

**O/0979/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
INTERNATIONAL REGISTRATION NO. WO0000001689788  
DESIGNATING THE UK OF HYPHEN-GROUP S.R.L.  
FOR THE FOLLOWING TRADE MARK:**

**HYPHEN**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 440319  
BY COSINE UK LIMITED**

## BACKGROUND AND PLEADINGS

1. International trade mark no. WO0000001689788 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Hyphen-Group S.r.l. The IR is registered with effect from 11 March 2022 and claims a priority date of 13 September 2021.<sup>1</sup> With effect from 11 March 2022, 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:** *Computer software and hardware; downloadable cloud computer software; computer operating systems; interactive software; integrated software packages; computer software platforms, recorded or downloadable; computer software for image processing; computer software for digital image processing and for enhancing digital image quality, integrated circuits for digital image processing and for enhancing the quality of digital images; data processing systems; computer programmes for data processing; software for the automation of industrial processes; computer software for application and database integration; software for the management and interpretation of data in the industrial and service fields; software for the control and management of industrial processes; software for collecting information; computer software for the automation and management of business processes; computer software and application software tools for business process, office automation and data management; artificial intelligence software; data processing apparatus with artificial intelligence; intercommunication apparatus with artificial intelligence; business intelligence software; software, in particular software for the creation, management, maintenance and operation of digital twins; simulation software; instrumentation simulators; computer programs and database software, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation; software*

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<sup>1</sup> Priority country: Italy; TM from which priority claimed: 302021000153890.

*for machine learning; analytical software; computer software for processing market information; computer software to enable the searching of data; downloadable applications for use with mobile devices; interface equipment; computer software for controlling the operation of audio, video and photography devices; data communication and processing apparatus; data loggers; data storage devices; data processing equipment; computer hardware for remotely accessing and transmitting data; machine readable data carriers, provided with programs and data, of all types, in particular CDs, DVDs, streamers, zip-drives, USB sticks, optical data carriers, optical discs and magnetic data carriers.*

**Class 35:** *Business consulting for enterprises; business management and organization consultancy; assistance, advice and consultancy in relation to business analysis; business consultancy relating to the administration of information technology; development of processes for the analysis and implementation of business strategy plans and business project management; business process re-engineering; brand positioning services, brand development; customer experience design and analysis; market research and market analysis; promotion of companies on the internet and other media, presentation of companies on the Internet and other media; compilation and systemisation of information and providing thereof to customers.*

**Class 42:** *Design, development, installation and maintenance of computer software and software tools and consultancy thereof; development of software application solutions; cloud computing; electronic image processing; digital image services [digitalization and scanning of images]; design and development of image processing software; digitisation of images; digital image retouching; digital image enhancement; scientific research and analysis in relation to the following fields: strategy, marks, digital technologies and digital transformation; technological services, namely development of computing strategies for companies; technological consultancy and analysis in the design, development and application of operating systems and information technology; technological consultancy in the field of information systems and information technology including project management; design, development and upkeep of digital presence, namely, websites, online shops, mobile applications, social*

*media platforms; technological consultancy and consultancy in the field of computer project management relating to the development of multimedia products and services; software as a service (SaaS), software as a service [SaaS] for providing artificial intelligence, analysis and automation and for providing IT services, cognitive application services, test verification and business process automation; development of digital dual technology for agile software delivery; software as a service [SaaS] for use by agile developers in developing and distributing all applications; recovery, analysis and processing of encoded information incorporated in products and product components; uploading of information to a cloud computing system or a distributed blockchain system; creation of digital twins of a physical product; creation of product profiles and association thereof with a physical product for product authentication purposes; brand protection, tracking and tracing of products and product components; design and development of computer software for logistics, supply chain management and e-business portals; creation, maintenance, servicing and adaptation of software, in particular artificial intelligence and business intelligence software, software for collecting information, analytical software, automatic learning software, data processing software, software for the integration of applications and databases, software for the integration of other software, simulation software, software for the creation, management and maintenance of digital twins; design and development of computer software for process control; design and development of software for controlling industrial processes; data duplication and conversion services, data coding services being computer programming; design and development of computer software for reading, transmitting and organising data; IT security services in the nature of protection and recovery of computer data; telecommunications engineering; engineering for process technology; engineering relating to the automation of industrial processes; engineering relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; research, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; quality control relating to software, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data*

*processing; technical transformation and redesigning of process management and quality management systems; providing of cloud services, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation.*

2. The request to protect the IR was published on 20 January 2023. On 18 April 2023, Cosine UK Limited (“the opponent”) opposed the protection of the IR in the UK based upon Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under Sections 5(2)(b), the opponent relies upon the single earlier mark shown below and the services covered by it:

UK00003274551

**HYPHEN**

Filing date: 01 December 2017

Registration date: 29 June 2018

**Class 35:** *Advertising, marketing, promotional and public relations services; advertising, promotional, public relations and marketing communications; advertising agency, marketing agency, promotional agency and public relations agency services; project management services; interactive and non-interactive marketing; marketing studies; online and internet advertising, promotion and marketing services; internet keyword marketing services; experiential marketing, promotion and advertising services and campaigns; virtual marketing, promotion and advertising services and campaigns; viral marketing, promotion and advertising services and campaigns; video marketing, promotion and advertising services and campaigns; creation of advertising campaigns; creation of advertisements, creation and arrangement of commercial sponsorships for advertising, marketing and promotional purposes; public relations services; field marketing; business consulting services; organisation and exhibitions and trade fairs for commercial and advertising purposes; marketing, advertising and consultancy services in relation to brand*

*strategies, brand relationships, customer relationship marketing, loyalty marketing and consumer targeting; segmentation and profiling of market data; database marketing; analysis of consumer responses to advertising; creation and development of retail strategies; business merchandising display services for optimising the utilisation of retail floor space; business and marketing studies relating to business, marketing and marketing information; business analysis relating to business, marketing and marketing information; preparation, compilation and analysis of statistics relating to business, marketing and marketing information; compilation of databases relating to business, marketing and marketing information; advertising services in relation to data mining, data manipulation, data cleansing, data transformation, data operations and transmission of data; providing on-line information relating to advertising and business consultancy services; marketing research services; retail research services; trend analysis services being business statistic, investigation and research services; trend analysis services being business statistic, investigation and research services for sales and business consultancy, marketing, advertising and promotional purposes; reprographic services; advertising services relating to packaging; public relations services, namely management of news and press coverage and stories; communications services for public relations purposes; creating advertising and/or public relations press releases; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, public relations purposes; consultancy, advice and information services relating to brands, brand identity and brand development; provision of information, advisory and consultancy services in relation to the aforementioned services; arranging of product launch events, product awareness campaigns and pop-up shops; events for promoting and encountering brands; media rights services, namely asset management; business promotion using social media to plan meetings, events and interactive pages where people using social media to encounter and experience the brand; none of the aforesaid related to human resources, vendor management or contingent labour services, including IT services and solutions in the fields of human resources, vendor management or contingent labour sourcing and management.*

**Class 41:** *Parties/events for raising awareness of brands; photographic services; entertainment services being film services, video services, music services; film services, namely film production, film post-production, film direction, film editing, film hire, film distribution, film studio services, entertainment by film, film performance, showing of films, presentation of films, provision of nondownloadable films, provision of facilities for production of films; video services, namely video production, video post-production, video direction, video editing, video hire, video distribution, video studio services, entertainment by video, video performance, showing of videos, presentation of video, provision of nondownloadable videos, provision of facilities for production of videos; music services, namely music instruction, music performance, music concerts, music publishing, musical entertainment, music recording, live music shows and performances, music production, music composition, production of music shows, publishing of musical works, provision of non-downloadable music from the internet, music studio services, provision of facilities for production and recording of music; photographic, film, video services, being production services; education, instruction, seminar and training services; cultural activities; consumer, customer, staff and employee education, instruction and training for sales, management, administration, marketing, advertising, public relations, financial management; provision of educational information through a database or the internet; online training, instruction and education services; music, video and film entertainment services; producing video compilations; selection and compilation of video and sound recordings; booking of events and competitions, tickets and seats; arranging and conducting colloquiums, exhibitions, concerts, entertainment events, conferences, congresses, seminars, symposiums, festivals, fairs, circuses, shows, workshops, fashion shows and contests; scriptwriting services; ghostwriting services; news reporter services; entertainment by way of pre-recorded messages and video messages; music, video and media recording, recording studio, and production services; publication and publishing services, including online and over the internet; cinema presentations; disc jockey and dj services; organizing, producing, arranging and curating entertainment, recreational, educational and cultural events; game shows; the organisation of sporting events and online gaming events ; games offered on-line and from a computer network; gambling services and betting services; entertainment services being provision of*

*virtual or online environments within which users can interact for recreational, competition, gaming, leisure or entertainment purposes; entertainment, education and publishing services provided by way of blogs and online forums; entertainment and education services provided by way of podcasts; provision of web based programmes for mobile communications devices, being nondownloadable media, multimedia, audiovisual media, games and publications; entertainment and education services by way of music and media provided through the internet or mobile telephone communication; entertainment and education services on social networking websites; the provision of on-line electronic publications and digital music (not downloadable) from the Internet; production, preparation, exhibition, distribution and rental of video, audio, audiovisual and radio programmes and of films, animated films, sound and video recordings and live events, including through interactive media, including on the internet; provision of recreational and entertainment facilities; provision of digital music (not downloadable) supplied from MP3 websites on the Internet; fan club services; providing digital music (not downloadable) from MP3 Internet websites; booking agencies; text, image, sound and video editing services; music, video and photographic composition services; provision of podcasts; video recording, taping, editing, production, exhibition; arranging of festivals, retailer brand engagement events; advisory and consultancy services relating to the aforementioned services; none of the aforesaid related to human resources, vendor management or contingent labour services, including IT services and solutions in the fields of human resources, vendor management or contingent labour sourcing and management.*

**Class 42:** *Design services; provision of websites relating to any of the aforesaid services; prototypes and rollout design services; design of point of sale material (graphic design); design of point of sale advertising material; design of customer information leaflets (graphic design); design of customer information leaflets for advertising purposes; design, drawing and commissioned writing, all for the compilation of webpages; creating, testing and maintaining websites; hosting the websites of others; installing websites; design services relating to brands, brand identity and brand development; software-as-service services for advertising, marketing, promotional, public relations purposes; search engine services; digital*

*coding services; coding of messages; consultancy services in relation to data mining, data manipulation, data cleansing, data transformation, data operations; information, research, evaluation and consultancy services relating to any of the aforesaid; creation of formats for media, television, music and video; none of the aforesaid related to human resources, vendor management or contingent labour services, including IT services and solutions in the fields of human resources, vendor management or contingent labour sourcing and management.*

**Class 45:** *Online social networking services; social introduction and networking services; intellectual property licensing and management; personal and social services rendered to meet the needs of individuals, being socialpolitical, sociological and political information services, including provided from searchable indexes and databases of information, including text, electronic documents, databases, graphics, video and audio visual information, on computer and communication networks, namely private investigation and legal research services; licensing of computer software and other technology; provision of information, advisory and consultancy services in relation to the aforesaid services.*

3. By virtue of its earlier priority 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 had not been registered for five years or more at the priority date of the IR,<sup>2</sup> it is not subject to the use conditions under Section 6A of the Act. Consequently, the opponent may rely upon 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 identical or similar, and the marks are similar, both incorporating the identical word “HYPHEN” as the dominant feature of the marks.

5. Under Section 5(4)(a), the opponent relies upon the unregistered sign ‘HYPHEN’ which it is said have been used throughout the UK since January 2018 in respect of marketing services as well as in relation to the goods and services covered by the

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<sup>2</sup> 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.

earlier mark. The opponent claims that it has achieved a turnover of approximately £1.3 million in 2018, increasing to £2.1 million in 2019 and that its clients include Vodafone, Shell, Nestle, Energizer, LG, Asda, Honda and Merlin Entertainments. The opponent also states that its 'HYPHEN' business has featured extensively in the marketing press, including a ranking in the Bizzabo Blog Top UK Event Agencies 2020, the Clutch Top Experiential Marketing Agencies in the UK in 2023; and was ranked no. 6 out of the UK Top 60 Experiential Marketing Agencies by The Manifest business guide in March 2023. By reason of these matters, the opponent states, it has acquired a substantial reputation and goodwill in connection with the sign 'HYPHEN' and the IR should be refused protection in the UK because its use by the holder 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 the opponent. As a result, the opponent is likely to suffer damage.

6. The holder filed a defence and counterstatement, denying the opponent's claims with the exception of the similarity of the marks which is not addressed. In particular, having denied the similarity of the goods and services, the holder submits that since it has used the mark 'HYPHEN' in the UK in respect of the goods and services for which the IR seeks protection since at least 2014 *"should any of the goods and services of the [IR] be deemed identical or similar to the services of the [earlier mark], then due to the [holder]'s prior use, the [holder] has grounds to invalidate the opponent's registered trade mark."* Likewise, in relation to the objection based upon Section 5(4)(a), the holder contends that *"due to the [holder]'s longstanding use of the mark 'HYPHEN' in the UK, the [holder] denies the opponent's claims that the [IR] should be refused registration under Section 5(4)(a) of the Trade Marks Act 1994, and requests that the grounds of opposition under this head are dismissed in their entirety."*

7. The opponent is represented by Decisis Limited, and the holder is represented by Cleveland Scott York.

8. 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**

9. 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**

10. The opponent's evidence came in the form of seven witness statements from the following witnesses:

- Luci Beaufort-Dysart, the director of Hyphen, an experiential marketing agency operating as part of the opponent's company, which it is also part of the opponent's sales and marketing group. Ms Beaufort-Dysart's witness statement is dated 25 September 2023 and is accompanied by 17 exhibits being those labelled LBD1 to LBD17. Her evidence goes to the use of the brand 'HYPHEN' in relation to the aforementioned experiential event agency.
- Michael Bilewycz, a registered trade mark attorney and managing director at Decisis Limited, the opponent's representative in these proceedings. Mr Bilewycz's witness statement is dated 25 September 2023 and is accompanied by one exhibit being that labelled MB1. His evidence is aimed at showing that prior to launching the present opposition, the opponent had sent a pre-action letter to the holder to which the holder did not respond. This, Mr Bilewycz alleges, demonstrates that by not responding to the pre-action letter and defending the opposition instead, the holder displayed a deliberate intention to deceive or cause confusion.
- Guy Ousey, the head of audience engagement at IGD, a research and learning organisation delivering commercial insight to the food and consumer goods

industry. Mr Ousey's witness statement is dated 21 September 2023. His evidence is that the opponent's Hyphen agency is one of his *"go to' agencies and [he has] commissioned work with Hyphen and recommended them to current industry contacts."*

- Dom Burch, the managing director of Why Social a strategic marketing consultancy and social media expert. Mr Burch's witness statement is dated 15 September 2023. His evidence is that he has worked with the opponent's Hyphen agency which he considers to be the *"best in class in the marketing industry for both its unrivalled creativity and its professional events activation."*
- Sarah Yeats, the managing director of Sledge, an award-winning creative live experiences agency. Ms Yeats' witness statement is dated 22 September 2023. She gave evidence that during her time working in the marketing industry she has been aware of the opponent's Hyphen agency, their work and reputation since they launched the business in 2018 when she read about them in Campaign magazine (an industry publication). As a competitor agency to her company, Ms Yeats says that she has followed their progress over the years via industry publications, social media and through Micebook of which they are also members and concludes that in her view *"any reference to Hyphen in the context of the marketing industry would refer exclusively to the [opponent's] Hyphen Agency"*.
- Chetan Shah, the CEO and founder of Micebook which is described as *"a revolutionary online community for event agencies and suppliers which is endorsed by notable global brands"*. Mr Shah's witness statement is dated 22 September 2023. His evidence is that he became aware of Hyphen in 2018 having read about their launch in industry publications and that in March 2020 he launched an agency leaders programme to encourage collaboration and networking between agency leaders of which Luci Beaufort-Dysart (i.e. the director of Hyphen) is part. Mr Shah also states that in his view *"any reference to Hyphen in the context of the marketing industry would refer exclusively to the*

*[opponent's] Hyphen Agency"* and that he is not aware of any other agencies in the UK who operate in this space with the same name.

- Sophia Weir, the founder of Jamsheer Ltd and shareholder of Hubly Technologies Ltd. Ms Weir's witness statement is dated 21 September 2023. Her evidence is that having worked in the retail sector for over 10 years, she was aware of Hyphen and their exemplary reputation within industry. Ms Weir also states that in her view "*any reference to Hyphen in the context of the marketing industry would refer exclusively to the [opponent's] Hyphen Agency.*"

11. I do not intend to summarise the evidence (or submissions) beyond what I have set out above. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

## **PRELIMINARY REMARKS**

12. There are a number of arguments from both parties which are either entirely devoid of substance, or of very limited assistance as I will now clarify.

13. First, in its statement of grounds the opponent referred to facts such as turnover which, in order to be considered, should have been re-filed in proper evidential format. As long as these facts are reflected in evidence filed, I will consider them.

14. Second, the holder states *that "should any of the goods and services of the [IR] be deemed identical or similar to the services of the [earlier mark], then due to the [holder]'s prior use, the [holder] has grounds to invalidate the opponent's registered trade mark."* The holder's argument cannot succeed. This is because the issue of earlier use has no bearing upon the instant opposition proceedings (and, in any event, the holder did not provide any evidence to substantiate its claim). Tribunal Practice Notice 4/2009 "*Trade mark opposition and invalidation proceedings – defences*", under the heading "*The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark*", outlines the approach. It states:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

15. As far as I am aware, at no time did the holder seek to invalidate the opponent’s earlier mark, thus, the existence of a prior right (even if had been established) would be irrelevant to the issue I have decided.

16. Lastly, five of the opponent’s witnesses gave opinion evidence about the level of notoriety of the opponent’s agency based on their personal experience rather than on factual evidence. The evidence provided by those witnesses lacks in any details about the opponent’s reputation within the relevant market to be almost worthless. Likewise, Mr Bilewycz’s evidence that the holder elected not to reply to the pre-action letter and then proceeded to file a defence in response to the present opposition is neither here nor there, and certainly does not establish intention to deceive.

## **DECISION**

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

17. 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.”

18. 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**

19. 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.”

20. 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.

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 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. 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.”

23. 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.”

24. 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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

25. The competing goods and services are as follows:

The holder's goods and services	The opponent's services
<p><b>Class 9:</b> <i>Computer software and hardware; downloadable cloud computer software; computer operating systems; interactive software; integrated software packages; computer software platforms, recorded or downloadable; computer software for image processing; computer software for digital image processing and for enhancing digital image quality, integrated circuits for digital image processing and for enhancing the quality of digital images; data processing systems; computer programmes for data processing; software for the automation of industrial processes; computer software for application and database integration; software for the management and interpretation of data in the industrial and service fields; software for the control and management of industrial processes; software for collecting information; computer software for the automation and management of business processes; computer software and application software tools for business process, office automation and data management; artificial intelligence software; data processing apparatus with artificial intelligence;</i></p>	

*intercommunication apparatus with artificial intelligence; business intelligence software; software, in particular software for the creation, management, maintenance and operation of digital twins; simulation software; instrumentation simulators; computer programs and database software, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation; software for machine learning; analytical software; computer software for processing market information; computer software to enable the searching of data; downloadable applications for use with mobile devices; interface equipment; computer software for controlling the operation of audio, video and photography devices; data communication and processing apparatus; data loggers; data storage devices; data processing equipment; computer hardware for remotely accessing and transmitting data; machine readable data carriers, provided with programs and data, of all types, in particular CDs, DVDs,*

<p><i>streamers, zip-drives, USB sticks, optical data carriers, optical discs and magnetic data carriers.</i></p>	
<p><b>Class 35:</b> <i>Business consulting for enterprises; business management and organization consultancy; assistance, advice and consultancy in relation to business analysis; business consultancy relating to the administration of information technology; development of processes for the analysis and implementation of business strategy plans and business project management; business process re-engineering; brand positioning services, brand development; customer experience design and analysis; market research and market analysis; promotion of companies on the internet and other media, presentation of companies on the Internet and other media; compilation and systemisation of information and providing thereof to customers.</i></p>	<p><b>Class 35:</b> <i>Advertising, marketing, promotional and public relations services; advertising, promotional, public relations and marketing communications; advertising agency, marketing agency, promotional agency and public relations agency services; project management services; interactive and non-interactive marketing; marketing studies; online and internet advertising, promotion and marketing services; internet keyword marketing services; experiential marketing, promotion and advertising services and campaigns; virtual marketing, promotion and advertising services and campaigns; viral marketing, promotion and advertising services and campaigns; video marketing, promotion and advertising services and campaigns; creation of advertising campaigns; creation of advertisements, creation and arrangement of commercial sponsorships for advertising, marketing and promotional purposes; public relations services; field marketing; business consulting services; organisation and exhibitions and trade fairs for commercial and advertising purposes; marketing, advertising and</i></p>

	<p><i>consultancy services in relation to brand strategies, brand relationships, customer relationship marketing, loyalty marketing and consumer targeting; segmentation and profiling of market data; database marketing; analysis of consumer responses to advertising; creation and development of retail strategies; business merchandising display services for optimising the utilisation of retail floor space; business and marketing studies relating to business, marketing and marketing information; business analysis relating to business, marketing and marketing information; preparation, compilation and analysis of statistics relating to business, marketing and marketing information; compilation of databases relating to business, marketing and marketing information; advertising services in relation to data mining, data manipulation, data cleansing, data transformation, data operations and transmission of data; providing on-line information relating to advertising and business consultancy services; marketing research services; retail research services; trend analysis services being business statistic, investigation and research services; trend analysis services being business statistic, investigation and research services for sales and business</i></p>
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	<p><i>consultancy, marketing, advertising and promotional purposes; reprographic services; advertising services relating to packaging; public relations services, namely management of news and press coverage and stories; communications services for public relations purposes; creating advertising and/or public relations press releases; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, public relations purposes; consultancy, advice and information services relating to brands, brand identity and brand development; provision of information, advisory and consultancy services in relation to the aforementioned services; arranging of product launch events, product awareness campaigns and pop-up shops; events for promoting and encountering brands; media rights services, namely asset management; business promotion using social media to plan meetings, events and interactive pages where people using social media to encounter and experience the brand; none of the aforesaid related to human resources, vendor management or contingent labour services, including IT services and solutions in the fields of</i></p>
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	<p><i>human resources, vendor management or contingent labour sourcing and management.</i></p>
	<p><b>Class 41:</b> <i>Parties/events for raising awareness of brands; photographic services; entertainment services being film services, video services, music services; film services, namely film production, film post-production, film direction, film editing, film hire, film distribution, film studio services, entertainment by film, film performance, showing of films, presentation of films, provision of nondownloadable films, provision of facilities for production of films; video services, namely video production, video post-production, video direction, video editing, video hire, video distribution, video studio services, entertainment by video, video performance, showing of videos, presentation of video, provision of nondownloadable videos, provision of facilities for production of videos; music services, namely music instruction, music performance, music concerts, music publishing, musical entertainment, music recording, live music shows and performances, music production, music composition, production of music shows, publishing of musical works, provision of non-downloadable music from the internet, music studio services, provision</i></p>

	<p><i>of facilities for production and recording of music; photographic, film, video services, being production services; education, instruction, seminar and training services; cultural activities; consumer, customer, staff and employee education, instruction and training for sales, management, administration, marketing, advertising, public relations, financial management; provision of educational information through a database or the internet; online training, instruction and education services; music, video and film entertainment services; producing video compilations; selection and compilation of video and sound recordings; booking of events and competitions, tickets and seats; arranging and conducting colloquiums, exhibitions, concerts, entertainment events, conferences, congresses, seminars, symposiums, festivals, fairs, circuses, shows, workshops, fashion shows and contests; scriptwriting services; ghostwriting services; news reporter services; entertainment by way of pre-recorded messages and video messages; music, video and media recording, recording studio, and production services; publication and publishing services, including online and over the internet; cinema presentations; disc jockey and dj services; organizing,</i></p>
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	<p><i>producing, arranging and curating entertainment, recreational, educational and cultural events; game shows; the organisation of sporting events and online gaming events ; games offered on-line and from a computer network; gambling services and betting services; entertainment services being provision of virtual or online environments within which users can interact for recreational, competition, gaming, leisure or entertainment purposes; entertainment, education and publishing services provided by way of blogs and online forums; entertainment and education services provided by way of podcasts; provision of web based programmes for mobile communications devices, being nondownloadable media, multimedia, audiovisual media, games and publications; entertainment and education services by way of music and media provided through the internet or mobile telephone communication; entertainment and education services on social networking websites; the provision of on-line electronic publications and digital music (not downloadable) from the Internet; production, preparation, exhibition, distribution and rental of video, audio, audiovisual and radio programmes and of films, animated films, sound and video recordings and</i></p>
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	<p><i>live events, including through interactive media, including on the internet; provision of recreational and entertainment facilities; provision of digital music (not downloadable) supplied from MP3 websites on the Internet; fan club services; providing digital music (not downloadable) from MP3 Internet websites; booking agencies; text, image, sound and video editing services; music, video and photographic composition services; provision of podcasts; video recording, taping, editing, production, exhibition; arranging of festivals, retailer brand engagement events; advisory and consultancy services relating to the aforementioned services; none of the aforesaid related to human resources, vendor management or contingent labour services, including IT services and solutions in the fields of human resources, vendor management or contingent labour sourcing and management.</i></p>
<p><b>Class 42:</b> <i>Design, development, installation and maintenance of computer software and software tools and consultancy thereof; development of software application solutions; cloud computing; electronic image processing; digital image services [digitalization and scanning of images]; design and</i></p>	<p><b>Class 42:</b> <i>Design services; provision of websites relating to any of the aforesaid services; prototypes and rollout design services; design of point of sale material (graphic design); design of point of sale advertising material; design of customer information leaflets (graphic design); design of customer information leaflets</i></p>

development of image processing software; digitisation of images; digital image retouching; digital image enhancement; scientific research and analysis in relation to the following fields: strategy, marks, digital technologies and digital transformation; technological services, namely development of computing strategies for companies; technological consultancy and analysis in the design, development and application of operating systems and information technology; technological consultancy in the field of information systems and information technology including project management; design, development and upkeep of digital presence, namely, websites, online shops, mobile applications, social media platforms; technological consultancy and consultancy in the field of computer project management relating to the development of multimedia products and services; software as a service (SaaS), software as a service [SaaS] for providing artificial intelligence, analysis and automation and for providing IT services, cognitive application services, test verification and business process automation; development of digital dual technology for agile software delivery; software as a service [SaaS] for use by agile developers in developing and

for advertising purposes; design, drawing and commissioned writing, all for the compilation of webpages; creating, testing and maintaining websites; hosting the websites of others; installing websites; design services relating to brands, brand identity and brand development; software-as-service services for advertising, marketing, promotional, public relations purposes; search engine services; digital coding services; coding of messages; consultancy services in relation to data mining, data manipulation, data cleansing, data transformation, data operations; information, research, evaluation and consultancy services relating to any of the aforesaid; creation of formats for media, television, music and video; none of the aforesaid related to human resources, vendor management or contingent labour services, including IT services and solutions in the fields of human resources, vendor management or contingent labour sourcing and management.

*distributing all applications; recovery, analysis and processing of encoded information incorporated in products and product components; uploading of information to a cloud computing system or a distributed blockchain system; creation of digital twins of a physical product; creation of product profiles and association thereof with a physical product for product authentication purposes; brand protection, tracking and tracing of products and product components; design and development of computer software for logistics, supply chain management and e-business portals; creation, maintenance, servicing and adaptation of software, in particular artificial intelligence and business intelligence software, software for collecting information, analytical software, automatic learning software, data processing software, software for the integration of applications and databases, software for the integration of other software, simulation software, software for the creation, management and maintenance of digital twins; design and development of computer software for process control; design and development of software for controlling industrial processes; data duplication and conversion services, data coding services being computer programming;*

*design and development of computer software for reading, transmitting and organising data; IT security services in the nature of protection and recovery of computer data; telecommunications engineering; engineering for process technology; engineering relating to the automation of industrial processes; engineering relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; research, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; quality control relating to software, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; technical transformation and redesigning of process management and quality management systems; providing of cloud services, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation.*

	<p><b>Class 45:</b> <i>Online social networking services; social introduction and networking services; intellectual property licensing and management; personal and social services rendered to meet the needs of individuals, being socialpolitical, sociological and political information services, including provided from searchable indexes and databases of information, including text, electronic documents, databases, graphics, video and audio visual information, on computer and communication networks, namely private investigation and legal research services; licensing of computer software and other technology; provision of information, advisory and consultancy services in relation to the aforesaid services.</i></p>
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**Class 9:** *Computer software and hardware; downloadable cloud computer software; computer operating systems; interactive software; integrated software packages; computer software platforms, recorded or downloadable; computer software for image processing; computer software for digital image processing and for enhancing digital image quality, integrated circuits for digital image processing and for enhancing the quality of digital images; data processing systems; computer programmes for data processing; software for the automation of industrial processes; computer software for application and database integration; software for the management and interpretation of data in the industrial and service fields; software for the control and management of industrial processes; software for collecting information; computer software for the automation and management of business processes; computer software and application software tools for business process, office automation and data management; artificial intelligence software; data processing apparatus with artificial intelligence; intercommunication apparatus with artificial intelligence; business*

intelligence software; software, in particular software for the creation, management, maintenance and operation of digital twins; simulation software; instrumentation simulators; computer programs and database software, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation; software for machine learning; analytical software; computer software for processing market information; computer software to enable the searching of data; downloadable applications for use with mobile devices; interface equipment; computer software for controlling the operation of audio, video and photography devices; data communication and processing apparatus; data loggers; data storage devices; data processing equipment; computer hardware for remotely accessing and transmitting data; machine readable data carriers, provided with programs and data, of all types, in particular CDs, DVDs, streamers, zip-drives, USB sticks, optical data carriers, optical discs and magnetic data carriers.

26. Along with his submissions in lieu, the opponent filed an annex setting out a table in which it identifies the goods and services that it considers to be similar and those that it considers to be identical to the opponent's services. However, the table is of very limited assistance since it says nothing about why the services are considered to be similar (or identical). The only comments the opponent made in relation to the contested goods in class 9 are as follows:

*"....reviewing the class 9 goods, it is submitted that all of those class 9 goods are similar to the Opponent's services, especially in classes 35 and 42, in that at a minimum they are complementary, since they are software and technology tools (e.g., software) essential to or important for use in providing the opponent's services. Even the specific items "software for the automation of industrial processes;" and "software for the control and management of industrial processes;" are arguably complementary to "project management services" and "business consulting services".*

27. The contested goods in class 9 are various type of software and hardware as well as apparatus and equipment such as interface equipment, simulators, data

communication and processing apparatus, data carriers and data storage devices. The opponent's services include a range of promotional, marketing, and business services in class 35, various entertainment, education and production services in class 41, various design services as well as services relating to websites and software as a service in class 42, and lastly, dating services, intellectual property licensing and management, and licensing of computer software in class 45.

28. It seems to me that the opponent's submission (i.e. that the contested software goods in class 9 are essential to or important for use in providing the opponent's services especially those in classes 35 and 42) fails to identify any concrete overlap between the respective goods and services. I say this because even if the holder's software goods might be used by the opponent in order to provide its services to the relevant public (for example, the opponent might use the holder's *computer software for image processing* in class 9 to deliver its *production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, public relations purposes* in class 35, or its film production services in class 41), this does not mean that the goods and services are similar (as suggested by the opponent). This is all of the more so, since nowadays software and hardware play a critical role in many aspects of our lives and in the provision of many disparate services. The nature, method of use, use and purpose of such goods and services are plainly different. Turning to trade channels, it is unlikely that the provider of the opponent's services would also offer the holder's software goods which are used for the delivery of the services, so there is no overlap in trade channels. On this point, I note that there is no evidence filed that suggests otherwise. On the contrary, in such scenario, the user of the holder's software goods (in class 9) will be the business providing the advertising, marketing, business, entertainment, educational, design, dating or legal/licensing services in classes 35, 41, 42 and 45 (i.e. the opponent), whereas the user of the opponent's services in classes 35, 41, 42 and 45 will be a business or an individual seeking the advertising, marketing, business, entertainment, educational, design, dating or legal/licensing services. As such, the user of the goods and services will not overlap either. In addition, the goods and services are neither complementary nor in competition. Finally, whilst it might be possible that the opponent's design services in class 42 might include the design of the holder's software in class 9, such an argument

has not been advanced by the opponent. Hence, I do not consider it appropriate to explore that type of argument in the absence of any clear submission from the opponent on the point. I am fortified in reaching this view by the comments made by Mr Ian Purvis, sitting as the Appointed Person in *SMARTX*, BL-O-0911/24, where he stated:

“27. On behalf of the Opponent, Mr Wood of Brandsmiths fairly accepted that the point had not been made. However, he submitted that the TM7 pleading was wide enough to cover the point (since it relied on ‘all’ the goods of the earlier marks and alleged ‘similarity’ in respect of all of them). In the circumstances, he contended, the Hearing Officer was obliged to compare each category of goods in the earlier marks and each category of goods in the Application, and to consider any points of similarity which might exist between them whether or not those points had been actually identified or relied on by the Opponent.

28. I do not accept this. As I have said, it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent.”

29. Having said that, the opponent’s specification covers *software-as-service services for advertising, marketing, promotional, public relations purposes* which I find to be similar to the holder’s terms Computer software; downloadable cloud computer software; interactive software; integrated software packages. This is because the holder’s terms are sufficiently broad to encompass software for advertising, marketing, promotional, public relations purposes, so although the nature of the goods and services is not the same, they have the same purpose and use, target the same users,

and are in competition as the relevant public might choose between buying the holder's software or accessing the same type of software through the opponent's services. **These goods are similar to a medium degree. However, the remaining goods in class 9 are dissimilar.**

### **Class 35**

Business consulting for enterprises; business management and organization consultancy; assistance, advice and consultancy in relation to business analysis; business consultancy relating to the administration of information technology; development of processes for the analysis and implementation of business strategy plans and business project management; business process re-engineering; brand positioning services, brand development; customer experience design and analysis; market research and market analysis; promotion of companies on the internet and other media, presentation of companies on the Internet and other media; compilation and systemisation of information and providing thereof to customers.

30. The holder's services in class 35 include business services as well as promotional and advertising services for businesses. The earlier mark covers various advertising, marketing and promotional services, as well as a number of business services in class 35. Clearly, the respective services are either identical or similar. Accordingly, I find as follows.

31. The contested brand positioning services, brand development; customer experience design and analysis; market research and market analysis; promotion of companies on the internet and other media, presentation of companies on the Internet and other media are all types of advertising, marketing and promotional services which fall within the opponent's term *advertising, marketing, promotional and public relations services*. **These services are identical on the principle outlined in *Meric*.**

32. The contested business consulting for enterprises; business management and organization consultancy; assistance, advice and consultancy in relation to business analysis; business consultancy relating to the administration of information technology are all types of business consultancy services which fall within the opponent's term

*business consulting services. These services are identical on the principle outlined in Meric.*

33. The contested compilation and systemisation of information and providing thereof to customers fall within the opponent's terms *preparation, compilation and analysis of statistics relating to business, marketing and marketing information; compilation of databases relating to business, marketing and marketing information*. If I am wrong, and the services are not identical, they are nonetheless highly similar because they have a similar nature, purpose, and use, all being business services consisting of the compilation of information (though the opponent's services do not involve the provision of the compiled information to customers). The services are likely to share trade channels and although they are not in competition, they are complementary, the compilation of information being indispensable for the provision of the same information to customers in such a way that customers may think that the responsibility for those services lies with the same undertaking. **These services are identical; alternatively, they are highly similar.**

34. The contested development of processes for the analysis and implementation of business strategy plans and business project management if not identical, are similar to the opponent's term *project management services*. This is because the holder's services are functional to, or part and parcel of, the opponent's services as they are delivered within the context of implementing the opponent's *project management services*. The services have the same nature and purpose, target the same business users, share trade channels and are complementary. **These services are identical; alternatively, they are highly similar.**

35. The term business process re-engineering in the holder's specification refers to a strategic management approach focused on redesigning business processes to achieve significant improvements. In my view, these services either fall within the opponent's terms *project management services* or are highly similar to the opponent's *business management and organization consultancy*, as the holder's services are effectively a type of business management service to which the opponent's consultancy services relate. **These services are identical; alternatively, they are highly similar.**

## **Class 42**

Design, development, installation and maintenance of computer software and software tools and consultancy thereof; development of software application solutions; cloud computing; electronic image processing; digital image services [digitalization and scanning of images]; design and development of image processing software; digitisation of images; digital image retouching; digital image enhancement; scientific research and analysis in relation to the following fields: strategy, marks, digital technologies and digital transformation; technological services, namely development of computing strategies for companies; technological consultancy and analysis in the design, development and application of operating systems and information technology; technological consultancy in the field of information systems and information technology including project management; design, development and upkeep of digital presence, namely, websites, online shops, mobile applications, social media platforms; technological consultancy and consultancy in the field of computer project management relating to the development of multimedia products and services; software as a service (SaaS), software as a service [SaaS] for providing artificial intelligence, analysis and automation and for providing IT services, cognitive application services, test verification and business process automation; development of digital dual technology for agile software delivery; software as a service [SaaS] for use by agile developers in developing and distributing all applications; recovery, analysis and processing of encoded information incorporated in products and product components; uploading of information to a cloud computing system or a distributed blockchain system; creation of digital twins of a physical product; creation of product profiles and association thereof with a physical product for product authentication purposes; brand protection, tracking and tracing of products and product components; design and development of computer software for logistics, supply chain management and e-business portals; creation, maintenance, servicing and adaptation of software, in particular artificial intelligence and business intelligence software, software for collecting information, analytical software, automatic learning software, data processing software, software for the integration of applications and databases, software for the integration of other software, simulation software, software for the creation, management and maintenance of digital twins; design and development of computer software for process control; design and development of software for controlling industrial processes; data duplication and conversion services, data coding

services being computer programming; design and development of computer software for reading, transmitting and organising data; IT security services in the nature of protection and recovery of computer data; telecommunications engineering; engineering for process technology; engineering relating to the automation of industrial processes; engineering relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; research, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; quality control relating to software, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; technical transformation and redesigning of process management and quality management systems; providing of cloud services, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation.

36. The opponent's design services are not restricted in any way and encompass the following services in the holder's specification: Design, development, installation and maintenance of computer software and software tools and consultancy thereof; design and development of image processing software; design, development and upkeep of digital presence, namely, websites, online shops, mobile applications, social media platforms; design and development of computer software for logistics, supply chain management and e-business portals; design and development of computer software for process control; design and development of software for controlling industrial processes; design and development of computer software for reading, transmitting and organising data; technical transformation and redesigning of process management and quality management systems. Admittedly, some of the services I have listed include services other than design services such as, for example, development, installation, maintenance and upkeep of goods. Nevertheless, these services can be provided in relation to goods that have been designed using the opponent's design services and are ancillary to them; although they might have a different nature, use and purpose, the services are highly complementary, target the same users and would be provided by the same providers through the same trade

channels. **These services are either identical or similar to, at least, a medium degree, to the opponent's design services.**

37. The same conclusions apply to the following services in the holder's specification: development of software application solutions; technological services, namely development of computing strategies for companies; technological consultancy and analysis in the design, development and application of operating systems and information technology; technological consultancy in the field of information systems and information technology including project management; technological consultancy and consultancy in the field of computer project management relating to the development of multimedia products and services; development of digital dual technology for agile software delivery; uploading of information to a cloud computing system or a distributed blockchain system; creation of digital twins of a physical product; creation of product profiles and association thereof with a physical product for product authentication purposes; creation, maintenance, servicing and adaptation of software, in particular artificial intelligence and business intelligence software, software for collecting information, analytical software, automatic learning software, data processing software, software for the integration of applications and databases, software for the integration of other software, simulation software, software for the creation, management and maintenance of digital twins; research, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; quality control relating to software, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; scientific research and analysis in relation to the following fields: strategy, marks, digital technologies and digital transformation.

38. Once again, these services are strictly related to the opponent's design services, the latter being so broad to encompass design of software, computing strategies, operating and information systems, multimedia products and services, digital dual technology for agile software delivery, cloud computing systems, digital twins of a physical product, product profiles, etc. As it can be seen, the services I have identified include (a) post-design activities such as the development, creation and quality control of technological goods and systems which may be designed using the opponent's

design services, (b) pre-design activities such as consultancy and research relating to goods that can be designed using the opponent's design services and (c) activities such as the uploading of information to a cloud computing system which could be designed using the opponent's design services.

39. Although the nature, use and purpose of the services are different, they are complementary, target the same users, and are likely to be provided by the same undertakings through the same trade channels. **These services are similar to a low to medium degree to the opponent's services.**

40. The holder's cloud computing; software as a service (SaaS), software as a service [SaaS] for providing artificial intelligence, analysis and automation and for providing IT services, cognitive application services, test verification and business process automation; software as a service [SaaS] for use by agile developers in developing and distributing all applications; providing of cloud services, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation are either identical or highly similar the opponent's *software-as-a-service services for advertising, marketing, promotional, public relations purposes*. This is because cloud computing and SaaS are the same thing. Cloud computing is a technology that allows users to access and store data and applications over the internet instead of on local servers or personal computers and Software as a Service (SaaS) is one of the three main models of cloud computing, alongside Platform as a Service (PaaS) and Infrastructure as a Service (IaaS). **These services are identical or similar to, at least, a medium degree because they are all SaaS type of services which consist in the provision of different types of software.**

41. The holder's recovery, analysis and processing of encoded information incorporated in products and product components; data duplication and conversion services, data coding services being computer programming; IT security services in the nature of protection and recovery of computer data; are either identical or similar to, at least, a medium degree to the opponent's *digital coding services; coding of messages; consultancy services in relation to data mining, data manipulation, data*

*cleansing, data transformation, data operations*. Although the services are not identically worded, they consist essentially in computer programming (coding) and processing, as well as protection and recovery of encoded information incorporated in products such as computers. **These services are identical or similar to, at least, a medium degree.**

42. Turning to the holder's *brand protection, tracking and tracing of products and product components*, the closest counterpart I can see is with the opponent's *design services relating to brands, brand identity and brand development*. Although the nature, use and purpose of the services differ, they both relate to the highly specialised field of branding; as such, the services are likely to target the same end-users and be provided by the same providers through the same trade channels. In addition, the services can be complementary, as for example, a business can seek services aimed at protecting its brand in conjunction with services aimed at strengthening and developing the brand identity. **These services are similar to a low to medium degree.**

43. Turning to the holder's *electronic image processing; digital image services [digitalization and scanning of images]; digitisation of images; digital image retouching; digital image enhancement*, these services relate to the process of converting physical images into a digital format; this involves scanning or capturing images and encoding them into a computer-readable digital format, allowing for easier storage, sharing, and access. I cannot see any obvious overlap with the opponent's services. In the absence of any specific submission on the point, I find that the nature, purpose and use of these services is different from that of the opponent's services and that although the services can target the same users, they are unlikely to be provided by the same undertaking. Further, I cannot detect any complementarity or competition. **These services are dissimilar.**

44. Lastly, engineering is the branch of science and technology concerned with the design, building, and use of engines, machines, and structures. Since the opponent's specification cover design services at large, I find that these services are similar to the opponent's design services because the latter can cover the design of goods to which the holder's engineering services relate: *telecommunications engineering; engineering*

for process technology; engineering relating to the automation of industrial processes; engineering relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing. **These services are similar to a low to medium degree**

45. For the sake of completeness, I should say that the only effect of the restriction *none of the aforesaid related to human resources, vendor management or contingent labour services, including IT services and solutions in the fields of human resources, vendor management or contingent labour sourcing and management* in the opponent's specifications in classes 35 and 42 is to exclude services relating to specific sectors; as such, it has not consequences on my finding of similarity or identity, as the holder's services are not restricted to the same field (so the services can relate to the same sectors).

### **Conclusions on the services comparison**

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

**Class 9:** *Computer hardware; computer operating systems; computer software platforms, recorded or downloadable; computer software for image processing; computer software for digital image processing and for enhancing digital image quality, integrated circuits for digital image processing and for enhancing the quality of digital images; data processing systems; computer programmes for data processing; software for the automation of industrial processes; computer software for application and database integration; software for the management and interpretation of data in the industrial and service fields; software for the control and management of industrial processes; software for collecting information; computer software for the automation and management of business processes; computer software and application software tools for business process, office automation and data management; artificial intelligence software; data processing apparatus with artificial intelligence; intercommunication apparatus with artificial intelligence; business intelligence software; software, in particular software for the creation, management,*

*maintenance and operation of digital twins; simulation software; instrumentation simulators; computer programs and database software, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation; software for machine learning; analytical software; computer software for processing market information; computer software to enable the searching of data; downloadable applications for use with mobile devices; interface equipment; computer software for controlling the operation of audio, video and photography devices; data communication and processing apparatus; data loggers; data storage devices; data processing equipment; computer hardware for remotely accessing and transmitting data; machine readable data carriers, provided with programs and data, of all types, in particular CDs, DVDs, streamers, zip-drives, USB sticks, optical data carriers, optical discs and magnetic data carriers.*

**Class 42:** *electronic image processing; digital image services [digitalization and scanning of images]; digitisation of images; digital image retouching; digital image enhancement.*

47. 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.”

48. 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**

49. 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.”

50. The services at issue are marketing, promotion and business services in class 35 as well as various IT related services in class 42, some of which relate to branding. The services 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.

51. The services will be selected primarily via visual means from the provider directly. The selection will occur from physical premises or online. The 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.

52. In terms of level of attention, it will depend on the cost and frequency of the purchase, however, as the services are mostly business to business services, or are highly specialised IT related services, the level of attention is likely to be above medium.

### Comparison of marks

53. 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.”

54. 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
<b>HYPHEN</b>	<b>HYPHEN</b>

## **Overall impression**

55. Both marks are figurative marks consisting of the identical word ‘HYPHEN’ presented in capital letters in a standard typeface (in the holder’s mark) and in a slightly stylised typeface (in the opponent’s mark). Although the stylisation of the third letter ‘P’ in the opponent’s mark is marginally more pronounced, it does not prevent the latter from being perceived as the word ‘HYPHEN’, which is the dominant and distinctive element of both marks.

56. As it will be recalled, the holder did not address the opponent’s claim that the marks are similar – it follows that the claim is admitted. Further, given that the only difference between the marks is the marginally more pronounced stylisation of the letter ‘P’ in the opponent’s mark, I find that the marks are visually similar to a very high degree, and aurally and conceptually identical.

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

57. 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).”

58. 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.

59. The opponent’s earlier mark consists of the word “HYPHEN” presented in a slightly stylised typeface. In its submissions in lieu, the opponent states that *“insofar as the opponent’s services in classes 35, 41, 42 and 45 are concerned, and given its well-known meaning – a term [which] defines a punctuation mark used to connect words or parts of words – the opponent’s mark is abstract in nature in that the word conveys no meaning whatsoever relating to the services covered by the opponent’s mark”*. Although not clearly stated, I think that the implication of such a submission is that the earlier mark is neither distinctive nor allusive for the services concerned and has a normal (medium degree of distinctiveness). I agree with this submission. Cambridge online dictionary defines ‘hyphen’ as *“the symbol -, used to join two words together, or to show that a word has been divided into two parts at the end of one line and the beginning of the next”*; clearly the word is neither descriptive nor allusive for the services at issue and is inherently distinctive to a medium degree.

60. In its submissions in lieu, the opponent also argued that *“given (a) the length of time the opponent’s mark has been used; and (b) the evidence of Guy Ousey, Dom Burch, Sarah Yeats, Chetan Shah and Sophia Weir all confirming [...] the opponent’s mark as effectively possessing an exclusive association with the opponent in the marketing sector, the opponent’s mark must be considered as having a high level of distinctiveness”*. As it will be recalled, I have already commented on the evidence given by Guy Ousey, Dom Burch, Sarah Yeats, Chetan Shah and Sophia Weir saying

that it is essentially opinion evidence lacking in fundamental details and, as such, it is nearly worthless.

61. Turning to the evidence of use provided by Ms Beaufort-Dysart, most of her evidence is about experiential marketing and her experience in that field. As regards the opponent's use of the mark HYPHEN, she states that:

- Hyphen was formed in 2018. The business was previously known as Engage Bee and rebranded Hyphen to better reflect the opponent's experiential offering and positioning. HYPHEN is an experiential events agency which is designed to connect brands to their audience to create experiences that the audience go on to share or talk about.
- The 'HYPEHN' agency run both consumer, employee and trade events and experiential activations which could be defined as anything from sampling products at a high footfall location to creating a pop-up store for a brand. These range from multi location roadshows, pop-up shops, trade shows and exhibitions, conferences, PR Stunts to immersive environment design which means designing a space which is interactive and plays on the senses so incorporates sight, sound and scent.
- The 'HYPHEN' agency is a full-service agency offering everything from creative strategy, ideation and design to production, staffing and activation. Since its commencement in 2018, the opponent has more than quadrupled its turnover, achieving more than £5.6 million in 2022, and adding significant numbers of major clients as shown by the table below:<sup>3</sup>

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<sup>3</sup> Exhibit LBD2

	2018	2019	2020	2021	2022	New clients for 2022
Turnover	£1,375,147	£2,105,101	£2,034,798	£3,292,282	£5,690,684	- Ubamarket - British Airways - Honda Marine - Porsche GB
Clients	Asda Merlin Vodafone Mars Bumble	Vodafone Asda Stanley Black and Decker Mars Bacardi LL Bean Shell Energizer Honda Nestle Merlin	Suntory Samsung SBD Diageo Asda Vodafone Merlin Bumble Nestle	Suntory Samsung SBD Diageo Asda Mars Vodafone Merlin Nestle	Suntory Samsung SBD Diageo Asda Mars Vodafone Porsche Retail Group We are Luxe Newell brands Hun wines Saudi Arabia Tourist Board Merlin	

- The HYPHEN agency has an online presence at the website [www.wearehypben.co.uk](http://www.wearehypben.co.uk), with the latest website having been launched in 2021. The business has also a presence on the CPM Group website - <https://www.cpm-int.com/group-companies/hyphen>, of which the opponent is part. In addition, the business has two live social media channels Instagram (in use since 2017) and LinkedIn (in use since 2018) and a Twitter account which they no longer post from.
- The business' largest clients are Porsche, Asda, Suntory, Altria and Vodafone. The business has also undertaken many events for these brands over the past 5 years.
- The Hyphen agency has made every effort and used all digital media available to raise its profile in the market. Whilst Ms Beaufort-Dysart says that Hyphen comes up on page one of a Google search for experiential agencies in Thame and provides the screenshot reproduced below as evidence,<sup>4</sup> the search was clearly conducted after the relevant date, so it does not count:

<sup>4</sup> Exhibit LBD13

experiential agencies theme

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All filters Tools SafeSearch

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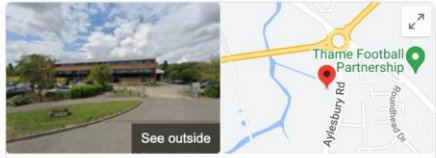
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- The Hyphen business has featured extensively in the marketing press and marketing directories, including a ranking in the Bizzabo Blog Top UK Event Agencies 2022, the Clutch Top Experiential Marketing Agencies in the UK, a ranking which it still attains in 2023. In addition, the Hyphen agency was in March 2023 ranked no. 6 out of the UK's Top 60 Experiential Marketing Agencies by The Manifest business guide. Finally, the Hyphen Agency has also featured in the Drum digital media publication in connection with their appointment by outdoor retailer, LL Bean. The main issue with this evidence is that it is after the priority date of 13 September 2021 and, as such, cannot be taken into account to establish the position at that date.

62. Clearly, the opponent's agency had not been trading under the name HYPHEN for a long time prior to the relevant date of 13 September 2021; as the name was changed in 2018 it has been trading only for 4 years. Admittedly there are turnover figures that amount to less than £9million for the period 2018-2021, however, it is not clear what proportion of the turnover for 2021 was generated prior to the relevant date. Further, whilst the evidence indicates that the opponent has worked with some very successful and well-known companies, there are no marketing figures and no indication of market share. In my view the strongest evidence here is that of the opponent working with some big names – this would suggest a reputable business in its field. However, given the relatively low turnover and the absence of information about market share, I am

not convinced that the use made has resulted in materially increasing the distinctive character of the mark.

### **Likelihood of confusion**

63. 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.

64. Earlier in this decision I found that:

- The IR and the earlier mark are visually similar to a high degree and aurally and conceptually identical.
- Some of the services are identical, whilst other goods and services are similar to a various degree.
- The average consumer will select the goods and services mainly visually, with a degree of attention which is above average.
- The earlier mark is distinctive to a medium degree.

65. Bearing in mind all of the above, I consider that given the high degree of visual similarity between the marks and their aural and conceptual identity, 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 an element of stylisation to the identical brand HYPHEN. There is a likelihood of confusion in relation to the services which I have found to be identical or similar.

### **Section 5(4)(a)**

66. 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.”

67. 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.”

68. 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).”

69. 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)*

80. 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.’ ”

81. The *prima facie* relevant date is the priority date of 13 September 2021. Whilst the holder claims to have used the mark before this date, given that they have not filed evidence there is no earlier date that can be taken into account.

## **Goodwill**

82. I will assume that the opponent had a more than trivial (and actionable) goodwill at the relevant date for marketing agency services. 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 services which I found to be identical or similar under Section 5(2)(b) were such on the basis that the registered services include services in class 42 for which there is no use and no goodwill; hence under Section 5(4)(a), I would find that all the contested goods in class 9, and all of the services in class 42 are dissimilar to the services to which the opponent’s goodwill is associated. 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.

83. 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

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

**Class 9:** *Computer software; downloadable cloud computer software; interactive software; integrated software packages*

**Class 35:** *Business consulting for enterprises; business management and organization consultancy; assistance, advice and consultancy in relation to business analysis; business consultancy relating to the administration of information technology; development of processes for the analysis and implementation of business strategy plans and business project management; business process re-engineering; brand positioning services, brand development; customer experience design and analysis; market research and market analysis; promotion of companies on the internet and other media, presentation of companies on the Internet and other media; compilation and systemisation of information and providing thereof to customers.*

**Class 42:** *Design, development, installation and maintenance of computer software and software tools and consultancy thereof; development of software application solutions; cloud computing; scientific research and analysis in relation to the following fields: strategy, marks, digital technologies and digital transformation; technological services, namely development of computing strategies for companies; technological consultancy and analysis in the design, development and application of operating systems and information technology; technological consultancy in the field of information systems and information technology including project management; design, development and upkeep of digital presence, namely, websites, online shops, mobile applications, social media platforms; technological consultancy and consultancy in the field of computer project management relating to the development of multimedia products and services; software as a service (SaaS), software as a service [SaaS] for providing artificial intelligence, analysis and automation and for providing IT services, cognitive application services, test verification and*

*business process automation; development of digital dual technology for agile software delivery; software as a service [SaaS] for use by agile developers in developing and distributing all applications; recovery, analysis and processing of encoded information incorporated in products and product components; uploading of information to a cloud computing system or a distributed blockchain system; creation of digital twins of a physical product; creation of product profiles and association thereof with a physical product for product authentication purposes; brand protection, tracking and tracing of products and product components; design and development of computer software for logistics, supply chain management and e-business portals; creation, maintenance, servicing and adaptation of software, in particular artificial intelligence and business intelligence software, software for collecting information, analytical software, automatic learning software, data processing software, software for the integration of applications and databases, software for the integration of other software, simulation software, software for the creation, management and maintenance of digital twins; design and development of computer software for process control; design and development of software for controlling industrial processes; data duplication and conversion services, data coding services being computer programming; design and development of computer software for reading, transmitting and organising data; IT security services in the nature of protection and recovery of computer data; telecommunications engineering; engineering for process technology; engineering relating to the automation of industrial processes; engineering relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; research, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; quality control relating to software, in particular relating to digital twin technology, artificial intelligence, simulations, application integration, analytical software, data processing; technical transformation and redesigning of process management and quality management systems; providing of cloud services, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and*

*providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation.*

85. 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:** *Computer hardware; computer operating systems; computer software platforms, recorded or downloadable; computer software for image processing; computer software for digital image processing and for enhancing digital image quality, integrated circuits for digital image processing and for enhancing the quality of digital images; data processing systems; computer programmes for data processing; software for the automation of industrial processes; computer software for application and database integration; software for the management and interpretation of data in the industrial and service fields; software for the control and management of industrial processes; software for collecting information; computer software for the automation and management of business processes; computer software and application software tools for business process, office automation and data management; artificial intelligence software; data processing apparatus with artificial intelligence; intercommunication apparatus with artificial intelligence; business intelligence software; software, in particular software for the creation, management, maintenance and operation of digital twins; simulation software; instrumentation simulators; computer programs and database software, in particular for monitoring product development, monitoring agile organisations, for modelling and providing virtual images of physical objects or systems, for modelling and providing digital twins, for documentation, modelling, planning and managing business processes and for managing documentation; software for machine learning; analytical software; computer software for processing market information; computer software to enable the searching of data; downloadable applications for use with mobile devices; interface equipment; computer software for controlling the operation of audio, video and photography devices; data communication and processing apparatus; data loggers; data storage devices; data processing equipment; computer hardware for remotely accessing and transmitting data; machine readable data carriers, provided with*

*programs and data, of all types, in particular CDs, DVDs, streamers, zip-drives, USB sticks, optical data carriers, optical discs and magnetic data carriers.*

**Class 42:** *electronic image processing; digital image services [digitalization and scanning of images]; digitisation of images; digital image retouching; digital image enhancement.*

## **COSTS**

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

Dated this 21<sup>st</sup> day of October 2025

TERESA PINTO  
For the Registrar