O/0758/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003875063
BY STITCH HEALTH LIMITED
TO REGISTER:

TRIALVIEW

Trialview

(SERIES OF TWO)

AS TRADE MARKS IN CLASSES 9, 35, 41 & 42

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 440856 BY
TRIALVIEW LIMITED

BACKGROUND AND PLEADINGS

1. On 6 February 2023, Stitch Health Limited ("the applicant") applied to register the series of trade marks shown on the cover page of this decision in the UK ("the application"). The application was published for opposition purposes on 17 February 2023 and registration is sought for the goods and services set out in the Annex of this decision.[1]

2. On 16 May 2023, the application was opposed by TrialView Limited ("the opponent"). The opposition is based upon sections 5(2)(a) and 5(3) of the Trade Marks Act 1994 ("the Act").

3. Both grounds are reliant upon the following mark:

TrialView
UK registration no. 914356125[2]
Filing date 13 July 2015; registration date 22 March 2016
Relying on all services, namely:

Class 38: Providing access to documents online or via the internet in dispute resolution forums.

Class 42: Design and development of computer software solution to facilitate the access of documents used in dispute resolution forums.

("the opponent's mark").

[1] It is noted that the specification for which protection is sought was amended via a Form TM21B dated 14 July 2023.
[2] The opponent's mark is a comparable mark based on earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMS. These comparable marks enjoy the same filing and registration dates as their EU counterparts.

4. Under its section 5(2)(a) ground, the opponent claims that the marks at issue are identical and that the parties' goods and services are either the same, or complementary to each other. As such, the opponent claims that there is a clear risk of confusion in the marketplace, including a risk of association.

5. Under the section 5(3) ground, the opponent claims that its mark has acquired a substantial reputation through use of its mark in the UK and Europe. It is claimed that this reputation, in combination with the identical marks and the similar goods and services, means that there can be no doubt that use of the application would take unfair advantage of and be detrimental to the distinctive character and repute of the opponent's mark.

6. The applicant filed a counterstatement wherein it denied the claims against it and requested that the opponent provide proof of use of its mark.

7. The applicant is represented by Howard Kennedy LLP, who have represented the applicant in these proceedings since 9 January 2025. The opponent is represented by Dehns, who have represented the opponent in these proceedings since 12 April 2024. Both parties filed evidence in chief with the opponent also electing to file evidence in reply. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

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

EVIDENCE

9. The opponent's evidence in chief came in the form of three witness statements, being that of Stephen Dowling dated 12 April 2024, Luke Harrison dated 9 April 2024 and Robert Worthington dated 11 April 2024. I will deal with these statements in turn.

10. Mr Dowling is the founder and director of the opponent, the latter being a position he has held since September 2014. His statement is accompanied by 19 exhibits, being SD1 to SD19, and was adduced in order to demonstrate genuine use of the opponent's mark and to prove that the opponent's mark enjoys a reputation in the relevant territory.

11. Mr Harrison is a solicitor and founding partner of Keldan Harrison and a co-chair of London International Disputes Week, an organisation he has been involved in since 2020. The purpose of Mr Harrison's statement was to support the claim that the opponent's mark is well-known in the disputes industry.

12. Mr Worthington is a Committee Member on the Commercial Litigators Forum. His statement was adduced to prove similar points to that of Mr Harrison's statement in that the opponent is a well-recognised provider of technology services to the legal disputes industry in the UK.

13. The applicant's evidence came in the form of the witness statement of Mr Michael Sterling dated 11 June 2024. Mr Sterling is the co-founder and Chief Operating Officer of the applicant. His evidence is accompanied by one exhibit, being MS1, and was adduced in order to demonstrate the different industries that the parties operate in as well as their differing consumer bases.

14. As above, the opponent also filed evidence in reply and this came in the form of the second witness statement of Mr Dowling, which is dated 12 August 2024. Mr

Dowling's second witness statement is accompanied by two further exhibits, being those labelled SD1 and SD2. For the purpose of this decision and given the identical way in which Mr Dowling has identified his exhibits across his two statements, I will, if necessary, refer to the exhibits in his second witness statement as 2SD1 and 2SD2. Mr Dowling's second statement was adduced in order to counter the evidence of Mr Sterling.

15. I do not intend to summarise the evidence in full (or the submissions of the opponent, for that matter). However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

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

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> (aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

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

[…]

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

17. Section 6A is also relevant. It reads:

"(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

18. Section 100 of the Act is also relevant. It reads:

> “100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

19. As the opponent’s mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

> “7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
>
> (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
>
> (3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
>
> (b) the references in section 6A to the United Kingdom include the European Union”.

20. Given its filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. The opponent's mark completed its registration process over five years prior to the filing date of the application. As set out above, the applicant requested that the opponent provide proof of use in respect of its mark. As a result, the opponent's mark is subject to the proof of use assessment.

21. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

22. In accordance with section 6A of the Act (cited above), the relevant period for the present assessment is the five-year period prior to the filing date of the application, being 6 February 2023. The relevant period is, therefore, 7 February 2018 to 6 February 2023 ("the relevant period"). As set out above, use in the EU is relevant prior to IP Completion Day, being 31 December 2020.

23. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[3] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

Evidence of use

24. The opponent's evidence sets out that it was established on 9 September 2014 and that its mark is used for a cloud/web-based platform that facilitates remote legal hearings and the presentation of documents at trial. It is set out that this is a live platform that is used by legal professionals, courts, tribunals and others involved in these cases. The opponent confirms that its platform is accessed through the internet via browsers such as Google Chrome, Safari and Microsoft Edge.

25. The opponent claims that its mark has been used in the EU (including the UK) since its registration in March 2015 and that said use in the UK continued after IP Completion Day.

26. The opponent's UK website, being that under 'trialview.co.uk', is confirmed as being set up in February 2014. This is confirmed via a 'whois' printout.[4] While noted, the simple registration of a website is not the same as evidence of the website actually being used. On this point, I note that there is nothing in the evidence to demonstrate the actual launch of this website to consumers and, further, I note that the evidence confirms that the opponent's focus in the early years was on Ireland.[5]

[3] *Jumpman* BL O/222/16
[4] SD2
[5] In respect of this point, I note that screenshots of the opponent's website are provided in evidence at SD4. However, these printouts are taken from 'trialview.com' and not 'co.uk'.

27. In 2019, the opponent confirms that it presented its product and mark to a number of law firms. It sets out that it conducted demonstrations for those firms, which included Harneys, Northridge and CYK. Correspondence from these firms is provided in evidence.[6] While this correspondence indicates that these firms would have an interest in the opponent's product, there is no confirmation as to whether they eventually became customers.

28. The opponent then sets out that significant use of the opponent's mark began in the UK in 2020 as a result of the COVID-19 pandemic. This uplift in use led to the opponent giving more focus to the UK market. In April of 2020, the opponent confirms that it undertook a marketing campaign wherein it sought to promote its remote hearing services to law firms in the UK. In respect of this campaign, the opponent has provided evidence of the advertisements it has placed on the social media platform, LinkedIn.[7] While the posts themselves are undated, the opponent confirms that the adverts were part of paid promotional campaigns in November 2020, in 2021, July 2022, October 2022 and February 2023. Further some adverts provided are confirmed to have run between 2020 and 2023, generally. It is confirmed that these adverts targeted the UK.

29. The opponent has provided a breakdown of its advertising expenditure in both the EU prior to IP Completion Day and the UK between 2021 and 6 February 2023. The breakdown is as follows:

Year	**EU (including the UK) Expenditure (£)**	**UK Expenditure (£)**
2020	9,908	-
2021	-	50,000
2022	-	50,000
2023 (up to 6 February)	-	2,500

[6] SD3
[7] SD5

30. Including the EU expenditure, the total marketing spend between 2020 and 6 February 2023 stood at £112,408. In support of this evidence I note that the opponent has provided evidence confirming its various advertising transactions.[8] Having considered these, I note that the total spend for 2021 was €36,093.32 and the total 2022 spend was €64,121.94. Together, these figures total €100,215.26.[9] It is not clear why there is a discrepancy between the table above and the transaction evidence but this is a point I will bear in mind going forward.

31. On the point of advertising, the opponent seems to suggest that the salary of its UK marketing director constitutes a marketing spend.[10] While I appreciate that this employee focuses on marketing, her salary is not a marketing spend and I will not consider it as such. I say this particularly given that the marketing spend I have discussed above already indicates that the opponent has made attempts to promote its brand so I do not see what the marketing director's salary contributes to this.

32. Staying with the topic of promotion/advertising, I note that the opponent has provided a range of invoices that demonstrate that it has sponsored a number of events or publications.[11] These included the sponsorship of an Arbitration Launch Event in October 2022 as well as the sponsorship of the Legal 500 Power List between September 2022 and September 2023. In 2022, it also provided the Annual Law Forum, a wine sponsorship. Lastly, in January 2023, the opponent sponsored the London Irish Lawyers Association.

33. The opponent's evidence then turns to its userbase between 2020 and 6 February 2023. The opponent confirms that in 2020, its had 850 active users in the UK and the EU. In 2021, it had 275 UK users, 500 in 2022 and, between 1 January and 6

[8] SD6
[9] By using an exchange rate that was accurate as of 31 July 2025, this equates to approximately £86,000.
[10] SD7
[11] SD11

February 2023, it had 750 UK users. I note that EU users for 2021 to 2023 are provided but this evidence falls after IP Completion Day so is not relevant here. In respect of this evidence, these figures are not to be taken cumulatively but each one reflects a total user base as at that time. It is noted that the opponent confirms that the above user base of 750 covers users across 25 different UK law firms such as Clyde & Co, Allen & Overy, Fieldfisher and Taylor Wessing. Further, the opponent's platform hosted over 100,000 documents.

34. The opponent confirms that its product was used regularly in the UK Commercial Courts, including the Technology and Construction Court and Chancery Division. In respect of this point, I note that evidence is provided showing a judgment of the Commercial Court in London wherein the TrialView platform was used.[12] The opponent's platform is referenced at paragraph 11 of the judgement of Bird J.

35. In respect of awards won, the opponent confirms that in 2022, it won the 'Best Technology Product' award at the 'Lawyer Awards' in London. It is confirmed that these awards are attended by leading law firms from across the UK, which includes over 250 partners and managing partners. The opponent also confirms that the awards are chosen by a judging panel that consists of members of the Bar, private practice and in-house sectors. Coverage of the award is provided in evidence[13] and it is noted that in early 2023, the opponent's product was shortlisted for this same award.

36. The evidence moves to discuss turnover that the opponent has accrued in providing its 'TrialView' services. This is set out in terms of overall figures but a breakdown is provided to demonstrate how much of the total revenue relates to use in the UK. This evidence is as follows:

[12] See SD8, though I note that additional confirmation of various court use is provided via SD9 which covers the opponent's own website, news articles and a judgement of the High Court in Ireland dated 8 February 2021 (being after IP Completion Day).
[13] SD15

Year	Revenue (€)	Percentage relating to UK
2023 (1 January to 6 February)	45,058	40%
2022	865,427.35	30%
2021	1,232,320.94	20%
2020	166,046.26	10%

37. The above figures equate to a total revenue of €2,308,853.55. How this relates to the UK can be approximately calculated based on the percentage figures given. By my calculation, the above evidence demonstrates a UK turnover of €540,720.22. In respect of the overall figures, and in light of the fact that the opponent only appears to operate in the EU, I am of the view that the entirety of the 2020 figure can be included in support of the present assessment given that it falls prior to IP Completion Day. As a result, the total revenue that is relevant here stands at €690,161.86. A range of sample invoices are provided in evidence in support of the above revenue figures.[14]

38. Lastly in respect of genuine use, I note that the opponent confirms that there are presently only two other key competitors in the market and that despite the opponent being a relative newcomer, it holds between a 3 and 5% share of the relevant market. It is confirmed that there are only two other key competitors in this market, indicating that these other companies' market share likely dwarfs the numbers provided by the opponent.

Assessment of evidence

39. In assessing the evidence before me, I remind myself that the case law in respect of genuine use sets out that use need not be quantitative in order for it to be deemed genuine. Instead, genuine use requires a finding that the proprietor of a mark has sought to create or preserve a market share for the relevant goods and

[14] SD16

services provided. In the present case, I appreciate that the use before me is not extensive. However, I consider that it is at a sufficient level so as to cross the threshold of genuine use to the point that it can be considered a genuine attempt by the opponent to create and preserve a market share in the relevant territory (be that the EU at large prior to IP Completion Day or the UK thereafter) for the services it offers under the TrialView brand.

40. The above being said, I do not consider that my finding of genuine use extends to all of the services relied upon by the opponent. Therefore, I consider it necessary to conduct a fair specification assessment based on what is actually shown in the evidence.

Fair specification

41. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

42. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation (though the approach applies equally to fair specification assessments under genuine use). This approach is as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

43. I remind myself that the opponent seeks to rely on the following services:

Class 38:	Providing access to documents online or via the internet in dispute resolution forums.
Class 42:	Design and development of computer software solution to facilitate the access of documents used in dispute resolution forums.

44. In considering the specification relied upon, I consider it necessary to firstly deal with the class 42 services. While I accept that the opponent may very well have designed and developed its own software solution,[15] there is nothing before me that suggests it actually offers these services to customers. Therefore, I am unable to find that the opponent has genuinely used its mark for the class 42 services that it seeks to rely upon.

45. Moving on to the class 38 services, I am of the view that it is this service that appears to be the primary function of the opponent's TrialView product. I consider it necessary to discuss this service in more detail here as, in its written submissions, the opponent argues that it the wording 'dispute resolution forums' within this term does not render the service as one that falls entirely within 'legal services'. This appears to have been raised in light of the limitation at the end of each class of goods/services in the applicant's specification (being to expressly exclude its goods and services from covering those used in legal services). Contrary to the opponent's position, it is my primary view that, upon the plain reading of the term as a whole, the wording of 'dispute resolution forum' is such that it renders the opponent's service as one relating to the legal sector. Whilst I appreciate that personal disputes do arise and people will look to resolve these

[15] Though I appreciate that there is no actual evidence of this.

outside of the legal sector, I am not convinced that those individuals will seek the provision of documents in a dispute resolution forum. As such, the opponent's service is one that will be sought in order to resolve a legal dispute.

46. While the above may be my primary view on this matter, I am of the view that the legal nature of the opponent's evidence and the way in which the opponent has argued its position renders it necessary to cover this point by way of introducing a further limitation to the opponent's term so as to limit it specifically to cover legal disputes. To do so will not only provide clarity to the term so that it is not open to strained interpretations but this is precisely how the opponent has used its mark. On this point, I note that at paragraphs 3 and 16 of Mr Dowling's first statement, he confirms that:

> "3. […] The TrialView mark (detailed below) is used for a cloud-/web-based platform that facilitates remote trials (legal hearings) and the presentation of documents at trial. It is a "live" platform that is used by legal professionals, courts, tribunals, and others involved in these cases.
>
> […]
>
> 16. The TrialView platform is used for a range of disputes cross multiple areas of law, including for example clinical negligence, commercial litigation, intellectual property litigation, regulatory (clinical, pharmaceutical and nursing), employment and many other matters."

47. Further, the evidence before me is specifically geared towards use in the legal sector. I say this because the opponent's evidence shows that its user base stems from users within 25 different UK based law firms and, further, is shown as being used in court or tribunal cases. Further, Mr Dowling's evidence in chief introduces evidence that shows that the opponent has actively sought to provide sponsorships in the legal sector only and the awards that the opponent has been awarded

specifically cover the legal sector. In addition, the supporting evidence of Mr Worthington and Mr Harrison is such that it shows that the opponent is well-recognised in the legal disputes industry in the UK.

48. Taking all of the evidence into account, I appreciate that the opponent's services may not necessarily always be used by legal professionals (as is confirmed at paragraph 4 of Mr Dowling's second witness statement which sets out that over 75% of users from over 400 disciplinary hearings were unrepresented). However, the evidence all points towards the opponent having used its mark in the context of legal disputes and while I appreciate that legal professionals may not always be the user of such services, the context of the use is important as even a medical professional representing themselves in a legal hearing will still understand that it relates to a legal dispute or is something that has legal ramifications. On this point, I remind myself that there is reference to 'regulatory' and 'employment' hearings. As far as far as I am aware, regulatory hearings are held to ensure compliance with laws and regulations whereas employment hearings are held to examine employee/employer conduct or the enforceability of employment contracts. Both of these are, in my view, legal in nature. Taking this into account together with what was said at paragraph 3 of Mr Dowling's first statement (reproduced above), I see no reason to conclude that these types of hearings are not of a legal nature.

49. As a result of everything I have said above, I am content to conclude that consumers of the opponent's service will be aware of the legal nature of the same and would seek to categorise the opponent's service in this manner. Therefore, my finding is that the opposition may proceed in reliance upon the following service only:

Class 38: Providing access to documents online or via the internet in legal dispute resolution forums.

50. For the avoidance of doubt, in reaching this conclusion I have borne in mind the case of *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) wherein the late Carr J, at paragraph 47, pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. In the present case, I consider that this is how the consumer would categorise the term and the above term reflects a fair sub-category of services that specifically relates to the use made of the mark by the opponent. Further, I am of the view that to grant protection for 'dispute resolution' as a whole would offer too broad a scope of protection to the opponent and, especially in light of the way in which the opponent has argued its position in respect of this category of service, result in the possibility of an imprecise interpretation of the same.

Section 5(2)(a): legislation and case law

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

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

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

[…]

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

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

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

53. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*. Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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;

[…]

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

(h) 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;

(i) 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.

Identity of the marks

54. It is a pre-requisite of section 5(2)(a) of the Act that the marks at issue be identical. In note that at paragraph 8(c) of its counterstatement, the applicant sets out that "the identity of the signs is offset by the differences in the goods and services". From this, it can be taken that the applicant concedes that the marks are identical. I agree that the marks are identical and the section 5(2)(a) ground may, therefore, proceed.

Comparison of goods and services

55. The applicant's goods and services are listed in the Annex of this decision whereas the opponent, further to my proof of use assessment above, may only rely on its class 38 service, being "providing access to documents online or via the internet in legal dispute resolution forums."

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

> "Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

58. In filing their documents in these proceedings, the parties gave significant focus to the goods and services comparison. I can confirm that I have given these documents due consideration and while I do not intend to discuss them in full here, there are a number of points that I wish to discuss further. Before moving to these points, I consider it necessary to briefly summarise the position of the parties.

59. The applicant's position is that the goods and services are outright dissimilar. It has filed evidence wherein it sought to highlight differences in the sectors within which the parties operate and providing further explanation surrounding the decision to add the limitation of 'none of the aforesaid in relation to legal services' across the

different classes of its specification. If the applicant is correct and the goods and services at issue are dissimilar, the present ground will fail in its entirety as, in order for there to be a likelihood of confusion under section 5(2)(a) of the Act, a level of similarity between the goods and services is required.[16]

60. As for the opponent, its evidence makes reference to a claimed overlap in users between the goods and services at issue and, further, it has made extensive comment to combat the position of the applicant in its written submissions. In short, the opponent argues that all of the goods and services at issue are the same or similar. That being said, these submissions include reference to the opponent's class 42 services, which are no longer at issue here.

61. As mentioned above, there are points raised that I wish to discuss in greater detail. The first of which relates to the opponent's evidence wherein it sought to demonstrate that there is an overlap in user between these goods. On this point, I note that the opponent's evidence (at paragraph 28 of Mr Dowling's first witness statement) confirms that its platform is used extensively for medical related hearings including hearings involving the regulation of doctors, nurses and pharmacists and other care professionals. Further, the evidence sets out (at paragraph 4 of Mr Dowling's second witness statement) that over 75% of over 400 disciplinary hearings relating to the medical profession were attended by professionals who were not legally represented. I do not doubt that this is the case. That being said, I am not convinced that this is of any meaningful assistance here. I say this because the majority of the goods and services of the applicant are not those that are actually targeted at medical practitioners. For example, a doctor or nurse would not, in their professional capacity, seek software (in class 9), advertising services (in class 35) or the design and development of computer software (in class 42). I appreciate that this argument carries some weight not only in respect of services that may be provided to medical practitioners (such as

[16] See paragraph 49 of *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

training services in class 41 or clinical trials in class 42, for example) but, generally speaking, it is not uncommon for anyone engaged in legal proceedings (regardless of their profession and their engagement of legal representatives) to seek a range of software goods in class 9, for example. This is something I will factor into my comparisons below.

62. The second point I wish to address is the fact that the opponent has made submissions in respect of the limitation of the applicant, being 'none of the aforesaid in relation to legal services', which sits across the entirety of the applicant's specification. The opponent claims that this fails to remove the overlap with 'dispute resolution forums' in the opponent's term. This is on the basis that dispute resolution forums are places where disputes are examined and hopefully resolved, with or without the involvement of legal representation. While this is noted, I have discussed this argument when considering a fair specification of the opponent's mark above. The resulting term for which use was granted has negated this issue as the opponent's use specifically related to legal disputes and its specification has been limited accordingly. That being said, I appreciate that there may still remain some overlap in user between the parties' goods and services and, as was the case above, I will discuss this where necessary in my comparison below.

Class 9

Application software; computer application software; computer software; downloadable computer application software; downloadable publications; downloadable software; software; database management software; downloadable computer application software for data analytics; downloadable data analytics software; downloadable electronic reports; none of the aforesaid in relation to legal services.

63. In considering the relevant factors set out in *Treat* (cited above), it is clear that the nature and purpose of the above goods differ when compared to the opponent's "providing access to documents online or via the internet in legal dispute resolution forums", especially when the above goods cannot be used in relation to legal services. That being said, the opponent's services cover those that will be accessed on a computer and may, therefore, be accessed via a type of software meaning that there may be some overlap in method of use, even in light of the limitation of the applicant. As for user, I am of the view that there inevitably exists some overlap on the basis that users of the above goods may still be involved in legal disputes. However, this overlap will be somewhat fleeting due to (1) the broad user base for the applicant's goods and (2) the different context in which the opponent's service will be used. As for trade channels, I have nothing to suggest that it is common in the trade for undertakings that offer the opponent's services to also offer a range of software that fall outside the legal services sector. That being said, I appreciate that large software companies may offer a wide variety of different platforms that cover a myriad of topics, one of which may include the provision of documents for court hearings. However, it is my view that this is insufficient to give rise to any meaningful overlap. Lastly, I do not consider that these goods and services are complementary to one another and neither do they share a competitive relationship.

64. In considering the present comparison, I am reminded of the case of *Unicorn Studio Inc v Veronese* [2024] EWHC 1098 (Ch) wherein Mr Iain Purvis K.C., sitting as deputy High Court judge, set out at paragraph 24 of his judgement that:

> "[A]ny finding of similarity in the end requires the exercise of common sense and requires the hearing officer to stand back and consider the overall question. It strikes me that here the hearing officer was engaging essentially in a box-ticking exercise, asking how many of the factors identified in *TREAT* or in *Canon* could be said to have been satisfied. Had the hearing officer stood back and considered the overall question of similarity, I believe she would have

considered and certainly ought to have considered that the idea that figurines and works of art were similar to electric lamps, chandeliers or mirrors was nonsensical and it hardly needed a careful consideration of the *Canon* or *TREAT* factors to come to that conclusion. I therefore agree with the appellant that this category of goods should have been found dissimilar, and certainly it could not have reasonably been found similar to more than 'a very low degree'."

65. While the above case involved a comparison of entirely different goods than those that are at issue here, I am of the view that the same principle applies. As I have set out above, it can be argued that, despite the applicant's limitation, there are overlaps in method of use, user and potentially trade channels. Those overlaps are not overly pronounced but they exist and if I were to simply apply a *tick-box* exercise, it could be argued that the overlaps give rise to a finding of similarity between these goods and services. However, I am of the view that upon taking a step back and considering the actual terms before me, a finding of similarity between them is non-sensical, especially in light of the limitation of the applicant. On this point, I am of the view that to find similarity here would offer far too broad a level of protection to the goods and services at issue. I say this because such an outcome would mean that any and all services that are offered to consumers via the internet or by providers who may also offer downloadable apps, for example, are similar to software goods, and vice versa. Given how many different trades and industries operate in this way, I consider that such a finding is not supportable and neither is it reasonable. As a result, I find that the above goods of the applicant are dissimilar to the opponent's service.

Downloadable computer software for managing and verifying clinical trial patient data, clinical trial results and clinical trial regulatory submissions; Downloadable computer software for use in managing and conducting clinical trials; Software and application software for computers or mobile devices in the fields of clinical and medical research and healthcare; Database management software in the fields of clinical and medical research and healthcare; none of the aforesaid in relation to legal services.

66. The nature of the above terms is even further removed from the opponent's service as they specifically relate to clinical trials or medical research. I appreciate that there may be some degree of overlap in user as, broadly speaking, a professional user of the above goods may find themselves embroiled in a legal dispute therefore requiring the opponent's service. However, such an overlap is fleeting. Further, I consider that the nature, purpose and trade channels of the above goods all differ from the opponent's service. Lastly, I accept that, as was the case in the preceding assessment, the above goods and the opponent's service will be used on a computer which could be said to lead to an overlap in method of use between them. That being said, I do not consider that this results in a meaningful overlap as, to suggest otherwise, would give far too broad a scope of protection to any goods or services that can be used on computers which, in the present day, covers a vast range of terms. Lastly, the goods and services are not complementary in nature and neither are they in competition. Taking all of this into account and bearing in mind what I have said at paragraph 65 above, I find that these goods are plainly dissimilar to the opponent's service.

Class 35

Administrative support and data processing services; advertising, marketing and promotional services; advisory services for business management; advisory services relating to business analysis; advisory services; business administration services in the fields of healthcare; business administration; business analysis services; business and market research; business consulting and management in the field of clinical trials; business data analytics; compilation, processing and analysis of statistics; computerised market research; data processing, systematisation and management; database management; distribution of advertising, marketing and promotional materials; distribution of promotional matter; interpretation of market research data; market analysis and research services; market research and market analysis; market

research consultancy; market research; marketing consulting services; none of the aforesaid in relation to legal services.

67. I note that the opponent's submissions make reference to some of the above services and set out that because they could entail or be complementary to the opponent's class 38 service. The opponent offers no further explanation beyond this and I see no reason to find that this is the case. The above services all relate to the operation of businesses or marketing, promotion or advertising services. Such services carry no obvious overlaps in nature, method of use, purpose or trade channels with the opponent's term and neither are they complementary or competitive with each other. Overall, I appreciate that there may be some degree of overlap in user given the broad userbase for the above services and the opponent's term. However, I do not consider that this alone is sufficient to give rise to a finding that these services are similar. As such, I find them to be dissimilar.

Class 41

Providing electronic publications; electronic publication services none of the aforesaid in relation to legal services.

68. The above terms are services in class 41 so are either publication services or services for the authoring of an electronic document. In contrast, the opponent's term is a telecommunication or transmission service in class 38. While this alone does not mean that the services are automatically dissimilar,[17] it does mean that their natures and method of uses are different. Turning to the remaining factors, I am of the view that, given that the applicant's terms are for the publishing or authoring of an electronic publication whereas the opponent's term is for the provision of a document online in a legal dispute, the core purposes of these services differ. That being said, I appreciate that there remains some degree of

[17] See Section 60A of the Act.

overlap in end purpose as both parties' services aim to ultimately provide a document/publication, albeit in different contexts (one side being for legal disputes, the other not). Turning to trade channels, I am of the view that the limitation of the applicant's terms means that it is unlikely for an undertaking that authors or publishes electronic documents completely unrelated to legal services would also offer the telecommunication service of providing documents in legal disputes. On this point, I also note that I have no evidence before me to suggest that there is any meaningful overlap in trade channels. In terms of user, I accept that, as has been the case throughout this comparison, there is some overlap here. Lastly, the services are not complementary and neither are they in competition. Taking all of the above into account, I am of the view that while there is some overlap in end purpose and user, those overlaps are limited and I do not consider that they warrant a finding that these services share any meaningful degree of similarity. They are, therefore, dissimilar.

Education and instruction services; education and training services; education services; training and consultancy services; none of the aforesaid in relation to legal services.

69. Plainly, the above services differ in nature, method of use and purpose with the opponent's service. In terms of trade channels, I accept that opponent service may provide tutorials or demonstrations in order to show its users how to use its service. However, I do not consider that this is the same as the provision of an education, training or instruction service in a trade mark sense. Instead, it is merely an ancillary service provided in support of the class 38 service. On this point, I have nothing before me to suggest that the provider of documents online for use in legal disputes offers any form of education or training service. As for user, I appreciate that the userbase for the above services is so broad that it will inevitably overlap with those who are involved in legal disputes and, therefore, require the service of the opponent. Lastly, the services are not complementary or competitive in nature.

Overall, while there is some overlap in user, I find that this is insufficient to give rise to a finding that these services are similar. They are, therefore, dissimilar.

Class 42

Clinical trials; none of the aforesaid in relation to legal services.

70. The above services are likely be sought by pharmaceutical companies that are engaged in trials in order to create a new drug. As has been the case throughout this comparison, I accept that users of the applicant's service may, in some capacity, end up in a legal dispute and require the opponent's service. While this may lead to some overlap in user, I find that all other factors differ. Plainly, the above services share no overlap in nature, method of use, purpose or trade channels with the opponent's service. Further, the services are not complementary or competitive in nature. Overall, I do not consider a singular overlap in user is sufficient to give rise to a finding of similarity between these services. They are, therefore, dissimilar.

Platform as a service [PaaS]; software as a service [SaaS]; none of the aforesaid in relation to legal services.

71. In considering the above terms, I am of the view that I can simply adopt the same reasoning that was reached in my comparison of the applicant's class 9 goods at paragraphs 63 to 65, above. Therefore, I find that the above services are dissimilar to the service of the opponent.

Computer data analytics software consultancy; computer data analytics software development; computer software advisory services; computerised data storage; database design and development services; design, development and programming of data analytics software; designing of data processing systems; installation, maintenance, repair, integration, configuration, updating, programming and

implementation of computer software; none of the aforesaid in relation to legal services.

72. The nature, method of use, purpose and trade channels of the above services are distinct from those of the opponent's service and neither are they complementary or competitive with each another. As has been the case throughout this comparison, there may be some degree of overlap in user. However, this alone is insufficient to give rise to a finding that these services are similar to any meaningful degree. As a result, I find that these services are dissimilar.

Computer programming in the fields of clinical and medical research; Computer programming in the fields of healthcare; Computerised data collection from clinical trial patients; Design, development and programming of software and application software in the fields of clinical and medical research; Design, development and programming of software and application software in the fields of healthcare; Document management for regulatory 42 compliance during clinical trials; Providing non-downloadable computer software for managing and verifying clinical trial patient data, clinical trial results and clinical trial regulatory submissions; Providing non-downloadable software for use in clinical trials; Remote monitoring of clinical trial patients; Secure sharing of data collected from clinical trial patients; Software as a service [SaaS] featuring software and application software in the fields of clinical and medical research; Platform as a service [PaaS] featuring software and application software in the fields of clinical and medical research; none of the aforesaid in relation to legal services.

73. The above services are all specific to the field of clinical and medical research or healthcare. Clearly, they differ in nature, method of use, purpose and trade channels with the opponent's services. Further, there is no complementary or competitive relationship between them. As for user, I am of the view that even if this were to overlap, it is insufficient (in the absence of any other overlaps) to give

rise to a finding of similarity between the services. As a result, I find that these services are dissimilar.

Conclusion of the goods and services comparison

74. As set out above, there can be no likelihood of confusion where the goods and services are dissimilar. Therefore, given that I have found the entirety of the applicant's specification to be dissimilar to the opponent's service, the present ground fails in its entirety.

75. I will now consider the section 5(3) ground of opposition.

Section 5(3)

76. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> > is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

77. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure,* Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; General Motors, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; General Motors, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; Adidas Salomon, paragraph 29 and Intel, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; Intel, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; Intel, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; L'Oreal v Bellure NV, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

78. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is

unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

79. In considering the issue of a reputation, I remind myself that I have summarised the opponent's evidence at paragraphs 24 to 38. In addition, I note that there are additional statements, being those from Mr Worthington and Mr Harrison, that attest to a level of awareness in the relevant industry for the 'TrialView' platform. Dealing with this evidence in turn, I note that Mr Worthington sets out that as part of his role as a Committee Member with the Commercial Litigators Forum, he is responsible for liaising with providers of third party services to law firms in London. One of these providers is the opponent and Mr Worthington sets out that, as of February 2023, 'TrialView' was a well-recognised provider of technology services to the legal disputes industry in the UK. He then states that he regards 'TrialView' as a well-recognised brand name amongst dispute professionals. As for the evidence of Mr Harrison, this follows a similar pattern wherein he confirms his position as a co-founding partner of a law firm and that he is co-chair of the London International Disputes Week. He then goes on to state, much like Mr Worthington, that as of February 2023, 'TrialView' was and remains a recognised provider of technology services to the disputes industry in the UK and that it has done work for a number of law firms and has provided its services in many cases in the UK courts.

80. While this additional evidence is noted, I am not convinced that it adds anything beyond the level of use that is provided by Mr Dowling in his evidence in chief. Firstly, I say this because Mr Dowling's evidence already speaks to the use of the 'TrialView' platform across a number of UK-based firms. The evidence of Mr Worthington and Mr Harrison only seem to confirm such points. Secondly, I am of

the view that while Mr Worthington and Mr Harrison are involved with legal dispute committees, I am not convinced that they are in positions to make bald statements that the mark is well-known across the UK as a whole.

81. In considering the present assessment, I wish to clarify that while I have found that this evidence was sufficient to prove that the opponent has been using its mark, the test for proving reputation is significantly more onerous than that for proof of use. I say this because a finding of genuine use only requires a sufficient level of use whereas a finding of a reputation requires that the mark relied upon is known by a significant part of the relevant public in the relevant territory. As a result, it does not simply follow that I must find a reputation in the opponent's mark because I found use.

82. In the present case, the opponent's evidence sets out that its service was used by 25 law firms in the UK and by 750 individual users in the UK as at the relevant date. In addition, I note that the EU use (which included the UK) in 2020 sat at 850 users but no information is provided in respect of the amount of EU based law firms that used the opponent's service at that time. In terms of turnover, the evidence shows that, across the relevant territory (including the EU prior to IP Completion Day), the opponent accrued a turnover of approximately €690,000 as at the relevant date. Comparing this level of use against the size of the relevant market in the UK (or the EU prior to IP Completion Day, for that matter), I am of the view that it represents a low level of use. On this point, I have nothing to suggest how many law firms are in the UK as a whole and use by just 25 of them is not, in my view, sufficient to demonstrate that the opponent's mark is well known amongst a section of the relevant public. The same applies to the active UK userbase of 750 users as at the relevant date and also the 850 EU based users (which, again, included the UK) in 2020. Even if limited to the legal industry alone, this is reflective of a low level of use. I note that the opponent's position in respect of its user base is that its services are sought by professionals in various fields such as medicine and pharmaceuticals. In short, this additional user base would vastly increase the

relevant market for the opponent's service and, in such circumstances, I see no scenario where 750 users can be said to point towards a level of use sufficient in order to warrant the existence of a reputation in the opponent's mark.

83. While the evidence sets out that the opponent began using the 'TrialView' brand in 2014, the actual use before me only covers a period of just over three years, between 2020 and the relevant date, being 6 February 2023. Such a period of use is not particularly longstanding and even though I appreciate that intensive use over a short period of time may be sufficient to give rise to a finding of a reputation, I note that, in the present case, the use not intensive either.

84. Lastly, I remind myself that the evidence sets out that the opponent enjoys between a 3% and 5% market share. While there are circumstances where this may be reflective of a high level of use (for very large and highly competitive markets, for example), the relevant market here is relatively niche and it is confirmed in the evidence that it consists of only two other key competitors. Given the figures involved, these other competitors are likely to dominate the market meaning that the market share given is not reflective of a high level of use, especially taken in the context of the use I have already discussed above.

85. Taking all of the above into account, I am of the view that the level of use before me is insufficient to give rise to a finding that the opponent enjoyed a reputation in the relevant territory as at the relevant date, being 6 February 2023. As a result, I find that the section 5(3) ground of the present opposition fails at the first hurdle.

86. In the event that I am wrong to dismiss the opponent's evidence as being insufficient to demonstrate a reputation, I am of the view that the opponent's best case is that its mark enjoys a weak to moderate reputation in respect of its class 38 services, being those that survived the genuine use assessment.[18] Even if this

[18] On this point, I remind myself that the issue of genuine use applies equally to the section 5(3) ground as it did to the section 5(2)(a) ground above.

were the case, I am of the view that the present ground would fail. My reasons follow.

Link

87. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

88. The marks are identical.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

89. The goods and services comparison I have conducted under the section 5(2)(a) ground above is relevant here. I do not intend to repeat this in full but remind myself that I found the applicant's goods and services to be dissimilar to the opponent's service.

90. As set out above, the present ground does not require a degree of similarity between goods and services in order for it to be successful. In respect of this point, I am of the view that any perceived closeness between the applicant's goods and services and the opponent's reputed term is fleeting. I say this because even where there may be a degree of overlap in user, the user will view the marks in different contexts. For example, the opponent's mark will be considered in the context of a legal dispute whereas the applicant's will, for the most part, be viewed in the context of clinical medical trials. Even where the application is not viewed in this context, it is limited from being viewed in any legal context.

The strength of the earlier mark's reputation.

91. The opponent's mark enjoys a between a weak and a moderate reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

92. I did not consider the distinctiveness of the opponent's mark under the section 5(2)(a) ground so will consider it for the first time here. In doing so, I remind myself that registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.[19]

93. The opponent's mark is a word only mark that consists of the word 'TrialView'. This will be understood as the conjoining of two words, being 'Trial' and 'View'. In the context of the services at issue, consumers will understand that it describes a service that enables users to 'view' something at a 'trial'. While not directly descriptive of the service relied upon, I am of the view that it will only be attributed a low degree of inherent distinctive character.

94. In terms of enhanced distinctiveness, my primary view is that the evidence is insufficient to give rise to a finding that the opponent's mark enjoys an enhanced degree of distinctive character. I say this in reliance upon the same reasons given above when discussing the issue of a reputation. That being said, the present scenario proceeds on the basis that there exists a reputation in the opponent's mark. In such circumstances, it is common for the finding of a distinctive character and reputation (where the factors are relatively equal) to mirror one another. As such, I will proceed on the basis that the opponent's mark is deemed to have an

[19] For guidance in respect of the determination of a mark's distinctive character, see paragraphs 22 to 23 of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*

enhanced degree of distinctiveness, but only to between a low and medium degree.

Whether there is a likelihood of confusion

95. Before moving to consider a likelihood of confusion, I wish to briefly discuss the fact that the opponent has sought to file evidence of actual confusion. I raise this issue for the first time here as it was not relevant to the section 5(2)(a) assessment above as that ground did not proceed to an assessment of confusion. Therefore, the present assessment represents the first opportunity for me to discuss this issue. In considering this point, I first remind of the case of *Roger Maier and Another v ASOS,* [2015] EWCA Civ 220, wherein Kitchin LJ set out that:

> "If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion."

96. Having considered the opponent's evidence, it is claimed that the presence of the applicant's mark has resulted in the opponent receiving time consuming complaints and support calls. While this broader claim is noted, there is only evidence of one instance of actual confusion occurring. Without anything further, I am not willing to accept that the actual confusion claimed goes beyond this. If it did, I consider it reasonable to expect more evidence in support of such a point.

97. In terms of the actual evidence filed, it is noted that it came in the form of a number of emails involving one Clinical Negligence practitioner and solicitor at the firm Fieldfisher Ireland LLP.[20] While this evidence is noted, it is from a practitioner outside of the UK. On this point, the question of a likelihood of confusion (and the question of a link, for that matter) is to be assessed from the consumer in the UK.

[20] SD18 and SD19

As such, the evidence provided, being from the EU, is of no assistance. Even if it were, it represents just one example and cannot be said to be indicative of wider instances where actual confusion occurred between the parties' marks. As a result, I do not consider that the opponent's evidence is of any assistance and I will, therefore, say no more about it.

98. Turning back to the issue of confusion, I appreciate that the present ground is one where confusion can exist where the goods and services are dissimilar. However, I do not consider that this is the case here regardless of the identity between the marks at issue. I say this because findings of confusion where the goods and services are dissimilar are ordinarily only made where the earlier mark is so well-known that the consumer is likely to be confused regardless of what goods or services it is used on, such as the mark 'MICROSOFT' on lamps, for example. Plainly, that is not the case here as the opponent's reputation does not sit anywhere near a level that can overcome the differences between the goods and services at issue.

Conclusion on link

99. Taking all of the above factors into account, I do not consider that consumers will consider that there exists a link between the marks. I say this because the distinctiveness and reputation of the opponent's mark do not sit at a high enough level to lead the consumers to believe that the marks are linked, despite their identity. For example, I see no reason why consumers who are aware of the 'TrialView' platform of the opponent, which they would use in the context of legal dispute resolution, would be caused to wonder that the undertaking responsible for the same would also offer goods or services in relation to clinical trials or those that are specifically excluded from the legal sector.

100. Without a link between the marks at issue, there can be no damage caused. Therefore, the present ground fails.

CONCLUSION

101. The opposition has failed in its entirety and the application may, subject to any successful appeal of my decision, proceed to registration for all of the goods and services applied for.

COSTS

102. The applicant has succeeded in defending the application in its entirety. The applicant is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,200 as a contribution towards its costs. The sum is calculated as follows:

Considering a notice of opposition and preparing the counterstatement:	£400
Filing evidence and considering the evidence of the opponent:	£800
Total:	**£1,200**

103. I hereby order TrialView Limited to pay Stitch Health Limited the sum of £1,200. 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 15th day of August 2025

A COOPER
For the Registrar

ANNEX

Class 9

Application software; Computer application software; Computer software; Database management software in the fields of clinical and medical research and healthcare; Database management software; Downloadable computer application software for data analytics; Downloadable computer application software; Downloadable computer software for managing and verifying clinical trial patient data, clinical trial results and clinical trial regulatory submissions; Downloadable computer software for use in managing and conducting clinical trials; Downloadable data analytics software; Downloadable electronic reports; Downloadable publications; Downloadable software; Software and application software for computers or mobile devices in the fields of clinical and medical research and healthcare; Software; none of the aforesaid in relation to legal services.

Class 35

Administrative support and data processing services; Advertising, marketing and promotional services; Advisory services for business management; Advisory services relating to business analysis; Advisory services; Business administration services in the fields of healthcare; Business administration; Business analysis services; Business and market research; Business consulting and management in the field of clinical trials; Business data analytics; Compilation, processing and analysis of statistics; Computerised market research; Data processing, systematisation and management; Database management; Distribution of advertising, marketing and promotional materials; Distribution of promotional matter; Interpretation of market research data; Market analysis and research services; Market research and market analysis; Market research consultancy; Market research; Marketing consulting services; none of the aforesaid in relation to legal services.

Class 41

Education and instruction services; Education and training services; Education services; Electronic publication services; Providing electronic publications; Training and consultancy services; none of the aforesaid in relation to legal services.

Class 42

Clinical trials; Computer data analytics software consultancy; Computer data analytics software development; Computer programming in the fields of clinical and medical research; Computer programming in the fields of healthcare; Computer software advisory services; Computerised data collection from clinical trial patients; Computerised data storage; Database design and development services; Design, development and programming of data analytics software; Design, development and programming of software and application software in the fields of clinical and medical research; Design, development and programming of software and application software in the fields of healthcare; Designing of data processing systems; Document management for regulatory 42 compliance during clinical trials; installation, maintenance, repair, integration, configuration, updating, programming and implementation of computer software; Platform as a service [PaaS] featuring software and application software in the fields of clinical and medical research; Platform as a service [PaaS]; Providing non-downloadable computer software for managing and verifying clinical trial patient data, clinical trial results and clinical trial regulatory submissions; Providing non-downloadable software for use in clinical trials; Remote monitoring of clinical trial patients; Secure sharing of data collected from clinical trial patients; Software as a service [SaaS] featuring software and application software in the fields of clinical and medical research; Software as a service [SaaS]; none of the aforesaid in relation to legal services.