
2009	28,815
2010	52,604
2011	112,804
2012	320,642
2013	725,148
2014	908,980
2015	1,319,413
2016	1,074,429

² On this point, I appreciate that I have separated out my evidence summary above but that was for ease of reference. As these proceedings are consolidated, the evidence filed in the opposition may still assist in the invalidation application.

³ AT4

⁴ Whilst bearing in mind that the relevant date is on 9 April 2020 meaning that a significant portion of the 2020 figures is irrelevant to this assessment.

2017	1,280,027
2018	1,528,030
2019	2,139,153
2020	2,162,902
Total	11,652,947

42. In terms of press coverage, HIC has provided five articles from various UK-based publications. They are as follows:

- a. An article from the BBC dated 16 July 2012 that relates to students at a school in Wirral taking pictures of Earth from space with the help of a NASA scientist.⁵ The nature of HIC's involvement in this project appears to be the assistance of downloading the footage from the balloon (that was sent to take the footage) after it was recovered and presenting it to the students.
- b. Another article dated 6 July 2012 discussing the same project as above from Wirral Council's website.⁶
- c. An article from Wirral View dated 13 June 2014 regarding a class in a local school dressing up as robots as part of a technology week.⁷ It is stated that the workshops regarding this were hosted by HIC.
- d. A press release from Big Bang North West dated April 2018 announcing the HIC would be returning to the Big Bang North West event as an exhibitor for its 2018 event.⁸ The event discussed is one that encourages young people to take up STEM related careers.
- e. Another article from Wirral View dated October 2019 that relates to a space-themed educational camp for young RAF students.⁹ HIC is mentioned as partnering with the RAF to deliver this experience.

43. The evidence makes reference to a number of awards HIC has won. This include HIC being named as a finalist for the Partnership Initiative of the Year in the SHP

⁵ Pages 136 to 138 of 1AT2

⁶ Page 139 of 1AT2

⁷ Page 140 of 1AT2

⁸ Pages 111 to 114 of 1AT2

⁹ Page 141 of 1AT2

IOSH Awards 2012.¹⁰ This is explained as being an award that was given to HIC for working with a school and the local authority health and safety officer in respect of the project discussed at paragraph 49a and b above. There is a photograph provided of the Education Investor Award event in 2013 that shows HIC's branding on the screen.¹¹ No information is given as to whether this is the receipt of an award or merely reference to HIC as a sponsor, partner or presenter of an award. The evidence discusses the fact that HIC was named as a finalist in the Liverpool Echo Regional Business Awards 2017. A screenshot of this is provided in evidence.¹² It is confirmed that this award was given predominantly for the innovative media services it provides to businesses in the area for its client's marketing and training. One last honour is discussed as being a UK Business Hero in 2020 that was awarded by the Countess of Wessex.¹³ However, this relates to how HIC went the extra mile during the COVID-19 pandemic and given that any recognition for activity during this time was likely to have come after April 2020 it would be after the relevant date. As such, I do not consider it of assistance here.

44. I turn now to the evidence claimed to specifically cover certain services relied upon.

Advertising, marketing and promotional services (or similar)

45. A range of invoices are provided in evidence to assist in showing sales of HIC's advertising, marketing and promotional services.¹⁴ It is stated that the invoices also show 'similar' services such as assets created to assist clients with advertising, marketing and promotion. Of the relevant invoices, they cover services provided to undertakings based in Birkenhead, Wirral, Liverpool, Middlesex, Isle of Man, London, Scotland and Bath. They cover event photography, printing services (including the printing of brochures, folders and seemingly posters),¹⁵ filming and DVD production, 3D design services, 3D infrared scanning, online hosting

¹⁰ Page 142 of 1AT2

¹¹ Page 143 of 1AT2

¹² Page 144 of 1AT2

¹³ Page 145 of 1AT2

¹⁴ Pages 3 to 31 of 1AT2 and pages 1 to 7 and 15 to 20 of 2AT3

¹⁵ In respect of these services, there does not appear to be any indication that HIC actually provided the design of these brochures as opposed to simply printing them.

(including hosting a 3D virtual tour), IT training for staff, filming services for hotel and staff, video editing services, creation of CGI images and training for marketing staff. I appreciate that these services may be associated with advertising, marketing and promotional services on the basis that photography services may, for example, provide photographs that are ultimately used by the customer to advertise. However, it is not clear whether this is actually the case or not and even if the photographs were used in this way, there is nothing to suggest that HIC actually designed the advertising campaign behind them. In any event, I do appreciate that some of the offerings covered by these invoices could be said to be digital and downloadable media (being terms that are relied upon), a point I will bear in mind. Further in the respect of these invoices, I am of the view that training of marketing staff is not a service for the provision of marketing.

46. In support of these services, HIC has provided a range of documents that it claims to show use of the same. The first document is a list of ongoing services and dates for the provision of said services in the Autumn and Spring of 2009 and 2010. The list of services includes reference to an 'eBay Launch', 'Picture the Music Day', 'Sound and Radio Training', 'Earth & Space', 'Pied Piper' and 'Reception Activity'.¹⁶ Outside of the sound and radio training, it is not clear what services are actually being offered here. Another document provided refers to a podcasting workshop in 2010.¹⁷ While these documents, and others like it, are noted, they appear to be advertising materials attempting to drive business towards HIC and are not documents that actually show that HIC actually offers such services to third parties.

Business consultancy, business monitoring, business network and general business services (or similar).

47. Again, invoices are provided in support of the above.¹⁸ These are to undertakings with addresses in Wirral, Cheshire, Middlesex, Jersey, York, London, Suffolk and Workington. They cover the provision of presentations, something referred to as a 'Greek Experience' and 'Creative Partnership Days', equipment rental, audits,

¹⁶ Page 90 of 1AT2

¹⁷ Page 102 of 1AT2

¹⁸ Pages 32 to 62 of 1AT2, pages 25 to 30, 46 to 49 and 51 to 54 of 2AT3

consultancy (some vaguely referred to as 'consultancy' some being consultancy in schools) and safety meetings. It is noted that some of these invoices includes the costs associated with hotel accommodation.

48. In further support of the claim to have used the sign on these services, HIC has provided a range of ancillary documents.¹⁹ These are noted but include audit reports, some consultancy documents and those referring to curriculum support. They do not point to actual business consultancy.²⁰ On this point, I consider it necessary to point out that business consultancy is a service provided to companies in order to give advice and direction regarding the actual running of their businesses, such as managing changes or to maximise growth via increased profits/lower expenditure, for example. I do not consider such services to be the same as consultancy services offered to an education provider in respect of its curriculum, which appears to be the focus of HIC's evidence. In any event, business services are not relied upon here.

Data analysis services and providing statistical business information

49. A number of the invoices I have discussed above are also discussed in the context of data analysis services, providing statistical business information or similar. These appear to be in respect of the audit services discussed above. In addition, further invoices are provided that show the provision of additional audit services, a tech report, hosting of staff meetings, consultancy and curriculum support to undertakings based in Ellesmere Port, Liverpool, Stockport, Wirral, London and Jersey.²¹ It is noted that one of these invoices includes the provision of an external hard drive.

50. In further support of a claim to have used these services, HIC has referred to a research report it provided in June 2011.²² This includes a wide range of data

¹⁹ Pages 36 to 38, 89 to 90, 115 to 123 of 1AT2 and pages 21 to 24, 31 to 45 and 48 to 50 of 2AT3

²⁰ For example, see page 90 of 1AT2 which appears to offer no such business related services. Further, see page 123 which is introduced as showing business networking services but the document provided is merely a flyer for a conference. Whilst it may be that HIC was attempting to network itself via this conference, it is not evidence that HIC actually offers such services to customers.

²¹ Pages 45 to 50 of 1AT2 and pages 56 to 59 of 2AT3

²² Pages 128 to 132 of 1AT2

relating to schools which, in my view, is the collection of data as opposed to its actual analysis or the provision of statistical business information. In addition, HIC has provided an audit report wherein it audited one school's use of ICT equipment.²³ It appears that the only data relates to whether teachers use laptops to teach ICT or whether they use laptops to use ICT in other curriculum subjects. While noted, this is an audit report in respect of one school's use of ICT equipment and I am not convinced that it covers the provision of data analysis or statistical business information (which are not even relied upon here) or any of the pleaded goods or services, for that matter.

51. Further to the above, a vague reference is made to a service level agreement ("SLA") and the use of the phrase 'Staff Virtual Learning Environment'.²⁴ There is nothing to suggest that this is the provision of data analysis or statistical business information so it does not appear relevant to the same. Lastly in respect of this evidence, HIC refers to a LinkedIn post from 2017 regarding HIC partnering with a third party company to bring secure online exam testing to Wirral.²⁵ This is noted but nowhere does it suggest that this is the offering of statistical analysis. In my view, the scoring of a secure online test taken by a student is not the provision of a statistical analysis service and neither is it the provision of statistical business information. Again, such services are not even relied upon under the present ground.

52. Lastly in respect of these services, I consider it necessary to point out that they are technical in nature. As a result, I am of the view that it is reasonable to expect further explanations in respect of such services and how they can be said to fall within the categories claimed. Without such, it is not possible for me to correlate the services covered in the evidence with those actually relied upon.

²³ Pages 115 to 119 of 1AT2

²⁴ Pages 63 to 64 of 1AT2

²⁵ Pages 134 and 135 of 1AT2

Education and entertainment services

53. Of the invoices provided in respect of these services, I note that they include the provision of staff training, photography workshops, a safety awareness course, workshops (including the provision of food), filming, editing and production, Google Apps training, a Skype poetry day, website set up including hosting and training, a 'Robotics Day', student training, curriculum consultancy, technical support, training for marketing staff, 3D infrared scanning, a 'Jersey to Mersey Conference', curriculum support services and something relating to a Nintendo Wii Video Conference.²⁶ It is noted that these invoices cover services provided to undertakings based in Wirral, Middlesex, Cheshire, Liverpool, Isle of Man, Jersey, London, Suffolk, Workington and York.

54. In addition to the above, additional documents have been provided by way of SLAs for such services.²⁷ While noted, they are documents that relate to curriculum consultancy. In addition, separate SLAs have been provided in respect of services offered to UK clients.²⁸ These are dated between 2014 and 2024, with only the ones from 2014 to 2019 being relevant here. These documents discuss technical support, curriculum support, training support, online support (including remote login and ticketing service), support visits, infrastructure support, multimedia and audio visual support, projector maintenance and cleaning, admin network support (including management of backups, the cloud and antivirus software) and internet, firewall and filtering support. All of these documents make reference to the provision of services over a school calendar and also make reference to non-school days, thereby indicating that the services are provided to schools. As a result, it is my view that these documents sit within a claim pertaining to use of HIC's services relating to the education sector.

²⁶ Pages 6, 10 and 51 to 60 of 1AT2 and pages 26 to 27, 30, 34 to 35, 38 to 39, 55, 58 to 59, 62 to 66, 74 of 2AT3

²⁷ Pages 21 to 23, 32 to 33, 45, 48 to 50 of 2AT3

²⁸ Pages 63 to 88 of 1AT2

55. A range of flyers provided by HIC are provided in evidence.²⁹ While it is noted that these documents appear to have been provided more generally to demonstrate the breadth of HIC's services, they cover services provided to school students, teachers and parents. As such, they appear to me to relate mainly to a claim in respect of a range of services relating to education. For example, the flyers refer to 'sessions' regarding pupil-voice podcasts, video conferences, blue screen movie making. All of these are mentioned in the context of projects to enhance learning and creativity in the classroom. One flyer is headlined with a claim that HIC creates synergy between innovative classroom teaching and technical support and makes reference to HIC's range of consultants who are experts in ICT and multimedia equipment to enhance creativity in classrooms.

56. In respect of entertainment alone, HIC has attempted to rely on a number of invoices provided in respect of services offered to undertakings based in Isle of Man, London and Somerset.³⁰ These are noted but relate to services such as 3D infrared scanning, hosting services (including the hosting of 3D tours), provision of still images, infrared walk throughs, filming services, creation of 3D models. Plainly, I fail to see how any of these are the provision of services for entertainment. That being said, I do bear in mind a similar point to that I have made above in that these offerings could be said to be "digital and downloadable media". Further, the 3D model related offering could be said to fall within "virtual tours for schools", but I appreciate that I have nothing before me to assist in categorically determining this.

Provision of websites featuring blogs and non-downloadable text

57. There is evidence that HIC has introduced to support a claim that it provides websites featuring blogs and non-downloadable text, video and audio files. One document is claimed as demonstrating use of such services but is merely a pamphlet regarding training to children on how to use the internet safely and does not, to me, appear to be the offering of services in line with the provision of a

²⁹ See pages 89 to 95 of 1AT2. While the narrative evidence mentions goods, there are no goods relied upon in the invalidation application.

³⁰ Pages 1 to 2, 4, 7, 16 and 20 of 2AT3

website.³¹ One article which discusses HIC's launch of an online education platform but this is dated July 2021 so is not relevant here.³²

Assessment of the evidence

58. It is noted that DNA's chief criticism of HIC's evidence is its localised nature in that any use is regional and covers just Liverpool, Wirral and the surrounding areas. Even in HIC's evidence in chief, this was not the case as it covered not only a large area in North West England but included invoices addressed to locations in Stockport (which is more central within England), York (which is in North East England), Jersey (which is an island to the South of mainland UK) and Middlesex (which is in the South East of England). In any event, HIC filed evidence in reply demonstrating a further spread. Such evidence was taken into account in my above summary and I see no reason to discuss it any further here. In short, it is clearly the case that the use shown covers a sufficient geographical spread across the UK at large and, as such, I see no merit in the argument raised by DNA. Even if there were, localised goodwill does not prevent a claim under the present ground from succeeding, as discussed in the cases of *Chelsea Man Menswear Limited v Chelsea Girl Limited and Another* - [1987] RPC 189 (CA) and *Caspian Pizza Ltd v Shah* [2017] EWCA (Civ) 1874.

59. In considering the evidence as a whole, it is clear that HIC has demonstrated that it has operated its business at a sufficient level and for a longstanding period of time (being a turnover of approximately £11 million over 12 years). Such a level of use is, on the face of it, sufficient to demonstrate that HIC's business enjoys a protectable level of goodwill. Further, I am satisfied that the sign relied upon is distinctive of and/or associated with that goodwill as it appears frequently throughout the evidence on flyers, SLAs and invoices. That being said, I have some reservations as to what services are actually provided. I say this because the turnover provided is not broken down in any way and because HIC claims to have used its sign on a disparate range of services, some of which do not even fall within

³¹ Page 99 to 101 of 1AT2

³² Page 126 of 1AT2

the goods and services pleaded in the invalidity application. For example, the invoices provided cover a disparate range of services such as 3D design services, auditing services, film production services, provision of websites and photography services. Additionally, some of the workshops covered by the evidence are vague as to what they aim to provide as, for example, they simply refer to ‘Shakespeare’ and ‘eBay Day’. I have nothing to suggest whether the ‘Shakespeare’ workshop teaches attendees about the writings of Shakespeare or simply a reading of Shakespeare’s works. Further, it is not clear to me what an ‘eBay Day’ is. On the point of the disparity of the services, by my own count, there appears to be over 50 different types of services covered by the evidence as a whole.

60. While the disparate nature of the evidence and lack of breakdown for the turnover would be a significant hurdle when it comes to determining the issue of genuine use,³³ the assessment of goodwill is not to be approached in such a granular fashion. In saying this, I remind myself of the comments of Dr Brian Whitehead who, sitting as the Appointed Person, in *BUNNYJUICE* (BL O/0064/24) set out at paragraph 57 that:

“In passing off law, however, goodwill attaches to a business, rather than to isolated individual goods and services. Of course, when assessing goodwill, it is necessary to ask, “What is the nature of the business?”, but it is not appropriate to break the business down at the same level of granularity as is done for assessing trade mark use etc.”

61. The consideration as to the nature of HIC’s business has been rendered somewhat difficult due to the broad range of use claimed and, further, some claims are incredibly vague. For example, HIC refers to photography services in support of advertising services but nowhere in the evidence does it clarify the nature of these services or what proportion of the overall business such services take up. Additionally, HIC relies on “virtual tours of schools” as a term under the present ground. While I note that some invoices include the scanning and generation of the

³³ See paragraphs 26 and 27 of *Eros Bodyglide* (BL O/0984/25), for example.

same (the end product of this is likely to be the production of ‘digital and downloadable media’), there is just nothing to allow me to accurately apportion the turnover to such a term in order for me to be able to assess how this impacts the nature of HIC’s business. Further, as I have discussed above, some of the evidence does not correspond to the goods and services in relation to which goodwill has been pleaded. In light of these issues, I consider it reasonable to approach this matter on the basis that unless I consider that the evidence offers a sufficient degree of clarity, I am not willing to find that any of HIC’s goodwill vests in the goods and services relied upon.

62. Keeping in mind the approach discussed above, I accept that the evidence appears to indicate that HIC has a primary focus in respect of services that relate to the education sector. Having considered such evidence, I am not willing to accept that it actually demonstrates the offering of educational services akin to a university operation or an adult learning provider, for example. In addition, while the evidence does include reference to HIC hosting workshops, I repeat what I have said above in that the evidence on this point is vague as some workshops simply refer to ‘Shakespeare’ or ‘eBay day’. As a result, I do not consider the evidence is sufficient enough to cover “educational services” at large. That being said, taking a step back and considering what I can categorically determine from the evidence, it appears to me that the SLAs provided by HIC, whilst seemingly including a range of ancillary services, are, at their core, documents regarding the provision of curriculum consultancy for education providers. These consultancy services are also covered by the flyers provided in evidence. In addition, while HIC has attempted to rely on a range of invoices in support of a wide variety of services, they mostly appear to be services provided to schools. On this point, I note for example, when seeking to claim use for business consultancy, there are invoices from June 2016 and February 2017 that provide a service for the provision of ‘consultants in school’.³⁴ To me, this is consultancy provided to a school as opposed to actual business consultancy services.

³⁴ See page 42 of 1AT2

63. As a result of the above, I am of the view that, on balance, I can satisfactorily conclude that the primary nature of HIC's business is that of an educational consultancy provider to schools. While the term relied upon is "consultancy services to schools and exam boards", this can cover any form of consultancy and, clearly, the evidence has a focus on education. As such, I find that in the present circumstances the goodwill stems from HIC's use of the term "educational consultancy services to schools".

64. As for the remaining services for which goodwill is claimed, I am of the view that seeking to prove use for such a wide range of services has ultimately meant that HIC's evidence lacks any real focus outside of what I have said in the preceding paragraphs. This is particularly the case given that the narrative evidence of Mr Thompson offers no real clarity as he simply states that HIC offers a wide range (or a 'wealth') of services. On this point, I will say that it appears to me that all HIC has done is collate a large number of invoices (a significant amount of which being from after the relevant date) and documents pertaining to curriculum consultancy and attempt to argue that they fall within a disparate range of services without any real justification for doing so. As just one example, I remind myself that HIC sought to rely on the provision of 3D infrared scanning at a school as an entertainment service. This is clearly misguided, in no way supportable and is indicative of a pattern that flows throughout the majority of HIC's evidence. Even if said service was capable of supporting use of "virtual school tours", there is nothing to assist me in determining the actual level of use for this.

65. To conclude the present assessment, I appreciate that the issue of goodwill is not to be made on an overly granular basis. However, the disparate nature of the services covered by HIC's evidence is such that I do not consider it appropriate to assign the goodwill to any other terms relied upon (or not pleaded). In short, I consider it reasonable to expect, for example, some degree of clarity in respect of how much the other services contribute to the overall revenue figures provided. Without this, I am not willing to make an inference as to do so would be inappropriate in the circumstances.

66. To summarise all of the above, I find that HIC's business enjoys a moderate level of goodwill in its business that vests in "educational consultancy services to schools". Further, the sign relied upon is distinctive of and/or associated with said goodwill.

Misrepresentation

67. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

"is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

68. And later in the same judgment:

".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and

concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

69. In light of the case law above, it is not necessary for the opponent to show that there has been actual misrepresentation to the relevant public. Therefore, a notional assessment of the same may apply.

70. I have found that the opponent enjoys a protectable level of goodwill for the sign ‘HI IMPACT’ in respect of “educational consultancy services to schools”. DNA’s mark is as follows:



71. While DNA’s mark is a figurative one, featuring a red academic cap and a red ‘heartbeat line’, it is clearly similar to HIC’s sign. I say this because it prominently features the words ‘the high impact’. In my view, the word ‘the’ is likely to be overlooked or given very little weight as it offers no real trade mark value. As such, ‘high impact’ will dominate the mark. Despite the addition of the figurative elements in DNA’s mark, it is still visually similar to HIC’s sign to at least a medium degree. Whilst DNA’s mark includes the letters ‘g-h’, ‘HI’ and ‘high’ will still be pronounced the same and, as such, consumers will attribute ‘HI IMPACT’ and ‘high impact’ as carrying the same meaning. Further, it is likely that ‘HI’ will be plainly viewed as a deliberate misspelling of ‘high’. Therefore, I find that the ‘HIGH IMPACT’ element of DNA’s mark is aurally and conceptually identical to ‘HI IMPACT’.

72. I turn now to the services at issue. DNA’s services are set out at paragraph 3 above. Under the present ground, the assessment of the services involves a consideration of the closeness (or otherwise) of the fields of activity in which the parties conduct their business. I consider that HIC’s field of activity sits in the education consultancy sector. Dealing with the educational services of DNA’s mark

first, I consider that there is a sufficient degree of closeness (arguably, even an outright overlap) between HIC's business and the following services of DNA:

Class 41: Educating services; providing a real-time information network relating to the latest stories, ideas, opinions, news and to information of educational interest; publication of online journals, namely, blogs featuring education; providing information relating to a wide variety of topics for education; providing a website featuring blogs and non-downloadable text, video and audio files in the fields of education; consultation, advisory and support services relating to all the aforesaid services.

73. In addition to the above, it is noted that DNA's services include a range of consultancy and advisory services. While HIC's service is limited to education consultancy for schools, it is still a form of consultancy and, therefore, operates within the same (or sufficiently similar) field as other consultancy services. In addition, I am of the view that some of DNA's class 35 business services can reasonably be said to those that are provided to, for example, private schools which in my understanding operate as a form of a business.³⁵ Additionally, I consider that the provision of advice is an offering that is sufficiently close to HIC's field of consultancy. As such, I find that there is a degree of closeness between HIC's field of activity and the various types of consultancy and advisory services in DNA's specification, regardless of the nature of that advice (be that health and diet advice, for example).

74. As a result, I find that the following services operate in the same (or a sufficiently similar) field of activity as HIC:

Class 35: Business monitoring and consulting services, namely, tracking users and advertising of others to provide strategy, insight,

³⁵ That being said, I do not consider that this automatically means an overlap with any type of business service. For example, I see no reason to find that a private school would require business data analysis to the point that it could be said that the fields of activity are similar. On this point, I note that I have no evidence to prove otherwise.

marketing guidance, and for analysing, understanding and predicting consumer behaviour and motivations, and market trends; advice for consumers [consumer advice shop].

Class 41: Advice relating to lifestyle, physical health, diet, cooking, mental health, general interests, publishing of books, magazines, journals and texts; providing a website featuring blogs and non-downloadable text, video and audio files in the fields of health advice, dietary advice, culinary advice.

75. Further, DNA's class 41 services include the catch-all terms of "providing online electronic publications (not downloadable) information relating to all the aforesaid provided online from a computer database on the Internet" and "consultation, advisory and support services relating to all the aforesaid services". Dealing with these in turn I note that the former term, insofar as it applies to sectors close to (or overlapping with) HIC's field of business, it too is sufficiently close to HIC's service.³⁶ Turning to the second term, even where the services in class 41 are not close to HIC's field of activity, this term covers consultation and advice. As above, I consider that both types of services either directly operate within HIC's field of activity or are sufficiently close to it. Therefore, I find that regardless of what service DNA's 'consultancy' and 'advice' catch-all services relate to, they operate in either the same, or a sufficiently close, field of activity as HIC. For the avoidance of doubt, this does not apply to the 'support' services.

76. As for the remaining services, these include terms such as those that relate to entertainment, sports, diet and health, business management, advertising, news reporting, publication services, amongst others. All such services operate in different fields of activity and I do not consider that there is any degree of closeness between them. Further, where DNA's specification includes the term "providing online electronic publications (not downloadable) information relating to all the aforesaid provided online from a computer database on the Internet", I find that

³⁶ This finding also applies to the term "information relating to all the aforesaid provided online from a computer database on the Internet"

insofar as it applies to these distant services, I find that this term too is distant because it covers topics unrelated to HIC's field of business.³⁷

77. In considering the issue of misrepresentation, I am of the view that the mark and sign at issue are similar enough to result in a sufficient number of the relevant public being deceived into thinking DNA's services that share an overlap (or degree of closeness) in their fields of activity with HIC are offered by, associated with or endorsed by HIC. Such a finding gives rise to the existence of a misrepresentation for those services, namely those I have discussed at paragraphs 72 to 75 above. However, as for the services for which there is no overlap or degree of closeness, I remind myself that the burden for proving a misrepresentation across differing fields of activity is a high one.³⁸ In short, HIC has failed to provide any sufficient evidence to satisfy this burden. Therefore, there is no misrepresentation for those services that do not operate in the same or similar fields of activity as HIC's services.

Damage

78. Having found the existence of goodwill and misrepresentation, I consider that damage through diversion of sales is easily foreseeable. The application for invalidity based upon section 5(4)(a) is, therefore, partially successful.

Conclusion of the application for invalidation

79. HIC's application for invalidity succeeds in part, meaning that DNA's mark is hereby declared invalid (and an application for the same is deemed to have never been made) for the services for which there exists a misrepresentation and damage. I do not intend to summarise the level of success here and will, instead, reserve that until the conclusion of my decision. However, the services against which the

³⁷As was the case above, this also applies to "information relating to all the aforesaid provided online from a computer database on the Internet"

³⁸ See *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) and *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501

application for invalidation has succeeded are set out at paragraphs 72 to 75 above.

80. As for the services for which DNA's mark may remain registered, it is necessary to set these out here as they will form the basis of DNA's opposition. They are as follows:

Class 35: Advertising and marketing; advertising services; online advertising and marketing services; business data analysis; promotional services; business networking; online service for connecting social network users with businesses; presentation of goods on communication media, for retail purposes; price comparison services; commercial information for consumers; providing consumer product information; providing comparison shopping information; sales promotion for others; compilation of information into computer databases; systemization of information into computer databases; data search in computer files for others; dissemination of advertising for others via an on-line electronic communications network; business data analysis; providing statistical business information.

Class 41: Entertainment services and information relating to lifestyle, physical health, diet, cooking, mental health, general interests, publishing of books, magazines, journals and texts; news reporting services, provision of news and current affairs; publication of online information, namely, blogs featuring user-defined content in the field of social networking; health, diet, cooking, exercise, general well being, and general interests, providing a real-time information network relating to the latest stories, ideas, opinions, news and to information of personal interest (entertainment, health, cooking, diet, and cultural services); publication of online journals, namely, blogs featuring personal information and opinions in the field of health, physical

fitness, diet, cooking, general well being and general interest; information relating to all the aforesaid provided online from a computer database on the Internet; Providing information relating to a wide variety of topics for entertainment, personal interests, or cultural purposes; providing a website featuring blogs and non-downloadable text, video and audio files in the fields of entertainment, sports, celebrity and culture and news; entertainment services, providing images from the Internet; provision of information relating to entertainment; publication of periodicals; providing online electronic publications (not downloadable) information relating to all the aforesaid provided online from a computer database on the Internet; support services relating to all the aforesaid services.

THE OPPOSITION

81.As HIC's application was partially successful, DNA's opposition may proceed but only in reliance upon those services for which its mark is permitted to remain registered for, being those listed at paragraph 80 above,

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

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

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

(a) [...]

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

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

83. Section 5A of the Act states as follows:

“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.”

84. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

[...]

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

85. Given its filing date, DNA’s mark qualifies as an earlier trade mark in accordance with the above provisions. As this mark did not complete its registration process more than five years prior to the filing date of HIC’s mark, the use provisions set out in section 6A of the Act do not apply. The consequence of this is that DNA may

rely on all of the services identified in its notice of opposition (subject to the above invalidation proceedings, of course).

86. The following standard summary of the principles applicable to the assessment of the likelihood of confusion (under section 5(2) of the Act) was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

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

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

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

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

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

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

in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods and services

87. The services upon which DNA can rely are set out at paragraph 80 above. As for the opposed goods and services of HIC's mark, these are set out at paragraph 4 above.

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

“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”.

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

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

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

Class 9

Downloadable media; Recorded media; Media content.

91.DNA’s services include the term “entertainment services and information relating to lifestyle, physical health, diet, cooking, mental health, general interests, publishing of books, magazines, journals and texts”. While the term beyond ‘entertainment services’ is noted, it is not limiting in any way. For example, if the term was “entertainment services, namely...” then I accept it would limit the nature of those entertainment services. However, that is not the case here and, in my view, this issue has come from DNA using commas to break up the services offered as opposed to a semi-colon. As such, my interpretation of the above term is that it includes “entertainment services” at large.

92.In comparing the above terms with “entertainment services”, I find that it is clear that the natures and methods of use differ. However, there is a general overlap in purpose as HIC’s goods are all likely to be viewed for entertainment purposes. Further, I am of the view that an undertaking that provides general entertainment services is also likely to provide the above goods. In addition, the users will all be the same as someone who watches downloadable media, for example, will seek entertainment services at large. Lastly, there is no degree of complementary between these goods and services but there may be a degree of competition on the basis that a user may seek to be entertained via downloadable media or another form of entertainment service. As a result, I find that these goods and services are similar to a medium degree.

Project management software.

93.DNA’s specification does not include any software items. Further, it offers no protection for any type of project management service. As such, I see no obvious

reason why any of the services for which DNA's specification is registered would overlap in any of the relevant factors to result in a degree of similarity with the above goods. As such, I find them to be dissimilar.

Downloadable educational media; Virtual classroom software; Virtual reality software for education.

94. Again, DNA's specification does not include any software. In addition, it does not provide any educational services or any services that can be said to overlap with education. As a result, I see no obvious reason why there would exist any overlap between DNA's services and the above goods of HIC. In short, I find that these goods are dissimilar.

Class 35

Retail services in relation to recorded content.

95. The above services cover the retail of any type of content that has been recorded. This can include the retail of music or videos and, further, it covers physical or digital media. Plainly, the nature, method of use and purpose of the above services differ from DNA's "entertainment services". However, there is a degree of overlap in trade channels on the basis that an undertaking that offers entertainment services may look to retail in the recorded content (especially insofar as it pertains to digital media) that is made during said entertainment services. For example, an undertaking that offers live theatre performances (which is covered by DNA's term) may wish to sell downloadable videos or DVDs of said performance and will likely retail in said goods (being HIC's term). Using this example, I find that the user who attends the live theatre performance may wish to buy a DVD or downloadable recording of said event and will, therefore, seek the above retail services. As such, I find that the user also overlaps. The services are not complementary because the services are not important or indispensable to one another. Lastly, they are not in competition. Overall, I consider that the overlaps in trade channels and user are sufficient to give rise to a finding that these services are similar to a low degree.

Class 41

Entertainment services provided by on-line streams; Providing multi-media entertainment via a website; Providing video entertainment via a website; Provision of entertainment information via television, broadband, wireless and on-line services; video entertainment services; Video entertainment services.

96. The above services are all entertainment services and, therefore, fall within DNA's term of "entertainment services". They are, therefore, identical under the principle outlined in *Meric*.

Providing entertainment information via a website.

97. The above service falls within DNA's service of "providing information relating to a wide variety of topics for entertainment". DNA's term is broader because it covers the provision of information on entertainment but is not limited to provision via a website. As a result, I find that these services are identical under the principle outlined in *Meric*.

Sound recording [...] services.

98. The above services are not for entertainment purposes but are, as far as I understand it, services more in line with production of music or sound. That being said, I consider that the term "entertainment services" in DNA's specification is the best comparator for these services. Even though that may be the case, the services clearly differ in nature, method of use and purpose. In respect of trade channels, I appreciate that there may be instances where a large production company offering sound recording may offer broader entertainment services. However, I have nothing before me to suggest that this is common in the trade so as to result in any meaningful overlap. In terms of user, someone seeking sound recording may be the user of entertainment services also but, in my view, the contexts of use mean that any overlap is fleeting. I say this because when seeking sound recording

services, the user will be focused on creating music or engaged in sound production, generally. This means that the user will be engaging the services in the context of business or professional use whereas, when consuming entertainment, it will be for personal reasons. Lastly, the services are not complementary and neither are they competitive. Overall, I do not consider that there is a material degree of similarity between these services. As such, they are dissimilar.

Conclusion of the goods and services comparison

99. Under the present ground, a likelihood of confusion can only exist where there is at least some similarity between goods and services.³⁹ This means that as a result of my findings above, the opposition fails against the following goods and services which I have found to be dissimilar to the earlier services:

Class 9: Project management software; downloadable educational media; virtual classroom software; virtual reality software for education.

Class 41: Sound recording services.

The average consumer and the nature of the purchasing act

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

101. In *Iconix Luxembourg Holdings* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

³⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

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

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

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

102. The average consumer for the goods and services at issue is likely to be a member of the general public at large. The goods will be available via physical retailers (be that specialist stores or more general ones) and online. They are likely to be selected after the consumer views them on display stands in stores or, if selected online, after having viewed an image of them on a webpage. As for the services, these are likely to be viewed after online searches, on signage or via

pamphlets/lists of services. Regardless of whether the consumer is selecting goods or services, the selection process will primarily be visual but I do not discount the aural component which may involve advice from sales assistants or word of mouth recommendations.

103. The frequency of selection and cost of the goods and services at issue will vary. I say this because downloadable media may be cheap (or even free) and consumed on a frequent basis. However, some entertainment services (such as music concerts, for example), are likely to be more expensive and selected with a much lesser degree of frequency depending on the user. In respect of the level of attention paid, the downloadable media goods may attract a low degree of attention due to their low cost. As for the broader entertainment services, these are likely to attract, for the most part, a medium degree of attention. I say this because regardless of the type of entertainment provided, the consumer is still likely to consider the content of the services, the provider and information as to how it is accessed (be that an in person event or a service provided via streaming, for example).

Comparison of the marks

104. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

105. 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.”

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

107. The respective trade marks are shown below:

The DNA's mark	HIC's mark
	HI-IMPACT

Overall impression

108. HIC's mark is word only and consists of 'HI-IMPACT'. I consider that the dash between 'HI' and 'IMPACT' will be overlooked and will, therefore, not contribute to the mark. As the words form a unitary phrase and because there are no other elements that contribute to the overall impression of the mark, I find that it lies equally across the words.

109. DNA's mark is a figurative mark that consists of the words 'the high impact' presented in a black standard typeface. The words 'the high' sit on top of 'impact'. There are two figurative elements, being a red heartbeat line and an academic cap. The dot above the 'i' in 'impact' is incorporated into the heartbeat line. In considering the overall impression of this mark, I appreciate that consumers tend to focus on elements of marks that can be read but I find that the word 'the' is likely

to be overlooked or given much less weight due to its lack of any trade mark significance. As such, it is the words 'high impact' that will dominate the overall impression of the mark. For the avoidance of doubt, the unitary meaning of 'high impact' overcomes the fact that 'high' appears on the same line as 'the' and on top of 'impact'. The device elements play a lesser role with 'the' playing either a much lesser role or having a negligible impact.

Visual comparison

110. Visually, the marks share the letters 'HI' and the word 'IMPACT'. The marks differ in the presence of the figurative elements, the word 'the' and the letters 'gh' in 'high' in DNA's mark. While the points of difference will be noticed, I am of the view that in light of what I have said about the overall impression of DNA's mark, there exists a medium degree of similarity between these marks. For the avoidance of doubt, I will say that even if the dash in 'HI-IMPACT' is noticed, it will not alter the conclusion I have reached above.

Aural comparison

111. Despite the inclusion of the letters 'g-h', 'high' and 'HI' will be pronounced identically. Further, despite its role in the mark, 'the' will still be pronounced. Therefore, aural comparison is 'HI-IMM-PAKT' against 'THE-HI-IMM-PAKT'. The entirety of HIC's mark sits identically within DNA's mark, with the only difference coming in the word 'the'. Given its role in DNA's mark, I find that this does not impact on the comparison to any great deal. As a result, I find that the marks are aurally similar to a high degree.

Conceptual comparison

112. Regardless of the word 'the' and the misspelling of 'HIGH' to 'HI' in HIC's mark, 'the high impact' and 'HI-IMPACT' have an identical concept, being a phrase with multiple meanings. I say this because it can be viewed as reference to a collision at high speeds, an outcome of something that yields a considerable return or

something that improves or involves physical activity. The heartbeat line in DNA's mark does not alter the concept of that mark to any material degree because it may be seen as alluding to the concept of something being 'high impact' (i.e. increasing the heartrate), therefore reinforcing the meaning of the words. As for the academic cap, this has no obvious reason within the mark and, as such, acts as a point of conceptual difference, albeit not a considerable one. Overall, bearing in mind the overall impression of the marks at issue, I find that they are conceptually similar to a high degree.

Distinctive character of DNA's mark

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

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

114. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that while DNA did file evidence, it was simply made up of submissions and, as such, does not pertain to any actual use of its mark. As a result, I only have the inherent position to consider.

115. DNA's mark is, as above, a figurative mark made up of the word 'the high impact' in a standard black typeface and two device elements, being a heartbeat line and an academic cap. As also stated above, 'high impact' will form a unitary phrase and, in my view, this is a somewhat laudatory phrase when considering it from a trade mark perspective. I say this because it suggests a claim that the services provided will offer 'high impact' results for the user. As such, I do not consider that the phrase 'high impact' (or 'the high impact' for that matter) carries much distinctiveness. While I do not consider that it is outright low, it does sit somewhere between a low and medium degree. As for the device elements, the 'heartbeat line' will have some allusive qualities on the basis that it may be seen as a reference to a high heart rate, resulting from something being 'high impact'. I set out above that this would reinforce the meaning of 'high impact'. As such, I do not consider that it contributes to the distinctiveness of the mark to any degree. As for the academic cap, this has no obvious connection to the services at issue, but it is a relatively small embellishment in the mark overall and I, therefore, do not consider that its impact is such that it will alter the distinctiveness of the mark beyond that created by the words. As a result, I find that DNA's mark enjoys between a low and medium degree of inherent distinctiveness.

Likelihood of confusion

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

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

117. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

118. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive

character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

119. I have found the goods and services at issue to be either identical or similar to varying degrees, including low. The average consumer base is formed of members of the general public who will select the goods via primarily visual means (though not discounting an aural component) whilst paying either a lower or a medium degree of attention, depending on what goods or services are being chosen. In respect of the similarity of the marks, I found that the marks at issue are visually similar to a medium degree, and aurally and conceptually similar to a high degree. Lastly, I concluded that DNA’s mark benefits from between a low and medium degree of distinctive character.⁴⁰

120. Taking all of the above factors into account and bearing in mind the principle of imperfect recollection, I find that the marks at issue will be misremembered or inaccurately recalled for one another. I say this because it is my view that the device elements and the word ‘the’ in DNA’s mark will be overlooked. As such, and given the similarity (and aural and conceptual identity) of the sole/dominant elements of the marks (being ‘HI-IMPACT’ and ‘high impact’), I find that consumers will fail to recall which mark was which. In reaching this finding, I appreciate that the distinctiveness of DNA’s mark sits at low to medium level, but I remind myself that it is not outright low and, as such, I do not consider that the shared connection with ‘high impact’ would be viewed as coincidental. Consequently, I find that there is a likelihood of direct confusion between the marks. For the avoidance of doubt, given the similarity of sole/dominant elements of the marks, I find that this applies regardless of the level of similarity between the goods and services at issue and even in circumstances where consumers pay a lower degree of attention.

121. For the sake of completeness, I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*,

⁴⁰ In respect of this point, I remind myself that a weak distinctive character does not preclude a likelihood of confusion. See *L’Oréal SA v OHIM*, Case C-235/05 P

BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

122. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

123. In considering the issue of indirect confusion, I am of the view that even if consumers notice the differences between the marks, they will still believe that the marks share the same (or an economically connected) origin. I say this because my primary finding is that the source of origin for both marks will be viewed as 'high impact' on the basis that the differences in spelling would be overlooked. In such circumstances, the differences will be noted as being the device elements and, when confronted with both marks, the consumer will see the marks as being alternative marks used by the same undertaking in different contexts. For example, the word only mark will be the one that is used in promotional materials whereas the figurative mark was the one used on packaging or signage. Even if consumers noticed the difference between 'HI-IMPACT' and 'the high impact', they would still connect the marks to the same undertaking. In this scenario, I consider it reasonable to suggest that consumers would believe that the undertaking responsible for 'the high impact' had modernised or streamlined its brand by altering it to a deliberate misspelling, being 'HI-IMPACT'. The device elements would not take away from this finding as, again, they would simply be viewed as part of the figurative mark that is used on packaging or signage. Consequently, I find that there is a likelihood of indirect confusion in respect of these marks, even in circumstances where the marks are viewed on goods or services that are only similar to a low degree and where the consumer pays a medium degree of attention.

124. The opposition succeeds in part.

CONCLUSION

125. HIC's invalidation application has been partially successful meaning that DNA's mark is hereby declared invalid for the following services and the application for the same is deemed never to have been made:

Class 35: Business monitoring and consulting services, namely, tracking users and advertising of others to provide strategy, insight, marketing guidance, and for analysing, understanding and predicting consumer behaviour and motivations, and market trends; advice for consumers [consumer advice shop].

Class 41: Educating services; advice relating to lifestyle, physical health, diet, cooking, mental health, general interests, publishing of books, magazines, journals and texts; providing a website featuring blogs and non-downloadable text, video and audio files in the fields of health advice, dietary advice, culinary advice; providing a real-time information network relating to the latest stories, ideas, opinions, news and to information of educational interest; publication of online journals, namely, blogs featuring education; information relating to all the aforesaid provided online from a computer database on the Internet; Providing information relating to a wide variety of topics for education; providing a website featuring blogs and non-downloadable text, video and audio files in the fields of education; providing online electronic publications (not downloadable) information relating to all the aforesaid provided online from a computer database on the Internet; providing online electronic publications (not downloadable); consultation, advisory and support services relating to all the aforesaid services.

126. It is, however, permitted to remain registered for the following services:

Class 35: Advertising and marketing; advertising services; online advertising and marketing services; business data analysis; promotional services; business networking; online service for connecting social network users with businesses; presentation of goods on communication media, for retail purposes; price comparison services; commercial information for consumers; providing consumer product information; providing comparison shopping information; sales promotion for others; compilation of information into computer databases; systemization of information into computer databases; data search in computer files for others; dissemination of advertising for others via an on-line electronic communications network; business data analysis; providing statistical business information.

Class 41: Entertainment services and information relating to lifestyle, physical health, diet, cooking, mental health, general interests, publishing of books, magazines, journals and texts; news reporting services, provision of news and current affairs; publication of online information, namely, blogs featuring user-defined content in the field of social networking; health, diet, cooking, exercise, general well being, and general interests, providing a real-time information network relating to the latest stories, ideas, opinions, news and to information of personal interest (entertainment, health, cooking, diet, and cultural services); publication of online journals, namely, blogs featuring personal information and opinions in the field of health, physical fitness, diet, cooking, general well being and general interest; information relating to all the aforesaid provided online from a computer database on the Internet; Providing information relating to a wide variety of topics for entertainment , personal interests, or cultural purposes; providing a website featuring blogs and non-downloadable text, video and audio files in the fields of entertainment, sports, celebrity and culture and news;

entertainment services, providing images from the Internet; provision of information relating to entertainment; publication of periodicals; information relating to all the aforesaid provided online from a computer database on the Internet; support services relating to all the aforesaid services.

127. In respect of DNA's opposition, this was also partially successful and HIC's mark is refused registration for the following goods and services:

Class 9: Downloadable media; Media content; Recorded media;

Class 35: Retail services in relation to recorded content.

Class 41: Providing entertainment information via a website; Entertainment services provided by on-line streams; Providing multi-media entertainment via a website; Providing video entertainment via a website; Provision of entertainment information via television, broadband, wireless and on-line services; Video entertainment services;⁴¹ Video entertainment services.

128. It is, however, permitted to proceed to registration for the following goods and services, being those against which the opposition either failed or was not aimed:

Class 9: Project management software; downloadable educational media; virtual classroom software; virtual reality software for education; Computer programs for use in data base management and for use in the field of management consulting; Downloadable educational media; Digital recording media; Media and publishing software; Media streaming software; Project management software; Recorded media; Website development software; Virtual reality software; Virtual and augmented reality software;

⁴¹ This term was initially part of a broader term of "sound recording and video entertainment services", of which 'sound recording services' was found dissimilar.

Virtual reality software for simulation; Virtual classroom software; Virtual assistant software; Virtual reality software for education; Virtual reality software for telecommunications; Virtual reality software for providing tours; Virtual reality platforms.

Class 41: Entertainment services for sharing audio and video recordings; Sound recording services.

129. For the avoidance of doubt, all of the outcomes reached above are subject to any successful appeal against my decision.

COSTS

130. While HIC succeeded in its invalidation application and its defence of the opposition to some extent, I consider that, on balance, DNA achieved the greater degree of success in these proceedings. As such, I consider that it is entitled to a contribution towards its costs.

131. In the present case, DNA was not legally represented and in order to claim its costs, it was required to file a costs proforma by 23 May 2025. This was not provided until 12 September 2025. The reasons given for the delay relate to a personal issue that Dr Ali, on behalf of DNA, was dealing with at the time. Given their personal nature, I do not intend to reproduce these reasons here but I deem them acceptable and will, therefore, consider the costs proforma in the usual way. On this point, I will further state that the deadline to file a costs proforma is an administrative deadline that does not require the filing of a formal request (via a Form TM9) to extend it. Additionally, the delay in filing the costs proforma resulted in no actual delays to these proceedings.

132. DNA's costs are broken down as follows:

Task	Time spent/value
Preparing a notice of opposition:	4h 00m
Considering cancellation application:	3h 00m
Preparing a notice of defence:	2h 00m
Considering forms filed:	2h 30m
Researching case law and legal grounds under both opposition and cancellation:	5h 30m
Drafting written submissions:	7h 00m
Reviewing HIC's evidence/submissions:	3h 00m
Organising case files and bundles and further drafting of submissions:	5h 00m
	£25
Printing, stationery and postage:	
Opposition filing fee:	£100
Total:	32h 00m and £125

133. The costs associated with organising case files and bundles are not recoverable in proceedings before the Tribunal. It is noted that the time associated with this task includes the drafting of submissions which, in my view, are already duly covered by the task regarding drafting submissions already claimed. In addition, the printing, stationery and postage costs are not recoverable either. Lastly, it is noted that DNA claims 5 hours and 30 minutes for research of case law and into the legal ground at issue. While it is appreciated that an unrepresented litigant would not readily be aware of the case law and grounds surrounding legal proceedings, this is reflected in the fact that they are commonly permitted to claim more time for the preparation of the relevant documents. In the present case, DNA claims a total of 9 hours for the preparing of the relevant forms and, in my view, this suitably covers the extra time required to complete said forms. As such, I do not consider that the specific time claimed in relation to DNA's research is recoverable.

134. Other than the points raised above, I consider that DNA's claims as to its costs are reasonable. Therefore, reducing the total amount claimed in accordance with what I have said above means that the present claim covers 21 hours and 30 minutes, with £100 recoverable via the official fee.

135. I note that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore calculate that, based on the above, DNA's costs sit at £508.50 (21 hours and 30 minutes at £19 per hour, plus the official fee).

136. In the present case, I appreciate that HIC did enjoy a degree of success in invalidating some services in DNA's mark's specification and in defending its mark for some goods and services. Therefore, I consider it appropriate to reduce the total costs to reflect HIC's partial success, albeit only slightly. **In the circumstances, I award DNA the sum of £458.50 in respect of the time claimed via its costs proforma.**

137. I hereby order Hi-Impact Consultancy Limited to pay DR N ALI LTD the sum of £458.50. The above sum should be paid within 21 days of the expiry of the appeal period (which runs from the date of this supplementary decision and not my original decision) or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of June 2026

A COOPER

For the Registrar