

O/0760/25

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1765313
DESIGNATING THE UK**

**IN THE NAME OF INUNUM AG
FOR THE FOLLOWING TRADE MARK:**

INU

IN CLASSES 9, 38, 39 and 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 447235

BY

INU – INNOVATIVE UNIVERSITY AG

Background and pleadings

1. InUnum AG (“the holder”) applied to protect the International Trade Mark Registration ‘INU’ in the UK on 05 October 2023 (application no: WO0000001765313). The International Registration (“IR”) was registered on 05 October 2023, and with effect from the same date the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal on 08 March 2024 in respect of the following goods and services¹:

Class 9 - Software, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; computer programs, downloadable, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; mobile apps, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; apparatus for the processing of images of landscapes, buildings, construction sites, technical infrastructure and landforms; measuring devices and apparatus for measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms; image capturing and developing devices for capturing and developing images and measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms; image scanning apparatus for images of landscapes, buildings, construction sites, technical infrastructure and landforms; apparatus for capturing and digitizing images and 3D scans of landscapes, buildings, construction sites, technical infrastructure and landforms; pre-recorded optical and magnetic discs, DVDs and digital files containing images and measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms.

¹ A Restriction of Protection was filed with WIPO which considerably limited the terms upon which the holder sought to rely. I will, therefore, only deal with the aforementioned goods and services as they now stand within this decision. I note that the opponent still considers there is overlap between the goods and services such that the opposition must continue.

Class 38 - Provision of access to a database containing images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms.

Class 39 - Navigation services [positioning, and route and course plotting]; route planning services [in particular inside of buildings] in the form of piloting services via navigation and positioning; rental of navigation devices.

Class 42 - Hosting services in relation to images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms; software as a service, and rental of software, in particular for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; software development, programming and implementation in relation to software for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; platform as a service [PaaS], in particular featuring mobile and web-based software for creating, organizing, storing, searching, sharing, displaying and interacting with images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms; 3D scanning services of landscapes, buildings, construction sites, technical infrastructure and landforms; measurement services of landscapes, buildings, construction sites, technical infrastructure and landforms; cartography services of landscapes, buildings, construction sites, technical infrastructure and landforms; optical measurement and measurement using 3D scanning of landscapes, buildings, construction sites, technical infrastructure and landforms.

2. The IR is derived from an earlier trade mark registered by the holders in Liechtenstein. As such, the IR benefits from an earlier priority date of 06 April 2023, being the filing date of the holders' Liechtenstein mark.

3. On 30 April 2024, INU - Innovative University AG ("the opponent") filed an opposition opposing the application in full under sections 5(1) and 5(2)(a) of the Trade

Marks Act 1994 (“the Act”). The opponent relies on the International Registration (“the earlier mark”):

(IR No: WO0000001636644)

INU

UK designating date: 16 August 2021

Date protection granted in the UK: 29 March 2022

Claiming a priority date of: 18 February 2021

Priority country: Germany

Relying on all of its goods and services in classes 9, 16, 35, 41 and 42 as set out in full later in my decision.

4. The opponent claims that there is a likelihood of confusion on the basis that the marks are identical, and the goods and services are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and that the IR should be refused protection.

5. The holder filed a defence and counterstatement stating as follows:

“The Applicant admits that the marks are identical.

The Applicant has amended the goods and services of the application at the WIPO. The amended list of goods and services is set out in the continuation sheet attached hereto. The Applicant denies that the goods and services are sufficiently similar to create a likelihood of confusion.

The opposition should be refused”.

6. In accordance with section 6 of the Act, the mark relied upon by the opponent is considered an earlier mark. As the mark had not completed its registration process more than five years prior to the priority date of the IR, it is not subject to the proof of

use provisions of section 6A of the Act and the opponent may rely upon all the goods and services of its registration as identified.

Representation

7. The opponent is represented by Beck Greener LLP and the holder is represented by Mathisen & Macara LLP². Neither party requested a hearing, but the opponent filed written submissions in lieu, dated 11 December 2024. The submissions will not be summarised but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Relevance of EU LAW

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

Decision

Section 5(1) and 5(2)(a) legislation

9. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

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

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

² The holder's representatives were changed to Mathisen & Macara LLP when a TM33 was filed on 08/07/24.

(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 of association with the earlier trade mark”.

11. 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.”

Identity of the marks

12. The holder accepts that the marks are identical³ and as such this satisfies the first requirement of both the section 5(1) and 5(2)(a) grounds.

My approach

13. I propose to deal with section 5(2)(a) of the Act first, and the assessment as to the identity/similarity of the goods and services given that any findings on identity will also satisfy section 5(1).

Section 5(2)(a) case law

14. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

³ See the holder’s counterstatement

The principles

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

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

15. The competing goods/services are shown in the table below:

The earlier mark	The IR
<p>Class 9 - Electronic publications recorded on sound, image and data carriers for education, training and educational purposes, namely education, training and educational films, clips and videos; education, training and educational software; electronic publications (downloadable) in the form of educational films, clips and videos; computer software [also downloadable], in particular for and in connection with electronic and digital publications of all kinds [also downloadable], in particular eBooks, ePapers, CD-ROMs, DVDs and audio books/audio files; machine-readable data carriers.</p>	<p>Class 9 - Software, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; computer programs, downloadable, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; mobile apps, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; apparatus for the processing of images of landscapes, buildings, construction sites, technical infrastructure and landforms; measuring devices and apparatus for measurements, in particular 3D scans, of</p>

	<p>landscapes, buildings, construction sites, technical infrastructure and landforms; image capturing and developing devices for capturing and developing images and measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms; image scanning apparatus for images of landscapes, buildings, construction sites, technical infrastructure and landforms; apparatus for capturing and digitizing images and 3D scans of landscapes, buildings, construction sites, technical infrastructure and landforms; pre-recorded optical and magnetic discs, DVDs and digital files containing images and measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms.</p>
<p>Class 16 - Printed matter, namely books, newspapers, journals, magazines, posters, calendars, card sets, question, interview and work sheets also suitable as teaching aids, namely drawings and symbols for illustrative teaching and for use on instruction and information signs and boards, graphic representations, presentation folders and foil transparencies; paper, cardboard (paperboard) and goods made of paper and cardboard, as far as included in this</p>	

class, namely, paper wipes, display cards (paper goods), stickers, stickers (paper goods), blocks (paper goods), flags, pennants (of paper), bottle covers of cardboard or paper, greeting cards, hat boxes of cardboard, coffee filters of paper, carafe coasters of paper, index cards (paper goods), cards, bibs of paper, bookmarks, paper ribbons (paper strips), paper face cloths, paper towels, paper cuffs for flower pots, paper bows, paper napkins, paper handkerchiefs, paper bags, paper place mats (sets), postcards, paper cream containers, absorbent sheets of paper for food packaging, stencils (paper goods), paper and cardboard signs, paper table linen, paper coasters, cardboard packaging materials; bookbinding articles; photographs; stationery; office supplies (except furniture); printed matter; paper and paperboard articles, namely paperboard, paperboard artwork and figurines, paperboard bags, pouches and articles for packing, wrapping and filing purposes, and paperboard labels, posters, placemats and coasters.

Class 35 - Management consulting in business management, business organization and commercial aspects, in particular start-up and growth consulting, strategy consulting, management consulting in business management,

business organization and commercial aspects, in particular for the purpose of knowledge management, for conducting benchmarking studies and with regard to customer relationship management (customer relationship management); organizational business project management, namely concerning strategy, organization and management of projects as far as included in this class; business consultancy concerning corporate identity; provision of office services; public relations, in particular press relations; organizational services for business consultancy in the field of knowledge and quality management as far as included in this class; event management, namely conception, planning, organization and implementation of business shows, trade fairs (including in-house trade fairs), exhibitions, product, service and company presentations, open days for economic and for advertising purposes; business consulting for the preparation of business plans; preparation of statistics, compilation of statistical information; provision of information in commercial matters; collection, preparation and compilation of business and financial information, data, statistics and indices in computer databases; business management for third parties;

<p>the aforementioned services also via the Internet, external networks and other electronic means; organizational business consultancy on multimedia, telecommunications and Internet applications; negotiation of contracts for the purchase, sale and rental of communications infrastructure (hardware and software).</p>	
	<p>Class 38 - Provision of access to a database containing images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms.</p>
	<p>Class 39 - Navigation services [positioning, and route and course plotting]; route planning services [in particular inside of buildings] in the form of piloting services via navigation and positioning; rental of navigation devices.</p>
<p>Class 41 - University and distance university services; education; training; sporting and cultural activities; education and training management, namely conception, planning, organization and implementation of training courses, seminars, workshops (training), colloquia and training; coaching; publication of printed matter (including online and in electronic form), except for</p>	

<p>promotional purposes, namely publication of texts, writings (publications), books, newspapers, journals, magazines, posters, calendars, card sets; pedagogical consultations; conducting pedagogical examinations; organization, production and presentation of meetings, exhibitions, congresses, conferences, symposia, workshops, company celebrations, competitions for sporting and cultural purposes; writing scientific papers and publications on business topics; lending books and films; publication of printed matter; distance learning; rental of recorded magnetic tapes; production of films, video films; production of radio and television programs; recording and production of films, video and audio recordings as well as radio and television programs; consulting services relating to continuing education; training and continuing education for personnel development; recording studio and film studio services.</p>	
<p>Class 42 - Scientific research work in the field of management; scientific services and research work; electronic storage of company data in databases for the purpose of knowledge management; technological consulting and expert activities; controlling, namely monitoring of operational processes from a</p>	<p>Class 42 - Hosting services in relation to images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms; software as a service, and rental of software, in particular for reality capturing, 3D scanning, digital modelling</p>

technical point of view; IT consulting, electronic storage of business and financial information, data, statistics and index for third parties; technical and IT consulting on multimedia, telecommunications and Internet applications; creation of Internet sites; services of a designer; creation of programs for data processing; services in connection with the Internet, namely creation, maintenance and care of computer programs for use on the Internet and/or for the use of the Internet, as well as advice on the use and further development of such programs, creation, maintenance and care of websites, creation, maintenance and care of computer utilities for the Internet, in particular cookies and banners, updating of computer software, computer technology consulting services, design of computer software, rental of computer software, recovery of computer data, maintenance of computer software; development of hardware and software for enterprise resource planning systems; development, design and maintenance of databases for teaching and learning materials; storage of teaching and learning materials in computer databases; electronic storage of computer programs in data networks; development, design and maintenance

and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; software development, programming and implementation in relation to software for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; platform as a service [PaaS], in particular featuring mobile and web-based software for creating, organizing, storing, searching, sharing, displaying and interacting with images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms; 3D scanning services of landscapes, buildings, construction sites, technical infrastructure and landforms; measurement services of landscapes, buildings, construction sites, technical infrastructure and landforms; cartography services of landscapes, buildings, construction sites, technical infrastructure and landforms; optical measurement and measurement using 3D scanning of landscapes, buildings, construction sites, technical infrastructure and landforms.

of databases; provision of computer programs in data networks, namely rental of computer software in data networks; computer programming services, namely programming software for the production of multimedia presentations; information technology [IT] consultancy, in particular to enable interactive learning via virtual project groups made available on the Internet for the interactive exchange of knowledge among themselves and with tutors.	
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16. The opponent submits as follows:

“The comparison of the goods and services is set out in Annex 2 hereto in the form of tables and the Opponent’s “commentary”. The said comparison must be undertaken not just within class but across classes also. The Opponent’s commentary is not intended to be exhaustive or to indicate all points of identity or similarity between the said products and services. However, including for the reasons indicated in the said table, all of the goods and services of the Application are either identical or similar to one or more the goods and services protected by the Registration.”

17. The holder submits:

“The Applicant has amended the goods and services of the application at the WIPO. The amended list of goods and services is set out in the continuation sheet attached hereto. The Applicant denies that the goods and services are sufficiently similar to create a likelihood of confusion.”

18. 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 1979.”

19. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

“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.”

20. 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.

21. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“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.”

22. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

23. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

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

24. I bear in mind that it is permissible to group goods together for the purposes of the assessment⁴. The holder has made no submissions regarding the similarity of any of the goods and services. The opponent has made submissions regarding the similarity or otherwise of the goods and services, which I will reference where appropriate. Whilst the opponent has provided a table setting out those goods/services it considers to be identical or similar to those of the holder, it has only done so in broad terms and neither party has sought to provide a detailed explanation of their respective terms. I must consider the terms therefore from the perspective of the ordinary meaning attributed to them by the average consumer confining the terms used to the substance or core of their possible meanings.⁵

Class 9

Software, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; computer programs, downloadable, for reality capturing, 3D scanning, digital

⁴ *Separode Trade Mark O/399/10*

⁵ *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36

modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; mobile apps, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; apparatus for the processing of images of landscapes, buildings, construction sites, technical infrastructure and landforms; measuring devices and apparatus for measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms; image capturing and developing devices for capturing and developing images and measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms;

25. The opponent submits that “all the above goods are software and are therefore identical to the following in the Opponent’s class 9 goods: “computer software [also downloadable], in particular ...” noting that the term “in particular” is not exclusive”. In *Häfele GmbH & Co. KG v OHIM*, Case T-336/09, the GC stated that the words “in particular” when used in a description are merely indicative of an example, rather than limiting those goods or services to those listed following the term⁶. Those words serve to distinguish goods that are of particular interest to the holder of a mark, without however excluding any other goods from the list (*affilene*, paragraph 39). Therefore, the comparison of the goods at issue should not be limited merely to *electronic and digital publications of all kinds [also downloadable], in particular eBooks, ePapers, CD-ROMs, DVDs and audio books/audio files; machine readable data carriers*. I agree with the opponent’s submissions and find that the holder’s terms are encompassed by the opponent’s wider term *computer software [also downloadable]...* and as such these are identical on the principles outlined in *Meric*.

Image scanning apparatus for images of landscapes, buildings, construction sites, technical infrastructure and landforms; apparatus for capturing and digitizing images and 3D scans of landscapes, buildings, construction sites, technical infrastructure and landforms;

⁶ See also (Case T-224/01 *Durferrit v OHIM – Kolene (NU-TRIDE)* [2003] ECR II-1589, paragraph 41, and judgment of 12 November 2008 in Case T-87/07 *Scil proteins v OHIM – Indena(affilene)*, not published in the ECR, paragraph 38)

26. The opponent submits:

“All the above goods are identical or similar to “machine-readable data carriers” listed in the Registration in that by their nature they would primarily comprise of machine readable data carriers to capture and digitize the data captured by the apparatus in question. Such goods are also similar to the computer software of the Registration in that software would likely be needed to operate those goods of the Application. Such goods are also similar to inter alia, the following class 42 services of the Registration: “electronic storage of business and financial information, data, statistics and index for third parties;” including on the basis of complementarity: data storage services, plainly require data storage apparatus”.

In the absence of any particular submissions to the contrary, my understanding is that the holder’s goods will be the type used for surveying and taking geographical measurements. Whilst apparatus of this nature will likely store data, such as scanned images and measurements, its purpose is to carry out image scanning and is therefore different to *machine-readable data carriers* in the opponent’s specification. I would consider a machine-readable data carrier to be a device used for scanning barcodes and the like. Therefore, the purpose of the goods is different, as a scanner is a device that captures an image or document and converts it into a digital format. I accept that data will need to be stored on the holder’s goods, but I do not consider that a machine-readable data carrier would be used to do this. As a result, I find that users and trade channels will differ. Without any further explanation I see no obvious similarity between the respective goods.

27. The opponent has submitted that the holder’s goods are also similar to their Class 42 services, being *electronic storage of business and financial information, data, statistics and index for third parties*. I consider the opponent’s term to relate to the provision of services for the storage of things such as business accounts which are held for third parties such as, for example, HMRC. I consider the uses are different to that in the holder’s specification and I find that users will differ as the opponent’s services will have a wider user base. I find that trade channels will not overlap, and I do not find complementarity. I therefore find the goods and services to be dissimilar.

Pre-recorded optical and magnetic discs, DVDs and digital files containing images and measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms.

28. The opponent submits:

“All the above goods are data carriers which need to be readable by machines and are therefore identical or similar to “machine-readable data carriers” listed in the Registration. Such goods are also identical and similar to “electronic publications (downloadable) in the form of educational films, clips and videos;” of the Registration in that such goods are publications and would include such publications for educational purposes”.

29. I consider that the holder’s goods relate to discs and DVDs which will be used to store data, such as scans. As I have set out above, my understanding is that these goods will be the type used for surveying and taking geographical measurements. I do not consider these to be identical to *machine-readable data carriers*, which I consider will be used as I have set out above. The opponent also submits that the holder’s goods are identical/similar to *electronic publications (downloadable) in the form of educational films, clips and videos*. The holder’s goods have a specific purpose, and I do not consider that this is the same as the opponent’s term, as the holder’s goods relate to files containing 3D scans of landscapes, not downloadable educational films. I therefore find the nature and purpose of the goods to be different. As a result of this, users will not overlap, as users of the holder’s goods are likely to work within surveying or building/construction. Consequently, I find that trade channels will be different, and I do not find complementarity. In absence of any specific submissions regarding identity/similarity, I see no obvious similarity between the respective goods, I therefore find the goods to be dissimilar.

Class 38

Provision of access to a database containing images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms.

30. The opponent submits:

“These services are closely similar to the class 42 services of the Registration. See for instance “electronic storage of company data in databases for the purpose of knowledge management;” and “electronic storage of computer programs in data networks; development, design and maintenance of databases;”.

They are also similar to the technical IT services listed in the class 42 services of the Registration including for instance, “provision of computer programs in data networks, namely rental of computer software in data networks;”.

The said services of the Application are also similar to the class 35 services of the Registration including “preparation of statistics, compilation of statistical information;” and “collection, preparation and compilation of business and financial information, data, statistics and indices in computer databases;” in the Registration.”

31. In the absence of submissions, I consider that the holder’s services are database services which will be used for the broadcasting and transmission of measurements and scans, as well as digital modelling and visualisations. I consider that these services have a specific purpose and are likely to be used by the surveying or building and construction industry. The opponent’s specification in Class 42 includes the term *development, design and maintenance of databases*. The opponent’s term is broad, and whilst I do consider that the nature of the services differs, as the holder’s services are *provision of access to a database*, whereas the opponent’s services are *development, design and maintenance of databases*, there will be an overlap in end users of the holder’s above services. Therefore, I find that there may be competition between the services. The method of use will be different, however, there may be an overlap in trade channels, and I do find complementarity, as it is foreseeable that an economic undertaking who provides access to a database may also develop, design and maintain the same. Overall, I consider the holder’s terms to be similar to the opponent’s to a medium degree.

Class 39

Navigation services [positioning, and route and course plotting]; route planning services [in particular inside of buildings] in the form of piloting services via navigation and positioning; rental of navigation devices.

32. The opponent submits:

“These services are similar to the “scientific services” listed in the Application. They are also similar to the Opponent’s “computer software” listed in class 9 of the Registration as well as to the software and IT services listed in Class 42 of the Registration particularly in view of the fact that such goods and services would include software for geolocation, positioning and navigation.”

33. In my opinion, the holder’s services are specific to navigation services, including planning and plotting routes. The opponent has submitted that these are similar to their term *computer software* in Class 9. Whilst the holder’s navigation services may require computer software to function, I do not consider that the purpose of the goods and services is similar. Whilst I accept that navigation services may utilise computer software, the fact that computer software may be used in the delivery of the services it is insufficient for a finding of similarity on this basis alone. I also consider that users will be different, and I do not consider that trade channels will overlap. I also do not find complementarity.

34. The opponent has also submitted that the holder’s above terms are similar to their Class 42 IT services, however, they have not specified which terms they believe to be similar. I cannot find any terms within Class 42 that bear any obvious similarity to that of the holder’s specification as stated above. I also bear in mind the decision of *SmartX*⁷ in which Ian Purvis KC stated:

“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

⁷ O/0911/24

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 therefore find the services to be dissimilar.

Class 42

Hosting services in relation to images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms;

35. The opponent submits:

“These services are effectively database services and are therefore identical or similar to for instance the following services in class 42 of the Registration: “electronic storage of business and financial information, data, statistics and index for third parties;” and “development, design and maintenance of databases;”.

Such services are also identical or similar to “development, design and maintenance of databases for teaching and learning materials; storage of teaching and learning materials in computer databases;” bearing in mind that the Applicant’s services would implicitly include teaching and learning materials.”

I understand image hosting services to be websites or mobile applications in which people can upload items, such as images, for others to view. In this instance the holder’s term is specific for hosting services relating to *images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms*. Again, I consider that users of these services are likely to work within surveying or the building/construction industry. In regard to the opponent’s specification, it is my understanding that a database is used to electronically store information or data in a computer system, and the opponent’s term specifically relates to the *development, design and maintenance of databases*. I consider that these terms have a different purpose, one being to host images whereas the other is to develop, design and maintain databases. I therefore find the nature and

use of the terms to be different. Users are unlikely to overlap, particularly given the specific nature of the holder's term. I therefore do not find that there is competition or complementarity. I do not find any other terms within the holder's specification to be similar, and as such, I find the services to be dissimilar.

Software as a service, and rental of software, in particular for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; software development, programming and implementation in relation to software for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; platform as a service [PaaS], in particular featuring mobile and web-based software for creating, organizing, storing, searching, sharing, displaying and interacting with images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, and landforms;

36. The opponent submits:

“These services are each software and IT services and are therefore identical or closely similar to for instance, “provision of computer programs in data networks, namely rental of computer software in data networks;” and “creation of programs for data processing; services in connection with the Internet, namely creation, maintenance and care of computer programs for use on the Internet and/or for the use of the Internet, as well as advice on the use and further development of such programs.

These services are also highly similar to the computer software listed in the class 9 goods of the Registration”

37. The holder's terms include Software as a service, and rental of software, as well as software development. The opponent relies on its Class 42 services, as well as its Class 9 *computer software*. Whilst I acknowledge that services are not the same as goods, there will be an overlap in end users of the holder's above services and the opponent's goods/services in Classes 9 and 42. The goods and services may be in competition, with the user electing either *Software as a service* or alternatively choosing to purchase comparable software as goods. With regard to the specific

nature of the respective goods and services i.e. the holder's *for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms* against the opponent's *services in connection with the Internet, namely creation, maintenance and care of computer programs for use on the Internet and/or for the use of the Internet, as well as advice on the use and further development of such programs*, the method of use and nature of the goods and services will be different, although the essential experience of the user of the software may be highly comparable, and there is likely to be an overlap in trade channels. Overall, I consider the holder's terms to be similar to the opponent's to a medium degree.

3D scanning services of landscapes, buildings, construction sites, technical infrastructure and landforms; measurement services of landscapes, buildings, construction sites, technical infrastructure and landforms; cartography services of landscapes, buildings, construction sites, technical infrastructure and landforms; optical measurement and measurement using 3D scanning of landscapes, buildings, construction sites, technical infrastructure and landforms.

38. The opponent submits that "these services are each scientific services and are therefore identical to the "scientific services" in the class 42 services of the Registration." As per my findings above, I consider that the holder's services relate to the type used for surveying and taking geographical measurements. I understand cartography to refer to maps or charts of geographical areas. Whilst these may fall under scientific and technological services in Class 42, I do not consider the above to be identical to the opponent's terms in Class 42 such as *electronic storage of company data in databases for the purpose of knowledge management*. I note that the opponent has not identified any specific terms that they believe to be identical, and I cannot find any terms within Class 42 that bear any similarity to that of the holder's specification as stated above. The holder's services are specific, and I do not consider that the nature or use of these services will overlap. Users will differ and there will not be competition. I therefore find the services to be dissimilar.

Conclusion on the goods/services comparison and my approach

39. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition under section 5(2)(a) aimed against those goods and services that I have found to be dissimilar will fail⁸. For completeness the opposition under section 5(1) would equally fail for these goods/services.

Average consumer and the purchasing act

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

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

41. The opponent submits:

“The relevant public for the purposes of this opposition consists primarily of end consumers with a normal level of attention. Overall, the average consumer in this case will pay a medium level of attention when selecting the goods and services in question. Some of the goods and services in question are technical. However, they are not limited to any price point, recipient or market and there is nothing unusual about the way in which the goods and services in question would be selected or purchased”.

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

42. I consider that the goods and services at issue will be purchased by both the general public and business or professional consumers, with the latter seeking out the more specialised goods/services such as *mobile apps, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms*. The goods and services will be sold through a range of channels, including from physical premises as well as via the internet and they may be sourced through specialist providers. For business consumers, purchase of the goods and services at issue will be an equally visual and aural process. Due to the nature of the goods and services at issue, the price and frequency of purchase is likely to vary. Considerations such as costs, quality and suitability will be considered. Business consumers may also consider contract terms. Given the nature of the goods and services, and their importance to the target consumer, I would expect the level of attention paid during the selection and purchasing process to be between a medium and high degree of attention as a result.

43. For the general public, the costs of the purchase will vary, but they are likely to be at the lower than for the business user/professional, and various factors will be taken into account such as the item's capacity and capabilities, as well as delivery methods. I consider that, in this instance, the selection process would be predominantly visual, although aural considerations will play a part, for example, if advice is obtained from sales assistants. When selecting the goods and services prior to purchase, the consumer will want to ensure that they are appropriate to their own specific needs, taking into account reviews, quality, ease of use, suitability of the product and the reputation of the provider. I would expect members of the general public to pay a medium degree of attention to the purchasing process.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and 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).”

45. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent submits “the trade mark INU has no meaning for either the Applicant’s Goods and Services, the Opponent’s Goods and Services, or at all. It is highly distinctive for those goods and services.” The Opponent has not filed any evidence and so I only have the inherent position to consider.

46. In *Kunze Folien GmbH v Kartell UK Limited*⁹, Mr Iain Purvis KC sitting as the Appointed Person, referred with approval to the decision of *Alfa-Beta Vassilopoulos AE v Agro de Bazan*¹⁰, in which the Board of Appeal stated as follows:

“As to the distinctive character of the letter combination ‘AB’ in the earlier marks and of the contested mark, [...] it should be noted that letters or letter combinations of two or three letters are inherently weak, given the limited number of letters in the alphabet, the great number of meanings that acronyms and abbreviations may have and the fact that consumers frequently encounter

⁹ BL O/085/14, paragraph 29

¹⁰ Case R 82/2011-4 of the Board of Appeal of OHIM (now the EUIPO), paragraph 16

abbreviations and letter combinations of all kinds in everyday life and business as generic abbreviations but not as marks.”

47. I consider that consumers will either consider the opponent’s mark to consist of a three-character alphabetical sequence, ‘INU’, or it will be considered to be a made-up word. I remind myself that a registered trade mark must be assumed to have at least some distinctive character¹¹ and that the mark is neither allusive nor descriptive of the opponent’s goods. If the mark is perceived by the average consumer as a series of letters, it will have a low degree of distinctive character. However, if the mark is perceived as being a made-up word, it will be high in distinctive character. I find that a significant proportion of average consumers would more likely consider this to be a three-character alphabetical sequence rather than an invented word, and therefore, I consider the inherent distinctive character of the mark to be inherently low.

Conclusions on sections 5(1) and 5(2)(a)

48. In respect of section 5(1) the marks are identical. I found that some of the goods in class 9 of the respective marks as set out at paragraph 26 are also identical. The opposition succeeds under section 5(1) in relation to those goods where I found identity.

Likelihood of Confusion

49. Turning to section 5(2)(a) 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/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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the

¹¹ *Formula One Licensing BV v OHIM*, Case C-196/11P, paragraphs 41 - 44.

goods/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.

I remind myself that I made the following findings:

- The goods and services at issue range from being identical upon the principles outlined in *Meric* to similar to a medium degree.
- I have identified that the average consumer will be members of the general public and businesses. Business consumers will select the goods and services by both aural and visual means, whereas the general public will select the goods and services through primarily visual means, although I do not discount an aural component;
- I have concluded that a medium degree of attention will be paid by members of the general public, and between a medium and high degree of attention will be paid by professionals;
- The marks are identical;
- I have found the earlier mark to be inherently distinctive to a low degree;

50. Taking all of the above factors into account, I find that consumers will be unable to accurately recall or remember the marks from one another. I consider this to be the case based on the fact that the marks at issue are identical. As such, regardless of the level of similarity between the goods/services at issue, the consumer will be unable to differentiate between the marks with any degree of accuracy and will directly mistake one for another. Consequently, despite having found that a substantial proportion of consumers would perceive the earlier mark as a series of three arbitrary letters and possess a low level of distinctive character, given the identity of the marks I find that there exists a likelihood of direct confusion between the marks in respect of all of the goods/services that I found to be similar. Even if I had found that a substantial proportion of consumers perceived the earlier mark as an invented word then this would not alter my finding as the likelihood of confusion is even more likely to occur

with a highly distinctive mark. , As a result of the above, the opponent's opposition succeeds under section 5(2)(a) of the Act.

Final Remarks

51. The opposition under section 5(1) and 5(2)(a) is partially successful. Therefore, subject to appeal, the application will be refused in relation to the following goods/services:

Class 9 Software, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; computer programs, downloadable, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; mobile apps, for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; apparatus for the processing of images of landscapes, buildings, construction sites, technical infrastructure and landforms; measuring devices and apparatus for measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms; image capturing and developing devices for capturing and developing images and measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms;

Class 38 Provision of access to a database containing images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms.

Class 42 Software as a service, and rental of software, in particular for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical infrastructure and landforms; software development, programming and implementation in relation to software for reality capturing, 3D scanning, digital modelling and visualization of landscapes, buildings, construction sites, technical

infrastructure and landforms; platform as a service [PaaS], in particular featuring mobile and web-based software for creating, organizing, storing, searching, sharing, displaying and interacting with images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, and landforms;

53. In light of my earlier findings the application will proceed to registration in relation to the following goods and services:

Class 9 Image scanning apparatus for images of landscapes, buildings, construction sites, technical infrastructure and landforms; apparatus for capturing and digitizing images and 3D scans of landscapes, buildings, construction sites, technical infrastructure and landforms; Pre-recorded optical and magnetic discs, DVDs and digital files containing images and measurements, in particular 3D scans, of landscapes, buildings, construction sites, technical infrastructure and landforms.

Class 39 Navigation services [positioning, and route and course plotting]; route planning services [in particular inside of buildings] in the form of piloting services via navigation and positioning; rental of navigation devices.

Class 42 Hosting services in relation to images, measurements, 3D scans, digital models and visualizations of landscapes, buildings, construction sites, technical infrastructure and landforms; 3D scanning services of landscapes, buildings, construction sites, technical infrastructure and landforms; measurement services of landscapes, buildings, construction sites, technical infrastructure and landforms; cartography services of landscapes, buildings, construction sites, technical infrastructure and landforms; optical measurement and measurement using 3D scanning of landscapes, buildings, construction sites, technical infrastructure and landforms.

Costs

52. The parties have both achieved a measure of success and I find it appropriate that each party bears its own costs.

Dated this 18th day of August 2025

L Bailey

For the Registrar