O/0939/25

TRADE MARKS ACT 1994

IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. WO0000001739632
DESIGNATING THE UK OF KAPPA DEVELOPMENT
FOR THE FOLLOWING TRADE MARK:

ELSE APP

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 444971
BY ELSE LONDON LTD

BACKGROUND AND PLEADINGS

1. International trade mark WO0000001739632 ("the IR") consists of the sign shown on the cover page of this decision. The holder is KAPPA DEVELOPMENT. The IR is registered with effect from 09 February 2023 and claims a priority date of 09 August 2022.[1] With effect from 09 February 2023, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the IR in relation to the following goods and services:

> **Class 9:** *Software (recorded programs); educational software; game software; downloadable computer software applications; downloadable applications for mobile devices; telephone and digital platform; content recorded on digital, multimedia or video media; downloadable music files or images.*
>
> **Class 41:** *Education; training; education and training with respect to the responsible use of telecommunication apparatus, computers or telephones; entertainment; sporting and cultural activities; providing information with respect to entertainment, education, training, sporting and cultural activities; photography services; electronic publication of books and journals online; editing and publishing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; providing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; rental and lending of books and of musical and/or audiovisual works; providing recreational facilities; providing non-downloadable films via video-on-demand services; production of multimedia, audio and video recording programs, films, games, radio or television programs; production, creation of musical and/or audiovisual works; booking of seats for shows; organization of competitions (education or entertainment); organization and conducting of colloquiums, conferences, congresses; organization and conducting of exhibitions for cultural or educational purposes; organization of sporting, cultural, musical and educational events; providing information with*

[1] Priority country: France; TM from which priority claimed: 4890514.

respect to music, shows, sport, leisure; organization of internships (education, training); organizing award and prize-giving ceremonies (entertainment); game services provided online from a computer network.

Class 42: *Design, writing (design), development, installation, maintenance or update of software; software rental; design, development, installation, maintenance, update and rental of software and programs for analytical use, digital flow control, cyber security, protection of access to computer and telecommunications systems; programming for computers and for mobile devices and particularly for telephones; Software as a Service (SaaS); advice regarding information technology; advice, auditing and providing information with respect to cybersecurity.*

2. The request to protect the IR was published on 29 September 2023. On 29 December 2023, Else London Ltd ("the opponent") opposed the protection of the IR in the UK based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under Sections 5(2)(b) and 5(3), the opponent relies upon the single earlier mark shown below and the services covered by it:[2]

UK00003269595 (series of three)
ELSE
Else
else
 	
Filing date: 09 November 2017
Registration date: 13 April 2018
 	
Class 42: *Design; design consultancy; product design; branding; digital design.*

3. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an "earlier mark" in accordance with Section 6 of the Act. As the opponent's earlier mark

[2] The mark also covers services in class 42 but those are not relied upon for the purpose of the present opposition.

had not been registered for five years or more at the priority date of the IR,[3] it is not subject to the use conditions under Section 6A of the Act. Consequently, the opponent may rely on all of the services it has identified without demonstrating that it has used the mark.

4. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the goods and services are highly similar, the marks are highly similar, and the addition of the descriptive element 'APP' in the contested mark is not enough to distinguish the marks.

5. Under Section 5(3), the opponent claims that its earlier mark enjoys a reputation in relation to all of the registered services and reiterates the claim that customers will see the contested mark as an extension of the opponent's mark confusing the origin of the goods and services, leading to the holder taking unfair advantage of, or causing detriment to, the reputation and distinctive character of the opponent's mark.

6. Under Section 5(4)(a), the opponent relies upon the unregistered sign 'ELSE' which it is said have been used throughout the UK since 2010 in relation to the following services: *design; design consultancy; product design; branding; digital design; design agency services; digital design agency services.* The opponent claims that due to the long standing use of the opponent's mark, they have built up a considerable goodwill in the mark 'ELSE' and that use of the contested mark, which is nearly identical to the opponent's mark, will mislead and misrepresent to the public that the goods and services offered by the holder are those of the opponent, or otherwise, associated with, or authorised by the opponent. As a result, the opponent is likely to suffer damage, including loss of sales and reputational damage.

7. The holder filed a defence and counterstatement, denying the opponent's claims and putting it to strict proof.

8. The opponent is represented by HGF Limited, and the holder is represented by Harrison IP Limited.

[3] See paragraph 2 of Schedule 2 of the Trade Marks (International Registration) Order 2008 which gives the filing date for Article 3ter(2) designations as the date the request for extension was recorded in the International Register

9. Only the opponent filed evidence. Neither party requested a hearing, but the opponent filed written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

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

EVIDENCE

11. The opponent's evidence came in the form of the witness statement of Warren Hutchinson dated 13 July 2024. Mr Hutchinson is the founder of the opponent's company; this is a position he has held since 2010. Mr Hutchinson's evidence is accompanied by six exhibits (being those labelled WH1-6) and was adduced in order to prove that the earlier mark enjoys reputation and goodwill.

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

DECISION

Section 5(2)(b)

13. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a) …

(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."

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v 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 greater 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 to mind the earlier mark, 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. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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."

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (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.

17. 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 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."

18. 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. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia 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."

19. 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."

20. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court ("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."

21. The competing goods and services are as follows:

The holder's goods and services	The opponent's services
Class 9: *Software (recorded programs); educational software; game software; downloadable computer software applications; downloadable applications for mobile devices; telephone and digital platform; content recorded on digital, multimedia or video media; downloadable music files or images.*	
Class 41: *Education; training; education and training with respect to the responsible use of telecommunication apparatus, computers or telephones; entertainment; sporting and cultural activities; providing information with respect to entertainment, education, training, sporting and cultural activities; photography services; electronic publication of books and journals online; editing and publishing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; providing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; rental and lending of books and of musical and/or audiovisual works; providing recreational facilities; providing non-downloadable films via video-on-demand services; production of multimedia, audio and video recording*	

programs, films, games, radio or television programs; production, creation of musical and/or audiovisual works; booking of seats for shows; organization of competitions (education or entertainment); organization and conducting of colloquiums, conferences, congresses; organization and conducting of exhibitions for cultural or educational purposes; organization of sporting, cultural, musical and educational events; providing information with respect to music, shows, sport, leisure; organization of internships (education, training); organizing award and prize-giving ceremonies (entertainment); game services provided online from a computer network.	
Class 42: *Design, writing (design), development, installation, maintenance or update of software; software rental; design, development, installation, maintenance, update and rental of software and programs for analytical use, digital flow control, cyber security, protection of access to computer and telecommunications systems; programming for computers and for mobile devices and particularly for telephones; Software as a Service (SaaS); advice regarding information technology; advice, auditing and*	**Class 42:** *Design; design consultancy; product design; branding; digital design.*

providing information with respect to cybersecurity.	

22. As regards the similarity of the goods and services, in its statement of grounds the opponent stated as follows:

> *"The opponent's services in class 42 are identically reproduced in class 42 of the contested application. Further, the opponent's design services are similar to the contested software related goods and services in class 9 and 42. Design services in class 42 can include design in the field of IT such as design of computer software and hardware and therefore they coincide in their relevant public. The opponent's digital design services extend into other digital fields, including digital and electronic publications. The contested services in class 41 fall within the scope of the opponent's design and digital design services in class 42. They target the same public and are often offered by the same undertakings. It is not uncommon that undertakings that specialise in design consultancy and design services, also offer publication of said designs as well as training in relation to those services, therefore, the contested services in class 41 are also similar to the opponent's services."*

23. The applicant merely denies that the goods and services are similar.

Class 9

Software (recorded programs); educational software; game software; downloadable computer software applications; downloadable applications for mobile devices; telephone and digital platform; content recorded on digital, multimedia or video media; downloadable music files or images.

24. In its submissions in lieu the opponent states that the contested goods in class 9 are highly similar to the earlier services as they are complementary to one another and consumers would believe that the respective goods and services are provided by the same undertaking. It also states:

"Design services are offered through multiple distribution channels, such as in-person design consultancy services where software is used to create designs such as digital designs and mock-ups, online/video consultancy services where software is used to connect the consumer and the designer and free access mobile applications and websites where software is the service. Design services can also cross over into multiple channels. For example, companies such as "HomeBase", who provide in person kitchen design consultation services, also provide DIV planner and design software. Regardless of the channel, software plays an indispensable role in design services.

Moreover, design previews are provided to consumers via mobile application software or downloadable digital media files.

The integral role that software plays in design services stretches across all industries, from branding and marketing to home improvements to clothing.

It is evident that software and design services are intertwined.

These goods and services can also be in direct competition with one another with regards to price and ease of user. For example, a consumer may choose to use a free online website builder, instead of consulting a private design agency.

The Contested Goods in class 9, which includes various types of software and digital content are therefore highly similar to the Earlier Services."

25. The contested goods in class 9 include various types of software as well as telephone and digital platforms, and downloadable or recorded multimedia content. The earlier services are essentially design services, which, as the opponent correctly states, include the design of the holder's software goods. However, as far as I am aware, whilst digital and multimedia content and music files and images are created and/or produced, they are not, by definition, the subject of design services; the explanatory note to Class 42 clarifies, in fact, that design services in class 42 are restricted to certain design services, for example, industrial design, design of computer

software and systems, interior design, packaging design, graphic arts design, dress designing.

26. Hence, in the absence of any overlap of the *Canon* criteria, I find that the contested *telephone and digital platform; content recorded on digital, multimedia or video media; downloadable music files or images* and the earlier *design; design consultancy; product design; branding; digital design* are dissimilar. The nature, purpose, uses and method of use of the goods and services is different, the goods and services target different users, do not share trade channels and are neither complementary nor in competition. As regards the opponent's claim that design previews are provided to consumers via mobile application software or downloadable digital media files, that does not create any meaningful degree of similarity between the goods and services. First, there is no evidence that providers of design services also provide the app through which the design previews are supplied to the consumers. Second, if the provider of design services supplies its customers with a downloadable digital media file in order to show the design before it is finalised, that is part and parcel of the design services, and it cannot be said that the provider of design services is in the business of marketing and/or selling downloadable digital media files – hence the opponent's example is inapt because it is outside the scope of what the respective specifications cover. Third, whilst designs previews can be shown to customers through app or digital media files, that does not mean that there is a close connection between the goods and services 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. These goods are dissimilar.

27. As regards the remaining software goods, namely *software (recorded programs); educational software; game software; downloadable computer software applications; downloadable applications for mobile devices,* the opponent's main argument, as I understand it, is that software is used to create designs such as digital designs and mock-ups, so it is a tool used in the provision of the opponent's design services. Admittedly, the opponent's *design services* also cover the design of the contested software goods. So, effectively, we have two overlaps because on one side, the holder's *software (recorded programs)* (which include design software) can be used by the opponent to create designs and provide design services; whereas on the other

side, the opponent's design services include services aimed at designing and developing the holder's software goods. As regards the first argument, it seems to me that it is too general as nowadays software is used in relation to the provision of many disparate services and there is no evidence that there is scope for the holder's software goods and the opponent's design services to be provided through the same trade channels and to the same users. In this connection, someone looking to use the holder's goods is not likely to also seek the design of said goods. Instead, the user of the services is likely to be a professional user looking for someone to design software on its behalf for it then to provide the software to its own end consumers. Further, any use by the opponent of the holder's software in order to provide design services, would be internal use by the opponent, and would not amount to the opponent offering software goods to its customers. Hence, I reject the argument that the integral role that software plays in design services creates a similarity in a trade mark sense. Lastly, as regards the possibility of the opponent designing and developing the holder's software goods, it is true that there is no evidence that manufacturers of computer software are also responsible for the provision of design services. Nevertheless, some of the holder's broader software goods and the opponent's design services might target the same users and be in competition as a business can either select the holder's ready-made software or approach the opponent seeking bespoke software design services. However, this would only apply in my view to *software (recorded programs); downloadable computer software applications* which I find to be similar to a **medium degree** because these goods are not limited in any way so can cover software that a business might seek to have built through bespoke software design services; however, this scenario does not apply to *educational software; game software; downloadable applications for mobile devices,* which would normally target members of the general public (including students) and which consumers would not seek to obtain through bespoke software design services. **Accordingly, I find that the contested *Software (recorded programs); downloadable computer software applications* are similar to the opponent's design services to a low to medium degree, whilst the other goods in class 9 (i.e. *telephone and digital platform; content recorded on digital, multimedia or video media; downloadable music files or images; educational software; game software; downloadable applications for mobile devices*) are dissimilar.**

Class 41

Education; training; education and training with respect to the responsible use of telecommunication apparatus, computers or telephones; entertainment; sporting and cultural activities; providing information with respect to entertainment, education, training, sporting and cultural activities; photography services; electronic publication of books and journals online; editing and publishing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; providing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; rental and lending of books and of musical and/or audiovisual works; providing recreational facilities; providing non-downloadable films via video-on-demand services; production of multimedia, audio and video recording programs, films, games, radio or television programs; production, creation of musical and/or audiovisual works; booking of seats for shows; organization of competitions (education or entertainment); organization and conducting of colloquiums, conferences, congresses; organization and conducting of exhibitions for cultural or educational purposes; organization of sporting, cultural, musical and educational events; providing information with respect to music, shows, sport, leisure; organization of internships (education, training); organizing award and prize-giving ceremonies (entertainment); game services provided online from a computer network.

28. In relation to these services the opponent states:

> *"It is submitted that the Contested Services in class 41 are highly similar to the Earlier Services as they are ancillary to those provided under the Earlier Mark.*
>
> *Creative industries and particularly those in relation to digital media, are constantly evolving to meet with market trends and keep up to date on technological advancements.*
>
> *As such, companies within the industry often provide training and educational services to businesses and creatives. For example, the Opponent themselves provide industry support and education services to students and emerging designers through a number of university institutions in the UK, as evidenced in paragraphs 5 and 13 of the previously submitted witness statement.*

Educational events and workshops are also used as a form of networking in the industry offering existing and prospective clients the opportunity to meet like-minded professionals and learn new skills. Else London has hosted a number of these types of events under the ELSE brand, as evidenced at paragraph 11 of the Witness Statement.

The publication of works such as articles, magazines and case studies are vital services for design agencies in order to showcase their creative works and provide consumers with an overview of their portfolios. For example, seen at exhibit WH4 of the Witness Statement is a case study of work done by Else London. Moreover, magazines and related publications are works of designers themselves.

The Contested Services 'organising award and prize giving ceremonies' are also ancillary to the Earlier services. Creative industries, particularly design industries, take great pride in their works and design competitions are regularly held to champion new and innovative designs. A google search of design competitions in the UK reveals over 12 pages of design competitions, awards and ceremonies.

Evidenced at paragraphs 4 and 12 of the Witness Statement, Else London themselves are a part of various award ceremonies and related bodies and has been in attendance/the recipient of numerous design awards.

Many of the Contested Services are ancillary and essential to the function of a thriving design agency.

The Contested Services are therefore highly similar to at least a medium degree to the Earlier Services."

29. The opponent's arguments are essentially that (1) businesses providing design services provide educational services to designers and students and use educational events and workshops as a form of networking; (2) the publication of works such as articles, magazines and case studies are vital for design agencies in order to

showcase their creative works; (3) design competitions are important to businesses providing design services and the opponent has won many design awards; (4) many of the contested services are ancillary and essential to the function of a thriving design agency.

30. I am not persuaded by the opponent's argument. The overlaps identified by the opponent have nothing to do with the *Canon* criteria. A business which delivers educational events/workshops, publishes articles/magazines/case studies and takes part in industry competitions/awards all in order to promote its own offerings, does not provide educational services, publishing services or organisation of awards ceremonies services aimed at third parties – these are all activities which are carried out by the business to enhance its brand and are part of a marketing strategy, rather than constituting the provision of complementary services. Hence, I find that the uses, nature, purpose and methods of use of the contested services in class 41 (which include, among others, entertainment, educational, publication and booking services) are different from those of the opponent's *design; design consultancy; product design; branding; digital design* services in class 42*.* In addition, the services are not complementary, neither are they in competition, and do not share trade channels. **These services are dissimilar.**

Class 42

Design, writing (design), development, installation, maintenance or update of software; software rental; design, development, installation, maintenance, update and rental of software and programs for analytical use, digital flow control, cyber security, protection of access to computer and telecommunications systems; programming for computers and for mobile devices and particularly for telephones; Software as a Service (SaaS); advice regarding information technology; advice, auditing and providing information with respect to cybersecurity.

31. In relation to these services, the opponent states:

> *"Software-as-a-service' in the Contested Services is a service that would be provided by design agencies and under the umbrella of design services,*

particularly when these services are provided to consumers via free websites and platforms, such as with companies like 'Wix' and 'Square Space'.

The Earlier 'design services' would wholly encompass the Contested Services for 'software design and development'.

'Digital design services' as included in the Earlier Services covers a wide range of fields, but is generally a type of visual communication or product or service provided through a digital interface. Digital design services would not be confined to simply marketing or branding but would touch on all digital fields such as those related to 'analytical, digital flow control, cyber security and telecommunications' included in the Contested Services.

These services in the Contested class 42 are therefore identical under the Meric principle to the Earlier Services.

It is further submitted that any low level of similarity between the goods and services, is offset by the high level of similarity between the marks (Canon)."

32. I agree with the opponent that some of the contested services in class 42 fall within the opponent's broad terms *design; design consultancy; product design; branding; digital design* and are identical on the principle outlined in *Meric*: *Design, writing (design) ….of software; design, …..of software and programs for analytical use, digital flow control, cyber security, protection of access to computer and telecommunications systems.* **These services are identical.**

33. I also believe that a business providing software design services in relation, for example, to bespoke business applications (for example software to manage core business processes or interactions with customers), would also be responsible for developing, installing, maintaining or updating the software it designs. I also agree with the opponent that it is possible that a business designing and building a custom software solution would also make the software accessible through a cloud-based solution (Software as a Service), or a secure platform, or license/rent the software to the end-user. Accordingly, I find that the contested *development, installation,*

maintenance or update of software; software rental; development, installation, maintenance, update and rental of software and programs for analytical use, digital flow control, cyber security, protection of access to computer and telecommunications systems; Software as a Service (SaaS) are similar to a medium degree to the opponent's design services. Although the services have a different nature, purpose and method of use, they clearly target the same users, share the same distribution channels and are highly complementary. **These services are similar to a medium degree.**

34. The same conclusion applies to *programming for computers and for mobile devices and particularly for telephones* because they can relate to the development/implementation of specific type of software designed using the opponent's design services. **These services are similar to a medium degree.**

35. Lastly, the contested *advice regarding information technology; advice, auditing and providing information with respect to cybersecurity* can all be provided in the context of the opponent's design services which cover design of software and other information technology products. **These services are also similar to a medium degree.**

Conclusions on the services comparison

36. Based on the above, I conclude that there is no similarity at all between the opponent's earlier services and the following goods and services in the contested IR:

> **Class 9:** *educational software; game software; downloadable applications for mobile devices; telephone and digital platform; content recorded on digital, multimedia or video media; downloadable music files or images.*
>
> **Class 41:** *Education; training; education and training with respect to the responsible use of telecommunication apparatus, computers or telephones; entertainment; sporting and cultural activities; providing information with respect to entertainment, education, training, sporting and cultural activities; photography services; electronic publication of books and journals online;*

editing and publishing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; providing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; rental and lending of books and of musical and/or audiovisual works; providing recreational facilities; providing non-downloadable films via video-on-demand services; production of multimedia, audio and video recording programs, films, games, radio or television programs; production, creation of musical and/or audiovisual works; booking of seats for shows; organization of competitions (education or entertainment); organization and conducting of colloquiums, conferences, congresses; organization and conducting of exhibitions for cultural or educational purposes; organization of sporting, cultural, musical and educational events; providing information with respect to music, shows, sport, leisure; organization of internships (education, training); organizing award and prize-giving ceremonies (entertainment); game services provided online from a computer network.

37. 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."

38. Some similarity of goods and services is therefore essential for a likelihood of confusion to be established. Since I have concluded that the above goods and services are dissimilar, the opposition aimed against them, insofar as it relies on the section 5(2)(b) ground, fails at the first hurdle.

Average consumer

39. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods and services. I must then determine the manner in which the goods and 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. (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."

40. The goods and services at issue are software goods, design services and a range of other services closely connected with software development and rental of software. The services in particular will be, for the most part, selected by business users though it cannot be excluded that they will be sought by member of the general public, for example, for website design.

41. Both the goods and the services will be selected primarily via visual means. The goods will be bought from retail environments, whilst the services will be available from the provider directly. Either way, the selection will occur from physical premises (such as shops and offices) or online. The goods and services will also be promoted visually through marketing material. Having said that, I do not discount aural considerations in the form, for example, of advice from salespersons or word of mouth recommendations.

42. In terms of level of attention, it will depend on the cost and frequency of the purchase, with some software goods being relatively cheap compared to the costs of, for example, designing a software for the management of a business. The level of attention can therefore vary from medium to above medium.

Comparison of marks

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

44. 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. The respective marks are shown below:

The holder's mark	**The opponent's mark**

ELSE APP	ELSE
	Else
	else

Overall impression

45. The opponent's mark is a series of three marks consisting of the word 'ELSE' presented in capital letters, title case and lower case. There are no other elements that contribute to the overall impression of the mark which lies in the word itself.

46. The holder's mark consists of the words 'ELSE' and 'APP' closely aligned (but not joined) presented in capital letters, in a standard font. I agree with the opponent that in the context of the contested goods in class 9 and services in class 42, which relate to software and computer programming, the word 'APP' will be perceived separately from the word 'ELSE' and understood as a descriptive or weakly distinctive element. In this connection, the opponent has provided a dictionary definition of the word 'APP' as *"(an) abbreviation for application: a computer program or piece of software designed for a particular purpose that you can download onto a mobile phone or other mobile device"* which also corresponds to my understanding of the meaning of the word. Consequently, whilst the word 'APP' is not totally negligible, it has less weight than the word 'ELSE' which is the dominant and distinctive component of the mark.

Preliminary remark

47. In its counterstatement, the holder denied that the marks are nearly identical, however, it did not deny that they are similar. Further, whilst the holder anticipated that more detailed submissions on the similarity of the marks would follow, nothing was filed beyond the counterstatement.

Visual similarity

48. As word-only marks protect the words itself, they cover use in all possible fonts and typefaces. This means that the particular way in which the word 'ELSE APP' is presented in the holder's mark does not create a material difference between the marks. The marks coincide in the identical word 'ELSE' which is the only element of the opponent's mark and the first element of the applicant's mark. Further, given the descriptiveness/weak distinctiveness of the second element 'APP' in the holder's mark, the rule of thumb that consumer's attention tends to focus upon the first element of the mark is fully applicable in this case. Overall, I consider the marks to be similar to a high degree.

Aural similarity

49. Aurally, the element 'ELSE' will be articulated identically in both marks. The holder's mark contains the additional word 'APP' which is descriptive/weakly distinctive and will be pronounced after the word 'ELSE'.[4] Overall, I consider the marks to be similar to a high degree.

Conceptual similarity

50. Conceptually, the word 'ELSE' is a common English word and will be given the same meaning in both marks, namely that of a word used *"after words beginning with any-, every-, no-, and some-, or after how, what, where, who, and why, but not which"* which means *"other, another, different, additional".* In addition, the holder's mark will convey the additional concept of a software app, which, as I have said, is either descriptive or weakly distinctive for the goods and services at issue. Overall, I consider the marks to be conceptually similar to a high degree.

Distinctive character of the earlier mark

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

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

[4] See *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) where the AP said that the descriptiveness of an element of the mark does not make it aurally invisible.

> 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)."

52. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with 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.

53. The opponent's earlier mark consists of the word 'ELSE'. The word 'ELSE' is a common English word, however, it is neither descriptive nor allusive of the registered services in class 42 and it is distinctive to a medium degree.

54. In its submissions in lieu, the opponent claims that earlier mark enjoys an enhanced degree of distinctive character in light of the evidence of reputation. I shall now turn to deal with this evidence.

55. Mr Hutchinson states that the opponent was founded in 2010 and is an independent experience design, strategy and innovation consultancy business. It provides support to businesses through times of significant change, offering design, design consultancy, product design, branding and digital branding services. The opponent is a member of the Design Effectiveness Awards, which is an independent body who recognise and champion companies and individuals providing the most effective designs, however, it is not said whether this is a UK body or not. The opponent is also the founding member of Blueprint 1000, an initiative by the Design and Technology Association, which partners companies and member schools to offer

industry support and education to students and emerging designers; however, again, it is not clear whether this is a UK initiative or not. In 2023, the opponent was awarded a place on the Great Places to Work lists and recognised as one of the Best Places to Work for Women, Best Places to work for Well Being and Best Workplaces for Consulting and Professional Services; once again, it is not clear whether this recognition reflects the opponent's position in the UK, but in any event, these initiatives and awards do not appear to be strictly related to the services marketed by the opponent under the earlier mark; rather, they seem to relate to corporate work which led to improved employees' satisfaction and networking initiatives aimed at enhancing and strengthening the opponent's image as a business to work for.

56. Mr Hutchinson says that the opponent provides its services to clients across the globe and has worked with a number of large multi-national corporations, including a number of well-known UK business, such as, for example, O2, Shell, The National Lottery, Bupa, The Rolling Stones, Legal & General, Unicef, National Accident Helpline and Universal Music. Non-UK businesses are also mentioned, however, as enhanced distinctiveness must be assessed from a UK perspective, this evidence does not assist the opponent.

57. The UK turnover generated by the offering of services under the brand 'ELSE' for the years 2019-2023 is as follows:

YEAR	TURNOVER (£)
2023	5m
2022	4.7m
2021	3m
2020	2.3m
2019	1.9m

58. In terms of marketing activity, the opponent markets its business by hosting private events to prospective clients with 50 events held in 2017 and 20 events in 2019, however, it is not said how many businesses/individuals attended those events, how the brand was promoted at those events, and if they led to any contract or collaboration with potential clients.

59. Mr Hutchinson also mentions the opponent winning a number of awards, however, some of the awards listed relate to work the opponent has carried out with non-UK-companies including, Spanish, Russian and French businesses; further, for most part, it is not clear whether they are UK awards or not. In this connection, there are only four awards which clearly relate to the UK, namely three British Interactive Media Association Awards, which are said to celebrates the best of British ingenuity and a 2022 Design Effectiveness Awards, which is said to recognise and champion companies and individuals providing the most effective designs. In relation to the former, the opponent was shortlisted in the category of Innovative Product and Service design (2018) and Mr Hutchinson and his business partner Dave Dunlop were recognised as top 100 leading persons in the Interactive Media and Design industry (2019 and 2022); in relation to the latter, the opponent won the Silver Award for its work with UK cruise line, Fred Olsen. Significantly, two of those awards relate to people employed by the opponent, rather than to the brand 'ELSE' and it is not clear whether the other awards relate to services marketed by the opponent. Lastly, it is uncertain whether the business award won in 2022 was awarded prior to the relevant date of 09 August 2022.

60. In addition, Mr Hutchinson says that the opponent is partnered with a number of highly regarded educational institutions and regularly teaches educational courses on design through the institutions listed below:

a) The Imperial Collage of London
b) Brunel University London
c) Northumbria University of Newcastle
d) The British Interactive Media Association
e) Future Academy London

61. Lastly, Mr Hutchinson states that the opponent uses the earlier mark on its social media pages, including its website, Twitter, Facebook and that the opponent's website continues to attract a large number of visitors. In this connection, although Mr Hutchinson provides a table showing the number of people who visited the opponent's website https://www.elselondon.com/ in the period 2020-2022, it is not clear what

proportion of the total visitors are from the UK - this is an important point, given that the domain .com does not specifically target the UK:

YEAR	NUMBER OF VISITORS
2020	34,073
2021	15,142
2022	14,333

62. This is the totality of the evidence. As I have already highlighted, the opponent's evidence is not particularly focused. First, it is not actually clear to me what type of services are provided under the earlier mark. The narrative evidence is not particularly illuminating on this point, as it refers to the opponent being an *"independent experience design, strategy and innovation consultancy business"* which *"provides support to businesses through times of significant change, offering design, design consultancy, product design, branding and digital branding services*" – this definition seems to mix business consultancy provided to business clients to fix business problems or improve outcomes (which would be in class 35 and is not covered by the earlier mark) with product design (which is covered by the earlier registration). Further, in relation to branding, it is not clear what services the opponent provides as brand strategy services are in class 35 whilst brand design services (including for example design of brand names) are in class 42. In this connection, the evidence refers to the opponent helping some of its clients improving users' experience of their websites/booking processes which resulted in increased bookings;[5] admittedly this would fall within the registered term *digital design*, but again it is not clear what percentage of turnover relate to these services as opposed to other business consultancy services which are outside the scope of the registration.

63. Added to this, the invoices exhibited in evidence have the description of the services redacted, which does not assist. Finally, whilst the turnover figures are not insignificant, some of the invoices produced in evidence are for very high amounts, such as £180,000 and over £75,000, which begs the question of how many customers the turnover corresponds to. Finally, there is no evidence about market share, but

[5] Exhibits WH3 page 31 and WH4

given the high value of the services involved it seems to me that the opponent's sales figures indicate a very tiny percentage of the overall market.

64. Bearing in mind all of the above, I am not satisfied that the use shown is sufficient establish enhanced distinctiveness.

Likelihood of confusion

65. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must 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. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

66. Earlier in this decision I found that:

- The IR and the earlier mark are visually, aurally and conceptually similar to a high degree.

- Some of the services are identical, whilst other goods and services are similar to a medium degree.

- The average consumer will select the goods and services mainly visually, with a degree of attention of attention ranging from medium to above medium.

- The earlier mark is distinctive to a medium degree.

67. Bearing in mind all of the above, I consider that given the high degree of similarity between the marks which share the dominant and distinctive component 'ELSE', the

descriptiveness or weakness of the differentiating element ‘APP’, and the normal degree of distinctive character of the earlier mark, consumers will directly confuse the marks when encountering them on identical or similar goods and services. Alternatively, if consumers notice the differences between the marks, they will consider the holder’s mark as a variant mark adding a descriptive/allusive element to the opponent’s brand ‘ELSE’. There is a likelihood of confusion in relation to the goods and services which I have found to be similar.

Section 5(3)

68. Section 5(3) states:

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

69. In *General Motors,* Case C-375/97, the CJEU held that:

> “25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

70. In *Spirit Energy Limited* v *Spirit Solar Limited* - BL O/034/20 – Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for Section 5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of Section 5(3).

71. In *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor* [2022] EWHC 319, HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of Section 10(3) – the latter is essentially a Section 5(3) claim for the purpose of infringement proceedings. The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. The claimants had provided dining vouchers worth about £17,000 to charities and there had been some press coverage and awards but only 7 such articles appear to have been in evidence. The judge stated that, although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The

judge concluded that the evidence satisfied the 'geographic' aspect of the test but not the 'economic' one, and that the use was not sufficient to establish that the claimants' mark had a reputation.

72. Further examples of insufficient reputation are *Supreme Petfoods Limited v Henry Bell & Co (Grantham) Limited,* [2015] EWHC 256 (Ch) and *Jadebay and Anor v Clarke-Coles Limited* [2017] EWHC 1400 (IPEC).

73. The above are examples showing that turnover in millions of pounds does not necessarily result in reputation being established. While the above examples are not on all fours with the present case, I consider that their outcomes are equally applicable here. As it will be recalled there are no marketing figures and the evidence about marketing is scant. Further, in the grand scheme of things, the opponent's turnover appears to amount to a very limited number of customers and to a minuscule share of the relevant market for the services concerned. Lastly, it is common for findings of reputation to mirror those for an enhanced distinctiveness, especially where the assessment is based on the same evidence, same relevant territory and aimed at the same relevant date. Therefore, taking into account what I have said at paragraphs 55 to 64 above, I find that the opponent's evidence is not sufficiently strong to establish a qualifying reputation for the purposes of Section 5(3).

74. The opposition under Section 5(3) fails.

Section 5(4)(a)

75. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) […]

(b) […]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

76. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

77. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

78. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent

intent, although a fraudulent intent is not a necessary part of the cause of action."

The relevant date for Section 5(4)(a)

79. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:
>
> > 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

80. The *prima facie* relevant date is the date the contested mark was filed. Hence, the relevant date in these proceedings is the priority date of 09 August 2022.

Goodwill

81. Notwithstanding what I have said about the nature of the services provided being unclear, I will assume that the opponent had a more than trivial (and actionable) goodwill at the relevant date for the services claimed, i.e. *design; design consultancy; product design; branding; digital design; design agency services; digital design agency services.* However, in my view, the services relied upon should be restricted to services not related to design of software. Based on these services, the opponent's position would already be less favourable than the one I have assessed under Section

5(2)(b). This is because most of the goods and services which I found to be identical or similar were such on the basis that the registered services include services related to the design of software; that overlap no longer existing under Section 5(4)(a), I would find that the goods and services are mostly dissimilar. Further, in *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that *"a substantial number"* of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises,* it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

82. Accordingly, even if I was wrong on this point and the contested goods and services were identical/similar to the opponent's services to the same extent as those which I have found to be identical/similar under Section 5(2)(b), the opponent's objection under this ground cannot succeed to a larger extent than that under Section 5(2)(b).

OUTCOME

83. The opposition has been successful in relation to the following goods and services which will be refused protection in the UK:

> **Class 9:** *Software (recorded programs); downloadable computer software applications.*
>
> **Class 42:** *Design, writing (design), development, installation, maintenance or update of software; software rental; design, development, installation, maintenance, update and rental of software and programs for analytical use, digital flow control, cyber security, protection of access to computer and telecommunications systems; programming for computers and for mobile devices and particularly for telephones; Software as a Service (SaaS); advice*

regarding information technology; advice, auditing and providing information with respect to cybersecurity.

84. The opposition has failed in relation to the following goods and services for which the IR will proceed to being granted protection in the UK:

Class 9: *educational software; game software; downloadable applications for mobile devices; telephone and digital platform; content recorded on digital, multimedia or video media; downloadable music files or images.*

Class 41: *Education; training; education and training with respect to the responsible use of telecommunication apparatus, computers or telephones; entertainment; sporting and cultural activities; providing information with respect to entertainment, education, training, sporting and cultural activities; photography services; electronic publication of books and journals online; editing and publishing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; providing texts other than advertising texts, images, books, newsletters, reviews, newspapers and/or magazines; rental and lending of books and of musical and/or audiovisual works; providing recreational facilities; providing non-downloadable films via video-on-demand services; production of multimedia, audio and video recording programs, films, games, radio or television programs; production, creation of musical and/or audiovisual works; booking of seats for shows; organization of competitions (education or entertainment); organization and conducting of colloquiums, conferences, congresses; organization and conducting of exhibitions for cultural or educational purposes; organization of sporting, cultural, musical and educational events; providing information with respect to music, shows, sport, leisure; organization of internships (education, training); organizing award and prize-giving ceremonies (entertainment); game services provided online from a computer network.*

COSTS

85. Since each party has achieved a measure of success, I order each party to bear their own costs.

Dated this 6th day of October 2025

TERESA PINTO
For the Registrar