

**O/0569/25**

**TRADE MARKS ACT 1994**  
**CONSOLIDATED PROCEEDINGS**

**IN THE MATTER OF APPLICATION NOS:**  
**UK3953428 & UK3948594**

**BY DR N ALI LTD**  
**TO REGISTER THE TRADE MARKS:**

Genius Ai 

**AND**

Genius i 

**IN CLASSES 9, 35 & 41**

**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO**  
**UNDER NOS: 444894 & 445069**  
**BY KID-SYSTEME GMBH**

## BACKGROUND AND PLEADINGS

1. These consolidated proceedings involve oppositions against two trade marks that DR N ALI LTD (“the applicant”) seeks to register in the UK. The details for those trade marks are set out below:

### 1. Genius I

UK application no. 3948594

Filing date: 22 August 2023

Publication date: 6 October 2023

(“the first application”)

### 2. Genius AI

UK application no. 3953428

Filing date: 5 September 2023

Publication date: 29 September 2023

(“the second application”)

2. The above applications are in respect of goods and services in Classes 9, 35 and 41.<sup>1</sup> However, the respective specifications are not identical.

### The related oppositions

3. The applicant’s marks are subject to two oppositions brought by KID-Systeme GmbH (“the opponent”). The opposition against the second application was brought on 27 December 2023, and the opposition against the first application was brought on 5 January 2024. The oppositions are directed at all the applied-for goods and services in Classes 9, 35 and 41.

4. The oppositions are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>2</sup> The opponent relies upon the following trade mark for the purpose of its oppositions:

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<sup>1</sup> See Annex 1 to this decision.

<sup>2</sup> 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. See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

Genius

International registration (“IR”) no. 1680521

International registration and designation date: 19 January 2022;

Priority date: 19 July 2021;<sup>3</sup>

Date of protection granted in UK: 17 November 2022;

Relying upon some goods and services, namely those in Classes 9, 35 and 41.<sup>4</sup>

(“the earlier mark”)

5. The opponent submits that the respective marks are visually, aurally and conceptually highly similar, and that the goods and services are identical or highly similar, resulting in a likelihood of confusion on the part of the relevant public. As such, the relevant public will believe that they are connected to or derive from the same economic undertaking.

6. The applicant filed counterstatements denying the grounds of both oppositions.

7. On 18 March 2024, the Tribunal wrote to the parties informing them that the two opposition proceedings had been consolidated, pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.

8. The opponent’s mark qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested marks, it is not subject to the use provisions contained in section 6A of the Act. Consequently, the opponent may rely upon all of the goods and services for which the earlier mark is registered without having to establish genuine use.

9. The opponent is represented by Hogan Lovells International LLP, whereas the applicant represents itself. Only the applicant filed evidence and only the opponent filed

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<sup>3</sup> Priority is claimed from German Trade Mark No. 30 2021 015 753.

<sup>4</sup> See Annex 2 to this decision.

written submissions. Neither party requested a hearing, nor did they choose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me.

## **EVIDENCE AND SUBMISSIONS**

10. The applicant's evidence comes in the form of a witness statement from Dr N Ali, the applicant's director, dated 9 July 2024. It is a brief witness statement providing some details about the contested mark. Additionally, Dr Ali remarks on, amongst other things, the state of the register and the target market of the parties' goods and services. I will address these matters as preliminary issues below.

11. In its Form TM7s,<sup>5</sup> the opponent submits that likelihood of confusion is enhanced between the respective marks due to the acquired distinctiveness in the earlier mark. Further, in their written submissions,<sup>6</sup> the opponent states that despite the earlier mark being less than 5 years old, a simple search of their website clearly demonstrates evidence of use of its mark. However, despite the opponent's submissions, evidence of use was not filed to support this claim.

## **PRELIMINARY ISSUES**

12. The applicant has raised points in its witness statement that I intend to address as preliminary issues. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

### State of the register

13. In its witness statement, the applicant states the following:

“The opposing mark is purely written as a textual word mark, of generic origin. With no distinct characteristics or features. They [sic] are many other registered

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<sup>5</sup> Filed on 27 December 2023.

<sup>6</sup> Filed on 20 May 2024.

marks with identical word mark or highly similar marks, under the identical categories, as well as stylized marks containing the word 'Genius' registered in the UK Trade Mark registry. Examples as follows, to name a few:

UK00003070295; UK00909165911; UK00001249328; UK00003772901;  
UK00801257412; UK 00002443302.

These set legal precedents that these previous cases cited above of identical word mark or highly similar word marks and different designs within the same classes and goods have been registered.”

14. I deduce that the main purpose of Dr Ali’s comments is to, amongst other things, demonstrate the generic nature of the earlier mark and the successful coexistence of closely similar marks and similar themed marks in the relevant marketplace.

15. In considering this issue, I refer to the case of *Zero Industry Srl v OHIM*, Case T-400/06, wherein 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).”

16. It is important to recall that the state of the register is not evidence of how many of such trade marks are effectively used in the market, nor does it clarify whether

consumers have or have not been confused by the presence of such marks. Accordingly, for the avoidance of doubt, I will say no more about this evidence and, instead, continue to make my decision based on a fair and notional assessment of the similarity of the marks and the respective goods and services at issue.

#### Goods comparison and the target market

17. In its witness statement, the applicant suggests that his goods and the opponent's goods fall in different categories. He states that his goods, include *AI software; Artificial intelligence and machine learning software; Machine learning software; software downloadable from the Internet; downloadable electronic publications; Online downloadable information, publications, e-books, courses on entertainment, education, and on health, lifestyle, physical health, mental health, diet, cooking and lifestyle, product advice, motivation, psychology, personal interests, and general culture;* whereas the opponent's goods appear to be heavily weighted upon engineering.

18. Differences between the goods and services currently provided by the parties, such as their particular characteristics, including whether they are concerned with engineering, for example, are irrelevant, except to the extent that those differences are apparent from each party's specification. Since the opponent's earlier mark is not subject to proof of use, it is entitled to protection in relation to all the goods and services for which it is registered. It is the goods and services relied upon by the opponent and the goods and services applied for by the applicant that I will be comparing later in this decision. The assessment I must make between the goods and services is a notional and objective assessment, rather than a subjective one.

19. In addition, marketing strategies, including the targeting of specific consumers, are temporary and may change over time. As such, it is not appropriate to take that factor into account in my assessment. I will make an assessment, later in this decision, as to who the average consumer could be for the goods and services at issue. However, again, this is a notional assessment based on how the terms are worded.

## DECISION

### Section 5(2)(b)

20. Section 5(2)(b) and 5A of the Act states that:

“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.”

21. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG, Case C-251/95*, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97*, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97*, *Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98*, *Matratzen Concord GmbH v OHIM, Case C-3/03*, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04*, *Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P* and *Bimbo SA v OHIM, Case C-591/12P*:

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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**

22. The parties' goods and services are set out in Annex 1 and 2 of this decision.

23. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

"23. In assessing the similarity of the goods or services concerned, ... 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".

24. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat* ") [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

25. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

"82. ...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

may think that the responsibility for those goods lies with the same undertaking”.

26. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.<sup>7</sup>

27. In the case of services (and goods), the terms used should not be interpreted widely but confined to the core of the possible meanings attributable to the terms: *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) [2024] UKSC 36*, at [365].

28. With regard to the similarity of the goods and services, in its written submissions,<sup>8</sup> the opponent states the following:

“Our client's earlier International Registration no. 1680521 designating the UK for 'Genius' covers classes 9, 11, 12, 35, 36, 37, 38, 41 and 42, including, *inter alia*, computer hardware, computer software and artificial intelligence and machine learning software in class 9 and advertising and marketing services in class 35. Such goods are, self evidently, identical to goods and services covered by classes 9 and 35 of the Applications (being, *inter alia*, computer hardware and firmware; computer software; AI software; Artificial intelligence and machine learning software; in class 9 and Advertising and marketing in class 35). *At this stage, we have not provided a full comparison of the entirety of the specifications* but use these as clear examples of the high degree of identity and similarity.” (emphasis added)

29. It is noted that a full comparison of the entirety of the respective specifications was not provided by the opponent. Accordingly, taking guidance from Iain Purvis KC, sitting as Appointed Person in the *SmartX* trade mark decision,<sup>9</sup> where the opponent has not provided a sufficient comparison between the goods and services at issue, I will proceed to make my own. As per *Separode*, I will approach the comparison of the

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<sup>7</sup> Paragraph 5

<sup>8</sup> Dated 20 May 2024.

<sup>9</sup> BL O/0911/24, at [32].

goods and services at issue by grouping them collectively in as few groups as I consider logical. Further, where the terms listed are particularly wide or vague, I will endeavour to follow the principles outlined in *Skykick* by comparing what I consider to be the core meaning of the goods and services, without affording them neither a too liberal, nor an artificially narrow, interpretation.

30. Pursuant to section 60A of the Act, I am mindful of the fact that the goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes. I also note that in *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense. Meanwhile, in *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.

31. The specifications of both applied-for marks are identical, with the following exceptions, which I will refer to during my goods and services comparison:

a) the second application has the additional goods “*AI software; Artificial intelligence and machine learning software; Machine learning software*” in Class 9 which have no counterpart in the specification of the first application;

b) the first application has “*consultation, advisory and support services relating to all the aforesaid services*” at the end of Class 35, which has no counterpart in the specification of the second application;

c) the second application has “*consultation, advisory and support services relating to all the aforesaid services*” at the end of Class 41, which has no counterpart in the specification of the first application;

d) finally, it is noted that in Class 41 of the applications whilst similar wording is used in relation to certain services the key wording appears in a different order. Ordinarily, this would likely make very little difference, however, in this instance, the difference changes the meaning of the services, namely:

The first application

***providing a website*** featuring blogs, non- downloadable text, video and audio files in the fields of entertainment, sports, education, health advice, dietary advice, culinary advice, celebrity and culture and news;

The second application

*providing blogs, non- downloadable text, video and audio files in the fields of entertainment, sports, education, health advice, dietary advice, culinary advice, celebrity and culture and news* **via a website**;

It is important to note that ***providing a website*** featuring...., as shown in the first application, is in fact a service proper to Class 42. However, as this term has been incorrectly caught in Class 41, for the purpose of my analysis I will interpret it within the parameters of this class, namely as, *providing blogs, non- downloadable text, video and audio files in the fields of entertainment, sports, education, health advice, dietary advice, culinary advice, celebrity and culture and news* **via a website**. This interpretation replicates the correctly classified respective services in the second application, as shown above.

The opponent's earlier mark

32. For the avoidance of doubt, I do not consider the limitations to the opponent's Class 9 and 41 specifications to be relevant to my comparison of the parties' goods and services.

**Class 9 of the contested applications**

Recorded media

33. The above contested goods, although worded slightly differently, have a direct equivalent in Class 9 of the opponent's earlier mark, namely *media, recorded*. Therefore, these goods are identical.

Computer hardware; computer software

34. The above goods are identically included in the opponent's specification, therefore the goods are identical.

Computer firmware

35. As a broad term, I find that the above contested goods encompass the opponent's *system and system support firmware and firmware drivers*. Therefore, these goods are identical in line with the principle set out in *Meric*.

Software downloadable from the Internet

36. The above contested goods are included in the broad term *software*, contained in the opponent's specification. Therefore, the goods are considered identical in line with the principle set out in *Meric*.

AI software; Artificial intelligence and machine learning software; Machine learning software

37. As previously mentioned, the above contested goods feature in the second application only. These goods are included in the broad term *software*, contained in the opponent's specification. Therefore, the goods are considered identical in line with the principle set out in *Meric*.

Downloadable electronic publications; Online downloadable information, publications, e books, courses on entertainment, education, and on health, lifestyle, physical health, mental health, diet, cooking and lifestyle, product advice, motivation, psychology, personal interests, and general culture

38. The above contested goods all appear to relate to downloadable publications in one form or another. I find that the contested goods have a complementary relationship with the opponent's broad term *publishing services and reporting and drafting of texts* in Class 41, with the contested goods being the end product of those services. As the opponent's services are unlimited, there is nothing preventing them from being services relating to online publications. Accordingly, the contested goods would not exist were it not for the provision of services for their publication. The nature of the goods and services will clearly be different, however, there will be some overlap in users. Further, it is not uncommon for the same undertakings to be responsible for the provision of electronic publications, for example, and their publishing, on the basis that, in the case of electronic publication, such as ebooks, the undertakings which produce, publish and sell ebooks will be the same. Accordingly, I consider these goods and services to be similar to a medium degree.

#### Mobile phone and smart watches

39. Broadly speaking, the above goods are communication devices used to transmit, receive, and process information, including voice, data, and video. The opponent's specification contains the broad term *communication equipment* which I find encompasses and/or overlaps with the contested goods. As such, I find that they are identical in line with the principle set out in *Meric*. However, if I have given too much weight to the identity of the goods, then I consider there to be an overlap in users, nature, purpose and channels of trade, such that I find the goods to be similar to a high degree.

#### Mobile phone accessories

40. I have found the opponent's *communication equipment* to be a broad term that would reasonably include mobile phones. On this basis therefore, I consider there to be a degree of similarity between the above contested goods and the opponent's *communication equipment*. Given that the accessories would be dependent on the *communication equipment*, being a mobile phone, for its use and that it is common for undertakings to offer the sale of mobile phones and accompanying accessories, I consider these goods to be complementary. Whilst the nature and uses of the goods

differ, the users will overlap. Additionally, mobile phones and their accessories can be found under the same category online and in the same or adjacent aisles in physical stores. Overall, I find these goods to be similar to a medium degree. However, bearing in mind the above comparison between *mobile phones* and *communication equipment*, in the event that I have given too much weight to the identity of these goods, then with regards to *mobile phone accessories* versus *communication equipment*, taking into consideration that there may be an overlap between users and channels of trade, I find the goods to be similar to a low degree.

### **Class 35 of the contested applications**

Advertising; advertising services; online advertising; dissemination of advertising for others via an on-line electronic communications network; Advertising, including on-line advertising on a computer network; Advertising services provided via the internet; Advertising consultancy; services of advertising agencies

41. I find that the above contested services overlap and/or encompass the opponent's *advertising through databases* and *advising and assistance services in the field of advertising*. As such, I find that the respective services are identical in line with the principle set out in *Meric*.

Marketing; marketing services; targeted marketing; product marketing; business marketing consultancy; marketing consultancy

42. I find that the above contested services overlap and/or encompass the opponent's *distribution of marketing materials; database marketing; advising and assistance services in the field of marketing*. I consider that the respective services are identical in line with the principle set out in *Meric*.

Promotional services

43. I find that the above contested services overlap and/or encompass the opponent's *distribution of promotional materials; advising and assistance services in the field of advertising and sales promotion; advertising through databases* and *advising and*

*assistance services in the field of advertising*. As such, I find that the respective services are identical in line with the principle set out in *Meric*.

#### Business data analysis

44. The above contested services are included in the broad term *business analysis*, contained in the opponent's specification. Therefore, the services are considered identical in line with the principle set out in *Meric*. However, if I have given too much weight to the identity of the services, then I consider there to be an overlap in users, nature, purpose and channels of trade, such that I find the services to be similar to a high degree.

#### Business management consultation

45. The above contested services, although worded slightly differently, have direct equivalents in Class 35 of the opponent's earlier mark, namely *business management; management consulting services; management consulting and assistance in business matters, management and administrative*. Therefore, the services are identical.

#### Online service for connecting social network users with businesses

46. The contested services overlap with the opponent's *providing business information and corporate communications via computer networks and global communications networks*; Therefore, the services are considered identical in line with the principle set out in *Meric*.

#### Compilation of information into computer databases; systemization of information into computer databases

47. Although worded slightly differently, the contested services have direct equivalents in Class 35 of the opponent's earlier mark, namely *compilation and systematisation of information and databases; compiling and systematising data in databases; compiling and entering information in databases; database management; computerised*

*database management; administration of databases.* Therefore, these services are considered identical.

#### Data search in computer files for others

48. I find that the above services overlap with the opponent's *compilation and systematisation of information and databases; compiling and systematising data in databases; compiling and entering information in databases; database management; computerised database management; administration of databases* in Class 35. As such, I find that the respective services are identical in line with the principle set out in *Meric*. However, if I have given too much weight to the identity of the services, then I consider there to be an overlap in users, nature, purpose and channels of trade, such that I find the services to be similar to a high degree.

#### Business monitoring and consulting services, namely, tracking users and advertising of others to provide strategy, insight, marketing guidance, and for analysing, understanding and predicting consumer behaviour and motivations, and market trends

49. The above services will include a wide range of business responsibilities. For example, the services are likely to involve, amongst other things, the provision of expert advice to business owners in order to, for example, analyse, understand and predict consumer behaviour, motivations, and market trends. Accordingly, I am of the view that these services share a degree of similarity with the opponent's *business management; advising and assistance services in the field of advertising, marketing and sales promotion; assistance in business matters; business analysis and information services and market research* in Class 35. Whilst the respective services are not the same, I consider that they share a close relationship. I find that the respective services can target the same end user, can be distributed via the same trade channels and can coincide in producers. As such, I am of the view that the average consumer of the respective services may assume that they come from the same source. Accordingly, I find there to be a medium degree of similarity between the services.

## Business networking

50. In general, *business networking* refers to a marketing strategy which focusses on building professional relationships with other businesses in order to, for example, generate business opportunities. These services are not present in the opponent's specification. However, I note that *trade fair and commercial exhibition services* are included. Broadly speaking, such services will involve a gathering where businesses in a specific industry can showcase and demonstrate their products and services, with a primary purpose being to facilitate business interactions, including networking. As such, I am of the view that the respective services are similar to a degree. The services can overlap in purpose, target the same end user, can be distributed via the same trade channels and can coincide in producers. Further, I am of the view that the average consumer of the respective services may assume that they come from the same source. Accordingly, I find there to be a high degree of similarity between the services.

## Presentation of goods on communication media, for retail purposes

51. The contested services are specific business services relating to product promotion and describe a service of placing goods on communication media for others to view or potentially purchase. I am of the view that these services broadly fall within the advertising, marketing and promotion sector, and as such, share a degree of similarity with the opponent's *advising and assistance services in the field of advertising, marketing and sales promotion* and *advertising through databases*. For example, I find that advice on how to present goods and services offered by a business to customers is clearly part of an advertising marketing and promotion service. Accordingly, I find that the respective services belong to the same homogeneous sector. The services at issue coincide in purpose, use and user, and have a similar nature, since they are both aimed at providing others with assistance in the sale of their goods. Moreover, the respective services will reach the market through overlapping trade channels and may be offered by the same undertakings. Overall, I find that the services are similar to at least a medium degree.

Price comparison services; commercial information and advice for consumers  
[consumer advice shop]

52. I find that the above contested services, although worded slightly differently, have a direct equivalent in Class 35 of the opponent's earlier mark, namely *commercial and consumer information services, namely commercial valuation services, price comparison services, procurement services for third parties*. Further, although not specifically mentioned, I am of the view that the opponent's *commercial and consumer information services* would include, providing advice to consumers. Therefore, the services at issue are considered identical.

Providing consumer product information; Providing comparison shopping information

53. Broadly speaking, 'consumer product information' refers to the details related to a product that are used to inform and attract potential buyers. Such information will include product specifications, sizes, materials, prices and reviews, etc, with a view to providing clarity about a certain product to potential customers in order to help them in their purchasing decision process. With regards to 'comparison-shopping', in general, this is when consumers compare the prices of products or services between different providers and retailers before making a purchase. This allows customers, for example, to *shop around* for what they perceive to be the best deal. Accordingly, I find that the contested services share a degree of similarity with the opponent's *commercial and consumer information services, namely commercial valuation services, price comparison services, procurement services for third parties and providing information on commercial and business matters from online databases*. Whilst I acknowledge that the respective services are not identical, I consider that they share a close relationship. I find that the services can target the same end user, can be distributed via the same trade channels and can coincide in producers. Further, I am of the view that the average consumer of the respective services may assume that they come from the same source. Accordingly, I find there to be a medium degree of similarity between the services.

### Sales promotion for others

54. I find that the above services overlap with the opponent's *advising and assistance services in the field of advertising, marketing and sales promotion* in Class 35. As such, the respective services are identical in line with the principle set out in *Meric*.

### Providing statistical business information

55. I find that the above services overlap with the opponent's *providing business information and corporate communications via computer networks and global communications networks* in Class 35. Broadly speaking, *business information* relates to any information that holds meaning, value or significance for a business, for example, financial data, customer information, and statistics, etc. Accordingly, I find that the opponent's broad term encompasses the contested services. Therefore, these services are identical in line with the principle set out in *Meric*. However, if I have given too much weight to the identity of the services, then I consider there to be an overlap in users, nature, purpose and channels of trade, such that I find the services to be similar to a high degree.

### Brand evaluation services; brand positioning; brand creation services (advertising and promotion); brand strategy services

56. Broadly speaking, a 'brand' is a name, term, design, symbol or any other feature that distinguishes one seller's goods or services from those of other sellers. Brands are used in business, marketing, and advertising for, amongst other things, recognition and to create brand equity, etc. In my view the contested services are essential components in brand development and brand management. Whilst I note that these services do not feature in the specification of the opponent's earlier mark, I find the contested services share a degree of similarity with the opponent's *advising and assistance services in the field of advertising, marketing and sales promotion and advertising through databases*. The purpose and nature of the services at issue are similar, and the users, providers and channels of trade can coincide. Further, I am of the view that the average consumer is likely to expect the contested services to be

provided as part of marketing and promotional services. Therefore, I find that the services at issue are similar to at least a medium degree.

57. As previously mentioned, the applicant's specification contained in the first application also includes *consultation, advisory and support services relating to all the aforesaid services* in Class 35. In so far as, and to the extent that the above specified services are identical or similar, I find that these *consultation, advisory and support services* are also identical or similar.

### **Class 41 of the contested applications**

Educating and entertainment services, information and advice relating to lifestyle, physical health, diet, cooking, mental health, general interests; entertainment services, providing images from the Internet; provision of information relating to entertainment; providing information relating to a wide variety of topics for entertainment, education

58. I find that the above contested services are included in the broad terms *education, entertainment and sports activities* contained in the opponent's specification. Therefore, the services are considered identical in line with the principle set out in *Meric*.

Health, diet, cooking, exercise, general well being, and general interests, providing a real-time information network relating to the latest stories, ideas, opinions, news and to information of personal interest (educational, entertainment, health, cooking, diet and cultural services); providing information relating to a wide variety of topics for personal interests, or cultural purposes; providing blogs, non- downloadable text, video and audio files in the fields of entertainment, sports, education, health advice, dietary advice, culinary advice, celebrity and culture

59. The above contested services relate to numerous activities which broadly speaking fall within the categories of educational, entertainment, health, cooking, diet, and cultural services. I am of the view that cultural services and services relating to health, cooking and diet, etc., can be educational as well as entertaining. As such, I find that the above contested services are included in the opponent's broad terms *education,*

*entertainment and sports activities; sports and fitness services; entertainment, sport and culture; and entertainment events and the organisation of sporting events and activities.* Therefore, the services are considered identical in line with the principle set out in *Meric*. However, if I have given too much weight to the identity of the services, then I consider there to be an overlap in users, nature, purpose and channels of trade, such that I find the services to be similar to a high degree.

Publication of online information, namely, blogs featuring user-defined content in the field of social networking; publication of online journals, namely, blogs featuring personal information and opinions in the field of health, physical fitness, education, diet, cooking, general well being and general interest; publishing of books, magazines, journals and texts; publication of periodicals; providing online electronic publications (not downloadable); information relating to all the aforesaid provided online from a computer database on the Internet

60. The above services are all types of publication/publishing services. As such, I am of the view that they are identical under the principle outlined in *Meric* to *publishing services and reporting and drafting of texts* in the opponent's specification.

Providing blogs, non- downloadable text, video and audio files in the fields of news

61. I am of the view that the above contested services could be provided in the form of an online publication. Accordingly, on this basis, I find that there is a degree of similarity between these services and the opponent's *publishing services and reporting and drafting of texts*. Therefore, I consider there to be an overlap in users, purpose and channels of trade, such that I find the services to be similar to a high degree.

News reporting services, provision of news and current affairs

62. None of the above services have equivalent terms in the opponent's specification. Furthermore, I find that the contested services are not obviously an *entertainment* or *education* service, and therefore are not covered by such broad terms. Accordingly, in the absence of submissions or evidence from the opponent as to why it is felt that the contested services are identical or similar to their own, I find them to be dissimilar to

all the opponent's services in Class 41. The same conclusion also applies to the opponent's remaining services in Class 35, as well as its goods in Class 9, on the basis that they share no direct similarities with the above contested services.

63. As previously mentioned, the applicant's specification contained in the second application also includes *consultation, advisory and support services relating to all the aforesaid services* in Class 41. In so far as, and to the extent that the above specified services are identical or similar, I find that these *consultation, advisory and support services* are also identical or similar.

64. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the oppositions aimed against those services I have found to be dissimilar will fail.<sup>10</sup> For ease of reference, the oppositions under the 5(2)(b) ground fails against the following services:

Class 41      News reporting services, provision of news and current affairs.

### **The average consumer and the nature of the purchasing act**

65. It is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

66. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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<sup>10</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

“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.”

67. The average consumer for the goods and services at issue is likely both to be members of the general public at large and business users. The goods are, for the most part, likely to be available via retailers in physical stores and their online equivalents. Where a business user is involved, I am of the view that this may include specialist retailers and, again, their online equivalents. Regardless of the nature of the retailer, the selection of the goods will ultimately be the same. In stores, the goods will be displayed on shelves and be self-selected by the consumer after a visual inspection. A similar process will apply when the goods are selected online in that the selection will follow a visual inspection of an image of the goods. I consider that the visual component will dominate the selection process of the goods at issue, but I do not discount an aural component playing a role in circumstances where the consumer seeks advice from sales staff.

68. Turning to the selection process for the services at issue, these are more likely to be available via specialist providers (regardless of who the consumer is) who will offer their services via physical stores and online. In physical stores, the services will be displayed on lists, signs or placards. As for the online process, I am of the view that the services will be provided on a list or menu that is displayed on a webpage. I consider that the selection process will, for the most part, be primarily visual (although not discounting an aural element via advice from sales assistants and/or word of mouth recommendations) but I acknowledge that for some services, such as those selected by business users, they will be selected after having had a discussion with a sales assistant. Even in such a scenario, the consumer will visually inspect the services at issue, meaning that the selection process will be both visual and aural.

69. As for the level of attention paid, I am of the view that for the goods at issue, this will be medium, even when considering the different types of average consumer. The factors that the consumer will consider are likely to vary depending on the nature of the goods sought. For example, the computer software goods are likely to be selected after the consumer has considered the compatibility, ease of use and functionality of the goods.

70. As for the services at issue, the considerations will also vary on the basis that the services cover a wide range of areas such as education, entertainment and publishing. Where the average consumer is a member of the general public selecting educational services, for example, they are likely to consider factors such as the expertise of the staff, the length of the education course, the type of assessment required (be that written test or simply completing various courses, for example) and the qualifications offered upon conclusion. In my view, the level of attention for such services is likely to be medium. While I appreciate that educational services may be important to the user, I make this finding on the basis that these factors will be considered in full but are not, in my view, likely to warrant any detailed considerations.

71. As for the services that will be selected by business users, I am of the view that these too will vary in what factors are considered. For example, a publisher will look to ensure that the materials used are of sufficient quality and whether the provider can meet its demand, whereas a business looking to arrange a trade fair, will want to ensure that the venue and any potential hosts or presenters are all suitable ensuring that the trade fair will run smoothly. For these users, I am of the view that the degree of attention paid will be higher than medium (but not high) on the basis that the selection will be important to the operation of their business.

### **Comparison of the marks**



72. It is clear from *Sabel BV v. Puma AG* 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

them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

74. The trade marks to be compared are as follows:

The applicant's marks		The opponent's mark
The first application	Genius 	Genius
The second application	Genius  AI	

75. With regard to the similarity of the mark, in its statement of grounds, the opponent submits the following:

“Application no. UK00003948594 for the figurative mark "GENIUS I" (the "Applicant's Sign") and Application no. UK00003953428 for the figurative mark "GENIUS AI" (the "Applicant's Sign") are visually, aurally and conceptually highly similar to the word mark "GENIUS" (the "Opponent's Sign") covered by WO0000001680521 (the "Earlier Mark").

[...]

On a global appreciation, there is a likelihood of confusion between the Applications and the Earlier Mark on the part of the relevant public. The high degree of similarity between the marks is such that the relevant public will believe that the marks are connected to or derive from the same economic undertaking.”

76. In its witness statement,<sup>11</sup> the applicant submits the following regarding the similarity of the marks:

“The opposing mark is purely written as a textual word mark of generic origin. With no distinct characteristics or features.

[...]

The applied mark is aurally distinctive, Genius Ai / Genius i sounds clearly different from Genius, a comparison would be iPhone and the generic word phone. Typical user will be able to hear the difference and assign different meaning. And consequently assign different source to the mark. In addition Ai [in the second application] has stronger meaning, namely artificial intelligence which would further add weight.

The applied mark is visually distinctive, with AI and atomic mark. Together the entity is highly stylized. The distinction, aurally, visually and conceptually is very different and unique. The typical users therefore would be able to assign a different source to the mark and avoid confusion or conflict.”

### Overall impression

#### *The opponent's mark - Genius*

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<sup>11</sup> Dated 9 July 2024.

77. The mark is a word only mark and comprises the word 'Genius'. The overall impression resides in this single element.

*The first application - Genius i*

78. The mark consists of the word 'Genius' presented in title case followed by a device element resembling a figurative 'flower'. However, I note from the applicant's submissions that the figurative element is intended to represent a letter 'i' incorporating an atomic symbol. Whilst I acknowledge that a proportion of consumers may recognise the figurative element in this way, I am of the view that it is more likely that consumers will perceive it merely as a decorative element, and therefore will not articulate this element. Whilst the overall impression of the mark lies in the combination of the word and the figurative element, I find that the word 'Genius' plays the greater role due to its size and position in the mark and the fact that the eye is naturally drawn to the element of the mark that can be easily read, with the figurative element playing a slightly lesser role.

*The second application - Genius Ai*

79. The mark consists of the word and letter 'Genius A' presented in title case followed by a figurative element resembling a flower. As previously stated, the applicant submits that the figurative element represents a letter 'i'. In this regard, contrary to my findings in relation to the first application, I am of the view that as the figurative element directly follows the letter 'A', these elements will be considered in combination, and as such, I find it more likely that consumers will perceive it as a figurative letter 'i' rather than as a figurative device. However, I acknowledge that a proportion of consumers may simply perceive it as a figurative device element. Accordingly, I am of the view that when considered as a whole, the mark will be perceived as 'Genius Ai'. Whilst the overall impression of the mark lies in the combination of these elements, I find that it is the word 'Genius' which plays the greater role in the overall impression due to its size and position within the mark, with the letter 'A' and figurative 'i' element playing a slightly lesser role.

## The comparison

*The first application* - Genius  i

### Visual comparison

80. Visually, the marks coincide insofar as they identically share the same first six-letter word 'Genius'. This similarity appears at the beginning of the respective marks, being where consumers tend to focus,<sup>12</sup> as this position is generally considered to have more impact due to consumers in the UK reading from left to right. Accordingly, this is the element that will be read first in the applicant's mark and is the only element of the opponent's mark. The marks are visually different in that the applicant's mark contains the additional figurative element. This difference appears at the end of the mark and renders the marks different in length. I find the competing marks visually similar to a high degree.

### Aural comparison

81. Both marks contain the well-known English dictionary word 'Genius' and will likely be pronounced in the ordinary way. Therefore, the shared word element will be pronounced identically. As previously stated, I am of the view that the figurative element in the application will be perceived as just that and therefore will not be articulated. Accordingly, the respective marks are aurally identical. However, in the event that the figurative element is perceived as a stylised letter 'i' and is articulated ('Genius-i'), I find that the marks are aurally similar to at least a medium degree.

### Conceptual comparison

82. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and

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<sup>12</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

83. In my view, the ordinary English dictionary word ‘Genius’ present in both marks, will be an immediately recognisable word for the average consumer, i.e. *a person with exceptional ability, especially of a highly original kind*.<sup>13</sup> Bearing in mind the nature of the goods and services at issue, the average consumer may perceive the word *genius* as alluding to certain characteristics of those goods and services, for example, that they are exceptional and/or unique, etc. Accordingly, this element in the marks share the same concept.

84. With regards to the figurative element present in the applicant’s mark, as previously stated, I am of the view that this will merely be perceived as a figurative device element. However, in the event that this element is viewed by a non-significant proportion of consumers as a figurative letter ‘i’, then it will likely be perceived and understood as the ninth letter of the English alphabet. In this scenario the average consumer may perceive the letter ‘i’ as alluding to certain characteristics of the goods and services at issue, for example, that they are intelligent or internet capable, etc. However, whether perceived as a figurative letter ‘i’ or as a device, neither will convey any precise or obvious meaning in relation to the goods and services at issue. Accordingly, when the mark is viewed as a whole, whichever way the figurative element is perceived, I find that it will only contribute as a slight point of conceptual difference between the marks. Taking all of this into account, I am of the view that the marks are conceptually similar to a high degree.

*The second application -* **Genius Ai** 

#### Visual comparison

85. As with my previous finding above, visually, the marks coincide insofar as they identically share the same first six-letter word ‘Genius’. This similarity appears at the

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<sup>13</sup> [www.collinsdictionary.com/dictionary/english/genius](http://www.collinsdictionary.com/dictionary/english/genius)

beginning of the respective marks, being where consumers tend to focus. Accordingly, this is the element that will be read first in the applicant's mark and is the only element of the opponent's mark. However, the marks are visually different in that the applicant's mark contains the letter 'A' and a figurative element, which as previously stated, is likely to be perceived as a figurative letter 'i'. These differences appear at the end of the mark, rendering the marks different in length. I find the competing marks visually similar to a high degree.

#### Aural comparison

86. As above, both marks contain the well-known English dictionary word 'Genius' and will likely be pronounced in the ordinary way. The letter 'A' and figurative 'i' element present in the application will likely be given their ordinary English pronunciations and will act as a point of aural difference. Accordingly, consumers are likely to perceive and pronounce the mark as 'Genius A-i'. Whilst I acknowledge that 'AI' is a common abbreviation for 'artificial intelligence', I am of the view that it is unlikely that the 'A-i' element will be articulated in this way. Therefore, I find the respective marks to be aurally similar to a medium degree. In the event that the figurative element is perceived merely as a decorative device element and not as a letter 'i', this element will not be articulated. Accordingly, in this scenario the respective marks are aurally similar to at least a medium degree ('Genius' v. 'Genius-A').

#### Conceptual comparison

87. As previously stated, conceptually the ordinary English dictionary word 'Genius' present in both marks will be attributed the identical meaning. Accordingly, this element in the marks share the same concept.

88. With regards to the letter 'A' and figurative letter 'i' present in the applicant's mark, these will be understood as the first and ninth letters of the English alphabet. However, I am of the view that they will be considered as a whole, namely as 'A-i' and as such, will likely be perceived by the average consumer as an abbreviation for 'artificial intelligence'. Accordingly, bearing in mind the nature of the applicant's goods and services, the average consumer will likely perceive the mark 'Genius Ai' as alluding to

certain characteristics, for example, that the goods and services possess a level of intelligence that is *genius*. As such, the 'A-i' element of the mark will act as a point of conceptual difference between the respective marks, albeit a slight one.

89. However, in the event that a proportion of consumers perceive the figurative 'i' element, merely as a decorative device resembling a flower, for example, this element will not be articulated. In this scenario, the letter 'A' present in the applicant's mark will be understood as the first letter of the English alphabet or as a determiner but neither the letter 'A' or figurative device element will convey any clear meaning or have any obvious connection to the applied goods and services, though will act as points of conceptual difference between the marks, albeit slight ones.

90. In my view, whichever way the figurative element is perceived, the prevailing concept of a reference to *genius* remains the dominant point in the mark, and therefore, the additional elements, whether perceived as 'A-i' or as 'A' plus a decorative device element, do not take away from this shared concept. Accordingly, I find that the marks are conceptually similar to a high degree.

### **Distinctive character of the earlier mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Alternberger* [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).”

92. Registered trade marks possess varying degree of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced through use, and on this point, I note that the opponent did initially plead that its mark had acquired distinctiveness through use. However, as they have omitted to file any evidence of use, I have only the inherent position to consider.

93. The word *Genius*, as previously stated, is a common English dictionary word with a recognisable meaning, and therefore will be readily understood by the average consumer. Whilst not directly descriptive, bearing in mind the nature of the goods and services at issue, I find that the term *genius* may play an allusive role in relation to certain characteristics of the goods and services, for example, that they are exceptional and/or unique, etc. I am reminded that invented words usually have the highest degree of distinctive character, whereas words which are descriptive of the goods and services relied upon normally have the lowest. Accordingly, as I am of the view that the word ‘Genius’ has an allusive nature in relation to the goods and services, overall, I find that the earlier mark has a low to medium degree of inherent distinctive character.

### **Likelihood of confusion**

94. 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. One such factor is the interdependency principle i.e. a lesser degree of

similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful 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.

95. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and services down to the responsible undertakings being the same or related.

96. Earlier in this decision, I found that:

- The parties' goods and services range between identical to similar to a low degree.
- The average consumer for the goods and services is most likely the general public as well as business users, who will pay a medium degree of attention during the purchasing process (although it may be higher in some instances).
- The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.
- The first application is visually and conceptually similar to the earlier mark to a high degree, and aurally identical or aurally similar to at least a medium degree, depending on how the application is perceived.
- The second application is visually and conceptually similar to the earlier mark to a high degree, and aurally similar to at least a medium degree, or aurally similar to a medium degree, depending on how the application is perceived.

- The earlier mark is inherently distinctive to between a low to medium degree. On this point, it is acknowledged that a weaker degree of distinctive character in an earlier mark does not preclude a finding of confusion.<sup>14</sup>

97. The fact that the word 'Genius' is identically present in the competing marks and that the purchasing process for the goods and services at issue is predominantly visual, is an important point of coincidence. Further, the word 'Genius' in the marks is visually, aurally and conceptually identical and is independently distinctive of the letter 'A' and figurative letter 'i' element in the applications. Moreover, the marks identically share the same beginnings resulting in the earlier mark being fully encompassed in the applications, where the only difference between the marks is the letter 'A' and/or a figurative element (whether perceived as a decorative device or as a figurative letter 'i'), at the end of the applications. On this basis, I keep in mind that the beginnings of marks tend to make more of an impact than the ends.

98. As previously stated, with regards to the figurative element present in the first application, the applicant submits that this element is intended to represent a letter 'i' incorporating an atomic symbol. Whilst I acknowledge that a proportion of consumers may recognise the figurative element in this way, I am of the view that it is more likely that consumers will perceive it merely as a decorative element, and therefore will not articulate it. However, in the event that the figurative element is perceived as a letter 'i' in the first application, then this may be understood as alluding to certain characteristics of the goods and services at issue, for example, that they are intelligent or internet capable, etc. Nonetheless, whichever way the figurative element is perceived, I find that the word 'Genius' will play the greater role in the overall impression, with the figurative element playing a slightly lesser role.

99. As for the second application, contrary to my findings with regards to the first application, I am of the view that as the figurative element directly follows the letter 'A', these elements will be considered in combination, and therefore, consumers are more likely to perceive the figurative element as the applicant suggests, that is, as a

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<sup>14</sup> See *L'Oréal SA v OHIM*, Case C-235/05 P

figurative letter 'i', rather than as a figurative/decorative device element. Whilst I acknowledge that a proportion of consumers may perceive it as a figurative device element, when considered as a whole, I find it more likely that it will be perceived as 'Genius Ai', rather than as 'Genius A' plus a figurative device. As such, bearing in mind the nature of the applicant's goods and services, the average consumer will likely perceive 'Ai' as an abbreviation for 'artificial intelligence' and therefore, when perceived as a whole, the mark 'Genius Ai' will likely be perceived as alluding to certain characteristics of the goods and services, namely that they possess a level of intelligence that is *genius*, for example. Nonetheless, whether perceived as 'Ai' or as 'A' plus a decorative device element, I am of the view that the word 'Genius' remains the dominant point in the mark.

100. Accordingly, given the stated similarities between the marks, I am of the view that the average consumer is likely to remember the marks as 'Genius' marks, with the additional figurative element in the first application, and the letters 'Ai' in the second application going unnoticed, being overlooked, or forgotten. Even in the case that 'Ai' gives the second mark a unitary meaning referring to a *Genius level of AI*, it does not take away from consumers misremembering 'Ai' and focusing their recollection on 'Genius'. On this point, I remind myself that consumers are rarely able to compare marks side by side and, as such, are likely to forget which marks had the letter 'A' and/or figurative letter 'i' or device element, and which ones did not. Instead, the average consumer will simply seek to remember the marks by recalling the shared dominant and distinctive verbal element, being 'Genius'.

101. Therefore, given the level of similarity across the marks at issue and the similarity or identity between the goods and services, I am of the view that the average consumer is unlikely to recall the differences between the marks resulting in a likelihood of direct confusion. This is so even bearing in mind the earlier mark's low to medium level of inherent distinctive character. In reaching this conclusion I note that a degree of caution is required before finding a likelihood of confusion on the basis of common elements which are either descriptive or are low in distinctive character,<sup>15</sup> nevertheless, I maintain that there is a likelihood of direct confusion.

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<sup>15</sup> *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch) and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

102. For the avoidance of doubt, I will proceed to consider indirect confusion. In doing so, I remind myself of the comments of Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>16</sup>

“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.).

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<sup>16</sup> BL O/375/10.

(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).”

103. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>17</sup>

104. In my view, in the circumstances where consumers do notice the difference between the marks, they will perceive the addition (or removal) of the additional elements, merely as brand variants or sub-brands of the ‘Genius’ mark. To my mind, consumers will not see ‘Genius’ used on different marks in relation to similar or identical goods and services and put it down to mere coincidence. Rather, they are far more likely to assume a connection between the two undertakings and will simply consider that the additional elements in the applications are alternative marks being used by the same or economically linked undertakings. Even where the additional ‘A-i’ elements in the second application are seen as a clear reference to ‘Artificial Intelligence’, despite a potential unitary meaning in the mark as a whole (‘Genius Ai’), I am of the view that consumers will merely believe that the marks at issue are connected to the same undertaking by virtue of the common use of ‘Genius’. The addition of ‘Ai’ will likely lead consumers to believe that the *Genius* brand has launched a range of goods and services that rely on artificial intelligence (AI). Therefore, I find that there is a likelihood of indirect confusion.

## **OUTCOME**

105. The oppositions filed against the applications have achieved partial success based on section 5(2)(b) of the Act. The services for which the oppositions have failed are set out below:

Class 41      News reporting services, provision of news and current affairs.

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<sup>17</sup> See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82].

## **COSTS**

106. In these consolidated proceedings, the opponent has achieved a greater measure of success and is entitled to a contribution towards its costs, in line with the scale set out in Tribunal Practice Notice (TPN) 1/2023. In the circumstances, I award the opponent the sum of £800 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fees (Form TM7 - £100 x 2)	£200
Preparing notices of opposition and considering the applicant's counterstatements	£400
Preparing written submissions and considering the applicant's witness statement	£200
<b>Total:</b>	<b>£800</b>

107. I therefore order DR N ALI LTD to pay KID-Systeme GmbH the sum of £800. The above 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 conclusion of the appeal proceedings.

**Dated this 25<sup>th</sup> day of June 2025**

**Sam Congreve**  
**For the Registrar**

## Annex 1

### UK application no. 3948594 (“the first application”)

Class 9 Recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; downloadable electronic publications; Online downloadable information, publications, e books, courses on entertainment, education, and on health, lifestyle, physical health, mental health, diet, cooking and lifestyle, product advice, motivation, psychology, personal interests, and general culture; mobile phone, mobile phone accessories, and smart watches.

Class 35 Advertising and marketing; advertising services; online advertising and marketing services; business data analysis; promotional services; business networking; online service for connecting social network users with businesses; business monitoring and consulting services, namely, tracking users and advertising of others to provide strategy, insight, marketing guidance, and for analysing, understanding and predicting consumer behaviour and motivations, and market trends; presentation of goods on communication media, for retail purposes; price comparison services; commercial information and advice for consumers [consumer advice shop]; providing consumer product information; providing comparison shopping information; sales promotion for others; compilation of information into computer databases; systemization of information into computer databases; data search in computer files for others; dissemination of advertising for others via an on-line electronic communications network; business data analysis; providing statistical business information Advertising, including on-line advertising on a computer network; Advertising services provided via the internet; Advertising and marketing consultancy; Advertising and marketing; Advertising, marketing and promotional services; Business marketing consultancy; Brand evaluation services; Brand positioning; Brand creation services (advertising and promotion); Brand strategy services; Business management consultation; Targeted marketing; Product marketing; Services of advertising agencies; consultation, advisory and support services relating to all the aforesaid services.

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

**UK application no. 3953428 (“the second application”)**

Class 9 Recorded media, computer hardware and firmware; computer software; AI software; Artificial intelligence and machine learning software; Machine learning software; software downloadable from the Internet; downloadable electronic publications; Online downloadable information, publications, e books, courses on entertainment, education, and on health, lifestyle, physical health, mental health, diet, cooking and lifestyle, product advice, motivation, psychology, personal interests, and general culture; mobile phone, mobile phone accessories and smart watches.

Class 35 Advertising and marketing; advertising services; online advertising and marketing services; Advertising, including on-line advertising on a computer network; Advertising services provided via the internet; Advertising and marketing consultancy; Advertising and marketing; Advertising, marketing and promotional services; Business

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

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

aforesaid provided online from a computer database on the Internet; consultation, advisory and support services relating to all the aforesaid services.

## Annex 2

### Earlier mark: International registration ("IR") no. 1680521

Class 9 Scientific, navigation, surveying, photographic, film, optical, weighing, measuring, signalling, control, rescue and teaching equipment; apparatus and instruments for controlling, switching, converting, storing, regulating and controlling electricity; apparatus for recording, transmitting and reproducing sound and image; magnetic recording media, recording discs; cds, dvds and other digital recording media; mechanisms for money-operated apparatus; cash registers, calculators, data processing hardware, computers; computer software; fire extinguishers; recorded data; databases; media, recorded; software; application software; communication and network software and social networking software; software for data and file management and for databases; media and publishing software; office and enterprise application software; artificial intelligence software and machine learning software; software for monitoring, analysing, controlling and executing operations in the physical world; system and system support software and firmware; firmware and device drivers; operating systems; utility, security and cryptography software; software for virtual and augmented reality; web applications and server software; content management software; e-commerce and electronic payment software; information technology, audio- visual, multimedia and photographic equipment; communication equipment; computer network and data communication equipment; point-to-point communication equipment; radios and broadcasting equipment; aerials and antenna systems as communication apparatus; data storage devices and media; replication devices; photocopiers; image scanners; printers; data processing equipment and accessories [electrical and mechanical]; peripherals adapted to computers and other intelligent devices; computers and computer hardware; computer components and parts; audio, visual and photographic equipment; audio equipment and radio receivers; indicators of the Common Regulations; television receivers and film and video equipment; image acquisition and development equipment; it, audio and telecommunications signal lines; magnetisation and demagnetisation devices; scientific and laboratory equipment for physical reactions through electricity; electrical appliances, instruments and cables; appliances and instruments for accumulating and storing electricity; apparatus and instruments for regulating electricity; photovoltaic installations for the production of

electricity; electrical and electronic components; cables and wires; electrical circuits and circuit boards; antennas and antenna systems as components; optical devices, enhancers and correctors; optical enhancers; lasers; safety, security, protection and signalling devices and equipment; alarm and access control devices; signalling apparatus; protective and safety equipment; navigation, orientation, monitoring and recording equipment; testing and quality control equipment; measuring instruments and apparatus; time measuring instruments and apparatus [excluding clocks]; weight-measuring instruments and apparatus; distance and dimension measuring instruments and apparatus; speed measuring instruments and apparatus; temperature measuring instruments and apparatus; electrical current measuring instruments and apparatus; control and regulating devices; data loggers and data recorders; sensors, detectors and monitoring tools and equipment; apparatus for scientific research and laboratories, educational apparatus and simulators; 360° cameras; 360° video cameras; 3d animation software; 3d computer graphics software; 3d television receivers; navigation software; navigation tools; electronic navigation devices; portable navigation devices; electric navigation apparatus; electrical navigational instruments; navigation equipment and instruments; vehicle navigation equipment [on-board computers]; software for gps navigation systems; multimedia navigation systems for vehicles; electronic navigation and positioning apparatus and instruments; navigation devices for interactive displays in vehicles; interactive computer software to provide navigation and travel data; computer programs for use in the autonomous navigation of vehicles; electronic location tracking equipment and instruments; computer hardware to track driving and flight behaviour; computer software to track driving and flight behaviour; surveying software; photographic surveying instruments; magnetic compasses for surveying; base plates for surveying purposes; theodolites for surveying purposes; database servers; database engines; electronic databases; interactive databases; database server software; interactive database software; computer software for database administration; computer software programs for database management; database synchronisation software; machine-readable computer programs for data management; computer software for the application of database integration; computer software allowing access to databases; computer software for creating searchable databases containing information and data; computer programs for accessing, browsing and researching in online databases; sensory software; testing equipment for use in aeroplanes; software platforms enabling users

to collect money; software for computer- aided technical engineering [cae]; seat controls; active matrix displays; sensors; electrical sensors; ultrasonic sensors; photoelectric sensors; fibre optic sensors; sensors for depth measurement; sensors for touchscreens; control units for sensors; sensors for measuring instruments; sensors to monitor physical movements and to determine positions; sensors, detectors and monitoring instruments and apparatus; sensors to detect the opening and closing of windows and doors; cameras; digital cameras and surveillance cameras; electrical monitoring equipment; surveillance equipment and instruments; none of the aforementioned goods for use in the field of medical imaging, breast health or cytology.

Class 35 Business management; organisational advice on the development of data processing organisation; management consulting services, in particular the development of organisational structures for the collection and processing of data relating to business-related technical and business operations; providing business information and corporate communications via computer networks and global communications networks; management and management consulting offered via global communications networks; database management; computerised database management; administration of databases; trade fair and commercial exhibition services; services related to loyalty, incentive and bonus programs; distribution of promotional, marketing and sales boosting materials; advising and assistance services in the field of advertising, marketing and sales promotion; making available and hiring advertising space, advertising times and advertising media; commercial and consumer information services, namely commercial valuation services, price comparison services, procurement services for third parties; assistance in business matters, management and administrative services; bookkeeping, accounting and auditing; administrative assistance and data processing services; administrative data processing, systematisation and management; human resources management and recruitment; management consulting; business analysis and information services and market research; rental of office machinery and equipment; database marketing; advertising for databases; advertising through databases; management of a database [office work]; compilation and systematisation of information and databases; compiling and systematising data in databases; compiling and entering information in databases; computerised updating and maintenance of data in databases; updating and maintaining data in computer databases; collection, updating and maintenance of data

in databases [office work]; collection, processing and output of data in databases [office work]; provision of subscriptions to database services related to telecommunications; providing information on commercial and business matters from online databases; providing information referring to the updating and maintenance of data in databases.

Class 41 Publishing services and reporting and drafting of texts; education, training, entertainment and sports activities; organisation and arrangement of conferences, exhibitions and competitions; education and training; audio, video, multimedia productions and photography; sports and fitness services; education, training and teaching; rental services related to equipment and facilities for education, entertainment, sport and culture; training services provided via simulators; rental of visual, audio-visual and photographic installations and equipment; live performances; translation and interpretation services; educational and entertainment events and the organisation of sporting events and activities; training in the use of optical sensors; none of the aforementioned services related to appliances for cooking, heating, cooling and preserving food and beverages and none of the aforementioned services for or in connection with the operation of day care centres, kindergartens, nurseries, crèches or schools; all above-mentioned training and instructional services exclusively with respect to accessories, components or other parts for airplanes and other aircraft or spacecraft.