

**O-0759-25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. UK3635437**

**IN THE NAME OF SHAREP AG IN RESPECT OF THE TRADE MARK**

**Share.** 

**Share.** 

**(Series of 2)**

**IN CLASSES 9, 39 & 42**

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO**

**UNDER NO. 506340**

**BY PARK AGILITY PTY LTD**

## **BACKGROUND AND PLEADINGS**

1. UK Registration No. 3635437 stands in the name of ShareP AG (“the Registered Proprietor”). The trade mark, as shown on the cover page of this decision, was filed by the Registered Proprietor on 30 April 2021. The registration date for the mark was 1 October 2021. The goods as registered are as follows:

Class 9: Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signaling, detection, testing, checking, life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; Apparatus and instruments for recording, transmission, reproduction or processing of sound, images or data; recorded and downloadable media, computer software, blank digital or analog recording and storage media; Computers and computer peripherals; Remote controls; Remote control and remote control devices; Remote control transmitters; electrical control apparatus; electronic access control systems for access gates; Apparatus for processing, transmission and storage of database information; Computer software and telecommunications equipment for connecting to databases and the Internet; automatic connection switching devices for telecommunications; Computer hardware for telecommunications; Communication server; Telecommunication devices for use with mobile networks; Telecommunications equipment and systems; Charger; Chargers for electric accumulators; Charging stations for electric vehicles; Downloadable software; Downloadable mobile application; Downloadable software for renting and sharing parking spots; Downloadable software for facilitating payments.

Class 39: Transportation services; Packaging and storage of goods; Travel arrangement; Rental, arranging rental and rental reservation services for garages and parking spaces for private individuals or companies via a global computer network.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; Quality control and authentication services; Design and development of computer hardware and software; Providing Internet platforms; Hosting platforms on the Internet; Hosting of web portals; Website design; Design of web portals; Development and maintenance of database software; Hosting of databases; Software as a service (SaaS); Platform as a service (PaaS); Design and development of software; Software as a service (SaaS) for renting and sharing parking spots; Software as a service (SaaS) for facilitating payments; Platform as a service (PaaS) for renting and sharing parking spots; Platform as a service (PaaS) for facilitating payments; Providing a website with information about and for booking temporary vehicle parking spaces.

2. On 21 July 2023, PARK AGILITY PTY LTD (“the Cancellation Applicant”) filed an application for invalidation under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) against all of the Registered Proprietor’s goods and services.

3. Section 5(2)(b) is relevant in invalidation proceedings under section 47(2) of the Act. The application for invalidation under section 5(2)(b) is on the basis of the following mark:

**UK917960088**<sup>1</sup>

Mark: SHAREPARK

Filing date: 24 September 2018

Registration date: 18 January 2019

Relying on all goods and services from its specification as follows:

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<sup>1</sup> On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UKIPO created comparable UK trademarks for all right holders with an existing EUTM. As a result of the Cancellation Applicant’s EUTM number 17960088 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark now recorded on the UK trade mark register has the same legal status as if it had been applied for and registered under UK law.

Class 9: Application software; Communication software; Computer software; Data communications software; Data processing software; Traffic control apparatus [electronic]; Traffic control apparatus [electric]; Computer systems; Control modules (Electric or electronic -); Data processing systems; Data terminals; Electronic control systems; Access control systems (Electric -); Access control systems (Automatic -); Electronic access control system for buildings; Information display terminals; Instruments for the transmission of information; Apparatus for the transmission of information; Apparatus for the reproduction of information; Apparatus for recording information; Advertising display apparatus [mechanical or luminous]; Data collection apparatus; Directional signage [luminous or mechanical]; Electrical signalling apparatus; Instruments for indicating directions; Signalling panels, luminous or mechanical; Road signs, luminous or mechanical; Traffic guidance apparatus [luminous sign]; Traffic guidance apparatus [electronic]; Traffic control apparatus [luminous]; Traffic cones; Traffic control apparatus [lighting]; Instruments for monitoring traffic; Traffic guidance apparatus [electric]; Traffic guidance apparatus [mechanical]; Luminous signs; Road signs [luminous]; Traffic information panels (non-metallic -) [luminous signs]; Automated car parking control devices; Communications apparatus for vehicles; Communications apparatus; Communications equipment; Communications software; Computer programs; Computer software for the control of lighting; Computer software to enable the provision of information via communications networks; Central processing units for processing information, data, sound or images; Programmable control apparatus.

Class 11: Lighting apparatus; Lighting apparatus and installations; Lighting apparatus for vehicles; Lighting tracks [lighting apparatus]; Apparatus and instruments for lighting; Apparatus for lighting; Computer controlled lighting instruments; Computer controlled lighting apparatus; Electric apparatus for lighting; Electric lighting apparatus.

Class 35: Advertising; Hire of advertising equipment; Provision of advertising information; Provision of information relating to advertising; Research services

relating to advertising; Direct marketing; Marketing; Marketing analysis; Marketing assistance; Marketing information; Promotional marketing.

Class 37: Installation of computerised information systems; Maintenance and repair of communications systems; Installation of traffic management systems.

Class 39: Parking of cars; Provision of vehicle parking facilities; Vehicle parking services; Computerised transport information services; Information services relating to methods of transport; Information services relating to road conditions; Information services relating to transportation; Information services relating to traffic; Information services relating to travel; Providing information relating to travel and transport, via electronic means; Providing transport and travel information; Provision of information relating to road transport; Provision of information relating to transport; Provision of information relating to road traffic conditions; Provision of information relating to the transportation of passengers; Traffic information; Transportation information; Transport information service.

Class 42: Advisory services relating to computer systems analysis; Computer system design; Design of communication systems; Designing of electronic systems; Design of information systems; Design of lighting systems.

4. In the statement of grounds, the Cancellation Applicant claims that the 'P' device element in the Registered Proprietor's mark will be understood to mean parking and therefore, the marks being compared will be SHAREPARK and Share.P(arking). Further, they state that the goods and services are the same/similar. Therefore, the marks are "deceptively similar and there is a high risk of confusion for consumers".

5. In response, the Registered Proprietor denied all the arguments put forward by the Cancellation Applicant. It put forward the position that the 'P' device is the dominant and distinctive element of their mark and that it does not appear within the Cancellation Applicant's mark and that the goods and services are not identical or similar to a high degree.

6. Both parties filed evidence. A hearing was held before me on 8 July 2024. The Registered Proprietor was represented by Mr Max Steinhausen of IP Service International and the Cancellation Applicant was represented by Mr Aaron Wood instructed by Basck Limited. I make this decision having taken full account of all the papers and the oral submissions, referring to them below as necessary.

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

## **Evidence**

8. The Cancellation Applicant's evidence consists of a witness statement dated 30 November 2023 from Max Steinhausen who is the director of IP Service International PTY LTD. The witness statement is accompanied by 'Annex A'. The purpose of the evidence is to show the meaning of a device which is a blue box containing a white 'P' as being reference to parking.

9. The Registered Proprietor's evidence consists of a witness statement dated 26 January 2024 from Mateusz Wojdylo who is the "CEO, found and Chief Visionary Officer" of ShareP AG. This is accompanied by 4 exhibits. The purpose of the evidence is to show what the Registered Proprietor offers and that he has no knowledge of any actual confusion between the marks. The evidence provided is of little assistance to me, particularly in relation to what work the Registered Proprietor actually undertakes. As there is no requirement to prove use in these proceedings, the decisions I make are notional and based upon the goods and services as they are registered.

## **Section 47:**

10. Section 47 of the Act states as follows:

"47. –

(1) [...]

(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

11. The trade mark upon which the Cancellation Applicant relies qualifies as an earlier trade mark because it was applied for at an earlier date than the contested marks pursuant to section 6 of the Act. The earlier mark is not subject to the proof of use requirements pursuant to section 6A of the Act. This is because it had not completed its registration processes more than 5 years before the filing date of the mark in issue. The Cancellation Applicant can, therefore, rely upon all of the goods and services for which its mark is registered.

### **Section 5(2)(b)**

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

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

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

## Case law

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

15. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

16. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

17. 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.

18. 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:

“[...] 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”.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)* (‘Meric’), Case T-133/05, the General Court stated that:

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

20. For the purposes of considering the issue of similarity of goods (and services), it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons

(see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. The Parties' respective specifications are:

<b>Registered Proprietor's goods and services</b>	<b>Cancellation Applicant's goods and services</b>
<p>Class 9: Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signaling, detection, testing, checking, life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; Apparatus and instruments for recording, transmission, reproduction or processing of sound, images or data; recorded and downloadable media, computer software, blank digital or analog recording and storage media; Computers and computer peripherals; Remote controls; Remote control and remote control devices; Remote control transmitters; electrical control apparatus; electronic access control systems for access gates; Apparatus for processing, transmission and storage of database information; Computer software and telecommunications equipment for connecting to databases and the</p>	<p>Class 9: Application software; Communication software; Computer software; Data communications software; Data processing software; Traffic control apparatus [electronic]; Traffic control apparatus [electric]; Computer systems; Control modules (Electric or electronic -); Data processing systems; Data terminals; Electronic control systems; Access control systems (Electric -); Access control systems (Automatic -); Electronic access control system for buildings; Information display terminals; Instruments for the transmission of information; Apparatus for the transmission of information; Apparatus for the reproduction of information; Apparatus for recording information; Advertising display apparatus [mechanical or luminous]; Data collection apparatus; Directional signage [luminous or mechanical]; Electrical signalling apparatus; Instruments for indicating directions; Signalling panels, luminous or mechanical; Road signs, luminous or</p>

<p>Internet; automatic connection switching devices for telecommunications; Computer hardware for telecommunications; Communication server; Telecommunication devices for use with mobile networks; Telecommunications equipment and systems; Charger; Chargers for electric accumulators; Charging stations for electric vehicles; Downloadable software; Downloadable mobile application; Downloadable software for renting and sharing parking spots; Downloadable software for facilitating payments.</p>	<p>mechanical; Traffic guidance apparatus [luminous sign]; Traffic guidance apparatus [electronic]; Traffic control apparatus [luminous]; Traffic cones; Traffic control apparatus [lighting]; Instruments for monitoring traffic; Traffic guidance apparatus [electric]; Traffic guidance apparatus [mechanical]; Luminous signs; Road signs [luminous]; Traffic information panels (non-metallic - ) [luminous signs]; Automated car parking control devices; Communications apparatus for vehicles; Communications apparatus; Communications equipment; Communications software; Computer programs; Computer software for the control of lighting; Computer software to enable the provision of information via communications networks; Central processing units for processing information, data, sound or images; Programmable control apparatus.</p>
<p>Class 39: Transportation services; Packaging and storage of goods; Travel arrangement; Rental, arranging rental and rental reservation services for garages and parking spaces for private individuals or companies via a global computer network.</p>	<p>Class 11: Lighting apparatus; Lighting apparatus and installations; Lighting apparatus for vehicles; Lighting tracks [lighting apparatus]; Apparatus and instruments for lighting; Apparatus for lighting; Computer controlled lighting instruments; Computer controlled lighting apparatus; Electric apparatus for lighting; Electric lighting apparatus.</p>
<p>Class 42: Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; Quality control and authentication services; Design and development of computer hardware and software; Providing Internet platforms; Hosting platforms on the Internet;</p>	<p>Class 11: Lighting apparatus; Lighting apparatus and installations; Lighting apparatus for vehicles; Lighting tracks [lighting apparatus]; Apparatus and instruments for lighting; Apparatus for lighting; Computer controlled lighting instruments; Computer controlled lighting apparatus; Electric apparatus for lighting; Electric lighting apparatus.</p>

<p>Hosting of web portals; Website design; Design of web portals; Development and maintenance of database software; Hosting of databases; Software as a service (SaaS); Platform as a service (PaaS); Design and development of software; Software as a service (SaaS) for renting and sharing parking spots; Software as a service (SaaS) for facilitating payments; Platform as a service (PaaS) for renting and sharing parking spots; Platform as a service (PaaS) for facilitating payments; Providing a website with information about and for booking temporary vehicle parking spaces.</p>	<p>Class 35: Advertising; Hire of advertising equipment; Provision of advertising information; Provision of information relating to advertising; Research services relating to advertising; Direct marketing; Marketing; Marketing analysis; Marketing assistance; Marketing information; Promotional marketing.</p> <p>Class 37: Installation of computerised information systems; Maintenance and repair of communications systems; Installation of traffic management systems.</p> <p>Class 39: Parking of cars; Provision of vehicle parking facilities; Vehicle parking services; Computerised transport information services; Information services relating to methods of transport; Information services relating to road conditions; Information services relating to transportation; Information services relating to traffic; Information services relating to travel; Providing information relating to travel and transport, via electronic means; Providing transport and travel information; Provision of information relating to road transport; Provision of information relating to transport; Provision of information</p>
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	<p>relating to road traffic conditions; Provision of information relating to the transportation of passengers; Traffic information; Transportation information; Transport information service.</p> <p>Class 42: Advisory services relating to computer systems analysis; Computer system design; Design of communication systems; Designing of electronic systems; Design of information systems; Design of lighting systems.</p>
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22. In the hearing I noted before I passed to the parties for submissions that there had been limited comment so far on the goods and services comparison. I mentioned that the list of goods and services to be compared was not insignificant and stated I would be grateful if the parties could make sure they addressed this within their submissions to me.

23. Mr Steinhausen gave initial submissions that the Cancellation Applicant had every class registered that the Registered Proprietor's mark had as well, being classes 9, 39 and 42. He said that class 9 has software and electrical apparatus, class 39 he summarised as transportation and car parking or parking services and class 42 was a service class for technology.

24. I asked Mr Steinhausen if his submissions meant that there was no real need for the Cancellation Applicant to rely upon their class 11, 35 and 37 goods and services as he had made no mention of them. He replied that this was not the case and those classes should also be taken into consideration and that he had been, in the first instance, addressing the goods and services in the identical classes.

25. Mr Wood in his response stated that the above submissions lacked detail and did not make reference to the *Treat* criteria.

26. After some discussion around the goods and services, Mr Steinhausen said he would stick to grouping the goods and services as he had set out above (paragraph 22).

27. I remind myself of what was said by Iain Purvis KC as the Appointed Person in *Abus August Bremicket Sohne KG v Muhammad Ali*, Case BL O/0911/24 at paragraph 9 that:

“9. In a case like this where the marks cover a multitude of different goods, it is obviously necessary for the Opponent to identify with precision, both in its pleaded case and in any submissions made to the Registry, which goods of its own registrations are alleged to be similar to which goods of the Application. If this is not done, it is unfair to the Applicant and it is extremely difficult if not impossible for the Hearing Officer to decide the case.”

I note that this decision came out after the hearing, however, it is not a new concept that the parties, in particular those bringing proceedings, should clearly outline their case. I have noted Mr Steinhausen’s submissions that were given in the hearing. I will therefore proceed on the basis of those submissions and I will only consider similarities where it is obvious to do so; otherwise, the goods and services will be found to be dissimilar.

### **Class 9**

*Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signaling, detection, testing, checking, life-saving and teaching apparatus and instruments;*

28. I consider that there is an overlap in purpose with ‘data collection apparatus’ from the Cancellation Applicant’s specification as all of the above goods could perform as data collection apparatus. The user and nature might also overlap as could the trade

channels. They are not complementary nor are they in competition and therefore, I consider them to be similar to a medium degree.

*Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity;*

29. Without any further submissions or evidence before me, I can see no obvious overlap of the *Treat* factors with the Cancellation Applicant's specification and therefore, find these goods to be dissimilar.

*Apparatus and instruments for recording, transmission, reproduction or processing of sound, images or data;*

30. I consider that 'Data collection apparatus; Apparatus for the reproduction of information; Central processing units for processing information, data, sound or images;' from the Cancellation Applicant's specification all fall within the above term and therefore consider them to be identical under the *Meric* principles.

*Recorded and downloadable media*

31. I will compare the above with the Cancellation Applicant's 'computer software'. Whilst software and media can be closely related, particularly in a digital sense, they are used differently and for a different purpose. Media refers to channels of communication and content and computer software refers to instructions or programs used to operate computers and therefore the nature differs. There could be an overlap in user where digital media is delivered through, and therefore accessed via, software. However, the goods are not complementary nor are they in competition. Taking all factors into account, the goods are similar to a low degree.

*Computer software, blank digital or analog recording and storage media;*

32. Computer software is found identically within the Cancellation Application's specification. Further I believe the rest of the Registered Proprietor's term falls within

the Cancellation Applicant's 'apparatus for recording information' and therefore, I consider them to be identical under the *Meric* principles.

*Computers and computer peripherals;*

33. "Computers and computer peripheral devices" are similar to "computer software" in the Cancellation Applicant's specification. Computer software is often integral to computers and therefore, often shares the same trade channels with the Registered Proprietor's goods. Whilst the goods differ in nature, purpose and method of use, they share end users and trade channels. The goods are not in competition and they are not complementary (whilst the goods might be integral for one another, as I pointed out above, I believe it falls on the second test, that being that the average consumer would expect them to come from the same undertaking). Therefore, I find the goods to be similar to a low degree.

*Remote controls; Remote control and remote control devices; Remote control transmitters;*

34. Without any further submissions or evidence before me, I can see no obvious overlap of the *Treat* factors with the Cancellation Applicant's specification, therefore, I find these goods to be dissimilar.

*Electrical control apparatus; electronic access control systems for access gates;*

35. I consider that the above terms would fall within the Cancellation Applicant's 'electronic control systems' and therefore consider them to be identical under the *Meric* principles.

*Apparatus for processing, transmission and storage of database information;*

36. I consider there to be an overlap in user, nature and use with the Cancellation Applicant's 'Apparatus for the transmission of information; Apparatus for the reproduction of information; Apparatus for recording information'. The Cancellation Applicant's goods cover information generally and therefore, that could include

database information. There is therefore also a chance that they overlap in trade channels. They are not in competition nor are they complementary. I therefore consider them to be similar to between a medium and a high degree.

*Computer software and telecommunications equipment for connecting to databases and the Internet;*

37. I consider that the above goods fall within the Cancellation Applicant's 'computer software' and 'communications equipment' and therefore find them identical under the *Meric* principles.

*Automatic connection switching devices for telecommunications; Computer hardware for telecommunications; Communication server; Telecommunication devices for use with mobile networks; Telecommunications equipment and systems;*

38. I consider that the above goods fall within the Cancellation Applicant's 'Communications apparatus; Communications equipment; Communications software' and therefore find them identical under the *Meric* principles.

*Charger; Chargers for electric accumulators; Charging stations for electric vehicles;*

39. Without any further submissions or evidence before me, I can see no obvious overlap of the *Treat* factors with the Cancellation Applicant's specification and therefore, find these goods to be dissimilar.

*Downloadable software; Downloadable mobile application; Downloadable software for renting and sharing parking spots; Downloadable software for facilitating payments.*

40. I consider that the above goods fall within the Cancellation Applicant's 'Application software; Computer software' and therefore find them identical under the *Meric* principles.

## Class 39

### *Transportation services;*

41. I consider there to be an overlap in user and use with the Cancellation Applicant's 'transportation information; transport information service' as the information will be pertinent to the services themselves. There might be an overlap in trade channels but the purpose and nature differ. They could be complementary as they are important/integral to one another and it would be reasonable for the average consumer to believe they are provided by the same undertaking. They are not in competition. I therefore consider them to be similar to a medium degree.

### *Packaging and storage of goods;*

42. Without any further submissions or evidence before me, I can see no obvious overlap of the *Treat* factors with the Cancellation Applicant's specification and therefore, find these services to be dissimilar.

### *Travel arrangement;*

43. I believe there is an overlap in user with the Cancellation Applicant's 'Information services relating to travel' as they would all be consumers interested in travel. The nature, use and purpose differ but there could be an overlap in trade channels and there might be complementarity as information on travel is intrinsic to then making the arrangements to travel and it would not be unreasonable for the average consumer to believe both services are provided by the same undertaking. They are not in competition. I therefore consider these services to be similar to no more than a medium degree.

*Rental, arranging rental and rental reservation services for garages and parking spaces for private individuals or companies via a global computer network.*

44. I consider that the above services fall within the Cancellation Applicant's 'Provision of vehicle parking facilities; vehicle parking services' and therefore find them to be identical under the *Merit* principles.

Class 42:

*Scientific and technological services and research and design relating thereto;*

45. I consider that the Cancellation Applicant's class 42 services 'Computer system design; Design of communication systems; Designing of electronic systems; Design of information systems;' all fall within the above service from the Registered Proprietor's specification and therefore, I find them identical under the *Merit* principles.

*Industrial analysis, industrial research and industrial design services; Quality control and authentication services; Providing Internet platforms; Hosting platforms on the Internet; Hosting of web portals; Hosting of databases; Website design; Design of web portals; Providing a website with information about and for booking temporary vehicle parking spaces.*

46. Without any further submissions or evidence before me, I can see no obvious overlap of the *Treat* factors with the Cancellation Applicant's specification and therefore, find these services to be dissimilar.

*Design and development of computer hardware and software;*

47. I find that the above service is identical to the Cancellation Applicant's 'Computer System Design' (or identical under the *Merit* principles).

*Development and maintenance of database software; Design and development of software;*

48. In my mind, 'computer system design' (as found in the Cancellation Applicant's specification), will include the design of software to use within the system and therefore, I find these services to be identical under the *Meric* principles.

*Software as a service (SaaS); Software as a service (SaaS) for renting and sharing parking spots; Software as a service (SaaS) for facilitating payments;*

49. The above services are all different types of software as a service which are a model for the distribution of software to customers who can access it over the internet. I therefore consider that these services overlap with the Cancellation Applicant's "computer software". They differ in nature as one is a good and the other is a service. The goods and services will overlap in trade channels, with the same undertaking providing both the goods and services. There will also be an overlap in user, and the user will also assume that the goods and services originate from the same undertaking, especially as they are important and indispensable to one another (the software as a service cannot be provided without the software). Consequently, I consider that they are complementary. I also consider that, to some extent, the goods and services may be in competition, with the user electing to either access their software via the internet, or alternatively choosing to purchase the equivalent software as goods. Therefore, taking all of the above into account, the goods and services are similar to between a medium and high degree.

*Platform as a service (PaaS); Platform as a service (PaaS) for renting and sharing parking spots; Platform as a service (PaaS) for facilitating payments;*

50. From my understanding, 'Platform as a Service' provides the user with the means to build, develop and maintain a software application and is therefore a step further away than the above 'software as a service' group. The provider of this service will host the network, servers, databases, software and any development tools by way of a cloud access. Therefore, the nature and use differs, they are not complementary but there could be an overlap in user and trade channels and be in competition with the

Cancellation Applicant's 'computer software'. I therefore find them similar to no more than a medium degree.

51. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

52. I have found no similarity for the following goods and services and therefore, the invalidation fails in relation to them:

Class 9: Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; Remote controls; Remote control and remote control devices; Remote control transmitters; Charger; Chargers for electric accumulators; Charging stations for electric vehicles;

Class 39: Packaging and storage of goods;

Class 42: Industrial analysis, industrial research and industrial design services; Quality control and authentication services; Providing Internet platforms; Hosting platforms on the Internet; Hosting of web portals; Hosting of databases; Website design; Design of web portals; Providing a website with information about and for booking temporary vehicle parking spaces.

53. The invalidation will continue in respect of the following:

Class 9: Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signaling, detection, testing, checking, life-saving and teaching apparatus and instruments; Apparatus and instruments for recording, transmission, reproduction or processing of sound, images or data; Recorded and downloadable media; Computer software, blank digital or analog recording and storage media; Computers and computer peripherals; Electrical control apparatus; electronic access control systems for access gates; Apparatus for processing, transmission and storage of database information; Computer software and telecommunications equipment for connecting to databases and the Internet; Automatic connection switching devices for telecommunications; Computer hardware for telecommunications; Communication server; Telecommunication devices for use with mobile networks; Telecommunications equipment and systems; Downloadable software; Downloadable mobile application; Downloadable software for renting and sharing parking spots; Downloadable software for facilitating payments.

Class 39: Transportation services; Travel arrangement; Rental, arranging rental and rental reservation services for garages and parking spaces for private individuals or companies via a global computer network.

Class 42: Scientific and technological services and research and design relating thereto; Design and development of computer hardware and software; Development and maintenance of database software; Design and development of software; Software as a service (SaaS); Software as a service (SaaS) for renting and sharing parking spots; Software as a service (SaaS) for facilitating payments; Platform as a service (PaaS); Platform as a service (PaaS) for renting and sharing parking spots; Platform as a service (PaaS) for facilitating payments.

## **Average consumer and the purchasing act**

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

55. 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:

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

56. I consider that the average consumer of the goods and services at issue could be members of the public or professionals/business (more particularly businesses in respect of the class 9 and 42 goods and services). The costs of these services are likely to vary between low (for example, downloadable mobile applications) and high. I would consider that some of the goods might be purchased more frequently, particularly for the class 9 goods whereas the services will be purchased relatively infrequently although there is potential for the services to be part of ongoing contracts. The average consumer will need to take into consideration the cost and suitability of the goods and services in accordance with their needs. I therefore consider that the average consumer would pay between a medium and an above medium (but not the highest) level of attention during the purchasing process.

57. The above services are likely to be selected from various retailers, websites, advertisements and signs on a physical property. I therefore believe that visual

considerations will dominate the selection process. However, I do not discount the possibility that there could be aural considerations from word-of-mouth recommendations or advice from a staff member.


### **Comparison of the marks**

58. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

60. The respective trade marks are shown below:

Registered Proprietor's marks	Cancellation Applicant mark
	<p data-bbox="933 365 1267 416">SHAREPARK</p>

61. The Cancellation Applicant's mark comprises two words conjoined. I consider that they hang together and the overall impression lies in the combination of these elements.

62. The Registered Proprietor's mark consists of the word 'Share' followed by a full stop and then a letter 'P' in a blue or grey background. I do not consider either element to be more dominant than the other and consider the overall impression to lie in the mark as a whole.

63. I turn now to the visual comparison of the marks. Mr Steinhausen pointed out in submissions that the beginning of the marks are identical which is self-evident. The Cancellation Applicant's mark has the further word 'PARK'. The Registered Proprietor's marks share the letter 'P' however, this is presented as a white letter on either a blue or grey background. The differences are the further letters 'ARK' in the earlier mark and the full stop in the contested marks. I therefore find the marks visually similar to between a medium and a high degree.

64. There was some discussion at the hearing about the aural comparison of the marks. It is obvious that, again, the beginning of the marks will be articulated identically. Mr Steinhausen stated that he believed it was unlikely that consumers would simply articulate the Registered Proprietor's marks as 'Share P' but rather would

say Share Park as they would recognise the P device as a car parking symbol (I will say more on this later). Mr Wood stated that the mark is likely to be referred to as 'Share P' (which he pointed out is shown throughout the evidence). I believe that a significant proportion of consumers will articulate the mark as "Share P" rather than doing the additional work of adding a word to it regardless of whether or not they view the 'P' element as a car parking sign. In this case, the marks are aurally similar to a medium degree. I do not discount that there might be a small but significant number of consumers that do articulate it as Share Park or Share Parking and in those instances the aural comparison is either identical or highly similar.

65. Conceptually, the marks both contain 'share' which will be given its ordinary dictionary definition. Regarding the word 'park' this has multiple possible dictionary meanings however, both parties' submissions clearly focused on the meaning in relation to vehicles and parking. The conceptual comparison is usually done without reference to the goods and services in question however, in this case I believe that the Cancellation Applicant's class 39 services do give context to the mark and reinforce the submissions that 'park' refers to the parking of vehicles.<sup>2</sup> The Cancellation Applicant provided evidence from the British Parking Association which shows that a white 'P' on a blue square is the symbol to denote a car park in the UK. I agree that I believe this is a well-known symbol to drivers and passengers alike. I note that within the contested marks, it is not a perfect square and has a tail on the left-hand lower side, however, neither party has referred to this and again, the Registered Proprietor does have some parking-based goods and services within their specification which enhances the likelihood of the device being seen as the parking symbol. It therefore follows that the marks are conceptually identical.

### **Distinctive Character of the Earlier Mark**

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

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<sup>2</sup> Mr Philip Johnson, sitting as the AP in *Viñedos Emiliana SA v Consorzio Tutela Vini Emilia*, (2) *Chiarli 1860 – Pr.I.V.I Srl* And (3) *Medici Ermete E Figli Srl* O/054/22.

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

67. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The Cancellation Applicant made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier registration and therefore I must rely on its inherent distinctiveness.

68. The earlier registration is comprised of two conjoined ordinary dictionary words. The mark is descriptive or allusive of some of the goods and services registered by the Cancellation Applicant but not for others. For the goods and services where the mark is allusive/descriptive, I consider the mark to be distinctive to a low degree. For those goods and services where the mark is not allusive/descriptive then the mark is inherently distinctive to a medium degree.

## **Likelihood of confusion**

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

70. The following factors must be considered to determine if a likelihood of confusion can be established:

- The contested mark is made up of the elements 'share', a full stop and the blue or grey P device. I found that the overall impression lies in the mark as a whole.
- The overall impression of the earlier mark lies in the combination of the two words 'SHARE' and 'PARK'.
- I have found them to be visually similar to between a medium and a high degree. For those who articulate the contested mark as 'Share P' then the marks are aurally similar to a medium degree. For those consumers who articulate the contested mark as 'Share park/share parking' it is aurally identical/similar to a high degree.
- The marks are conceptually identical.

- I have found the earlier mark to be inherently distinctive to a low degree for those goods and services which are related to parking and inherently distinctive to a medium degree for the other remaining goods and services.
- I have identified the average consumer for the goods and services at issue to be a combination of members of the general public as well as professionals/businesses. The purchasing process is likely to be predominantly visual.
- I have concluded that between a medium and an above medium (but not the highest) level of attention will be paid during the purchasing process.
- I have found the remaining goods and services at issue to range between identical and similar to a low degree.

71. Taking all of the above factors into account, I find that as the marks are conceptually identical, and for the significant proportion of average consumers who will pronounce the marks either identically or similar to a high degree, I consider that this is enough to counteract the visual differences between them. This will result in a likelihood of direct confusion between the marks, even where the level of similarity between the goods and services are low.

72. If I am wrong in the above finding, I turn now to consider indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

73. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”<sup>3</sup>

74. Even though the earlier mark is lowly distinctive for the goods and services related to parking it is still entitled to protection for the goods and services for which it is registered.<sup>4</sup> I believe that the average consumer, on seeing the marks at issue, noticing the ‘P’ device element compared to the word ‘PARK’ might view them as a rebrand or alternative mark used by the same undertaking on the basis that the ‘P’ device element could be interchanged with the word ‘Park’ and they evoke the same meaning. I believe this will still apply where the goods and services are not related to parking as the marks will still evoke the same meaning and it will be more distinctive for those goods and services. I therefore consider there to be a likelihood of indirect confusion.

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<sup>3</sup> Paragraph 12

<sup>4</sup> *Formula One Licensing BV v OHIM*, Case C-196/11P

## Conclusion

75. The invalidation fails, subject to any appeal, in relation to the following goods and services:

Class 9: Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; Remote controls; Remote control and remote control devices; Remote control transmitters; Charger; Chargers for electric accumulators; Charging stations for electric vehicles.

Class 39: Packaging and storage of goods.

Class 42: Industrial analysis, industrial research and industrial design services; Quality control and authentication services; Providing Internet platforms; Hosting platforms on the Internet; Hosting of web portals; Hosting of databases; Website design; Design of web portals; Providing a website with information about and for booking temporary vehicle parking spaces.

76. The invalidation succeeds, subject to any appeal, in relation to the following goods and services:

Class 9: Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signaling, detection, testing, checking, life-saving and teaching apparatus and instruments; Apparatus and instruments for recording, transmission, reproduction or processing of sound, images or data; Recorded and downloadable media; Computer software, blank digital or analog recording and storage media; Computers and computer peripherals; Electrical control apparatus; electronic access control systems for access gates; Apparatus for processing, transmission and storage of database information; Computer software and telecommunications equipment for connecting to databases and the Internet; Automatic connection switching devices for telecommunications; Computer hardware for telecommunications; Communication server;

Telecommunication devices for use with mobile networks; Telecommunications equipment and systems; Downloadable software; Downloadable mobile application; Downloadable software for renting and sharing parking spots; Downloadable software for facilitating payments.

Class 39: Transportation services; Travel arrangement; Rental, arranging rental and rental reservation services for garages and parking spaces for private individuals or companies via a global computer network.

Class 42: Scientific and technological services and research and design relating thereto; Design and development of computer hardware and software; Development and maintenance of database software; Design and development of software; Software as a service (SaaS); Software as a service (SaaS) for renting and sharing parking spots; Software as a service (SaaS) for facilitating payments; Platform as a service (PaaS); Platform as a service (PaaS) for renting and sharing parking spots; Platform as a service (PaaS) for facilitating payments.

## Costs

77. The Cancellation Applicant has the larger proportion of success in these proceedings and is therefore entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 as these proceedings commenced after 1 February 2023. I award the Cancellation Applicant the sum of **£1350**, calculated as follows:

Official fee	£200
Preparing the Application for Invalidation and reviewing the counterstatements	£250
Preparation of evidence	£300*
Preparing for and attending a hearing	£600

**Total**

**£1350**

\*I have awarded less than the scale suggests for costs on evidence as the evidence provided was very light.

78. I therefore order SHAREP AG to pay PARK AGILITY PTY LTD the sum of £1350. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 15<sup>th</sup> day of August 2025**

**L Nicholas**

**For the Registrar**