

O/0535/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003832297

BY RETAIL247 CONSULTING LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASSES 9, 35 AND 42

AND

AN OPPOSITION THERETO UNDER NUMBER 600002763

BY ORIGYN FOUNDATION

Background and pleadings

1. On 23 September 2022, RETAIL247 CONSULTING LIMITED (“**the Applicant**”) applied to register the trade mark shown on the cover page of this decision (“**the Contested Mark**”) in the UK. The application was accepted and published in the Trade Marks Journal for opposition purposes on 18 November 2022 and registration is sought for the following goods and services in classes 9, 35 and 42:

Class 9 Business management software; Business software; Computer software; Computer software platforms; Data engines; Data management software; Data processing software; Data processing systems; Digital solutions provider [DSP] software; Downloadable computer software for the management of information; Downloadable software; Enterprise software; Inventory software; Management information system [MIS] software; Maintenance software; Product lifecycle management software; Retail software; Software for Automated Business Process Discovery (ABPD); Workflow software; all of the aforementioned in relation to data management, product information management, stock management, retail and wholesale services, hospitality services, leisure services and business management services; none of the aforementioned relating to the fields of digital certification and authentication of watches, luxury products, digital media, and works of art.

Class 35 Business consultancy services; Business consultancy services relating to data processing; Business consultancy services relating to the supply of quality management systems; Business consulting for enterprises; Business management consulting; Computerised compilation of stock control records; Computerised inventory control; Computerised inventory preparation; Computerised stock management; Consultancy and advisory services relating to business management; Consultancy relating to data processing; Data management; Data processing; Data processing for the collection of data for business purposes; Data processing, systematisation and management; Data-based stock control; Data-based stock location services; Database management;

Electronic data processing; Electronic stock management services; Inventory control; Inventory management; Product sales information; Search engine optimisation; Search engine optimisation for sales promotion; Stock control services; Supply chain management services; all of the aforementioned in relation to data management, product information management, stock management, retail and wholesale services, hospitality services, leisure services and business management services; none of the aforementioned relating to the fields of digital certification and authentication of watches, luxury products, digital media, and works of art.

Class 42 Computer software consultancy; Computer software consultancy services; Design and development of software for inventory management; Development of software for Automated Business Process Discovery (ABPD); Hosting services, software as a service, and rental of software; Information technology consultancy; Online data storage; Platform as a Service [PaaS]; Programming of software for inventory management; Providing search engines for obtaining data via communications networks; Providing temporary use of non-downloadable business software; Providing temporary use of on-line non-downloadable software for inventory management; Rental of software for inventory management; Software as a service [SaaS]; Technical data analysis; all of the aforementioned in relation to data management, product information management, stock management, retail and wholesale services, hospitality services, leisure services and business management services; none of the aforementioned relating to the fields of digital certification and authentication of watches, luxury products, digital media, and works of art.

2. On 16 February 2023, ORIGYN Foundation (“***the Opponent***”) filed a fast-track opposition,¹ opposing the application in full under section 5(2)(b) of the Trade

¹ With the official communication of 20 April 2023 the Registrar informed the Opponent that the Earlier Right relied upon for the opposition was, at that date, not a registered right being the Earlier Mark opposed in another proceedings (OP000425379). For this reason, the Registrar converted the fast-track opposition into a

Marks Act 1994 (“*the Act*”).² The Opponent relies upon the following earlier International Registration (IR) for its opposition:

IR number: WO0000001573907

Mark’s representation: **ORIGYN**

Filing date in UK: 4 February 2021

International registration date: 2 October 2020

Date of protection of the IR in UK: 29 June 2023

3. For the purpose of these proceedings, the Opponent relies upon all the goods and services for which the Earlier Mark is registered in classes 9, 35, 42 and 45 as indicated in the Annex to this decision.
4. By virtue of its earlier filing date, that registration constitutes an earlier mark within the meaning of section 6 of the Act. As the Earlier Mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.
5. In its statement of grounds, the Opponent claims that the Applicant’s mark is highly similar to the Opponent’s mark as the respective marks share visual similarities and are aurally identical. The Opponent also submits that the word ‘ORIGIN’ in the Applicant’s mark is the dominant element and consumers are likely to pay less attention to the device element. The Opponent contends that the goods and services in the application are largely identical or highly similar to those covered by the Opponent’s Earlier Mark.
6. On 6 March 2024 the Applicant filed a defence and counterstatement denying all grounds of the opposition.

standard opposition. On 28 June 2023 the Opponent in the opposition number 425379 withdrew the opposition and the Earlier Right became registered on 2 October 2020.

² The original Form TM7F was filed on 16 February 2023, following the conversion of these proceedings to a standard opposition, a form TM7 was then filed on 28 April 2023.

7. The Applicant is represented by Legalvision Law UK Ltd and the Opponent is represented by Sipara Limited.

Relevance of EU law

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

Evidence and submissions

9. During the evidence rounds, neither party filed evidence, however, the Applicant filed written submissions. These will not be summarised here but will be referred to as and where appropriate during this decision. Neither party requested a hearing nor did they file written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

Preliminary Matters

10. I note that the Applicant submitted that “*both marks should be able to coexist on the register, as they have been in the marketplace for many years*”.³ Although I acknowledge these comments, I note that the Applicant has not provided any evidence of prior use of the mark. In any event, I must clarify that the absence of actual confusion will not have any bearing on whether there exists a likelihood of confusion between the Applicant's mark and the Opponent's mark. Whilst evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant.⁴ This is because the absence of confusion may be attributable to the Earlier Mark having only been used to a limited extent, in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being mistaken for the other.⁵

³ Applicant's written submissions dated 27 August 2024, [23].

⁴ *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283.

⁵ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

The provisions of the Act are not merely a reflection of what may be happening in the market. Even where there is no confusion in practice, it remains possible for there to be a finding of a likelihood of confusion.⁶

State of the Register argument

11. The Applicant contended that “[...] *ORIGIN*, being a common English word, is used as, or within, a trade mark on 755 occasions on the trade marks register, in respect of classes associated with the Applicant’s Goods and Services, thereby rendering the mark highly non-distinctive”.⁷ The applicant neither provided any evidence nor clarified further this argument. For the reasons that I will now explain, these submission do little to assist the Applicant. I note that in the case of *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

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

12. The fact that there are a multitude of trade marks that contain the word ‘ORIGIN’ for the classes at hand, does not provide much assistance in relation to the distinctiveness of the Opponent’s mark. The Applicant has filed no evidence to demonstrate that any of these marks are actually in use in the marketplace and this evidence does little, therefore, to assist the Applicant; the assessment that I

⁶ *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41).

⁷ Applicant’s written submissions dated 27 August 2024, [16].

must undertake is based on the perception of the average consumer. The outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors and the state of the register offers little to that assessment.

Decision

Section 5(2)(b)

13. Sections 5(2)(b) and 5A of the Act state:

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

[...]

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

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

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

Relevant law

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

The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

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

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

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

Comparison of goods and services

15. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

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

16. 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.

17. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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.”

18. Further, in *Kurt Hesse v OHIM*,⁸ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,⁹ the GC stated that “complementary” means:

“[...] there is close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

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

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]- [49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because

⁸ Case C-50/15 P

⁹ Case T-325/06

the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

20. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded.”

21. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

“[...] definitions of services [...] are inherently less precise than specifications of goods. [...] In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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

23. The goods and services to be compared are shown in the table below:

The Opponent's goods and services	The Applicant's goods and services
<u>Class 9</u>	<u>Class 9</u>
<p>Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signaling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for sound, image or data recording, transmission, reproduction or processing; recorded or downloadable media, software, blank digital or analogue recording and storage media; computers and computer peripherals; optical character recognition devices; downloadable software; computer programs; software packages; interactive software; database management software; OCR (optical character recognition) software; data search software; software for data and document capture, transmission, storage and indexing; computer platforms in the form of recorded or downloadable software; all of the aforementioned goods only in the fields of digital certification and authentication of watches, luxury products, digital media, and works of art, and none being in or related to the fields of chemistry, applied</p>	<p>Business management software; Business software; Computer software; Computer software platforms; Data engines; Data management software; Data processing software; Data processing systems; Digital solutions provider [DSP] software; Downloadable computer software for the management of information; Downloadable software; Enterprise software; Inventory software; Management information system [MIS] software; Maintenance software; Product lifecycle management software; Retail software; Software for Automated Business Process Discovery (ABPD); Workflow software; all of the aforementioned in relation to data management, product information management, stock management, retail and wholesale services, hospitality services, leisure services and business management services; none of the aforementioned relating to the fields of digital certification and authentication of watches, luxury products, digital media, and works of art.</p>

chemistry, bio-based chemistry or bioplastics.	
<u>Class 35</u>	<u>Class 35</u>
Advertising; commercial business management; commercial administration; office functions; provision of online commercial information directories on the Internet; computer file management services; computerized file management services; compilation and systematization of information into computer databases; updating and maintenance of data in computer databases.	Business consultancy services; Business consultancy services relating to data processing; Business consultancy services relating to the supply of quality management systems; Business consulting for enterprises; Business management consulting; Computerised compilation of stock control records; Computerised inventory control; Computerised inventory preparation; Computerised stock management; Consultancy and advisory services relating to business management; Consultancy relating to data processing; Data management; Data processing; Data processing for the collection of data for business purposes; Data processing, systematisation and management; Data-based stock control; Data-based stock location services; Database management; Electronic data processing; Electronic stock management services; Inventory control; Inventory management; Product sales information; Search engine optimisation; Search engine optimisation for sales promotion; Stock control services; Supply chain management services; all of the aforementioned in relation to data management, product information

	management, stock management, retail and wholesale services, hospitality services, leisure services and business management services; none of the aforementioned relating to the fields of digital certification and authentication of watches, luxury products, digital media, and works of art.
<u>Class 42</u>	<u>Class 42</u>
Scientific and technological services as well as research and design services relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; authentication of works of art; design and development of computers and software; programming of software for Internet platforms; design, maintenance, rental and updating of software; design and development of data reading, transmission and organization software; computer database design; hosting of computer databases; rental of computer database software; temporary provision of Web software; temporary provision online of non-downloadable software for database management; provision of temporary use of online non-downloadable software for importing and managing data; electronic data back-up; Software as a Service (SaaS); design and development of systems for data input,	Computer software consultancy; Computer software consultancy services; Design and development of software for inventory management; Development of software for Automated Business Process Discovery (ABPD); Hosting services, software as a service, and rental of software; Information technology consultancy; Online data storage; Platform as a Service [PaaS]; Programming of software for inventory management; Providing search engines for obtaining data via communications networks; Providing temporary use of non-downloadable business software; Providing temporary use of on-line non-downloadable software for inventory management; Rental of software for inventory management; Software as a service [SaaS]; Technical data analysis; all of the aforementioned in relation to data management, product information management, stock management, retail and wholesale services, hospitality

<p>extraction, processing, display and storage; management of computer projects in the field of electronic data processing; development of computer platforms; hosting platforms on the Internet; computer Platform as a Service (PaaS); hosting of platforms on the Internet; hosting memory space on the Internet; all of the aforementioned services only in the fields of digital certification and authentication of watches, luxury products, digital media, and works of art, and none being in or related to the fields of chemistry, applied chemistry, bio-based chemistry or bioplastics.</p>	<p>services, leisure services and business management services; none of the aforementioned relating to the fields of digital certification and authentication of watches, luxury products, digital media, and works of art.</p>
<p><u>Class 45</u></p>	
<p>Return of lost property; Locating stolen goods; provision of reconnaissance and surveillance services; tracking services with a view to the recovery of encoded products.</p>	

24. I notice that the Applicant's specification in class 9 contains the positive limitation "*all of the aforementioned in relation to data management, product information management, stock management, retail and wholesale services, hospitality services, leisure services and business management services*". Limitations should be drafted with sufficient clarity and precision to enable the Registrar and third parties to identify what is and is not covered by the specification.¹⁰ In *Oska's Ltd's Trade Mark Application [2005] R.P.C. 20* at [56], Richard Arnold Q.C. (as he then was), sitting as the Appointed Person found that it would not be permissible to limit

¹⁰ See case C-307/10, *IP Translator*, [49], [53] and [64].

a specification by reference to the applicant's intended target market. In cases where the limitation impacts the functionality of the software, this would be, in principle, acceptable; conversely, in those circumstances where the limitation concerns the field (or fields) of the software's application (e.g., 'software for use in the field of healthcare'), the limitation would be not acceptable. Therefore, I find the Applicant's restriction above to be artificial and excessively vague and I will not take it into consideration for my assessment of the goods' similarity.

25. The same reasoning applies to the Opponent's restriction "*none being in or related to the fields of chemistry, applied chemistry, bio-based chemistry or bioplastics*" in classes 9 and 42 as the fields to which the limitation refers are excessively wide, vague and/or unclear. Hence, I will not take this limitation into consideration in my similarity assessment below.

26. Similarly, turning to classes 35 and 42 of the Applicant's specification, I am reminded of the findings of Mr Richard Arnold Q.C. (as he then was) in *Omega*¹¹ where he stated that [48]:

"In *MERLIN Trade Mark* (BL O/043/05) at [27]-[28] I held when sitting as the Appointed Person held that the disclaimer "but not including the provision of venture capital" was acceptable, because it was not framed by reference to the absence of particular characteristics of the services, but rather it was a restriction on the scope of the services embraced by the specification. Accordingly,

"the effect of [the disclaimer] is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable."

27. In the case at hand, the limitation in object does not circumscribe the services to a particular type of service (or services) but refers to wide (and generally not sufficiently clear and precise) fields of application for such services. Thus, I find the positive limitation to be unacceptable also for the services in classes 35 and 42.

¹¹ *Omega Engineering Inc v Omega SA* [2012] EWHC 3440 (Ch).

28. I also note the Applicant's specification, in classes 9, 35 and 42 contains the restriction "*none of the aforementioned relating to the fields of digital certification and authentication of watches, luxury products, digital media, and works of art*". The Opponent's specification contains the positive variation of this limitation in classes 9 and 42. With regard to both limitations, positive and negative, it is unclear to me what type of goods "luxury products" and "works of art" may identify. Such wording lacks the required clarity and precision and creates legal uncertainty.¹² For this reason, I will disregard this part in both parties' limitations. The remaining limitation is properly defined (without being too artificially narrow) and clearly identifies subcategories of software (for class 9 goods) as well as different fields of application of the services (for classes 35 and 42 services) that are excluded from the specification (for the Applicant) or to which the specification is limited (for the Opponent). I will only take into consideration this part of the limitation(s) in my assessment of similarity (or lack thereof) below.

29. With regard to the similarity between the competing goods and services, the Opponent provided, in its statement of ground, a table of the parties' respective goods and services highlighting in bold and underlined those terms deemed to be identical. No further specification is provided. The Applicant's written submissions regarding the similarity of the competing goods and services all revolve around the respective specifications' limitations, highlighting that the goods and services refer to different market contexts and, for this reason, are dissimilar. Following from my considerations above on the limitations, I acknowledge the parties' submissions and I will proceed to assess the similarity of the goods and services at hand as follows.

Class 9

- "*Computer software; Downloadable software [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media*"

30. The term "*downloadable software*" is identically reproduced in the Opponent's specification in class 9. The Earlier Mark is also registered for "*computer*

¹² *Croom's Trade Mark Application*, [2005] R.P.C. 2, [27] – [30].

programs”; regarding this latter term, although worded differently, this is identical to the Applicant’s “*Computer software*”. I appreciate the competing goods have different fields of application due to their respective limitations (i.e., exclusive application to/exclusion from *the fields of digital certification and authentication of watches, digital media*). Thus, I find the respective goods to have the same nature (software) and method of use, however, they are likely to differ in their end users, trade channels and not to be in competition with each other. Therefore, I find the goods to be similar to at least a medium degree.

- “*Business management software; Business software; Digital solutions provider [DSP] software; Downloadable computer software for the management of information; Retail software; Enterprise software; Inventory software; Management information system [MIS] software; Maintenance software; Product lifecycle management software; Software for Automated Business Process Discovery (ABPD); Workflow software [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media*”

31. All the above goods essentially consist of software (downloadable or non-downloadable) relating to the functioning/administration of an organisation or business excluding the application of these goods for “*digital certification and authentication of watches, digital media*”. The Earlier Mark is registered for goods such as “*downloadable software*”, “*computer programs*” and “*software packages*” for the “*digital certification and authentication of watches, digital media*”. The Applicant submitted that “*the Applicant’s goods and services explicitly exclude the fields that the Opponent’s protection is exclusively limited to, thereby eliminating any chance of overlap between each respective party’s areas of interest*”. The competing goods have the same nature (software) and method of use (being a software that needs to run on a hardware), but they differ in their intended purpose (as indicated by their opposite limitations) and end users. Certification/authentication software is likely to be available online on specialised platforms (e.g., a website on which directly purchase the software or a platform from which download the software). The competing goods could share the same trade channels in the eventuality of platforms that make available different types of (downloadable) software. Given the niche (and restricted) fields of application of the Opponent’s goods and the Applicant’s restriction, I find the goods at hand are

neither complementary nor in competition with each other. Overall, I find the respective goods to have a medium level of similarity.

- *“Computer software platforms [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media”*

32. In relation to the Opponent’s *“computer platforms in the form of recorded or downloadable software”* (for the certification/authentication of watches and digital media), I find the competing goods share the same nature (computer software platforms), method of use and intended purpose (i.e., a digital system that enables a software application to launch and run smoothly). In light of their respective limitations, the competing goods are unlikely to share the same users as well as neither be complementary nor in competition. However, the goods can overlap in trade channels (e.g., in the eventuality the software platforms are available for purchase or download on a wider online platform such as a website). Overall, I find the competing goods to have a medium degree of similarity.

- *“Data engines; Data management software; Data processing software; Data processing systems [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media”*

33. The Applicant’s goods are software to collect, process, store, manage, and utilise data efficiently within an organisation. The Opponent’s specification features *“software packages”, “database management software”, “data search software”* (for the certification/authentication of watches and digital media). The respective goods have the same nature (software), method of use and intended purpose (i.e., software to support the user with the process and management of data), however differ in their end users since the Opponent’s goods target exclusively the market of certification/authentication of watches and digital media (being excluded from the Applicant’s specification) and channels of trade (the Opponent’s goods are likely to be offered on specialised platforms). The goods are neither in competition nor are they complementary. Overall, the competing goods have a medium degree of similarity.

Class 35

- *“Business consultancy services; Business consultancy services relating to data processing; Business consultancy services relating to the supply of quality management systems; Business consulting for enterprises; Business management consulting; Consultancy and advisory services relating to business management [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media”*

34. The Opponent’s specification contains “*commercial business management*” and “*office functions*”. I accept that “consulting” suggests an advisory function rather than management services per se; thus, the services differ in their nature. Nevertheless, business consultancy refers to services that aim to help companies manage their business and therefore will involve activities associated with the day to day running of a business. On this basis, I consider that these services share some similarities with the above contested services. Whilst the competing services may not overlap in methods of use, these respective services share not only users (businesses), but also purpose (the smooth and effective running of business enterprise) and potentially channels of trade. Furthermore, whilst they are not complementary, they may well be in competition. I consider those services similar to a medium degree.

- *“Computerised compilation of stock control records; Computerised inventory control; Computerised inventory preparation; Computerised stock management; Electronic stock management services; Supply chain management services; Inventory control; Inventory management; Product sales information; Stock control services; Data-based stock control; Data-based stock location services [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media”*

35. I find the Applicant’s services above to fall within the Opponent’s wider category of “*compilation and systematization of information into computer databases*”. Thus, these services are identical in line with the principle outlined in *Meric*.

36. In the eventuality I am mistaken, I find the services to be highly similar. Inventory and stock management comprises tracking and managing stock levels, orders, and related data within a business to ensure it always has the right products and materials available. These services encompass the goods’ entire supply chain

process (from raw materials to finished products), including ordering, storing, and selling inventory. The Opponent's mark is registered for "*compilation and systematization of information into computer databases*" and "*office functions*" services. I find the competing services overlap in their nature (i.e., compiling data) and their method of use as the systematisation of data/information is likely to be carried out with digital databases stored in computers. The services can also overlap in their intended purpose as the Opponent's wider term "*compilation and systematization of information into computer databases*" can encompass the compilation/systematisation of information also for stock/inventory management purposes. The services share the same end users (businesses), trade channels and are likely to be in competition with each other.

- "*Data management; Data processing; Data processing for the collection of data for business purposes; Data processing, systematisation and management; Database management; Electronic data processing; Consultancy relating to data processing [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media*"

37. The Opponent's specification features the term "*compilation and systematization of information into computer databases*" and "*updating and maintenance of data in computer databases*". The Opponent does not restrict the purpose of the compiled and systemised information so it could include data being updated and maintained (i.e., processed) for business purposes (including consultancy services relating to data processing and excluding the field of certification/authentication of watches and digital media). Therefore, the Opponent's terms encompass the Applicant's services above and are considered as *Merit identical*.

- "*Search engine optimisation; Search engine optimisation for sales promotion [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media*"

38. The above services are aimed at improving the quality and quantity of website traffic to a website or a web page from search engines. These services will be used by business users who will seek them to get the most out of search engines and website traffic. The purpose of doing so is to create more flow to the user's website by seeking to promote it on search engines or other means of website traffic. As

such, I am of the view that the above terms are marketing and advertising services and, therefore, fall within the broad term “*advertising*” in the Opponent’s specification. They are, therefore, identical under the principle outlined in *Meric*.

39. In the eventuality I am mistaken, whilst I find the respective services to have different nature (engine optimisation versus advertising), they share the same method of use and intended purpose (i.e., advertising). The respective services also overlap in trade channels, as advertising companies are also likely to offer search engine optimisation as part of their marketing services, they are in competition and target the same users (e.g., businesses interested in online advertising). Overall, I find these services to be highly similar to each other.

Class 42

- “*Computer software consultancy; Computer software consultancy services; Information technology consultancy; [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media*”

40. Consultancy services that relate to computer software may be services that are provided to businesses that, themselves, develop and design computer software. However, I also consider that there is scope for these services to be provided directly to the end user. For example, the end user of the software may contract a provider of these services and provide them with advice and information about how to meet their software needs. Consequently, I consider that there is overlap in user between the Applicant’s terms above and “*software as a service*” in the Opponent’s specification being this a cloud-based method of providing non-downloadable software. Although the competing services differ in their nature (software consultancy versus provision of software) and method of use, they have the same intended purpose (enable software use) notwithstanding their different fields of application (according to the services’ respective limitations). It is my understanding that software consultants merely are IT consultants that advise businesses (or individual users) on which software to implement to meet their needs, but they are unlikely to offer the software themselves. Therefore, the services at hand neither overlap in trade channels nor are in competition with each other. Overall, albeit these services share the same object (i.e., software), I find

they have a low degree of similarity. The same considerations can be generally made in relation to “*Information technology consultancy*” and for which I reach the same conclusion as outlined above in this paragraph.

- “*Design and development of software for inventory management; Development of software for Automated Business Process Discovery (ABPD); Programming of software for inventory management [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media*”

41. The Opponent’s specification contains “*design, maintenance, rental and updating of software all of the aforementioned services only in the fields of digital certification and authentication of watches, digital media*”. The competing services share the same nature (development/programming of software) and method of use. The services differ in their intended purpose (inventory management against certification/authentication) and end users. Given the specifications’ respective above-mentioned limitations, the services will not be in competition with each other. I find, however, that the services likely share the same trade channels as end users of these services (especially businesses) will refer to companies specialised in software design to purchase software design services that are tailored to their needs. Overall, I find these services to have between low and medium similarity.

- “*Hosting services; Platform as a Service [PaaS]; [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media*”

42. The Opponent’s specification features “*hosting platforms on the Internet [...] all of the aforementioned services only in the fields of digital certification and authentication of watches, digital media*”. The respective services are identical in so far as they both consist of services that run servers connected to the Internet, allowing organisations and individuals to serve content or host services connected to the Internet. Thus, these services overlap in their nature, method of use, intended purpose (i.e., provide an online hosting platform), and trade channels. However, given their limitations, the services are likely to address different consumers and not to be in competition with each other. Overall, I find the services to have a medium degree of similarity.

- *“software as a service; Software as a service [SaaS] [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media”*

43. The Opponent’s specification features *“Software as a Service (SaaS) [...] all of the aforementioned services only in the fields of digital certification and authentication of watches, digital media”*. The respective services are identical except for their fields of application as a result of their respective limitations. Therefore, the same reasoning as the paragraph above can apply resulting in the services being similar to a medium degree.

- *“[...] rental of software; Providing temporary use of non-downloadable business software; Providing temporary use of on-line non-downloadable software for inventory management; Rental of software for inventory management; [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media”*

44. The services above essentially consist of rental or provision of software for business-related activities (e.g., inventory management). The Opponent’s specification features the term *“temporary provision online of non-downloadable software for database management [...] all of the aforementioned services only in the fields of digital certification and authentication of watches, digital media”*. The respective services have the same nature (provision of software), method of use (access of software, whether downloadable or not, being provided online) and intended purpose (use of a software for data management or other business-related activities). It is my view that the services can partially overlap in their consumers as users can be interested in accessing a software for data management notwithstanding the different field of application of the data (i.e., inventory management or certification/authentication) as well as same trade channels. The services may also be in competition with each other whereas they are not complementary. Overall, I find these services to be highly similar.

- *“Online data storage [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media”*

45. The Applicant's above term refers to the storing of electronic data (provided by a third party) that can be accessed via the Internet. The Earlier Mark features the services "*hosting memory space on the Internet*" in class 42 (exclusively for digital certification and authentication of watches and digital media). The respective services share the same nature (data storage), method of use, and intended purpose (to store data). I note the services' respective limitations, however it is my view that data storage for certified/authenticated documents is unlikely to have (or require) any particular feature that would differentiate it from a regular data storage platform (once the digital item has been certified/authenticated it can be stored in a traditional online database). Therefore, I find the respective services also share the same users, trade channels and are in competition with each other as consumers will select a data storage service independently from the use they intend for it. I find these services to be identical.

- "*Providing search engines for obtaining data via communications networks [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media*"

46. A search engine is a software that allows to retrieve and display relevant information from the Internet. With regard to the Opponent's "*The programming of software for Internet platforms*" and "*design and development of systems for data input, extraction, processing, display and storage*" (only for the fields of digital certification and authentication of watches and digital media) I find that the services do not have the same nature (provision of search engine versus programming/design of software) and method of use, but they likely overlap in their intended purpose (provision of a search engine software). Businesses providing search engines could also design the software for the engine they provide or offer engines developed by third parties. Therefore, the services can overlap, in part, in their end users (businesses) and trade channels. It is my view that there could also be some level of competition as consumers could decide to purchase a ready-made search engine or refer to a company to have the search engine designed to best fit their needs. This especially keeping in mind the services' respective limitations (i.e., different fields of application). Overall, I find the respective services to have a medium level of similarity.

- “*Technical data analysis [...] none of the aforementioned relating to the fields of digital certification and authentication of watches, digital media*”

47. The Opponent’s specification features “*industrial analysis [...] services [...] all of the aforementioned services only in the fields of digital certification and authentication of watches, digital media*”. Whilst I appreciate the respective services differ in their fields of application, according to their respective limitations, however, I find that the Opponent’s industrial analysis services also encompass the Applicant’s analysis of technical data. Thus, the services overlap in their nature (data analysis), method of use and intended purpose (reach conclusions based on data analysis). It is my view that even industrial analysis for the industry of certification/authentication could encompass a wider activity of data analysis (e.g. cutting across different markets or requiring the analysis of other technical data) with the result that the competing services can share the same customers, trade channels and be in competition with each other. As a result, I find these services to be highly similar.

The average consumer and the purchasing act

48. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services for which I found similarity or identity. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

49. For the purposes 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 and services in question.¹³
50. The average consumer of the category of products (and services) concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).
51. Consistent with my approach to the comparison of the parties' goods and services above in this decision, my assessment will focus upon the average consumer of specialised technical goods and services in business administration that are likely purchased by professionals (i.e., companies) for their businesses and that have a specific professional knowledge or expertise, such as business consultants and IT specialists.
52. The degree of attention is likely to be higher than average because some of these goods and services may be highly priced, infrequently purchased and might require some specialised knowledge due to the nature or conditions of the goods and services. The average consumer will take various factors into consideration such as the suitability of the goods and services for their needs, the reputation and reliability of the provider, the provider's technical expertise and the goods/services' functionalities. I consider that the degree of attention for the goods and services at hand is expected to be above average for such goods and services since they usually have a clear impact on a company's commercial strategy and correct functioning.¹⁴
53. The goods and services are likely to be obtained at specialist retailers, be those physical stores or online. Alternatively, the goods and services may be purchased following perusal of advertisements or inspection of a catalogue. The purchase/selection process will involve primarily visual considerations. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.

¹³ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

¹⁴ See case T-353/11, *Event Holding GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, [34].


Comparison of trade marks

54. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

55. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

56. The marks to be compared are as follows:

The Opponent's Earlier Mark	The Applicant's Contested Mark
	

Overall impression

57. The Applicant's mark consists of the word 'ORIGIN' all in capital letters. On the verbal element's left-hand side, the mark features an incomplete rounded device predominantly black that fades to white as it goes from right to left. Taking into consideration that the consumer's eye is naturally drawn to the elements of the

mark that can be read (i.e., 'ORIGIN')¹⁵, the figurative device, although clearly visible in the mark, makes a lesser contribution to the mark's overall impression. The word 'ORIGIN' is the most dominant element of the mark.

58. The Opponent's mark consists of the letter combination 'ORIGYN' in standard font and all in capital letters. The mark's overall impression resides in the single letter combination of which it is composed.

Visual similarity

59. The Earlier Mark consists of the letter combination 'ORIGYN' resembling the misspelling of the dictionary word 'origin'. The mark is represented in all-capitalised standard font.

60. The Contested mark features that word 'ORIGIN' all in capital letters. This word is represented in the mark with a thinner typeface than the standard font for word marks. The verbal element is preceded by a device consisting of a circle fading vertically from black (on the right) to white (on the left). The black side is predominant in the device pouring into the white side. The manner in which the black colour dissipates into the white half is represented to resemble a pixelated image as little white squares and rectangles are placed on the darker background of the circle. The circle does not close (or connect) on the left side.

61. The Applicant contended that:

"The Earlier Mark is an invented word with unique misspelling, and due to this intended misspelling, consumers are likely to attribute more attention and weight to the letter "Y" in the Earlier Mark. The misspelling creates a distinct visual impression that would be readily recognisable and memorable to consumers".¹⁶

62. It was also stated that:

"In contrast, the Opposed Mark uses a plain and common English spelling in conjunction with a visual device element to create an entirely different mark. Consumers are likely to recognise when a common English word has been

¹⁵ *MigrosGenossenschafts-Bund v EUIPO*, T-189/16, [52].

¹⁶ Applicant's written submissions dated 27 August 2024, [15].

misspelt in a brand name. [...] visual devices shouldn't be disregarded in the comparison of the marks, and the Applicant submits that, whilst both marks may have been considered identical/similar if they were just the plain word ORIGIN, the misspelling of the Earlier Mark and the visual device accompanying the Opposed Mark take both marks in different directions that ultimately render the marks conceptually, visually and aurally distinguishable from one another".¹⁷

63. I note the Applicant's submissions above, however, I find that, firstly, the relevant consumers, when confronted with the marks, will focus on the verbal elements and, secondly, will perceive the letter combination 'ORIGYN' as the misspelling of the word 'ORIGIN'. Both marks are made up of 6 letter words and begin with the same four letters, "ORIG-". The marks then have differing fifth letters, with the Earlier Mark having a "Y" as its fifth letter and the Contested Mark having an "I" as its fifth letter. Both marks then end with the same letter "N". Whilst the beginnings and the final letters of the marks are almost identical (save for the slightly stylised typeface of the Contested Mark), I cannot overlook the visual difference in their fifth letter and the presence of the figurative device in the Contested Mark that creates a point of visual difference. Taking all of this into account, and also bearing in mind that consumers tend to focus on beginnings of marks (being where the point of identity lies),¹⁸ I find that the marks are similar to a high degree.

Aural similarity

64. In its statement of grounds, the Opponent contended that the respective marks are aurally identical. The Applicant submitted that *"the introduction of the letter "Y" in the Earlier Mark also arguably creates a word aurally different from the word "origin". Words that contain the prefix "GYN" may likely be pronounced as "guy-n", as opposed to "jin", such as gynaecology for example*".¹⁹

65. I acknowledge the parties' submissions and I find that, as outlined above, the only aural difference in the marks is that of the fifth letter. The figurative device in the Contested Mark will not be articulated. I do not consider that the difference created

¹⁷ Ibid [16] – [17].

¹⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

¹⁹ Applicant's written submissions dated 27 August 2024, [15].

by the misspelling in the Earlier Mark will impact how the marks are pronounced because the phonetic spelling of “origyn”, when pronounced in the ordinary way, is “origin”. The phonetic pronunciation of the “I” and “Y” in the relevant marks when positioned between the “G” and “N” will be the same, and, as such, I find the marks to be aurally identical.

Conceptual similarity

66. The Applicant argued that *“the Earlier Mark is an invented word with unique misspelling, and due to this intended misspelling, consumers are likely to attribute more attention and weight to the letter “Y” in the Earlier Mark”*.²⁰ Whilst I note that the Applicant contended that the Earlier Mark consists of an invented word, I also note that they refer to the Earlier Mark as a “misspelling”. Thus, I derive from the Applicant’s submission that they interpret the Earlier Mark “ORIGYN” to be the incorrect spelling of the dictionary word “ORIGIN”. Accordingly, I am of the view that the relevant consumers would see “ORIGYN” as an obvious play on the word “ORIGIN”, or a misspelling of it. As such, I consider that the average consumers would immediately grasp the concept of the word “origin” when viewing the Earlier Mark. The figurative device in the Contested Mark does not convey any clear meaning that may affect the conceptual comparison of the marks at hand (it may be seen as a planet or a moon, but the relevant consumers will not derive any clear meaning from it). Therefore, I find the marks to be conceptually identical.

Distinctive character of the earlier mark

67. In *Lloyd Schuhfabrik Meyer* 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-

²⁰ Ibid [15].

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).”

68. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words.

69. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the Opponent has not filed any evidence of use in relation to its mark. Consequently, I have only the inherent position to consider.

70. The Earlier Mark is the misspelling of the English dictionary word “ORIGIN” consisting of a noun with multiple meanings, but all referring to the beginning or source of someone or something. I find the mark to be neither descriptive of nor to have any semantic correlation with the goods and services at hand. Neither party has provided further clarification in this regard. As I find “ORIGYN” not to be a very imaginative misspelling of the word “origin”, it is my view that the Earlier Mark has a medium degree of inherent distinctive character.

Likelihood of confusion

71. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel*

at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

“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).”

73. I have found the degree of similarity of the respective goods and services to range from low to identical. The consumer is likely to pay a higher than medium (average) level of attention in their selection. The distinctiveness of the Earlier Mark is medium. The marks are visually similar to a high degree and are aurally and conceptually identical. The purchase of the contested goods and services is considered to be mainly visual but the potential for aural use is borne in mind.

74. Taking all of these factors into account and bearing in mind the principle of imperfect recollection, I find that there is a likelihood of direct confusion. I appreciate that the average consumer will pay a higher-than-average degree of attention, but this does not mean that they will remember the marks perfectly. Additionally, although there are some presentational differences between the marks, I consider these to be offset by the very high degree of similarity (especially aural and conceptual) between the verbal elements of the marks, the fact that misspelling a word by substituting a “I” with a “Y” is quite common, and the overall similarity of the competing goods and services. As such, the presentational differences will be misremembered. I consider that consumers will misremember which mark offered the goods/services by “ORIGIN” along with a black and white device and the word “ORIGYN”, especially in light of the principle of imperfect recollection and the fact that consumers rarely have the opportunity to compare marks side by side. As a result, I consider that there exists a likelihood of direct confusion between the marks.

Conclusion

75. The opposition under section 5(2)(b) succeeds and the application, subject to any appeal, will be refused for all goods and services.

Costs

76. The Opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Annex A to the Tribunal Practice Notice (TPN) 1/2023. Bearing that scale in mind I award costs to the Opponent as follows:

Official fee	£100
Preparing a statement of grounds and considering the other side's statement	£250
Total	£350

77. I therefore order RETAIL247 CONSULTING LIMITED to pay ORIGYN Foundation the sum of **£350**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 16th day of June 2025

For the Registrar

Andrea Rossi

Annex

Good and services relied upon for the opposition

Class 9 Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signaling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for sound, image or data recording, transmission, reproduction or processing; recorded or downloadable media, software, blank digital or analogue recording and storage media; computers and computer peripherals; optical character recognition devices; downloadable software; computer programs; software packages; interactive software; database management software; OCR (optical character recognition) software; data search software; software for data and document capture, transmission, storage and indexing; computer platforms in the form of recorded or downloadable software; all of the aforementioned goods only in the fields of digital certification and authentication of watches, luxury products, digital media, and works of art, and none being in or related to the fields of chemistry, applied chemistry, bio-based chemistry or bioplastics.

Class 35 Advertising; commercial business management; commercial administration; office functions; provision of online commercial information directories on the Internet; computer file management services; computerized file management services; compilation and systematization of information into computer databases; updating and maintenance of data in computer databases.

Class 42 Scientific and technological services as well as research and design services relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; authentication of works of art; design and development of computers and software; programming of software for Internet platforms; design, maintenance, rental and updating of software; design and development of data reading, transmission and organization software; computer database design; hosting of computer databases; rental of computer database software; temporary provision of Web software; temporary provision online of non-downloadable software for database management; provision of temporary use of online non-downloadable software for importing and managing data; electronic data

back-up; Software as a Service (SaaS); design and development of systems for data input, extraction, processing, display and storage; management of computer projects in the field of electronic data processing; development of computer platforms; hosting platforms on the Internet; computer Platform as a Service (PaaS); hosting of platforms on the Internet; hosting memory space on the Internet; all of the aforementioned services only in the fields of digital certification and authentication of watches, luxury products, digital media, and works of art, and none being in or related to the fields of chemistry, applied chemistry, bio-based chemistry or bioplastics.

Class 45 Return of lost property; Locating stolen goods; provision of reconnaissance and surveillance services; tracking services with a view to the recovery of encoded products.