O/0542/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3848780

BY FIND SATOSHI LAB LTD

TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASSES 9, 35 AND 42

AND

THE OPPOSITION THERETO UNDER NUMBER 440452

BY SATOSHILABS GROUP A.S.

Background and pleadings

1. On 13 November 2022, Find Satoshi Lab Ltd ("the applicant") applied to register the figurative trade mark shown on the first page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 27 January 2023 in respect of the following goods and services:

> *Class 9: Smartphone software applications, downloadable; computer software applications, downloadable; downloadable computer software for use as a digital wallet; downloadable image files; virtual reality headsets; pedometers; wearable activity trackers; video recorders; measuring instruments; 3D spectacles; portable power chargers; smartphones; electronic publications, downloadable; computers.*
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> *Class 35: Marketing; import-export agency services; sales promotion for others; provision of an online marketplace for buyers and sellers of goods and services; updating and maintenance of data in computer databases; advertising; personnel management consultancy; presentation of goods on communication media, for retail purposes; providing business information via a website; online promotion of computer networks and websites; secretarial services; book-keeping; sponsorship search; business management assistance; online retail services connected with the sale of software.*
>
> *Class 42: Design and development of computer software; design and development of multimedia products; software as a service [SaaS]; platform as a service [PaaS]; providing virtual computer systems through cloud computing; user authentication services using blockchain technology; video game development services; design of prototypes; technological research; computer programming; design, programming and maintenance of computer software; electronic data storage; authenticating works of art; updating and maintenance of computer software.*

2. On 27 April 2023, SatoshiLabs Group a.s. ("the opponent") opposed the trade mark, based upon Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK trade mark:

UK registration number: UK00801456592

Filing date: 13 September 2018

Registration date: 27 August 2019

3. The following goods are relied on in this opposition:

Class 9: Cryptocurrency hardware wallets, computer software for use as a cryptocurrency wallet, apparatus and installations related to digital currencies and cryptocurrencies.

Class 35: Retail store services in the field of cryptocurrency hardware wallets and computer software for use as a cryptocurrency wallet, wholesale services in the field of cryptocurrency hardware wallets and computer software for use as a cryptocurrency wallet.

Class 36: Financial affairs and monetary affairs, namely, financial information, management and analysis services, insurance underwriting in the field of product destruction and loss of product, issuance of tokens of value.

Class 38: Communication services, namely electronic transmission of data and documents among users of computers, computer aided transmission of messages and images, transmission of digital files, communications by computer terminals, electronic message sending, providing access to databases, providing multiple-user access to a global computer information network, providing user access to global computer networks, transmission of electronic mail.

Class 42: Computer technology consultancy, conducting of feasibility studies in the field of new technologies, consulting in the field of telecommunications technology, conversion of data or documents from physical to electronic media, data encryption services, software design and development, software as a service (SaaS) services featuring software for use as a cryptocurrency wallet,

technological consulting in the field of cryptocurrency, technology consultation and research in the field of data coding, computer security consultancy, computer software consulting, computer system analysis, computer system design, data conversion of electronic information, data security consultancy, Internet security consultancy.

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark in accordance with section 6 of the Act. In accordance with section 6A of the Act, the earlier mark is not subject to proof of use. The opponent may therefore rely upon all the goods for which the mark is registered.

5. Under section 5(2)(b), the opponent claims that the respective goods are identical or highly similar and that the marks are highly similar, and that, as such, there will be a likelihood of confusion between the marks.

6. The applicant filed a counterstatement in which they state that whilst there is a possibility of some goods being deemed similar, some exhibit clear differences and some of the goods and services are dissimilar. The applicant states that the differences in the marks and the goods and services prevent any likelihood of confusion between the marks.

7. The opponent filed written submissions, but the applicant did not. Neither party filed evidence in these proceedings. No hearing was requested. This decision is taken following a careful perusal of the papers.

8. The opponent is represented by Bird & Bird LLP. The applicant is represented by Paweł Wowra.

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

Decision

Section 5(2)(b)

10. Section 5(2)(b) of the Act is as follows:

> "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".

Section 5A

11. Section 5A of the Act is as follows:

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

The principles

12. 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 C120/04, *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 Page 5 of 17 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

13. 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."

14. 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.

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

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

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

17. Further, in *Kurt Hesse v OHIM*,[1] 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*,[2] the General Court ("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."

[1] Case C-50/15 P
[2] Case T-325/06

18. The goods to be compared are shown in the table below:

The opponent's goods relied on	**The applicant's goods**
Class 9: Cryptocurrency hardware wallets, computer software for use as a cryptocurrency wallet, apparatus and installations related to digital currencies and cryptocurrencies. *Class 35: Retail store services in the field of cryptocurrency hardware wallets and computer software for use as a cryptocurrency wallet, wholesale services in the field of cryptocurrency hardware wallets and computer software for use as a cryptocurrency wallet.* *Class 36: Financial affairs and monetary affairs, namely, financial information, management and analysis services, insurance underwriting in the field of product destruction and loss of product, issuance of tokens of value.* *Class 38: Communication services, namely electronic transmission of data and documents among users of computers, computer aided transmission of messages and images, transmission of digital files, communications by computer terminals, electronic message sending, providing access to databases, providing multiple-user access to a global computer information network,*	*Class 9: Smartphone software applications, downloadable; computer software applications, downloadable; downloadable computer software for use as a digital wallet; downloadable image files; virtual reality headsets; pedometers; wearable activity trackers; video recorders; measuring instruments; 3D spectacles; portable power chargers; smartphones; electronic publications, downloadable; computers.* *Class 35: Marketing; import-export agency services; sales promotion for others; provision of an online marketplace for buyers and sellers of goods and services; updating and maintenance of data in computer databases; advertising; personnel management consultancy; presentation of goods on communication media, for retail purposes; providing business information via a website; online promotion of computer networks and websites; secretarial services; book-keeping; sponsorship search; business management assistance; online retail services connected with the sale of software.*

providing user access to global computer networks, transmission of electronic mail. *Class 42: Computer technology consultancy, conducting of feasibility studies in the field of new technologies, consulting in the field of telecommunications technology, conversion of data or documents from physical to electronic media, data encryption services, software design and development, software as a service (SaaS) services featuring software for use as a cryptocurrency wallet, technological consulting in the field of cryptocurrency, technology consultation and research in the field of data coding, computer security consultancy, computer software consulting, computer system analysis, computer system design, data conversion of electronic information, data security consultancy, Internet security consultancy.*	*Class 42: Design and development of computer software; design and development of multimedia products; software as a service [SaaS]; platform as a service [PaaS]; providing virtual computer systems through cloud computing; user authentication services using blockchain technology; video game development services; design of prototypes; technological research; computer programming; design, programming and maintenance of computer software; electronic data storage; authenticating works of art; updating and maintenance of computer software.*

19. The applicant's counterstatement acknowledges that some of the goods and services may be regarded as similar, but that there are clear dissimilarities in some of the goods, particularly in classes 9 and 25.

Class 9

Smartphone software applications, downloadable; computer software applications, downloadable; downloadable computer software for use as a digital wallet

20. The opponent's 'computer software for use as a cryptocurrency wallet' falls within the scope of the above goods. These goods are therefore considered identical according to the principles set out in *Meric*.[3]

Downloadable image files

21. The above goods are closest to the opponent's 'transmission of digital files', as this includes the transmission of downloadable image files. The nature of the above goods differs from the opponent's services because the above goods are digital files, while the opponent's services are an avenue by which to transmit digital files. The purpose of the above goods is to download and view an image, while the purpose of the opponent's services is to transmit a digital file, such as an image. The users overlap to the extent that both will be used by the general public as well as professionals. Trade channels differ as the above goods will likely be purchased via websites selling, for example, stock images, while the opponent's services will be purchased via websites selling file transmission services. It is unlikely that both downloadable image files and file transmission services will be offered from the same entity on the same website. There is no competition. The transmission of files requires files themselves and downloading an image file requires the file to be transmitted. However, the consumer would not likely conclude that the responsibility for both the image file itself and the transmission of the image file would lie with the same entity. There is no complementarity. Overall, I find the above goods to be dissimilar to the opponent's 'transmission of digital files'.

Electronic publications, downloadable

22. The opponent's written submissions state that the above goods are "similar to the Opponent's class 9 goods insomuch as the content of the publication could cover the cryptocurrency goods covered by the Registration". I will therefore compare the above goods to the opponent's 'cryptocurrency hardware wallets', 'computer software for use as a cryptocurrency wallet' and 'apparatus and installations related to digital currencies and cryptocurrencies'.

[3] Case T-133/05

23. Although I appreciate that the content of the above publications could contain information relating to the cryptocurrency goods covered by the opponent's registration, I do not find any material overlap between the goods themselves. The nature of the above goods differs from the opponent's goods because the above goods are downloadable digital files, while the opponent's goods are a hardware wallet, computer software, apparatus and installations. The purpose of the above goods is to provide information to a consumer, possibly information related to cryptocurrency goods, while the purpose of the opponent's goods is to store cryptocurrency. The users overlap only to the extent that both will be used by the general public as well as professionals with an interest in cryptocurrency. Trade channels differ as the above goods will likely be purchased via journal and publication websites, while the opponent's goods will be purchased via websites selling cryptocurrency accessories. It is unlikely that both downloadable electronic publications and cryptocurrency accessories will be offered by the same entity on the same website, even if the publications are related to cryptocurrency goods. There is no competition or complementarity. Overall, I find the above goods to be dissimilar to the opponent's 'cryptocurrency hardware wallets', 'computer software for use as a cryptocurrency wallet' and 'apparatus and installations related to digital currencies and cryptocurrencies'.

Virtual reality headsets; 3D spectacles; pedometers; wearable activity trackers; measuring instruments; video recorders; portable power chargers

24. The above goods are considered the most similar to the opponent's 'software design and development'. Their nature clearly differs as the above goods are electronic hardware, while the opponent's service relates to the creation of software which can then be used on some of these hardware. The above goods are used to view virtual reality or 3D images, measure, record video or charge other devices, while the opponent's services are used to create software. Their purpose therefore differs. The users of the goods differ as the opponent's goods are used by professionals, while the above goods are used by the general public. Trade channels differ as the above goods are sold by technology retailers, both online and in store, while the opponent's services will be sold directly by the software developer themselves. Although it is possible there are some entities that may offer both software development and

hardware such as wearable activity trackers, I do not consider that this is common enough to cause the average consumer to assume that the goods and service will be undertaken by the same entity. There is no competition or complementarity. Overall, I find the above goods to be dissimilar to the opponent's services.

25. I will also consider the similarity of the above goods to the opponent's 'apparatus and installations related to digital currencies and cryptocurrencies'. The nature of the goods broadly overlaps insofar as both are electronic hardware, but their specific nature differs. Their purpose differs as the above goods are for recording data or outputting media, while the opponent's goods are for storing or allowing access to cryptocurrencies. The users overlap as both will be used by the general public, although the opponent's goods will also be used by professionals with an interest in cryptocurrency. Trade channels differ as the above goods will likely be purchased via technology stores or online retailers, while the opponent's goods will be purchased via websites selling cryptocurrency accessories. It is unlikely that cryptocurrency related goods will be available for purchase from general technology retailers. There is no competition or complementarity. Overall, I find the above goods to be dissimilar to the opponent's 'cryptocurrency hardware wallets'.

Smartphones; computers

26. In its written submissions in lieu, the opponent submits the following:

> "19. The applied for terms "*smartphones*" and "*computers*" are similar insomuch as both of these operate by using software, such as that covered by the Application and Registration. Furthermore, consumers using these items would purchase 'apps' which are computer software and the manufacturers of these products would typically be involved in the creation of software and its development. The trade channels also overlap. As such, theses Contested Goods are highly similar to those covered by the Registration."

27. I note the opponent submits above that the applicant's *smartphones* and *computers* are similar to its goods as they operate using software such as that covered by the registration. I therefore consider firstly the similarity between these goods and the opponent's 'computer software for use as a cryptocurrency wallet'. The nature of

the goods differ as the above goods are computer hardware, while the opponent's goods are computer software. The purpose of the above goods is for making calls and sending messages, and/or accessing software and the internet, while the purpose of the opponent's goods for is accessing, buying and making payments using cryptocurrency. The users of both goods will overlap at a general level as both goods will be used by the general public as well as professionals. Trade channels differ as the above goods will be purchased by technology retailers, both online and in store, while the opponent's services will be purchased via websites selling cryptocurrency accessories. There is no competition or complementarity. Whilst smartphones and computers are important or essential for accessing the software goods, the consumer would not believe on this basis that the goods derive from the same entity. I do not consider the general overlap in users sufficient to give rise to similarity between the goods. Overall, I find the above goods to be dissimilar to the opponent's 'software design and development'.

27. I will also consider the similarity of the above goods to the opponent's 'software design and development'. The nature of the above goods clearly differs from that of the opponent's as the above goods are computer hardware, while the opponent's service relates to the creation of software which can then be used on hardware. The above goods are used to access software, while the opponent's services are used to create software. Their purpose therefore differs, as does the method of use. The users of both goods will overlap at a general level where both the goods and services are used by professionals but differ where the above goods are also used by the general public. Trade channels differ as the above goods are sold by technology retailers, both online and in store, while the opponent's services will be sold directly by the software developer themselves. Although it is possible there are some entities that may offer both software development and hardware such as smartphones and computers, I have no evidence on this point, and I find it unlikely this is common. There is no competition. Software design and development must be conducted on a computer or smartphone, but the offering of the goods and services are not related or dependent on each other. Even if the goods and services are important to each other, I do not consider that this will lead the consumer to the conclusion that both are undertaken by the same entity. There is therefore no complementarity. Overall, I find the above goods to be dissimilar to the opponent's 'software design and development'.

Class 35

Marketing; advertising; online promotion of computer networks and websites; sales promotion for others

28. The above services are related to marketing and promotion. These services are not related to cryptocurrency, financial services, the transmission of data, software design or data security. I see no obvious reason why such services would overlap with or have similarity to any the opponent's goods or services, none of which relate to marketing or promotion. In the absence of any evidence or arguments from the opponent regarding this matter, I find the above goods to be dissimilar to the opponent's services.

Provision of an online marketplace for buyers and sellers of goods and services; presentation of goods on communication media, for retail purposes

29. The above services are related to the provision of an online marketplace and the presentation of goods for retail. These services are not related to cryptocurrency, financial services, the transmission of data, software design or data security. I see no obvious reason why such services would overlap with or have similarity to any the opponent's goods or services, none of which relate to marketplaces or the retail of goods. In the absence of any evidence or arguments from the opponent regarding this matter, I find the above goods to be dissimilar to the opponent's services.

Updating and maintenance of data in computer databases

30. The opponent's 'conversion of data or documents from physical to electronic media' would include the creation of computer databases for the data. The above goods relate to the updating and maintenance of data in such databases. The purposes overlap as both relate to providing a functional database but differ where the opponent's services relate to the initial input of data into a database and the above services relate to its maintenance. The nature of the services overlaps as both relate to inputting data and the utilisation of databases. Trade channels overlap as an entity that inputs data into databases is likely to sell maintenance and updating services through the same means, likely a website. There is no competition between the services. The updating and maintaining of data in a database requires the initial input

of data into the database, and it is likely that a consumer would conclude that the same entity is responsible for both services. The services are therefore considered complementary. Overall, I find a high level of similarity between the above goods and the opponent's 'conversion of data or documents from physical to electronic media'.

Import-export agency services; personnel management consultancy; secretarial services; book-keeping; sponsorship search; business management assistance; providing business information via a website

The above services cover a range of services that are not related to cryptocurrency, financial services, the transmission of data, software design or data security. I see no obvious reason why such services would overlap with or have similarity to any the opponent's goods or services, none of which relate to import-export, personnel management, secretarial services, book-keeping, business management or business information. In the absence of any evidence or arguments from the opponent regarding this matter, I find the above goods to be dissimilar to the opponent's services.

Online retail services connected with the sale of software

31. The above services are most similar to the opponent's 'wholesale services in the field of cryptocurrency hardware wallets and computer software for use as a cryptocurrency wallet'. The above services would include online retail services connected with the sale of software for use as a cryptocurrency wallet. Their purpose overlaps as both relate to the sale of computer software, although the above services relate to online retail while the opponent's services relate to wholesale. Their users overlap as both services will be used by professionals, although the above services will also be used by the general public. The nature overlaps as the opponent's services are likely to be primarily online wholesale, therefore both services involve the online sale of software. I find it unlikely that trade channels will overlap with retail and wholesale services generally offered via different outlets, however, there is competition between the services as computer software for use as a cryptocurrency wallet could be purchased via either service. There is no complementarity. Overall, I find the above services highly similar to the opponent's 'wholesale services in the field of cryptocurrency hardware wallets and computer software for use as a cryptocurrency wallet'.

Class 42

Design and development of computer software; design, programming and maintenance of computer software

32. The above goods are identical to or fall within the scope of the opponent's 'software design and development'. These goods are therefore considered identical according to the principles set out in *Meric*.[4]

Software as a service [SaaS]

33. The opponent's 'software as a service (SaaS) services featuring software for use as a cryptocurrency wallet' falls within the scope of the above goods. These goods are therefore considered identical according to the principles set out in *Meric*.[5]

Platform as a service [PaaS]

34. The above services are considered most similar to the opponent's 'software as a service (SaaS) services featuring software for use as a cryptocurrency wallet'. The purpose of the services differs as the above services provide a platform for developing applications and software, while the opponent's services provide pre-developed applications and software. The nature of the services differ as the above services are a platform for developing software, while the opponent's services are software themselves. The users overlap as both would be used by professionals, both in technology fields and in general business fields. It is likely that trade channels would overlap, as both services may be provided by computer technology companies. There may be competition as a consumer is likely to decide whether to use PaaS or SaaS for their business needs. There is no complementarity. Overall, I find the above goods to have a low level of similarity to the opponent's 'software as a service (SaaS) services featuring software for use as a cryptocurrency wallet'.

[4] Case T-133/05
[5] Case T-133/05

User authentication services using blockchain technology

35. The above services are considered most similar to the opponent's 'computer security consultancy' as both the above services and the opponent's services relate to computer security. The nature and purpose of the services differs as the above services provide security themselves, while the opponent's services provide consultation regarding security, which could include advising a consumer to use techniques such as user authentication services using blockchain technology. The users overlap as both would be used by mainly professional consumers wanting to make their system more secure. The trade channels may overlap, as an entity selling computer security services such as user authentication may also offer consultation services to their customers. There is no competition or complementarity. Overall, I find the above services to have a low level of similarity to the opponent's 'computer security consultancy'.

Video game development services; design of prototypes; computer programming; design and development of multimedia products; providing virtual computer systems through cloud computing

36. The opponent's 'software design and development' can include the design of software prototypes, computer programming, video game development services, the design and development of multimedia products and the design of virtual computer programs through cloud computing. These goods are therefore considered identical according to the principles set out in *Meric*.[6]

Technological research

37. The opponent's 'technology consultation and research in the field of data coding' falls within the scope of the above goods. These goods are therefore considered identical according to the principles set out in *Meric*.[7]

[6] Case T-133/05
[7] Case T-133/05

Electronic data storage

38. The above services are most similar to the opponent's 'conversion of data or documents from physical to electronic media'. The above service relates to the electronic storage of data, which can include data or documents that have been converted from physical to electronic media. The purposes overlap as both relate to storing data digitally but differ where the opponent's services relate to the conversion of physical to electronic data. The nature of the services overlaps to the extent that both relate to electronic data. The users of the services overlap as both members of the general public and professionals may want their data to be converted to electronic media, and then stored electronically. I consider that it is likely that the trade channels will overlap as an entity that converts data or documents from physical to electronic would likely also offer a service for the storage of said electronic data and documents, although I note I have no evidence on this point. There is no competition between the services. The conversion of data from physical to electronic requires the electronic data to be stored afterwards, and it is likely that a consumer would conclude that the same entity is responsible for both services. There is therefore complementarity between the services. Overall, I find a medium level of similarity between the above services and the opponent's 'conversion of data or documents from physical to electronic media'.

Authenticating works of art

39. The above services are not related to cryptocurrency, financial services, the transmission of data, software design or data security. I see no obvious reason why such services would overlap with or have similarity to any the opponent's goods or services, none of which relate to authenticating works of art. In the absence of any evidence or arguments from the opponent regarding this matter, I find the above goods to be dissimilar to the opponent's services.

Updating and maintenance of computer software

40. The above goods are considered most similar to the opponent's 'software design and development'. The purposes overlap to the extent that both relate to providing

functional computer software but differ where the opponent's services relate to the initial design and development of the software and the above services relate to its maintenance. The nature of the services overlaps as both relate to the utilisation of computer software. The users of both services will include both members of the general public and professionals. Trade channels overlap as an entity that designs and develops software is likely to sell maintenance and updating services through the same means, likely a website. There is no competition or complementarity between the services. Overall, I find a high level of similarity between the above goods and the opponent's 'software design and development'.

Conclusion of goods and services comparison

41. There can be no likelihood of confusion in respect of section 5(2)(b) of the Act regarding the applicant's goods which were found to be dissimilar to the opponent's goods.[8] In light of my findings above, the present opposition fails against the following goods:

> *Class 9: 'downloadable image files; electronic publications, downloadable; virtual reality headsets; pedometers; wearable activity trackers; video recorders; measuring instruments; 3D spectacles; portable power chargers; smartphones; computers.'*
>
> *Class 35: 'marketing; advertising; online promotion of computer networks and websites; sales promotion for others; provision of an online marketplace for buyers and sellers of goods and services; presentation of goods on communication media, for retail purposes; import-export agency services; personnel management consultancy; providing business information via a website; secretarial services; book-keeping; sponsorship search; business management assistance.'*
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> *Class 42: 'authenticating works of art'.*

42. I will proceed against the goods that I have found to be identical or similar.

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

Comparison of marks

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

44. 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 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.

45. The respective trade marks are shown below:

The opponent's earlier marks	**The applicant's contested mark**

	

Overall impression

46. The opponent's mark consists of the letters "SATOSHILABS" and a figurative element which is a stylised "SL" (which in my view may or may not be recognised by the consumer as letters) inside a circle on the lefthand side of the letters. Given that consumers tend to be drawn to word elements, the word element contributes more to the overall impression of the mark. Although there is no space between the two words, the consumer would note the recognisable word 'labs' in the mark. The consumer would therefore identify the opponent's mark as having two distinguishable elements in the word: 'SATOSHI' and 'LABS'.

47. The applicant's mark consists of the words "Find Satoshi Lab" aligned on top of each other and a figurative element which is a stylised F and S on the lefthand side of the words. It is possible that some consumers may not see both an F and an S in the figurative element. Instead, they may see no letters at all, or just an S with a horizonal line above it. Given that consumers tend to be drawn to word elements, and that they may not see the figurative element as letters at all, the word element contributes more to the overall impression of the mark.

Visual comparison

48. Both marks contain a figurative element on the lefthand side of the mark. In the opponent's mark, this figurative element is a stylised "SL" next to each other, surrounded by an outline of a circle. In the applicant's contested mark, this figurative element is a stylised "F" merged with a stylised "S" underneath. As noted above, some

consumers may view this as a stylised “S” with a horizontal line above it. The stylisation of the letters in the two marks is different, with the opponent’s mark using harsh lines and right-angle corners, and the letters being placed side by side. The applicant’s mark uses soft, rounded corners, with the S having a gap between the top horizontal section and the middle, curved section, and the F is placed on top of the S. I also note that some consumers may not see these letters, and instead may view the applicant’s figurative element as a straight line with two curved lines underneath it, and the opponent’s figurative element as two vertical lines, each with one or two horizontal lines, placed inside a circle.

49. Both marks contain letters placed to the right of the figurative element. The opponent’s mark contains the letters “SATOSHILABS” in capital letters, while the applicant’s mark contains the words “Find”, “Satoshi” and “Lab”, each beginning with a capital letter and continuing with lowercase letters, placed on top of each other. Both marks use the letters “SATOSHILAB”, with the opponent’s mark adding an “S” to the end, and the applicant’s mark adding “Find” at the beginning. The placement of the words stacked on top of each other in the applicant’s mark gives a different visual impression to the words placed horizontally in the opponent’s mark.

50. Overall, I consider the marks to have a medium visual similarity.

Aural comparison

51. The figurative element of both marks is unlikely to be spoken. These elements therefore have no impact on the aural nature of the marks. However, the figurative element of the opponent’s mark (where it is seen as SL) does direct the consumer to read “SATOSHILABS” as two words – Satoshi and Labs. As noted above, there may be some consumers who do not see the letters in the figurative mark, but in any case, those consumers would note the recognisable word ‘labs’ in the mark and therefore identify the opponent’s mark as having two distinguishable elements: ‘SATOSHI’ and ‘LABS’. They will therefore pronounce the mark as two words. The word “Satoshi” will be pronounced as either “SA-TOE-SHI” or “SA-TOSH-EE”. Labs will be pronounced in the typical way.

52. The applicant's mark will be read as "Find Satoshi Lab", with "Find" and "Lab" being pronounced in the typical way, and "Satoshi" being pronounced the same way as in the opponent's mark.

53. There is overlap in the aural nature of the marks with the word "Satoshi". There is also significant overlap where the opponent's mark uses "labs" and the applicant's mark uses "lab"; it is likely that a consumer would not hear the addition or removal of the "S".

54. The main point of aural difference is that the opponent's mark contains the word "Find" at the beginning. This makes a significant difference aurally, particularly given that it is found at the beginning of the mark.

55. Overall, I consider the marks to have a slightly above medium level of aural similarity, by virtue of the shared four syllables in each.

Conceptual comparison

56. I refer to *Usinor SA v OHIM,* Case T-189/05, in which the General Court found that:

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

57. As noted above, the figurative element of the opponent's mark directs the consumer to read "SATOSHILABS" as two words – Satoshi and Labs. However, consumers who do not see the letters within the figurative element are still likely to note the known word "labs", and therefore read the mark as two words: "SATOSHI" and "LABS". Both marks therefore comprise the words "Satoshi" and "Lab(s)". The

word “Satoshi” is a dictionary word but one that in my view, a significant portion of consumers would not know the meaning of. A small number of consumers may understand this word to relate to the creator of bitcoin, or a unit (one hundred millionth) of bitcoin currency.[9] However, I do not consider that the average consumer will necessarily understand this link, and I have not been provided with any evidence to suggest otherwise. It is my view that even consumers of cryptocurrency related goods or services will not necessarily have a detailed knowledge of its creator or of the name for a tiny unit of bitcoin. Indeed, this might not even be the type of cryptocurrency they are engaged with. For a significant portion of consumers, the word “Satoshi” will be conceptually neutral, being considered as an invented word or as a word of foreign origin with an unknown meaning.

58. The word “lab(s)” will be understood by the consumer to be a truncation of the word “laboratory” or “laboratories”.

59. The figurative elements have no impact on the conceptual nature of the marks, as some consumers will see them as initials that only serve to highlight the words that follow them, while others will see them as figurative elements that do not convey any meaning.

60. In both marks, the words “Satoshi” and “lab(s)” will not form a unit with a meaning that is more than the sum of its parts.

61. The applicant’s mark further includes the word “find” at the beginning. This will be understood to mean to discover or perceive by chance. “Find” is also not considered to form a unit with the other words in the mark. Instead, it leads the consumer to understand that “Satoshi Lab” should be found, and therefore acts as a call to action.

62. There are conceptual overlaps with “Satoshi” for some consumers, and “lab(s)” for all consumers, as well as conceptual differences created by “find” in the opponent’s mark. I consider the marks to have a medium level of conceptual similarity where Satoshi is not understood, and a high level of conceptual similarity where it is.

[9] Oxford English Dictionary

Average consumer and the purchasing act

63. As the case law above indicates, it is necessary to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

64. The average consumer of the goods at issue will include members of the general public purchasing goods such as software applications and services such as electronic data storage, which are relatively low-cost items. Consumers would consider factors such as security and privacy for their data, as well as functionality and suitability of the software in the purchasing act. I consider that this group of consumers will pay a medium level of attention during the purchasing act.

65. Average consumers will also include members of the general public purchasing services such as to software as a service or platform as a service, which are likely to be higher cost items. Due to these items being more expensive and not purchased frequently, careful consideration will be taken of factors such as price, quality, capability and suitability. I consider that this group of consumers will pay a slightly higher than average level of attention during the purchasing act.

66. Further, average consumers will include members of the general public or professionals purchasing services for business or personal use. During the purchasing process, consideration will be taken of factors such as price and suitability. I consider

that this group of consumers will pay a higher than average level of attention during the purchasing act.

67. The goods and services are likely to be engaged with visually, via websites or visual advertising. However, I cannot discount the possibility that that there will be recommendations made by word of mouth, or that goods or services will be discussed over the telephone. I therefore cannot completely disregard the aural comparison.

Distinctive character of the earlier trade mark

68. 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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

69. 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 which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. There is no evidence regarding the use of the earlier mark. Consequently, I have only the inherent position to consider.

70. The opponent's mark is, as above, includes the slightly stylised letters 'SATOSHILABS'. To the left of these words is a black device element which comprises the heavily stylised letters 'SL' in a circle. As noted above, both elements contribute to the overall impression of the mark and the mark will be read as two separate words – 'SATOSHI' and 'LABS'. The mark is not allusive of the goods at issue. The word 'labs' is a common shortening of the word 'laboratories'. I do not consider that this word is descriptive or allusive of the goods. As noted above, some consumers may understand "Satoshi" to be the name of the creator of bitcoin, or as a unit of bitcoin currency. However, in the absence of any evidence or arguments from the opponent on this matter, I find it likely that a significant portion of consumers would not attribute any meaning to the word "Satoshi", either because they see it as an invented word or because they see it as a foreign language word with an unknown meaning. These consumers will therefore not consider it to be allusive or descriptive of the goods.

71. For those consumers that do not understand its meaning of SATOSHI, I find that the opponent's mark possesses a high level of inherent distinctive character for all of the opponent's goods and services. For those consumers that do understand this element, SATOSHI will be at least allusive of a number of the goods and services, and the marks inherent distinctiveness will be low to medium overall.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

72. 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 (*Canon* at [17]). It is necessary to keep in mind the distinctive character of the opponent's trade mark,

the average consumer of the goods and services and the nature of the purchasing act. 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 (*Lloyd Schuhfabrik* at [26]).

73. 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 down to the responsible undertakings being the same or related.

74. Although I noted above that a portion of consumers may note the meaning of the word 'Satoshi', I will consider what I find to be the opponent's most favourable position, where the meaning of the mark is not known by the consumer. Whilst I note for completeness that there is an additional conceptual similarity where this element is understood, I consider that this will be based on an element that is generally at least allusive, and as such I still find this to be the opponent's less favourable case.

75. Earlier in this decision, I found the goods and services to range from dissimilar to identical to the opponent's goods and services. I found the marks to have a medium level of visual and conceptual similarity, and a slightly above medium level of aural similarity. I found the earlier mark to possess a high level of distinctive character for a significant portion of consumers. I identified the average consumer would include both professionals and members of the general public, paying either a medium or above medium level of attention. I found that the goods would be selected primarily by visual means, although I did not discount an aural aspect to the purchasing process.

76. As noted above, 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 (*Lloyd Schuhfabrik* at [26]).

77. Taking all of the above factors into account, particularly given the high distinctive character of the earlier mark, I am satisfied that the average consumer, paying a medium level of attention, would likely mistake the parties' marks for each other on the applied for goods and services. I therefore find there to be a likelihood of direct

confusion between the parties' marks for the applicant's goods and services where the consumer pays a medium level of attention.

78. For the goods and services to which the consumer pays a higher than medium level of attention, I proceed to continue whether there is a likelihood of indirect confusion, whilst reminding myself that, as James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16], "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion".

79. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

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

80. I do not consider this case to fit neatly into one of the categories set out in *L.A. Sugar* above. However, I remind myself that these are not exhaustive. I also consider the relevance of *Medion vs Thomson*[10] and the subsequent case law. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion v Thomson.* The judge said:

"18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

[10] Case C-120/04

> 20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).
>
> 21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

81. Earlier I found that the word elements play a larger role than the figurative elements in both marks. It is also my view that "Satoshi Lab" has an independent distinctive role in the contested mark, with "Find" acting as a call to action. I did not find the word elements to form a unit that was more than a sum of their parts. Considering these factors, I find it likely in this instance that a consumer who has previously encountered similar or identical goods or services under the earlier "Satoshi Labs" mark will see a product or service under the "Find Satoshi Lab" mark and note the additional word "Find" and likely not note the loss of the "S" at the end of 'Labs', but recognise the words "Satoshi Lab" as being linked to the goods of the earlier brand. In these circumstances, it is my view that the consumer is likely to consider "Satoshi Lab" as an indication of origin in both marks, and the addition of "Find" in the later mark as reference to an alternative range of goods or services from the same origin, with the alternative device element, if remembered, simply used in relation to the alternative product ranges. The consumer is therefore likely to conclude that the goods and services are supplied by the same, or economically linked, undertakings.

82. Taking all of this into account, I consider there to be a likelihood of indirect confusion in relation the applicant's goods and services where there is at least a low degree of similarity.

Final Remarks

83. The opposition under Section 5(2)(b) has been successful in respect of the following goods:

> Class 9: *smartphone software applications, downloadable; computer software applications, downloadable; downloadable computer software for use as a digital wallet.*
>
> Class 35: *updating and maintenance of data in computer databases; online retail services connected with the sale of software.*
>
> Class 42: *design and development of computer software; design and development of multimedia products; software as a service [SaaS]; platform as a service [PaaS]; providing virtual computer systems through cloud computing; user authentication services using blockchain technology; video game development services; design of prototypes; technological research; computer programming; design, programming and maintenance of computer software; electronic data storage; updating and maintenance of computer software.*

84. The opposition has failed in respect of the following goods:

> Class 9: *downloadable image files; electronic publications, downloadable; virtual reality headsets; pedometers; wearable activity trackers; video recorders; measuring instruments; 3D spectacles; portable power chargers; smartphones; computers.*
>
> Class 35: *marketing; advertising; online promotion of computer networks and websites; sales promotion for others; provision of an online marketplace for buyers and sellers of goods and services; presentation of goods on communication media, for retail purposes; import-export agency services; personnel management consultancy; providing business information via a website; secretarial services; book-keeping; sponsorship search; business management assistance.*
>
> Class 42: *authenticating works of art.*

COSTS

85. Both parties have achieved a relatively equal measure of success in these proceedings. In the circumstances, I order that each party bear its own costs for these proceedings.

Dated this 17th day of June 2025

K HARBACH

For the Registrar