

O/0995/25

**CONSOLIDATED PROCEEDINGS**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS. UK00003717494 & UK00003717512  
BY MTN GROUP MANAGEMENT SERVICES (PROPRIETARY) LIMITED TO  
REGISTER:**

**Y'ELLO**

**AS A TRADE MARK IN CLASS 36**

**AND**

***y'ello***

**AS A TRADE MARK IN CLASSES 9, 35 & 38**

**AND**

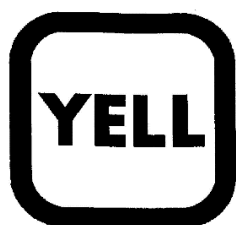
**IN THE MATTER OF THE OPPOSITIONS THERETO  
UNDER NOS. 431237 & 432785 BY  
YELL LIMITED**

## BACKGROUND AND PLEADINGS

1. On 3 November 2021, MTN GROUP MANAGEMENT SERVICES (PROPRIETARY) LIMITED (“the applicant”) applied to register the trade marks shown on the cover page of this decision in the UK (hereinafter referred to as the applicant’s first and second marks, respectively). The applicant’s first mark was published for opposition purposes on 19 November 2021 and its second was published on 21 January 2022. Registration is sought for the goods and services set out in **Annex 1** of this decision.
2. The applicant’s marks were opposed by Yell Limited (“the opponent”) on 21 February 2022 and 21 April 2022, respectively. The first opposition was initially based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, in its written submissions, the opponent dropped its section 5(4)(a) ground. As for the second opposition, this is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Act. While the oppositions are based on some of the same grounds, there is a variance in relation to the marks and services relied upon. I will therefore break down the nature of the different oppositions below.

### The first opposition

3. Insofar as it relates to the section 5(2)(b) ground, the first opposition is reliant upon the following marks:



UK registration no. 902372472<sup>1</sup>

Filing date 11 September 2001; registration date 17 September 2019

("the opponent's first mark"); and

YELL

UK registration no. 3069427

Filing date 20 August 2014; registration date 27 March 2015

("the opponent's second mark").

4. Under the section 5(2)(b) ground, the opponent relies on only some of the goods and services for which its marks are protected. Those are set out in **Annex 2** of this decision. Further, I note that while reliance upon the opponent's first mark is aimed at all of the services in the applicant's first mark, it is noted that the section 5(2)(b) ground reliant upon the second mark is aimed only at the following services in the applicant's first mark's specification:

Class 36: Providing cash and other rebates as part of a customer loyalty program; insurance, financing and guarantee services relating to telecommunications and communications apparatus and instruments; providing an internet website portal in the field of financial transaction and payment processing; provision of information and advice for the prospective purchasers of commodities and goods, all related to payment terms and insurance.

5. The opponent claims that the goods and services are identical and/or similar and that the marks at issue are similar. In addition, the opponent claims that its marks benefit from an enhanced degree of distinctive character which means that they

---

<sup>1</sup> The opponent's first mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

enjoy a broader scope of protection. It is argued that these factors mean that there exists a significant risk of confusion between the parties' marks, including a likelihood of association.

6. Turning to the section 5(3) ground, the first opposition is reliant upon the opponent's second mark only. However, this ground is aimed at all of the services in the applicant's first mark and is reliant upon all of the goods and services for which the opponent's second mark is registered, being those set out in **Annex 3** of this decision.
7. Under this ground, the opponent claims that its second mark enjoys a reputation amongst the relevant public in the UK for the goods and services relied upon. It is claimed that this, together with the similarity between the marks, means that the marks will be linked in the minds of the relevant public in the UK. As such, the opponent claims that use of the applicant's first mark will result in an unfair advantage in favour of the applicant. Further, it is claimed that use of the applicant's mark will cause a detriment to the repute and/or distinctive character of the earlier mark.
8. The applicant filed a counterstatement wherein it denied the claims against it. I also note that the applicant requested that the opponent provide proof of use for its second mark.

#### The second opposition

9. Under the section 5(2)(b) ground of the second opposition, the opponent relies on its first and second marks, as outlined above. However, in respect of this opposition, the opponent relies on a different set of goods and services for those marks. These are set out in **Annex 4** of this decision.

10. In addition to its first and second marks, the opponent also relies on the following mark under the section 5(2)(b) ground of this opposition:



UK registration no. 3069451

Filing date 20 August 2014; registration date 27 March 2015

Relying on some goods and services, namely those set out in **Annex 5** of this decision.

(“the opponent’s third mark”).

11. In respect of this ground of the second opposition, it is noted that the opponent seeks to oppose all of the applicant’s goods and services. The opponent claims that the similarity of the marks, the identity/similarity of the goods/services at issue and the enhanced distinctive character enjoyed by its mark are such that there exists a significant risk of confusion, including a likelihood of association, between the marks.

12. Under the section 5(3) ground, the opponent relies on its second and third marks and claims that they each enjoy a reputation for all of the goods and services for which they are registered. The second mark’s specification is set out at **Annex 3** with the specification for the third mark set out in **Annex 6** of this decision. In respect of this ground, the opponent claims that the marks at issue are similar and that, due to the reputation of its own marks, use of the applicant’s second mark would create a link between the marks amongst the relevant public in the UK. It is claimed that this will result in the applicant gaining an unfair advantage from the opponent’s marks and, further, that it would cause a detriment to the repute and/or distinctive character of the opponent’s marks.

13. Lastly, the section 5(4)(a) ground is reliant upon two unregistered signs. The first of which is the sign 'YELL' which it claims to have used throughout the UK since at least 2001. The second sign is one that is identical to the opponent's third mark and it is claimed that this has been used throughout the UK since at least as early as 2014. The goods and services for which this use is claimed are set out in **Annex 7** of this decision. In light of this use, the opponent claims that it has established a goodwill in its signs and that use of the applicant's mark would misrepresent to consumers that the applicant is the opponent, or has a connection to it. It is claimed that this misrepresentation will result in damage to the goodwill of the opponent meaning that the applicant's mark is liable to be prevented by virtue of the law of passing off.
14. The applicant filed a counterstatement wherein it denied the claims against it and requested that the opponent provide proof of use for the second and third marks relied upon.
15. Upon the filing of the counterstatement in the second opposition, the Registrar directed, under Rule 62(1)(g) of the Trade Marks Rules 2008, that these proceedings be consolidated. This was confirmed to the parties on 23 January 2024.
16. The applicant is represented by Reddie & Grose LLP and the opponent is represented by Bristows LLP. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
17. 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**

18. The opponent's evidence in chief came in the form of the witness statement of Paul Manwaring dated 25 March 2024. Mr Manwaring is General Counsel and Company Secretary of the opponent. He confirms that he has worked in various roles within the company since September 2009. The evidence was adduced in order to demonstrate use of the opponent's second and third marks and in order to prove that all marks relied upon enjoy a reputation and goodwill in the goods and services highlighted across the opponent's notice of opposition. The statement is accompanied by 28 exhibits, being PM1 to PM28.

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

## **DECISION**

### **Proof of use**

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

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in

question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

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

[...]

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

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

“(1) This section applies where:

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

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

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

23. Given their earlier filing dates, all of the opponent’s marks qualify as earlier trade marks under the above provisions. As set out above, the applicant requested that the opponent provide proof of use for its second mark (for both oppositions) and its third mark (for the second opposition only). As a result, the opponent’s second and third marks are subject to the use provisions on the basis that they completed their registration processes more than five years prior to the filing date of the applicant’s mark. As for the opponent’s first mark, this did not complete its registration process more than five years prior to the filing date of the applicant’s mark so it is not subject to the use provisions. Therefore, for this mark, the opponent may rely on all of the goods and services highlighted in its notices of opposition.

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent

of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

25. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant’s mark, being 3 November 2021. The relevant period is, therefore, 4 November 2016 to 3 November 2021 (“the relevant period”).

26. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>2</sup> because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

---

<sup>2</sup> *Jumpman* BL O/222/16

## Evidence of use

27. While the evidence begins with talk of the Yellow Pages, it doesn't appear as though the opponent began operating the 'YELL' brand until 1996, which is when 'Yell.co.uk' was launched. This is described as an online business directory which was the first use of the 'YELL' brand. The evidence confirms that since the Yellow Pages ceased production of physical copies in 2017 the opponent has focused on providing digital marketing solutions and an online directory for UK businesses.
28. It is confirmed that 'Yell.co.uk' then changed its domain to 'Yell.com'. It is claimed that 'YELL' is a leading provider in the UK for managed digital marketing services for all types of local businesses. The evidence explains that its managed marketing service is an offering wherein the opponent collaborates with customers to develop personalised marketing plans that are suited to their individual businesses. The 'Yell' platform is confirmed as consisting of a number of tools, such as messaging, ratings and reviews which allow for business to consumer connections. In terms of visibility, the evidence confirms that the opponent works with Apple, Amazon and Microsoft in order to assist in expanding the reach of the listings on its platform. This allows a greater degree of visibility for its customers.
29. In respect of the YELL platform, the evidence confirms that the opponent consistently uses its 'YELL' word mark (being its second mark). In respect of what is referred to as its 'walking fingers mark' (being its third mark), the opponent confirms that it has been used in the same way since 2014.
30. The evidence moves to discuss in further detail the services that the opponent offers. As above, this includes digital marketing services for local businesses. In addition to this, the evidence sets out that the opponent assists customers in effectively managing and addressing reviews and services for customers to enhance their local visibility through a managed search engine. The main offerings are summarised as including the following services:

- a. Online business directory;
- b. Digital marketing services;
- c. Website design and development, and associated services;
- d. Search engine optimization (SEO) services;
- e. Pay-per-click (PPC) advertising;
- f. Social media advertising;
- g. Display advertising; and
- h. Video marketing.

31. In support of the reference to the above services, the opponent has provided a range of printouts taken from its own website which set out the offering of said services.<sup>3</sup> These all show dates within the relevant period and I note that they confirm the offering of all services set out above. This includes website design services (with the offering of support services in respect of the same), the business directory search function and digital marketing services. In addition, I note that the opponent has provided a copy of its 2016 brochure which also shows the offering of such services.<sup>4</sup>

32. In terms of the goods relied upon, I note that the evidence confirms that the opponent offers a downloadable app which allows customers to access the various services it provided. Copies of printouts from the opponent's website and the Apple App Store showing the app available for download during the relevant period are provided in evidence.<sup>5</sup> I also note that the opponent's own website makes reference to the app being available via Google's Play Store.

---

<sup>3</sup> PM2

<sup>4</sup> PM3

<sup>5</sup> PM4

33. In respect of the websites and brochures I have discussed in the preceding paragraphs, I consider it necessary to point out that they include both the opponent's second and third marks throughout.

34. In terms of the opponent's financial performance, I note that evidence of its revenue has been provided for the period of 1 April 2017 to 31 March 2021. The figures are presented in the millions of pounds, are broken down by revenue source and each year is confirmed as being the year ending 31 March. The revenue is reproduced below:

<b>Year</b>	<b>Yell.com (£)</b>	<b>Digital marketing services (£)</b>
2018:	108.3	91.1
2019:	106.5	83.2
2020:	90.2	75.6
2021:	67.8	54
<b>Total:</b>	<b>372.8</b>	<b>303.9</b>
<b>Overall Total:</b>	<b>676.7</b>	

35. I note that the opponent has provided a sample of invoices and credit notes that it issued to UK based customers for its services between 2016 and 2021.<sup>6</sup> The invoices are heavily redacted but they plainly demonstrate the provision of services over a number of years.

36. In addition to the above, I note that the opponent confirms how many customers it acquired during the financial years of 2017/18 to 2020/21. This information also includes how many customers the opponent retained at the end of each financial year. I do not intend to reproduce this in full but note that at the end of 2018, the opponent had 131,900 customers and, on 31 March 2021, it had 86,200

---

<sup>6</sup> PM5

customers. It is confirmed that these figures were obtained from the Yell Full Year Trading update, copies of which have been provided in evidence.<sup>7</sup>

37. In respect of advertising, the opponent confirms that between 4 November 2016 and 3 November 2021, it spent an average of £1,444,668.53 per year advertising its business in the UK. This would mean that the total advertising spend during the relevant period was in excess of £7 million.

38. In terms of press coverage, the opponent has provided a range of articles from between 1 September 2017 to 1 October 2020 from various nationwide publications such as BBC News, Independent, Inspct and the Daily Mail as well as a local publication, being About Manchester.<sup>8</sup>

39. The opponent has provided visitor figures for its website for the years 2016 to 2021. This is broken down to visits to its Yell.com website and the Business.Yell.com website. I do not intend to discuss these in full but note that the visits to Yell.com ranged from a high of 176.3 million visits in 2016 to a low of 98.5 million visits in 2021. While the numbers reduced during the relevant period, they remain significant. As for the Business.Yell.com website, this attracted an average of around 1 million visits per year during this same timeframe. Data in support of these figures is provided in evidence, and is taken from the website Snowflake.com,<sup>9</sup> which is confirmed as being a website that allows organisations to gain insights from their data.

40. In addition to the above, the opponent has provided evidence of the awards it has obtained throughout the years as well as evidence demonstrating its attendance at trade shows in order to advertise its services.<sup>10</sup> I do not intend to discuss this evidence in any detail as it does little to elevate the already significant evidence I

---

<sup>7</sup> PM6 and PM7

<sup>8</sup> See PM8 to PM12

<sup>9</sup> PM17

<sup>10</sup> See PM19 to PM26

have summarised above. As an example, however, I note that during the relevant period, the opponent obtained a number of awards from various advertising agencies such as the Field Marketing and Brand Experience Awards.<sup>11</sup>

### Assessment of the evidence

41. I am of the view that I can deal with the assessment of genuine use relatively swiftly. Firstly, the opponent has shown consistent use of both its second and third marks throughout the evidence. Secondly, the level of use demonstrated sits at a significant level. As set out above, the total revenue throughout the relevant period sits at £676.7 million. Further, the advertising spend sits at approximately £7 million during that same time period. Clearly, this level of use is demonstrative of an effort to create or preserve a market share for the goods and services offered.

42. While there is plainly use of the opponent's marks, the nature of the use is limited to only some goods and services and it is, therefore, necessary for me to consider a fair specification for the marks at issue.

### Fair specification

43. In considering a fair specification, I am guided by the various case law that covers the issue, including *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, wherein Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

---

<sup>11</sup> PM25

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

44. In addition, I refer to paragraphs 245 to 249 of *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 as well as paragraph 47 of *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) which set out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

45. The goods and services relied upon across the different grounds and oppositions vary and these are all set out in full in Annexes 2, 3, 4, 5 and 6 of this decision. Given the nature of the use shown before me, I do not consider that it is necessary to go over each and every term across the specifications at issue relied upon under the different oppositions. Instead, I will only discuss various terms where I consider it necessary to do so below.

46. For the avoidance of doubt, where I have permitted the opponent to proceed in reliance upon broad terms and where I have introduced specific limitations, I consider it necessary to confirm that I have deemed these terms to be in line with how the average consumer would fairly describe the use shown. In addition, I note that the opponent relies on a range of terms that, while worded differently, cover the exact same services. Where this occurs, I will permit the reliance upon just one term and I do so on the basis that it does not unduly impact the strength of the opponent's position as the relevant goods or services remain at issue for the purpose of these oppositions. Lastly, there are a range of broad terms for which the use shown is more suitably allocated to a separate and more limited term. It is not plausible to go over each instance where this occurs but, for example, “compilation of information” is included as a term in class 35 of the opponent's

second mark and while I appreciate that use has been shown for such a term, the term that more accurately reflects the evidence before me is “compilation of business directories”.

### Class 9

47. The class 9 specifications consist of a wide range of terms for which the opponent has failed to make any effort to demonstrate use. While this issue applies to a large number of goods, I refer to terms such as “floppy disks” and “debit cards”, for example. Neither of which appear in the evidence whatsoever. Having considered the evidence before me, I consider that the following goods represent a fair specification of the use shown:

*“Computer software, namely search engine software for business databases; downloadable software for mobile devices, namely for updating business database entries and database management; website development software; downloadable software for providing consumer information, namely rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers.”*

### Class 16

48. While there is evidence of a phone book provided in evidence,<sup>12</sup> this is not branded with the second or third marks. It is, instead, a Yellow Pages phone book. I appreciate that the branding ‘YELL’ is derived from the Yellow Pages branding, this is not use of the marks at issue. In addition, I note that there is nothing before me to demonstrate that the opponent has sought to create or preserve a market share for the provision of class 16 goods. On this point, the provision of a brochure advertising its own services (see PM3), is not an example of genuine use for class

---

<sup>12</sup> I note that an image of a Yellow Pages book is provided at PM13. However, this is not branded with the second or third marks so is of no assistance to the present assessment.

16 goods. Having considered the evidence before me, I do not consider that the opponent has shown use of any of the class 16 goods.

#### Class 35

49. Having considered the evidence before me, I consider that the following services represent a fair specification of the use shown:

*“Advertising, marketing and promotional services; production, preparation and presentation of advertising matter; provision of advertising space online media; providing an online commercial information directory on the Internet; advertising services provided over the Internet; display advertising; banner advertising; pay per click advertising; search engine marketing services; business information services; compilation of business directories; providing an online searchable database for the provision of business information, including rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; business management services; professional consultancy services in relation to advertising.”*

#### Class 38

50. I appreciate that the opponent’s website and downloadable app allow users to post comments and reviews about businesses. However, just because an app or website may have commenting or messaging facilities, that does not mean that it constitutes a genuine attempt to create or preserve a market share for a range of telecommunication services. In making this finding, I refer to the fact that a wide variety of websites, such as those provided by retailers, for example, have messaging features. However, this does not mean that those retail providers are offering telecommunication services. In my view, the same applies here. Therefore, I do not consider that the simple offering of a website or app that has communication features is the provision of “telecommunication services enabling

individuals and businesses to transmit messages, comments information and other user generated content via a global computer network”.

51. While I consider that the above reasoning applies to the majority of the class 38 services relied upon, I am of the view that the evidence is sufficient in demonstrating genuine use for the following services:

*“Computerised consultation of telephone directories; providing access to an online interactive website containing users comments concerning various businesses and service providers.”*

#### Class 41

52. Having considered the evidence before me, I consider that the following services represent a fair specification of the use shown:

*“Online publication of business directories, business reviews, market analysis and research; Online publishing of reviews.”*

#### Class 42

53. Having considered the evidence before me, I consider that the following services represent a fair specification of the use shown:

*“Design and development of computer software for businesses.”*

#### Class 45

54. The opponent’s class 45 services relate to various social networking services. While the opponent has social media accounts,<sup>13</sup> nowhere in the evidence does it

---

<sup>13</sup> See PM27 and PM28

show that the opponent offers its own social networking service. As a result, I do not consider that the opponent has provided any genuine use for these services.

55. This concludes my assessment of proof of use. I do not intend to summarise the goods and services for which the oppositions reliant upon the opponent's second and third marks may proceed here. Instead, I will set this out when considering the goods and services comparison below.

### **Section 5(2)(b): legislation and case law**

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

“(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 or association with the earlier trade mark.”

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

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

58. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

59. The applicant's goods and services are listed in Annex 1 of this decision. As for the opponent, its first mark's specification is set out in Annex 2 of this decision. The opponent's second and third marks were subject to the proof of use assessment above which resulted in their specifications being limited. The goods and services for which these marks are permitted to proceed as set out below. That being said, it is necessary to point out that under the first opposition, the opponent relied on a much more limited specification in respect of its second mark. This results in only

those goods and services I have underlined below being at issue in the opposition reliant upon the opponent's second mark against the applicant's first mark. In respect of the opponent's second mark insofar as it is aimed against the applicant's second mark, all of the below goods and services are at issue. Lastly, the opponent's third mark may be relied upon for all of the below goods and services also.

Class 9: Computer software, namely search engine software for business databases; downloadable software for mobile devices, namely for updating business database entries and database management; website development software; downloadable software for providing consumer information, namely rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers.

Class 35: Advertising, marketing and promotional services; production, preparation and presentation of advertising matter; provision of advertising space online media; providing an online commercial information directory on the Internet; advertising services provided over the Internet; display advertising; banner advertising; pay per click advertising; search engine marketing services; business information services; compilation of business directories; providing an online searchable database for the provision of business information, including rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; business management services; professional consultancy services in relation to advertising.

Class 38: Computerised consultation of telephone directories; providing access to an online interactive website containing users comments concerning various businesses and service providers.

Class 41: Online publication of business directories, business reviews, market analysis and research; Online publishing of reviews.

Class 42: Design and development of computer software for businesses.

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

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

*The applicant's first mark*

Class 36

62. The applicant's first mark consists solely of services in class 36. These are all various types of broad or specification services relating to finance. They range from the general terms "financial affairs" to the more specific term of "providing an internet website portal in the field of financial transaction and payment processing". All of the services are financial in nature and given that the opponent's first mark is registered for the term "financial services", I find that these services are identical be that self-evidently or under the principle outlined in *Meric*.

63. For the avoidance of doubt, I find that there is no degree of similarity between the applicant's first mark's services and the goods and services in the opponent's second mark.

*The applicant's second mark*

Class 9

*Electrical and electronic telecommunications and communications apparatus and instruments; data communication apparatus and instruments, including portable electronic devices to access the Internet wirelessly; apparatus for recording, transmission or reproduction of sound or images; apparatus and instruments for the processing, transmission, storage, logging, reception and retrieval of data being in the form of encoded data, text, graphic images or video or a combination of these formats; telecommunications products, namely, computer control hardware for use in wireless communications systems; routers; modems; satellite receiving and transmission*

*apparatus and instruments; apparatus for downloading audio, video and data from the internet; television apparatus and instruments; radio and television broadcasting transmitters and receivers; apparatus for access to broadcast or transmitted programmes; telephones; mobile telephones; cordless telephones; telephone accessories, including, telephone cords and batteries; electronic products, namely, digital photograph receivers; telecommunication couplers; telecommunication modular plugs; transceivers; wireless transceivers; teleconferencing telephones; telephone answering machines; internet telephones; wireless telephones; earphones and antennae for cordless and wireless telephones; communication apparatus and instruments for wireless internet access and online streaming; hands-free devices for car telephones and mobile telephones; in-car telephone handset cradles; parts and fittings included in class 09 for the aforementioned goods.*

64. The above goods are all different types of goods for use in telecommunication.

Given that the opponent's first mark includes the term "telecommunication goods", it can be said to encompass any type of class 9 goods that falls within the category of telecommunication. As a result, I find that all of the above goods are identical under the principle outlined in *Meric*.

*Data processing equipment, including calculating machines and computers; parts and fittings included in class 09 for the aforementioned goods.*

65. As far as I am aware, data processing is not a form of telecommunication. As such, I do not consider that the above term is the same as the opponent's "telecommunication goods", in its first mark's specification. That being said, I am of the view that there is a degree of similarity between them. I say this because the opponent's term is very broad and can cover goods that are used in conjunction with the applicant's goods in order to aid the transmission (via telecommunications) of the data being processed. So while the nature, method of use and purpose of the goods differ, I consider that there is some degree of overlap in trade channels on the basis that an undertaking that produces and sells telecommunication goods

is also likely to produce and sell data processing equipment. Further, a user looking to transmit data after processing it is likely to select both the above goods of the applicant and a telecommunication good. While the goods are not complementary or competitive in nature, I am of the view that the aforementioned overlaps are sufficient to warrant a finding that these goods are similar to a low degree.

*Computer software; computer application software for mobile phones; parts and fittings included in class 09 for the aforementioned goods.*

66. I consider that the software terms above both encompass the opponent's term of "downloadable software for mobile devices, namely for updating business database entries and database management" which is in both its second and third marks' specifications. As such, these goods are identical under the principle outlined in *Meric*. As for the parts and fittings term, I consider that this is similar to a medium degree with the opponent's term on the basis that they overlap in trade channels and user and are likely to have a complementary relationship on the basis that parts and fittings are likely to be important to the software itself to the point that consumers will believe them to be the responsibility of the same undertakings.<sup>14</sup>

*Computer chatbot software; communication software for providing access to the Internet; parts and fittings included in class 09 for the aforementioned goods.*

67. While the above goods are not the same as telecommunication goods, they are goods used for the purpose of communication via the internet. This is a form of telecommunication. As such, I consider that while the natures and methods of use differ, the above goods are similar to the opponent's "telecommunication goods" in its first mark's specification. I say this because there is some overlap in purpose (both allow for the transmission of telecommunications). Further, the goods are

---

<sup>14</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

likely to be sold by the same undertakings and selected by the same users. Taking all of this into account, I find that these goods are similar to between a low and medium degree.

68. As for the parts and fittings term, I consider that this is similar to a low degree with the opponent's "telecommunication goods" on the basis that there is an overlap in trade channels and user between them.

*Computer software for financial management and planning, account aggregation and budgeting; parts and fittings included in class 09 for the aforementioned goods.*

69. While the opponent's specifications do not include software for financial management, the opponent's first mark does include the term "financial services". While these terms differ in nature and method of use, I do consider them to be similar to a degree. I say this because the purpose of the above term is to allow the user to manage their finances, which is essentially the same purpose as the opponent's service. Further, I consider it likely that the provider of financial services may also provide software to its customers in order for them to manage their finances. Further, the users will also overlap. The goods and services are not competitive in nature and, in respect of complementarity, I do not consider that these goods and services are necessarily important to one another as financial services do not always require the use of software. Taking all of this into account, I find that these goods and services are similar to a medium degree.

70. As for the parts and fittings term, I consider that this is similar to a low degree with the opponent's "financial services" on the basis that there is an overlap in trade channels and user between them.

*Image processing apparatus, instruments and equipment; magnetically encoded cards; smart cards; holograms; media for storing information, data, images and sound; blank and pre-recorded magnetic cards; cards containing microprocessors; integrated*

*circuit cards; electronic identification cards; telephone cards; telephone credit cards; credit cards; debit cards; magnetic, digital and optical data carriers, recording and storage media (blank and pre-recorded); recording discs; compact discs; DVDs and other digital recording media; machine readable media; digital video, and data (downloadable) provided from a computer database or the internet; personal digital assistants; programmed-data-carrying electronic circuits; electronic and satellite navigational and positional apparatus and instruments, including global positioning systems; parts and fittings included in class 09 for the aforementioned goods; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; mechanisms for coin-operated apparatus; fire-extinguishing apparatus.*

71. The above goods are not telecommunication goods and while I appreciate that some of them may require software to operate, there is no obvious reason why such goods would be similar to the various types of software goods in the opponent's specifications. In short, I see no reason why any of the above goods would share overlaps with the opponent's goods (or services, for that matter). As such, I find them to be dissimilar.

*Mobile phone cases; parts and fittings included in class 09 for the aforementioned goods.*

72. On the basis that the opponent's term "telecommunication goods" in its first mark's specification can cover a mobile phone, I find that it is similar to a medium degree with "mobile phone cases". I say this because the goods are likely to overlap in trade channels and user and, further, will be complementary to one another. As such, I find that they are similar to a medium degree.

73. As for the parts and fittings term, I consider that this is similar to a low degree with the opponent's "telecommunication goods" on the basis that there is an overlap in trade channels and user between them.

#### Class 35

*Advertising and promotion services; marketing.*

74. The opponent's second and third marks include the term "advertising, marketing and promotional services", which encompasses both of the above services of the applicant. As such, these services are identical under the principle outlined in *Meric*.

*Loyalty card services; organisation, operation and management of customer loyalty schemes; organisation, operation and supervision of sales and promotional incentive schemes.*

75. Loyalty card services and loyalty schemes are, as far as I am aware, a form of promotion whereby a business offers incentives to its customers as a reward for their repeat custom. As a result, I consider that the above services all fall within the term "advertising, marketing and promotional services" in the opponent's second and third marks' specifications. Therefore, I find that these services are identical under the principle outlined in *Meric*. If this is incorrect then I find that they are at least similar to a medium degree on the basis that the services share the same purpose (by attempting to deliver more business to the customer) and are likely to overlap in trade channels and user.

*Provision of trade information; provision of directory services.*

76. While expressed differently, the above terms include the provision of information relating to businesses. As the terms are not limited in any way, they can include

the provision of said information on the internet. Therefore, I find that both of the above terms encompass the opponent's term of "business information, [...] provided on-line from a computer database or by means of web pages on the Internet" which is in its first mark's specification. As a result, I find that these services are identical under the principle outlined in *Meric*. Further, I note that the opponent's second and third marks include the term "business information services" which can cover the provision of business information so will also encompass the above services. As such, these services are also identical under the principle outlined in *Meric*.

*Retail and wholesale services connected with electrical and electronic telecommunications and communications apparatus and instruments; retail and wholesale services connected with data communication apparatus and instruments, including portable electronic devices to access the Internet wirelessly; retail and wholesale services connected with apparatus for recording, transmission or reproduction of sound or images; retail and wholesale services connected with telecommunications products, including, computer control hardware for use in wireless communications systems; retail and wholesale services connected with routers, modems; retail and wholesale services connected with satellite receiving and transmission apparatus and instruments, apparatus for downloading audio, video and data from the internet, television apparatus and instruments, radio and television broadcasting transmitters and receivers, apparatus for access to broadcast or transmitted programmes, programmed-data-carrying electronic circuits; retail and wholesale services connected with telephones, mobile telephones, cordless telephones, telephone accessories, including, telephone cords and batteries; retail and wholesale services connected with electronic products, namely, digital photograph receivers; retail and wholesale services connected with telecommunication couplers, telecommunication modular plugs, transceivers, wireless transceivers, teleconferencing telephones, telephone answering machines, internet telephones, wireless telephones, earphones and antennae for cordless and wireless telephones, communication apparatus and instruments for wireless internet access*

*and online streaming, hands-free devices for car telephones and mobile telephones, and in-car telephone handset cradles; the bringing together, for the benefit of others, of a variety of goods namely [...], mobile telephones, smart phones and related accessories, modems, routers, telephone cards, telecommunication devices and related accessories, [...] enabling customers to conveniently view and purchase those goods.*

77. The above services cover the retail of a range of goods that relate to telecommunication goods. While the opponent's specifications do not include retail services (or services for the bringing together of goods for others), they do cover goods that are identical or similar to the goods retailed by the above services, namely "telecommunication goods" in its first mark's specification. On this point, I refer to the case of *Oakley, Inc v OHIM*, Case T-116/06, namely paragraphs 46 to 57, wherein the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. I find that these overlaps are present here and, as a result, conclude that the above services are similar to a medium degree to the opponent's goods.

*Retail and wholesale services connected [...] computer software, communication software for providing access to the Internet, computer application software for mobile phones; the bringing together, for the benefit of others, of a variety of goods namely software, [...] and related accessories, [...] enabling customers to conveniently view and purchase those goods.*

78. Following the same logic applied in the preceding paragraph, I find that the above services are similar to a medium degree with the terms "computer software, namely search engine software for business databases" and "downloadable software for mobile devices, namely for updating business database entries and database management" in its second and third marks' specifications.

*Retail and wholesale services connected with computer software for financial management, planning, account aggregation and budgeting.*

79. While the opponent does not have computer software for financial purposes in its specifications, it does have the broad term of “financial services” in its first mark’s specification. I have set out above that the provider of financial services is likely to also offer its own software for financial management, for example. That being said, I am not necessarily convinced that they will actually offer the retail services in respect of the same. In addition, I appreciate that the user of financial services may look to download the software but I’m not sure they would necessarily seek the retail of the same. As a result, I do not consider that these services overlap in trade channels or user and, on this point, I have nothing before me by way of evidence to suggest otherwise. In comparing these services, I find that they clearly differ in nature, method of use and purpose and neither do I consider them to share a complementary or competitive relationship. As a result, I find that these services are dissimilar.

*Retail and wholesale services connected with data processing equipment; retail and wholesale services connected with apparatus and instruments for the processing, transmission, storage, logging, reception and retrieval of data being in the form of encoded data, text, graphic images or video or a combination of these formats; retail and wholesale services connected with mobile phone cases.*

80. I appreciate that the opponent’s specifications do not include any of the above goods. That being said, I remind myself that in the case of *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. set out that the GC’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services covered exactly the same goods as those

for which the other party's mark is registered. As such, it does not automatically follow that just because the opponent's marks do not include the goods covered by the above services that they are dissimilar. It is my view that while the nature, method of use and purpose of the above services and the opponent's "telecommunication goods" in its first mark's specification differ, there is an overlap in trade channels and user. I say this because a producer of the opponent's goods is also likely to sell, and retail in, the goods covered by the above terms. Further, those looking to buy such goods are also likely to seek the retail of the goods covered by the above terms. As such, I find that these goods and services are similar to a low degree.

*Retail and wholesale services connected with image processing apparatus, instruments and equipment; retail and wholesale services connected with media for storing information, data, images and sound; retail and wholesale services connected with blank and pre-recorded magnetic cards, cards containing microprocessors, integrated circuit cards, electronic identification cards, telephone cards; retail and wholesale services connected with magnetic, digital and optical data carriers, recording and storage media (blank and pre-recorded); retail and wholesale services connected with recording discs, compact discs, DVDs and other digital recording media, machine readable media, digital video, and data (downloadable) provided from a computer database or the internet; retail and wholesale services connected with personal digital assistants; retail and wholesale services connected with electronic and satellite navigational and positional apparatus and instruments, including global positioning systems; retail and wholesale services connected with scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life- saving and teaching apparatus and instruments; retail and wholesale services connected with apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; retail, and wholesale services connected with mechanisms for coin-operated apparatus; retail and wholesale services connected with fire-extinguishing apparatus; retail and wholesale services connected with [...] magnetically encoded cards, smart cards,*

*holograms; the bringing together, for the benefit of others, of a variety of goods namely chemical products, unprocessed artificial resins, unprocessed plastics, manures, fire extinguishing compositions, tempering and soldering preparations, tanning substances, adhesives used in industry, paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, metals in foil and powder form for use in painting, decorating, printing and art, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, non-medicated soaps, perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions, nonmedicated dentifrices, industrial oils and greases, lubricants, dust absorbing, wetting and binding compositions, fuels (including motor spirit) and illuminants, candles and wicks for lighting, pharmaceutical products and dietetic substances for humans and animals, disinfectants, agricultural chemicals, metal goods namely metal hardware and containers for storage or transport, hand tools and implements, cutlery, side arms, razors, [...] surgical, medical and veterinary apparatus and instruments, massage apparatus, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, apparatus for locomotion by land, air or water, firearms, ammunition, explosives and fireworks, jewellery, musical instruments, paper, printed matter, stationery, packaging, unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials, plastics and resins in extruded form for use in manufacture, packing, stopping and insulating materials, flexible pipes, tubes and hoses, not of metal, leather and imitations of leather, luggage, bags, whips, harnesses, saddlery, collars, leashes and clothing for animals, building materials, furniture and home decor, non-metallic containers, household or kitchen utensils and containers, combs and sponges, brushes, articles for cleaning purposes, unworked or semi-worked glass, glassware, porcelain and earthenware, rope, string, nets, tents, tarpaulins, awnings of textile or synthetic materials, sails, sacks for the transport and storage of materials in bulk, padding, cushioning and stuffing materials, yarns, threads, textiles, clothing, footwear, headgear, lace, embroidery, ribbons, braid, buttons, hooks and eyes, pins, needles, artificial flowers, hair decorations, flooring, carpets, wall hangings, false hair, foodstuff,*

*groceries, games, toys, gymnastic articles, sporting articles, decorations for Christmas trees, raw and unprocessed agricultural, aquacultural, horticultural and forestry products, raw and unprocessed grains and seeds, fresh fruits and vegetables, fresh herbs, natural plants and flowers, bulbs, seedlings and seeds for planting, live animals, foodstuffs and beverages for animals, malt, alcoholic beverages, non-alcoholic beverages, smokers' articles, tobacco and matches, enabling customers to conveniently view and purchase those goods; the bringing together, for the benefit of others, of a variety of services namely an online marketplace for application programming interface (API) tools and resources to enable developers to create software applications, an online marketplace enabling application programming interface (API) providers to register application programming interfaces (API), [...] office functions, [...] real estate services, building construction, repair and installation services, [...] transportation services, packaging services, travel arrangement services, services relating to the treatment of materials, educational services, entertainment services, services relating to sporting and cultural activities, scientific and technological services and research and design relating thereto, industrial analysis and research services, design and development of computer hardware, [...] services for providing food and drink, temporary accommodation services, medical services, veterinary services, hygienic and beauty care for human beings or animals, agriculture, horticulture and forestry services, legal services, security services for the physical protection of tangible property and individuals, personal and social services rendered by others to meet the needs of individuals, enabling customers to conveniently view and purchase those services.*

81. While some of the goods covered by the above terms relate to electrical equipment, I do not consider that they share a close enough connection with any of the opponent's goods or services that would give rise to a reasonable overlap in trade channels or user. On this point, I will state that, clearly, such goods or services differ in nature, method of use and purpose. In addition, I note that the above terms cover a wide range of other goods/services such as those that relate to real estate services, veterinary services and glassware, for example. Plainly, such services

bear no obvious connection to any of the opponent's goods or services. As such, I see no reason why such goods and services would overlap to any degree. Taking all of this into account, I find that the above terms are dissimilar to any of the opponent's goods or services.

*Provision of an online marketplace for buyers and sellers of goods and services.*

82. The above service describes something akin to eBay or Amazon Marketplace which provides a platform for third parties to sell various goods or services. It is not a retail service and while I appreciate that undertakings such as Amazon may retail in goods directly and also produce their own goods for sale, I am not aware that this is something that is common in the trade. As such, I cannot reasonably conclude that the provider of the opponent's goods or services would also provide online marketplaces for third parties to sell goods and services to others. As such, I do not consider that these goods and services overlap in trade channels. Further, I do not consider that the goods and services overlap in nature, method of use or purpose and neither is there any complementary or competitive relationship between them. While users of the opponent's goods and services may also buy or sell buy goods and services via online marketplaces, any overlap would be fleeting given the broad nature of the userbases. Even so, the sole overlap in user is insufficient to give rise to a finding that the above services are similar to any of the opponent's goods and services. They are, therefore, dissimilar.

*The bringing together, for the benefit of others, of a variety of services namely an online marketplace enabling application developers to search for and download application programming interfaces (APIs), advertising, business management, business administration, [...] insurance, financial services, [...] telecommunication services, [...] design and development of computer [...] software, [...] rendered by others to meet the needs of individuals, enabling customers to conveniently view and purchase those services.*

83. Despite referring to the 'bringing together' of various services, the above terms are technically for the provision of online marketplace. I appreciate that the services covered by the above terms are identical or similar to services across the opponent's specification, however, they are not retail services. Therefore, the findings I have made in respect of similarity between some of the applicant's retail services and the opponent's goods/services are not applicable here. Instead, I adopt the same findings I have made in the preceding paragraph and, as a result, I find that the above services are dissimilar to the opponent's services.

*Arranging and conducting of exhibitions for business purposes.*

84. While the opponent's second and third marks include the term "business management services", I do not consider that the above is a business management service. I say this because it is a service for arranging and conducting exhibitions, meaning that it does not share an overlap in nature, method of use or purpose with the opponent's service. Further, as far as I am aware, the provider of business management services does not offer services for the arranging or conducting of exhibitions. These services are not competitive and neither are they complementary in nature. Lastly, I appreciate that the users may overlap, however, this alone is not sufficient in order to warrant a finding that these services are similar to any degree. They are, therefore, dissimilar.

*Business management; business administration; business research; business strategy and planning services; economic forecasting, [...], market research, market analysis and survey services; compilation of statistical information.*

85. The opponent's second and third marks include the term "business management services". I find that this term is identical with the above services, be that self-evidently identical or under the principle outlined in *Meric*.

*Franchising and merchandising services.*

86. As set out in the preceding paragraph, the opponent's second and third marks' specifications include "business management services". As far as I understand it, the above service relates to the expansion and growth of a business as opposed to the management of the same. As such, I do not consider that the opponent's service encompasses the above. That being said, I find likely that a provider of business management services will also offer services in relation to the franchising and merchandising of said business. Therefore, I find that there exists an overlap in trade channels between these services. In addition, a user looking to expand its business via franchising or merchandising is also the user of the opponent's management service. Overall, while the nature, method of use and purpose of these services do not overlap, I consider that these services are similar to a low degree.

Class 38

*Messaging services, including, sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; online messaging services; unified messaging services; computer aided transmission of messages and images; video conferencing services; video telephone services, teleconferencing services, voice over internet protocol (VOIP) services; paging services; telephone telecommunications services provided via prepaid telephone calling card; providing prepaid minutes for use on mobile phones; providing telephone communication and internet telephony services; telephone and mobile telephone message collection and transmission, radio-paging, call diversion, answerphone and electronic mail services for others; transmission, delivery and reception of sound, data and images; personal numbering services; hire, leasing and rental of telecommunications, telephonic and communications apparatus and instruments; loan of replacement telecommunications and communications apparatus and instruments; provision of internet access services; telecommunications services for location and*

*tracking of persons and objects; tracking of mobile telephone via satellite signals; provision of information relating to or identifying telecommunications and communications apparatus and instruments; provision of wireless application protocol services, including those utilizing a secure communications channel; provision of information relating to or identifying telecommunications and communications apparatus and instruments; broadcast or transmission of radio or television programmes; providing telecommunications connections to computer databases, the internet or other electronic networks; provision of wireless electronic transmission of credit and debit card transaction data and wireless electronic savings and payment data via a global computer network; providing access to digital audio, video and data websites from a database, the internet, or other electronic network; streaming of audio and video material on the internet; providing access to telecommunications infrastructures for other operators; telecommunication and communication database services, including enabling the consumer to download digital content from a network and server to an individual database; providing and leasing access time to computer databases, computer bulletin boards, computer networks and interactive computer communications networks; advisory, information and consultancy services relating to all the aforementioned.*

87. While the opponent's second and third marks' specifications include telecommunication services in class 38, I consider that it is the opponent's term of "telecommunication goods" in its first mark's specification that offers the opponent its best case. I say this because all of the above goods require the use of a telecommunication good. For example, video conferencing services require use of a physical set up which includes a number of telecommunication goods. Further, messaging services will require a device to send messages and paging services will require the use of a pager, both of these are telecommunication goods. In such scenarios, both the goods and services will generally be used to enable communication between people, meaning that there is likely to be some overlap in purpose. Further, I consider that it is common in the trade for telecommunication service providers to also provide the device used to facilitate the service. As a

result, I find that the goods and services overlap in trade channels. Further, someone seeking video conferencing services or paging services is likely to require telecommunication goods in order to use the same. Therefore, the user of these goods and services overlap. Lastly, there is a complementary relationship between these goods and services on the basis that the telecommunication goods are important to the provision of the services and, in my view, consumers are likely to believe that they originate from the same undertakings. Taking all of this into account and even bearing in mind the clear difference in nature and method of use, I find that these goods and services are similar to at least a medium degree.

88. In respect of the advisory, information and consultancy term, I consider that this is similar to a low degree with the opponent's "telecommunication goods" in its first mark's specification. I say this because, in my view, the provider of such goods is also likely to provide a range of telecommunication services that will be sought by the same user, meaning that there is an overlap in trade channels and user between said goods and services.

*Telecommunication services; mobile, fixed, satellite, cellular, mobile and radio telecommunication services; telecommunications services, including, mobile telephone services, voicemail, facsimile transmission and data transmission; wireless communication services, including, wireless mobile telephone calling, electronic messaging and data transmission service plans; information and consultancy services relating to all the aforementioned.*

89. The above services are all telecommunication services and despite the use of 'including' in some of them, they are not bound to cover those types of services only. They are, therefore, very broad terms that can cover any type of telecommunication services such as the opponent's "computerised consultation of telephone directories" and "providing access to an online interactive website containing users comments concerning various businesses and service providers"

in its second and third marks' specifications. As such, I find that these services are identical under the principle outlined in *Meric*.

90. In respect of the advisory, information and consultancy term, I consider that this is similar to a low degree with the class 38 services in the opponent's second and third mark's specifications. I say this because the provider of the opponent's services is also likely to provide advice, information and consultancy in respect of a range of telecommunication services. Further, said services are likely to be sought by the same users.

#### Conclusion of the goods and services comparison

91. In order for there to be a likelihood of confusion under section 5(2)(b) grounds, a level of similarity between the goods and services is required.<sup>15</sup> Therefore, in light of my above findings, the section 5(2)(b) grounds of the oppositions fail in respect of the following goods and services:

Class 9: Image processing apparatus, instruments and equipment; magnetically encoded cards; smart cards; holograms; media for storing information, data, images and sound; blank and pre-recorded magnetic cards; cards containing microprocessors; integrated circuit cards; electronic identification cards; telephone cards; telephone credit cards; credit cards; debit cards; magnetic, digital and optical data carriers, recording and storage media (blank and pre-recorded); recording discs; compact discs; DVDs and other digital recording media; machine readable media; digital video, and data (downloadable) provided from a computer database or the internet; personal digital assistants; programmed-data-carrying electronic circuits; electronic and satellite navigational and positional apparatus and instruments, including global positioning

---

<sup>15</sup> See paragraph 49 of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

systems; parts and fittings included in class 09 for the aforementioned goods; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; mechanisms for coin-operated apparatus; fire-extinguishing apparatus.

Class 35: Retail and wholesale services connected with computer software for financial management, planning, account aggregation and budgeting; retail and wholesale services connected with data processing equipment; retail and wholesale services connected with apparatus and instruments for the processing, transmission, storage, logging, reception and retrieval of data being in the form of encoded data, text, graphic images or video or a combination of these formats; retail and wholesale services connected with mobile phone cases; retail and wholesale services connected with image processing apparatus, instruments and equipment; retail and wholesale services connected with media for storing information, data, images and sound; retail and wholesale services connected with blank and pre-recorded magnetic cards, cards containing microprocessors, integrated circuit cards, electronic identification cards, telephone cards; retail and wholesale services connected with magnetic, digital and optical data carriers, recording and storage media (blank and pre-recorded); retail and wholesale services connected with recording discs, compact discs, DVDs and other digital recording media, machine readable media, digital video, and data (downloadable) provided from a computer database or the internet; retail and wholesale services connected with personal digital assistants; retail and wholesale services connected with electronic and satellite navigational and positional apparatus and instruments, including global positioning systems; retail and wholesale services connected with

scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life- saving and teaching apparatus and instruments; retail and wholesale services connected with apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; retail, and wholesale services connected with mechanisms for coin-operated apparatus; retail and wholesale services connected with fire-extinguishing apparatus; retail and wholesale services connected with [...] magnetically encoded cards, smart cards, holograms; the bringing together, for the benefit of others, of a variety of goods namely chemical products, unprocessed artificial resins, unprocessed plastics, manures, fire extinguishing compositions, tempering and soldering preparations, tanning substances, adhesives used in industry, paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, metals in foil and powder form for use in painting, decorating, printing and art, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, non-medicated soaps, perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions, nonmedicated dentifrices, industrial oils and greases, lubricants, dust absorbing, wetting and binding compositions, fuels (including motor spirit) and illuminants, candles and wicks for lighting, pharmaceutical products and dietetic substances for humans and animals, disinfectants, agricultural chemicals, metal goods namely metal hardware and containers for storage or transport, hand tools and implements, cutlery, side arms, razors, [...] surgical, medical and veterinary apparatus and instruments, massage apparatus, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, apparatus for locomotion by land, air or water, firearms, ammunition, explosives and fireworks, jewellery, musical instruments, paper, printed matter, stationery, packaging, unprocessed and semi-

processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials, plastics and resins in extruded form for use in manufacture, packing, stopping and insulating materials, flexible pipes, tubes and hoses, not of metal, leather and imitations of leather, luggage, bags, whips, harnesses, saddlery, collars, leashes and clothing for animals, building materials, furniture and home decor, non-metallic containers, household or kitchen utensils and containers, combs and sponges, brushes, articles for cleaning purposes, unworked or semi-worked glass, glassware, porcelain and earthenware, rope, string, nets, tents, tarpaulins, awnings of textile or synthetic materials, sails, sacks for the transport and storage of materials in bulk, padding, cushioning and stuffing materials, yarns, threads, textiles, clothing, footwear, headgear, lace, embroidery, ribbons, braid, buttons, hooks and eyes, pins, needles, artificial flowers, hair decorations, flooring, carpets, wall hangings, false hair, foodstuff, groceries, games, toys, gymnastic articles, sporting articles, decorations for Christmas trees, raw and unprocessed agricultural, aquacultural, horticultural and forestry products, raw and unprocessed grains and seeds, fresh fruits and vegetables, fresh herbs, natural plants and flowers, bulbs, seedlings and seeds for planting, live animals, foodstuffs and beverages for animals, malt, alcoholic beverages, non-alcoholic beverages, smokers' articles, tobacco and matches, enabling customers to conveniently view and purchase those goods; the bringing together, for the benefit of others, of a variety of services namely an online marketplace for application programming interface (API) tools and resources to enable developers to create software applications, an online marketplace enabling application programming interface (API) providers to register application programming interfaces (API), [...] office functions, [...] real estate services, building construction, repair and installation services, [...] transportation services, packaging services, travel arrangement services, services relating to the treatment of materials, educational

services, entertainment services, services relating to sporting and cultural activities, scientific and technological services and research and design relating thereto, industrial analysis and research services, design and development of computer hardware, [...] services for providing food and drink, temporary accommodation services, medical services, veterinary services, hygienic and beauty care for human beings or animals, agriculture, horticulture and forestry services, legal services, security services for the physical protection of tangible property and individuals, personal and social services rendered by others to meet the needs of individuals, enabling customers to conveniently view and purchase those services; provision of an online marketplace for buyers and sellers of goods and services; the bringing together, for the benefit of others, of a variety of services namely an online marketplace enabling application developers to search for and download application programming interfaces (APIs), advertising, business management, business administration, [...] insurance, financial services, [...] telecommunication services, [...] design and development of computer [...] software, [...] rendered by others to meet the needs of individuals, enabling customers to conveniently view and purchase those services; arranging and conducting of exhibitions for business purposes.

92. In addition, given that I have found no similarity between the services in the applicant's first mark and the goods and services in the opponent's second mark's specification, the first opposition insofar as it relies on the opponent's second mark also fails.

### **The average consumer and the nature of the purchasing act**

93. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course

of trade. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

94. The opponent submits that the average consumer for the goods and services at issue will be both members of the general public at large and business users. Given the wide ranging nature of the goods and services at issue, I agree. I consider that the goods and services will be selected via physical stores (be that general retailers or the producer/provider itself) and online via lists of goods/services on a website. In my view, the goods and services will, for the most part, be selected on a primarily visual basis, though I do not discount an aural component playing a role. That being said, I do appreciate that some services (such as telecommunication or advertising services, for example) will be selected after detailed discussions with sales assistants meaning that, for these services, the aural component will play an equal role to the visual one.

95. Given the wide ranging nature of the goods and services at issue, I find that the frequency of selection and cost of the goods/services will vary quite considerably. For example, “computer software” is a very broad term and will inevitably cover some cheaper and more frequently selected goods whereas some advertising services will be expensive and selected on a more infrequent basis. Plainly, some goods will attract a lower degree of attention (where “computer software” covers

cheaper downloadable apps, for example) and some will attract a medium degree of attention (where “telecommunication goods” covers items such as mobile phones or video conferencing equipment for example). That being said, I acknowledge that some services will attract a higher (though not outright high) degree of attention. I say this because business users looking for advertising services, for example, will consider such a selection an important one for the success of their business so will, therefore, pay particular attention to a wide range of factors during the selection process.

### **Comparison of the marks**

96. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.




97. 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.”

98. 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.

99. The respective trade marks are shown below:

The opponent's marks	The applicant's marks
<div style="text-align: center;">  <p>("the opponent's first mark")</p> </div> <div style="text-align: center; margin-top: 20px;"> <p>YELL</p> <p>("the opponent's second mark")</p> </div> <div style="text-align: center; margin-top: 20px;">  <p>(the opponent's third mark")</p> </div>	<div style="text-align: center; margin-top: 20px;"> <p>Y'ELLO</p> <p>("the applicant's first mark")</p> </div> <div style="text-align: center; margin-top: 20px;">  <p>("the applicant's second mark")</p> </div>

100. Given that I have found that the first opposition fails insofar as it relies on the opponent's second mark, it is not necessary to compare the opponent's second mark and the first mark of the applicant. In addition, the opponent's third mark is only relied upon under the second opposition so, therefore, it is only necessary to consider it against the applicant's second mark.

101. As was the case with the goods and services comparison above, I have submissions from the opponent as well as comments from the applicant via its

counterstatement. While I will not reproduce those submissions/comments here, I can confirm that I have taken these into account.

### Overall impression

102. The applicant's first mark is a word only mark that consist of the words 'Y'ELLO'. I note that the opponent submits that the apostrophe between the letters 'Y' and 'E' is insignificant. I disagree and for reasons that I will come to discuss below, I consider that the apostrophe will be noticed. As such, I find that the overall impression of the applicant's first mark lies in the mark in its entirety. The applicant's second mark is a figurative mark that consists of the word 'Y'ello' presented in a standard black typeface on a white background. Given the standard typeface used and in light of what I have said regarding the apostrophe above, I find that the 'Y'ELLO' element will play the strongest role with the typeface used having a negligible impact.

103. In respect of the opponent's marks, I note that the first mark is a figurative mark that consists of the word 'YELL' in a standard black typeface that sits on a white background and is surrounded by a black, rounded-square shaped border. The word itself will play the greatest role in the overall impression of the mark and whilst the border will not be ignored outright, its impact will be negligible given its role as a fairly banal border. The opponent's second mark is a word only mark consisting solely of the word 'YELL'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself. The opponent's third mark is a figurative mark consisting of the word 'Yell' in a standard black typeface on a white background. Before this element is a black and yellow device which appears to be two fingers of a human hand, presented in black, configured as if they are walking. Given that consumers tend to focus on parts of marks that can be read, I find that the word 'Yell' plays the greater role in the overall impression of this mark, with the device playing a lesser role.

## Visual comparison

### *The applicant's first mark*

104. In comparing the applicant's first mark to the opponent's first mark, I note that they share the letters 'Y-E-L-L'. The marks differ in the presence of an apostrophe between the letters 'Y' and 'E' in the applicant's mark and the letter 'O' at its end. In addition, the marks differ in the presence of the border device in the opponent's first mark. While the latter point only has a negligible role in the opponent's first mark, it still acts as a point of visual difference. In respect of the typeface used, I note that the applicant's mark is a word only mark so is capable of being presented in any standard typeface. As such, the typeface used in the applicant's first mark is not a point of distinction between the marks. Overall, I find that the marks are visually similar to between a medium and high degree.

### *The applicant's second mark*

105. The applicant's second mark shares the same points of similarity with the opponent's first mark as discussed above. As for the points of difference, they are mostly the same, although I note that both marks are figurative marks so are not capable of being presented in differing typefaces. While the typefaces used in the marks are standard, they do act as a slight point of difference between the marks. Taking this into account together with the points of similarity and differences I have discussed above, I find that these marks are visually similar to a medium degree.

106. The opponent's second mark is a word only mark so is capable of use in any typeface meaning that the typeface used does not act as a visual distinction between the marks. Similarly to the marks compared above, these marks share the letters 'Y-E-L-L' and differ in the use of an apostrophe and the letter 'O'. Overall, I consider that these marks are visually similar to a high degree.

107. The opponent's third mark also shares the letters 'Y-e-l-l' with the applicant's second mark. The points of difference between the marks the same as those discussed in the preceding paragraph. That being said, a further point of difference comes in the device element of the opponent's third mark. While this plays a lesser role in the overall impression of that mark, it will still contribute as a point of visual difference between the marks. Taking all of this into account, I find that these marks are visually similar to a medium degree.

#### Aural comparison

108. All of the opponent's marks will be pronounced as the word 'YELL', being just one syllable in length. Despite the apostrophe, the applicant's marks will be pronounced identically to the word 'yellow', being two syllables in length. The first syllable in the applicant's marks is identical to the only syllable in the opponent's marks, with the only difference coming in the pronunciation of the letter 'O'. Overall, I find that all of the marks at issue are aurally similar to a high degree.

#### Conceptual comparison

109. While I appreciate that the opponent's marks stem from the branding 'the yellow pages', this is not evident in the mark itself. Secondly, I remind myself that conceptual comparisons do not take into account the reputation of earlier marks. In *Ravensburger AG v OHIM*, the GC stated:<sup>16</sup>

"27.... The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05

---

<sup>16</sup> Case T-243/08.

Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway), not published in the ECR, paragraphs 50 and 51).”

110. In *Retail Royalty Company v Harringtons Clothing Limited*, Phillip Harris, as the Appointed Person, considered the argument that the letters “AE” had, through their use, acquired an independent conceptual significance which would mean that the average consumer would always perceive them as meaning “AMERICAN EAGLE”.<sup>17</sup> He said:

“74. The Opponent is trying to equate reputation in a trade mark sense with conceptual meaning. They are not the same thing. Reputation can mean different things, and in trade mark law the term is sometimes used loosely, but in this context, it concerns the factual extent to which a sign is recognised by a significant part of the public as a *trade mark* [original emphasis].

75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trademark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken. Whilst a trade mark’s reputation might evolve or be converted into a conceptual meaning (possibly to its detriment in terms of genericity), it needs to be properly proven.

76. It is true that there are cases where an extensive reputation has been parlayed into conceptual meaning (for example C-361/04 P *PICASSO/PICARO* and C-449/18 *MESSI*) but these are the exception rather than the rule and depend on their own facts. Furthermore, the “reputation” element in those cases related to the fame attached to the names of the individuals for their roles in

---

<sup>17</sup> BL O/593/20.

society, rather than specifically to a trade mark function. In other words, it was a different sort of reputation.”

111. Accordingly, it is not correct to attribute to the earlier mark a ‘brand’ meaning. Therefore, the sole concept of the opponent’s marks lies in the word ‘YELL’, which will be understood as an ordinary dictionary word meaning to shout, cheer or utter in a loud and piercing way.<sup>18</sup> As for the applicant’s marks, their concepts will be derived from the word ‘Y’ELLO’. This is not a dictionary word and while it will be pronounced like the word ‘yellow’, I consider that the use of the apostrophe will impact upon the mark to the point that it will take consumers away from the belief that it is a misspelling of the word ‘yellow’. It is for this reason that I consider that the apostrophe will not be overlooked because, put simply, it will result in consumers’ understanding of the mark itself. My primary view is that consumers will view the mark as an informal greeting. On this point, I note that the opponent’s submissions suggest that it will be seen as a portmanteau of the words ‘yes’ and ‘hello’ which will be viewed as an informal greeting.<sup>19</sup> While I am not convinced of the opponent’s submission, its position remains that ‘Y’ELLO’ is an informal greeting.

112. The opponent claims that the word ‘Y’ELLO’ will be viewed as an informal salutation which will bring to mind the idea of speaking out, which is to ‘yell’. While I accept that it is a salutation, I see no reason why consumers would bring to mind any concept associated with the meaning of ‘yell’. As a result, I find that both parties’ marks have distinct meanings that are graspable by the average consumer. I, therefore, find that they are conceptually dissimilar.

---

<sup>18</sup> <https://www.collinsdictionary.com/dictionary/english/yell>

<sup>19</sup> I note that this finding is in line with the opponent’s submissions on the meaning of the applicant’s marks.

## **Distinctive character of the opponent's marks**

113. 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).”

114. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has filed evidence of the use of its marks and has argued that its marks

enjoy an enhanced degree of distinctive character. I will, therefore, consider whether this evidence is sufficient to give rise to a finding that the distinctiveness of the opponent's marks has been enhanced through use. Before doing so, I will consider the inherent position.

115. While the opponent's first mark consists of a border device, this is banal and, as such, I find that the distinctiveness of the mark lies solely in the word 'YELL'. As a word only mark, the same goes for the opponent's second mark. In respect of the opponent's third mark, I appreciate that the device element adds some distinctiveness to the mark. However, I do not consider that it is to any material degree in order to increase the level of inherent distinctiveness to a degree beyond that created by the word 'YELL'.

116. I have set out above that the word 'YELL' is an ordinary dictionary word that will be recognised by consumers. While it is not descriptive or allusive of the goods and services relied upon, it is an ordinary dictionary word which is not remarkable from a trade mark perspective. As a result, I find that the opponent's marks enjoy a medium degree of inherent distinctive character.

117. Turning to the position in respect of enhanced distinctiveness, I refer to the evidence summary I have produced at paragraphs 27 to 40 above. On this point, I note that this summary was made in respect of the opponent's second and third mark. However, the distinctiveness of the opponent's branding is in the word 'YELL' so I see no reason why the evidence cannot also point to the enhanced distinctiveness of the opponent's first mark.

118. I do not intend to reproduce that summary here but remind myself that the opponent's revenue was, as at the relevant date, £676 million. Further, I note that it also had an advertising expenditure of approximately £7 million. Under the present comparison, I appreciate that the test for enhanced distinctiveness is considerably more onerous than that for genuine use. However, I consider that the

level of use is so high that it is sufficient to give rise to a finding that the opponent's marks have been enhanced to a high degree thanks to the use made of them. That being said, as the use only relate to some goods and services, I find that this conclusion only applies to those same goods and services, being those set out at paragraph 59 above.

### **Likelihood of confusion**

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

120. In respect of the goods and services at issue, I have found them to be either identical or similar to varying degrees. The average consumer base is formed of members of the general public and business users. In respect of the selection process, I have found that some consumers will select the goods via primarily visual means (though not discounting an aural component) whereas some others will pay attention to both the visual and aural component equally. I have concluded that average consumers will pay varying degrees of attention, ranging from a

relatively low to a higher (though not outright high) degree. In respect of the similarity of the marks, I have found all of the marks at issue to be aurally similar to a high degree and conceptually dissimilar. As for the visual comparison, I have found the following:

- a. The applicant's first mark is similar to between a medium and high degree with the opponent's first mark;
- b. The applicant's second mark is similar to a medium degree with the opponent's first mark;
- c. The applicant's second mark is similar to a high degree with the opponent's second mark; and
- d. The applicant's second mark is similar to a medium degree with the opponent's third mark.

121. Lastly, I found the opponent's marks to be inherently distinctive to a medium degree, with the marks being enhanced to a high degree of distinctive character due to the use made of them. However, the enhanced distinctiveness finding applies only to some goods and services, being those listed at paragraph 59 above.

122. Taking all of the above factors into account and even bearing in mind the principle of imperfect recollection, I do not consider that the marks at issue will be misremembered or inaccurately recalled for one another. While the shared use of the letters 'Y-E-L-L' will be noticed across all of the marks, the differences in the apostrophe and the letter 'O' would not be misremembered or overlooked, regardless of the latter's placement at the end of the applicant's marks.<sup>20</sup> In addition, I note that the parties' marks are relatively short (being four and five letters in length). While I appreciate that there is no special test for short marks,<sup>21</sup> the shortness of the marks adds further support to the conclusion that consumers are

---

<sup>20</sup> I say this whilst bearing in mind that, as per the case of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the beginnings of marks tend to have more impact than their ends. That being said, this is not always the case as similar beginnings are not necessarily important or decisive. See *CureVac GmbH v OHIM*, T-80/08.

<sup>21</sup> See paragraph 44 of *BOSCO*, BL O/301/20

more likely to notice the differences between them. In making this finding, I appreciate that the opponent's marks are highly distinctive for some goods and services at issue. However, the marks at issue are dissimilar from a conceptual standpoint and, on this point, I remind myself of the case of *The Picasso Estate v OHIM*, Case C-361/04 P, wherein the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

123. As such, I consider that even though the visual and aurally similarity between the marks, for the most part, sits at a higher degree, the distinct concepts of the marks are sufficient to point the consumer away from being directly confused by the marks. Consequently, I find that there exists no likelihood of direct confusion between the marks at issue even where the goods or services are identical and where the consumer pays a lower than medium degree of attention.

124. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later

mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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

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

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

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

125. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

126. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of

James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

127. I appreciate that ‘YELL’ is highly distinctive for some goods and services and that these letters, in the same order, fall within the entirety of both of the applicant’s marks. However, the presence of an apostrophe and the letter ‘O’ at the end of the opponent’s marks are sufficient to prevent the consumer from believing that the shared use of the letters ‘Y-E-L-L’ are such that only one undertaking would use them. Again, the overall impressions of the applicant’s marks lie in the ‘Y’ELLO’ element as a whole and this creates a distinct concept, different to that of the distinctive ‘YELL’ element. As a result, I see no reason why the consumers would believe that the marks originate from the same or economically linked undertakings simply because of the shared use of the letters ‘Y-E-L-L’. Additionally, I see no scenario wherein consumers would consider the changes/additions between the marks (being the apostrophe between the letter ‘Y’ and ‘E’ and the letter ‘O’ at the end) to be indicative of a sub-brand or brand extension. Lastly, I note that the examples given in the case of L.A. Sugar (cited above) are not exhaustive, however, I have been presented with no alternative argument as to indirect confusion from the opponent. Therefore, bearing in mind what I have said above and the comments set out in the case law I have discussed in the preceding paragraph, I find that there exists no likelihood of indirect confusion, even where the marks are viewed on identical goods or services and where the consumer pays a lower degree of attention.

### **Section 5(3)**

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

“5(3) A trade mark which –

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

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

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; Intel, paragraph 42

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation

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

130. Under the present ground, the opponent relies on its second mark in respect of the opposition against the applicant's first mark and, in its second opposition, it relies on both the second and first marks. The goods and services relied upon are set out in Annexes 3 and 6 of this decision. However, as proof of use applies equally to section 5(3) grounds as it does to section 5(2)(b) grounds, my findings above means that this ground may only proceed in respect of those goods and services for which I have found use. For ease of reference, these are as follows:

Class 9: Computer software, namely search engine software for business databases; downloadable software for mobile devices, namely for updating business database entries and database management; website development software; downloadable software for providing consumer information, namely rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers.

Class 35: Advertising, marketing and promotional services; production, preparation and presentation of advertising matter; provision of advertising space online media; providing an online commercial information directory on the Internet; advertising services provided over the Internet; display advertising; banner advertising; pay per click advertising; search engine marketing services; business information services; compilation of business directories; providing an online

searchable database for the provision of business information, including rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; business management services; professional consultancy services in relation to advertising.

Class 38: Computerised consultation of telephone directories; providing access to an online interactive website containing users comments concerning various businesses and service providers.

Class 41: Online publication of business directories, business reviews, market analysis and research; Online publishing of reviews.

Class 42: Design and development of computer software for businesses.

131. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks at issue are similar. Secondly, the opponent must show that its marks have achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

## **Reputation**

132. I have assessed the opponent's evidence of use at paragraphs 27 to 40 above. I do not intend to repeat this evidence in full here but remind myself that the opponent enjoyed a turnover of £676 million with an advertising spend of

approximately £7 million. Such use is clearly significant and, in my view, is sufficient to warrant a finding that the opponent's marks enjoy a strong reputation in the UK for the same goods and services listed at paragraph 130 above.

## **Link**

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

### The degree of similarity between the conflicting marks.

134. Under the section 5(2)(b) ground, I found that all of the marks at issue were highly similar from an aural perspective but conceptually dissimilar. In respect of the visual similarity of the marks that remain at issue here, I found the applicant's second mark to be visually similar to a high degree with the opponent's second mark and the applicant's second mark to be visually similar to a medium degree with the opponent's third mark.

135. I note that the opponent's second mark and the applicant's first mark were not compared under the section 5(2)(b) ground.<sup>22</sup> However, I consider that the above findings as to the aural and conceptual comparison apply to those marks also. As for the visual comparison between these marks, I note that they share use of the letters 'Y-E-L-L'. However, as was the case in the comparison of the other marks, the differences brought about by the presence of the apostrophe and the letter 'O' in the applicant's first mark will not go unnoticed. Further, under the present comparison, I am of the view that the differences between the typefaces used, while not stylised, act as a point of visual difference between the marks. Overall, I consider that these marks are similar to a medium degree.

---

<sup>22</sup> Neither were the opponent's third mark and the applicant's first mark. However, the opposition against the applicant's first mark is not reliant upon the opponent's third mark.

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

136. I have conducted a full goods and services comparison at paragraphs 62 to 90 above. That comparison was, in part, based on goods and services of the opponent's first mark, which is not at issue here. Therefore, I find that only where the comparison was reliant upon goods or services in the opponent's second and third marks' specifications is it relevant here.<sup>23</sup> This means that the findings I have reached in reliance upon the opponent's first mark are not relevant here. For ease of reference, those goods and services of the applicant that I found to be identical/similar to the opponent's first mark can be found at paragraphs 62 to 65, 67, 69 to 70, 72 to 73, 77 and 87 to 88 above. Again, those findings are not applicable here. In considering them in the context of the present ground, I find that, save for the services discussed at paragraphs 86 and 87, these goods and services share no obvious overlaps with the reputed goods and services of the opponent. Such services are, therefore, dissimilar. As for the services in paragraphs 87 and 88, I remind myself that these cover a broad range of telecommunication services and while they are not identical to the class 38 services for which the opponent enjoys a reputation, I do find them similar to a low degree. This is on the basis that these services, as telecommunication services, are likely to overlap in trade channels and user.

137. While there are a range of goods and services that are dissimilar, I am of the view that there remains a degree of closeness between them on the basis that the sections of the relevant public that select such goods and services are likely to overlap. For example, I consider that the various financial services covered by the

---

<sup>23</sup> I note that while the opponent initially relied upon wider specifications for these marks, the specifications were limited due to the use made of them. Those goods and services are the same as those for which these marks enjoy a reputation.

applicant's first mark's specification and the telecommunication goods and dissimilar retail services covered by the applicant's second mark's specification will be selected by overlapping sections of the relevant public as the opponent's reputed class 9 goods.

The strength of the earlier mark's reputation.

138. The opponent's marks enjoy a strong reputation.

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

139. The opponent's second and third marks are inherently distinctive to a medium degree. As for the position in respect of enhanced distinctiveness, I have found that these marks enjoy a high degree of distinctive character thanks to the use made of them. For the avoidance of doubt, the latter finding applies to those same goods and services for which the opponent enjoys a reputation.

Whether there is a likelihood of confusion

140. I have found that there is no likelihood of confusion between the opponent's second and third marks and the applicant's marks.

Conclusion on link

141. While I have found there to be no confusion, this is not the end of the matter as the opponent has claimed that consumers will bring to mind the opponent's marks when confronted by the applicant's marks. This claim is noted, however, I see no reason why the consumer would bring to mind the opponent's 'YELL' marks when confronted by the applicant's 'Y'ELLO' marks, even where some of the applicant's goods and services are identical to the reputed goods and services of the

opponent. Further, I do not consider that the consumer would be caused to wonder if the marks at issue were linked. I make this finding because while the marks share the letter string 'Y-E-L-L', the context of each parties' use of these letters differs. This is on the basis that 'YELL' forms its own word in the opponent's marks and only serves as part of a distinct (albeit visually and aurally similar) word in the applicant's marks, being 'Y'ELLO'. As above, 'Y'ELLO' will be viewed as an informal salutation which carries no conceptual overlap with 'YELL', despite the shared use of the same four letters. As such, I do not consider that the shared use of these letters is sufficient to lead the consumer to automatically thinking of the opponent's 'YELL' marks when confronted with 'Y'ELLO'. For the avoidance of doubt, I find that this applies even in circumstances where the consumer confronted with the applicant's marks was aware of the opponent's reputation.

142. Taking all of the above into account, I find that there exists no link between the marks at issue. Without a link between the marks, there cannot be any damage and, as such, I find that the section 5(3) ground fails at this stage.

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

143. Section 5(4)(a) of the Act states as follows:

"5(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”.

144. Subsection (4A) of section 5 of the Act 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.”

145. As I have set out above, the opponent dropped the section 5(4)(a) ground of its first opposition. This ground, therefore, only applies to the applicant’s second mark.

146. I consider that I can deal with this ground briefly. I say this because based on the evidence before me (and as already assessed above), there exists a level of protectable goodwill in the opponent’s business in respect of the goods and services for which there exists genuine use, enhanced distinctiveness and reputation.<sup>24</sup> Further, I find that the opponent’s signs are distinctive of and/or associated with that goodwill. I remind myself that, under the 5(2)(b) ground, I found there to be no likelihood of confusion between the opponent’s second and third marks and the applicant’s second mark in respect of all goods and services. In assessing the present ground, I remind myself of the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, wherein Kitchin LJ set out that it was doubtful whether the difference between the legal tests for likelihood of confusion and misrepresentation will (all other factors being equal) produce different outcomes. Because the opponent’s signs are identical to the marks relied upon under the section 5(2)(b) ground, I am of the view that this

---

<sup>24</sup> On this point, I note that save for some additional terms (such as “online business directories”), the specification relied upon under this ground is the same as that relied upon under its third mark, being that which was subject to these assessments above. In my view, those additional terms offer no further assistance to the opponent under the present ground.

principle applies here. As such, I find that there exists no misrepresentation under the present ground. Without a finding of misrepresentation, there can be no damage meaning that this ground of opposition fails in its entirety.

## **CONCLUSION**

147. The oppositions fail in their entirety and the applicant's marks will, subject to any successful appeal of my decision, proceed to registration for all of the goods and services applied for.

## **COSTS**

148. The applicant has been successful and it is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the present case, I note that the applicant was required to consider two notices of opposition and file two counterstatements. The below costs will take that point into account. While I appreciate that the applicant did not file any evidence in these proceedings, it was required to consider the evidence of the opponent so I consider it necessary to award costs for that task.

149. In circumstances, I award the applicant the sum of £1,500 as a contribution towards its costs. The sum is calculated as follows:

Considering two notices of opposition and preparing two counterstatements:	£1,000
Considering the opponent's evidence:	£800
<b>Total:</b>	<b>£1,800</b>

150. I hereby order Yell Limited to pay MTN GROUP MANAGEMENT SERVICES (PROPRIETARY) LIMITED, Inc the sum of £1,800. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 24<sup>th</sup> day of October 2025**

**A COOPER**

**For the Registrar**

## ANNEX 1

### *The applicant's first mark*

#### Class 36

Financial affairs; monetary affairs; banking services including home, internet and remote banking; financial sponsorship; insurance and finance services including such services provided over the internet or any other electronic network; discount services including discount card services; issue and redemption of tokens, vouchers and points; issuance of tokens of value as a reward for customer loyalty; providing cash and other rebates as part of a customer loyalty program; credit card services; charge card services; pre-paid purchase card services, including processing electronic payments made through prepaid cards; insurance, financing and guarantee services relating to telecommunications and communications apparatus and instruments; provision of electronic and online financial services, including electronic fund transfer services and secure on-line monetary transaction facilities; providing an internet website portal in the field of financial transaction and payment processing; processing financial transactions via a global computer network; providing multiple payment options by means of customer-operated electronic terminals available on-site in retail stores; provision of investment and fund management information; administration of funds and investments; stock, shares and bond information and brokerage services; provision of information and advisory services relating to monetary affairs and the aforementioned services, including the provision of information from a computer database, the internet or other electronic network; provision of information and advice for the prospective purchasers of commodities and goods, all related to payment terms and insurance.

### *The applicant's second mark*

#### Class 9

Data processing equipment, including calculating machines and computers; computer software; computer Chatbot software; communication software for providing access to

the Internet; computer application software for mobile phones; computer software for financial management and planning, account aggregation and budgeting; electrical and electronic telecommunications and communications apparatus and instruments; data communication apparatus and instruments, including portable electronic devices to access the Internet wirelessly; apparatus for recording, transmission or reproduction of sound or images; apparatus and instruments for the processing, transmission, storage, logging, reception and retrieval of data being in the form of encoded data, text, graphic images or video or a combination of these formats; image processing apparatus, instruments and equipment; telecommunications products, namely, computer control hardware for use in wireless communications systems; routers; modems; magnetically encoded cards; smart cards; holograms; media for storing information, data, images and sound; blank and pre-recorded magnetic cards; cards containing microprocessors; integrated circuit cards; electronic identification cards; telephone cards; telephone credit cards; credit cards; debit cards; magnetic, digital and optical data carriers, recording and storage media (blank and pre-recorded); recording discs; compact discs; DVDs and other digital recording media; machine readable media; digital video, and data (downloadable) provided from a computer database or the internet; personal digital assistants; satellite receiving and transmission apparatus and instruments; apparatus for downloading audio, video and data from the internet; television apparatus and instruments; radio and television broadcasting transmitters and receivers; apparatus for access to broadcast or transmitted programmes; programmed-data-carrying electronic circuits; electronic and satellite navigational and positional apparatus and instruments, including global positioning systems; telephones; mobile telephones; cordless telephones; telephone accessories, including, telephone cords and batteries; electronic products, namely, digital photograph receivers; telecommunication couplers; telecommunication modular plugs; transceivers; wireless transceivers; teleconferencing telephones; telephone answering machines; internet telephones; wireless telephones; earphones and antennae for cordless and wireless telephones; communication apparatus and instruments for wireless internet access and online streaming; hands-free devices for car telephones and mobile telephones; in-car telephone handset cradles; mobile

phone cases; parts and fittings included in class 09 for the aforementioned goods; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; mechanisms for coin-operated apparatus; fire-extinguishing apparatus.

### Class 35

Advertising and promotion services; loyalty card services; organisation, operation and management of customer loyalty schemes; organisation, operation and supervision of sales and promotional incentive schemes; retail and wholesale services connected with data processing equipment, computer software, communication software for providing access to the Internet, computer application software for mobile phones, computer software for financial management, planning, account aggregation and budgeting; retail and wholesale services connected with electrical and electronic telecommunications and communications apparatus and instruments; retail and wholesale services connected with data communication apparatus and instruments, including portable electronic devices to access the Internet wirelessly; retail and wholesale services connected with apparatus for recording, transmission or reproduction of sound or images; retail and wholesale services connected with apparatus and instruments for the processing, transmission, storage, logging, reception and retrieval of data being in the form of encoded data, text, graphic images or video or a combination of these formats; retail and wholesale services connected with image processing apparatus, instruments and equipment; retail and wholesale services connected with telecommunications products, including, computer control hardware for use in wireless communications systems; retail and wholesale services connected with routers, modems, magnetically encoded cards, smart cards, holograms; retail and wholesale services connected with media for storing information, data, images and sound; retail and wholesale services connected with blank and pre-recorded magnetic cards, cards containing microprocessors, integrated circuit cards, electronic identification cards, telephone cards; retail and wholesale services

connected with magnetic, digital and optical data carriers, recording and storage media (blank and pre-recorded); retail and wholesale services connected with recording discs, compact discs, DVDs and other digital recording media, machine readable media, digital video, and data (downloadable) provided from a computer database or the internet; retail and wholesale services connected with personal digital assistants; retail and wholesale services connected with satellite receiving and transmission apparatus and instruments, apparatus for downloading audio, video and data from the internet, television apparatus and instruments, radio and television broadcasting transmitters and receivers, apparatus for access to broadcast or transmitted programmes, programmed-data-carrying electronic circuits; retail and wholesale services connected with electronic and satellite navigational and positional apparatus and instruments, including global positioning systems; retail and wholesale services connected with telephones, mobile telephones, cordless telephones, telephone accessories, including, telephone cords and batteries; retail and wholesale services connected with electronic products, namely, digital photograph receivers; retail and wholesale services connected with telecommunication couplers, telecommunication modular plugs, transceivers, wireless transceivers, teleconferencing telephones, telephone answering machines, internet telephones, wireless telephones, earphones and antennae for cordless and wireless telephones, communication apparatus and instruments for wireless internet access and online streaming, hands-free devices for car telephones and mobile telephones, and in-car telephone handset cradles; retail and wholesale services connected with mobile phone cases; retail and wholesale services connected with scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life- saving and teaching apparatus and instruments; retail and wholesale services connected with apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; retail, and wholesale services connected with mechanisms for coin-operated apparatus; retail and wholesale services connected with fire-extinguishing apparatus; franchising and merchandising services; the bringing together, for the benefit of others, of a variety of goods namely chemical products, unprocessed artificial resins, unprocessed plastics,

manures, fire extinguishing compositions, tempering and soldering preparations, tanning substances, adhesives used in industry, paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, metals in foil and powder form for use in painting, decorating, printing and art, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, non-medicated soaps, perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions, nonmedicated dentifrices, industrial oils and greases, lubricants, dust absorbing, wetting and binding compositions, fuels (including motor spirit) and illuminants, candles and wicks for lighting, pharmaceutical products and dietetic substances for humans and animals, disinfectants, agricultural chemicals, metal goods namely metal hardware and containers for storage or transport, hand tools and implements, cutlery, side arms, razors, software, mobile telephones, smart phones and related accessories, modems, routers, telephone cards, telecommunication devices and related accessories, surgical, medical and veterinary apparatus and instruments, massage apparatus, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, apparatus for locomotion by land, air or water, firearms, ammunition, explosives and fireworks, jewellery, musical instruments, paper, printed matter, stationery, packaging, unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials, plastics and resins in extruded form for use in manufacture, packing, stopping and insulating materials, flexible pipes, tubes and hoses, not of metal, leather and imitations of leather, luggage, bags, whips, harnesses, saddlery, collars, leashes and clothing for animals, building materials, furniture and home decor, non-metallic containers, household or kitchen utensils and containers, combs and sponges, brushes, articles for cleaning purposes, unworked or semi-worked glass, glassware, porcelain and earthenware, rope, string, nets, tents, tarpaulins, awnings of textile or synthetic materials, sails, sacks for the transport and storage of materials in bulk, padding, cushioning and stuffing materials, yarns, threads, textiles, clothing, footwear, headgear, lace, embroidery, ribbons, braid, buttons, hooks and eyes, pins, needles, artificial flowers, hair decorations, flooring, carpets, wall hangings, false hair, foodstuff,

groceries, games, toys, gymnastic articles, sporting articles, decorations for Christmas trees, raw and unprocessed agricultural, aquacultural, horticultural and forestry products, raw and unprocessed grains and seeds, fresh fruits and vegetables, fresh herbs, natural plants and flowers, bulbs, seedlings and seeds for planting, live animals, foodstuffs and beverages for animals, malt, alcoholic beverages, non-alcoholic beverages, smokers' articles, tobacco and matches, enabling customers to conveniently view and purchase those goods; The bringing together, for the benefit of others, of a variety of services amely an online marketplace for application programming interface (API) tools and resources to enable developers to create software applications, an online marketplace enabling application programming interface (API) providers to register application programming interfaces (API), an online marketplace enabling application developers to search for and download application programming interfaces (APIs), advertising, business management, business administration, office functions, insurance, financial services, real estate services, building construction, repair and installation services, telecommunication services, transportation services, packaging services, travel arrangement services, services relating to the treatment of materials, educational services, entertainment services, services relating to sporting and cultural activities, scientific and technological services and research and design relating thereto, industrial analysis and research services, design and development of computer hardware and software, services for providing food and drink, temporary accommodation services, medical services, veterinary services, hygienic and beauty care for human beings or animals, agriculture, horticulture and forestry services, legal services, security services for the physical protection of tangible property and individuals, personal and social services rendered by others to meet the needs of individuals, enabling customers to conveniently view and purchase those services; provision of an online marketplace for buyers and sellers of goods and services; arranging and conducting of exhibitions for business purposes; business management; business administration; business research; business strategy and planning services; economic forecasting, marketing, market research, market analysis and survey services; compilation of statistical information; provision of trade information; provision of directory services.

### Class 38

Telecommunication services; mobile, fixed, satellite, cellular, mobile and radio telecommunication services; telecommunications services, including, mobile telephone services, voicemail, facsimile transmission and data transmission; wireless communication services, including, wireless mobile telephone calling, electronic messaging and data transmission service plans; messaging services, including, sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; online messaging services; unified messaging services; computer aided transmission of messages and images; video conferencing services; video telephone services, teleconferencing services, voice over internet protocol (VOIP) services; paging services; telephone telecommunications services provided via prepaid telephone calling card; providing prepaid minutes for use on mobile phones; providing telephone communication and internet telephony services; telephone and mobile telephone message collection and transmission, radio-paging, call diversion, answerphone and electronic mail services for others; transmission, delivery and reception of sound, data and images; personal numbering services; hire, leasing and rental of telecommunications, telephonic and communications apparatus and instruments; loan of replacement telecommunications and communications apparatus and instruments; provision of internet access services; telecommunications services for location and tracking of persons and objects; tracking of mobile telephone via satellite signals; provision of information relating to or identifying telecommunications and communications apparatus and instruments; provision of wireless application protocol services, including those utilizing a secure communications channel; provision of information relating to or identifying telecommunications and communications apparatus and instruments; broadcast or transmission of radio or television programmes; providing telecommunications connections to computer databases, the internet or other electronic networks; provision of wireless electronic transmission of credit and debit card transaction data and wireless electronic savings and payment data via a global computer network; providing access to digital audio, video and data websites from a database, the

internet, or other electronic network; streaming of audio and video material on the internet; telecommunication and communication database services, including enabling the consumer to download digital content from a network and server to an individual database; providing access to telecommunications infrastructures for other operators; providing and leasing access time to computer databases, computer bulletin boards, computer networks and interactive computer communications networks; advisory, information and consultancy services relating to all the aforementioned.

## ANNEX 2

*The opponent's first mark*

### Class 9

Telecommunications goods.

### Class 35

Organisation, operation, management, sale and supervision of promotional, incentive and loyalty schemes; business information, advertising and promotional services provided on-line from a computer database or by means of web pages on the Internet.

### Class 36

Information and advisory services relating to finance and insurance, shares and share dealing; financial services; banking services; credit card, debit card token card and charge card services; credit services; computerised financial services; discount card services; issuing of travel cards; credit card, charge card and debit card authorisation, validation and issuance services; information and advisory services relating to finance and insurance, provided on-line from a computer database or by means of web pages on the Internet; financial information disaster recovery services; the bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase those goods and services from a web site specialising in classified directory, business advertising and business information goods and services or from a catalogue specialising in classified directory, business advertising and business information goods and services by mail order or by means of telecommunication; issue and redemption of tokens and vouchers; automated payment services; database, on-line, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services.

### Class 38

Telecommunications services; telecommunication of information (including web pages); providing access to databases and information via the Internet; transmitting information via the worldwide web; services for the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet.

*The opponent's second mark*

### Class 9

Downloadable software for providing consumer information, namely rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers.

### Class 35

Providing an online commercial information directory on the Internet; business information services; providing an online searchable database for the provision of business information, including rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; compilation, provision and retrieval of business and commercial information; organisation, operation, management, sale and supervision of promotional, incentive and loyalty schemes.

### Class 38

The transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; on-line information services; providing access to an online interactive website containing users comments concerning various businesses and service providers.

### ANNEX 3

#### *The opponent's second mark*

##### Class 9

Computer software; application software; computer software, including search engine software, database management software, website development software, software for electronic financial transactions, application software and software for the creation of mobile Internet applications and client interfaces; computer software recorded on tapes, discs and cards; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the internet (including web sites); computer software and telecommunications apparatus (including modems) to enable connection to databases and to the internet; computer software to enable searching of data; computer software to enable searching of data; downloadable software for providing consumer information, namely rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; computer games and computer games software; web pages downloadable from the Internet; computer databases; apparatus and instruments for recording, transmission, reception, processing, retrieval, reproduction, manipulation, analysis, display and print-out of sound, images and/or data; digital communications apparatus and instruments; telecommunications apparatus and equipment; telecommunications goods; mobile and fixed telephone apparatus and instruments; facsimile machines; answering machines; pagers; switchboards; data communications goods; satellite communications goods; data terminals; remote access on-line information apparatus and instruments, all being electronic; aerials, cables and ducts all for electrical, telecommunications or optical signal transmissions; magnetic data carriers; magnetic and optical data media, namely magnetic discs, optical discs, floppy discs, magnetic tapes, magnetic cards, optical cards, integrated circuit cards, optical data carriers; compact discs; CD-ROMs; video cassettes; audio cassettes; DVDs and other digital recording media; compact disc players; video phones and video game cartridges; electronic memory cards, phone cards and electronic cards all for use with

communications apparatus and instruments; downloadable electronic publications; electronic notice boards; dealer boards (circuits); user (work) stations; electronic trading systems apparatus; debit cards, credit cards and charge cards; parts and fittings for all the aforesaid goods.

#### Class 16

Paper, cardboard; printed matter; bookbinding material; photographs; stationery; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed publications; printed directories; printed newsletters; books; booklets, leaflets, brochures and manuals; posters; maps; directories; directory covers; directory covers made from paper and cardboard; printed tickets, coupons and vouchers; advertising and promotional materials; advertisements; wrapping and packaging materials; plastic for packaging and wrapping goods; cling film for palletization; plastic polythene bags; tapes and cards, all for the recordal of computer programs and of data; computer programs in printed form; parts and fittings for all the aforesaid goods.

#### Class 35

Advertising, marketing and promotional services; production, preparation and presentation of advertising matter; distribution of advertising, marketing and promotional material; distribution of printed advertising matter; provision of advertising space in printed and online media; providing an online commercial information directory on the Internet; advertising services provided over the Internet; display advertising; banner advertising; electronic billboard advertising; pay per click advertising; provision of advertising space in a classified directory specialising in advertising and information, these services also provided from a web site and by telecommunications means; sales promotion; search engine marketing services; search engine optimisation; compilation of advertisements for use as web pages; production of video recordings for advertising and marketing purposes; business advisory and consultancy services; research and information services, including

analysis of market research data and statistics, and business investigations; business information services; compilation of business directories; market analysis and research; providing an online searchable database for the provision of business information, including rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; business management services; compilation, provision and retrieval of business and commercial information; compilation and systemisation of information into computer databases; systemisation of information into databases and data processing services; telephone answering services and message handling services; compilation and transcription of data; preparation of business reports; electronic database services for the provision of business information; data processing services; receipt, processing, recording or retrieval of data; collection and processing of messages and data; data processing and database services; database management services; database management services, including receipt, processing, compilation, systemisation, recording or retrieval of data; compilation of information; organisation, operation and management of promotional, incentive and loyalty schemes; provision of an on-line platform to facilitate business networking and the sharing of commercial information; business customer relationship management and problem solution services; expert, professional consultancy services in relation to advertising; providing a market place for the advertisement of services, all being provided via an Internet portal; providing a market place for the advertisement of goods to buy and sell, all being provided via an Internet portal; providing information about import and export agencies and international trade; import and export services; retail services in the field of software; business advisory services relating to cellular communications tariffs; database, online, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

### Class 38

Telecommunications services; cellular communications services; mobile communications services; digital communications services; satellite transmission

services; communications by fibre optic networks; telecommunication and transmission of information (including web pages), computer programs and other data, including in audio or visual form; electronic mail services; services for the collection, transmission, processing and storage of messages and data; remote data access services; electronic data interchange services; data communications services; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; provision of telecommunication access and links to computer databases and to the Internet; communication by computer terminals; the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; providing access to computer databases and to online computer services; leasing access time to computer databases and to online computer services; professional consultancy services in the field of telecommunications; telecommunication services enabling online and real time interaction between and among users of computers and mobile devices; display, transmission and processing of data from remote locations to mobile telephones; telephone messaging services; hire and rental of telecommunications apparatus, installations and instruments; advisory and information services relating to the provision of voice and data communications services; paging services; monitoring, organisation and analysis of call information; call screening services; call diversion and call re-routing services; multiple message sending services; call recording services; facsimile transmission services; call barring services; call alerting services; advisory services, provision of information and preparation of reports, all relating to telecommunications; telecommunication and dissemination of information in audio or visual form; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; providing access to computer databases and to online computer services; leasing access time to computer databases and to on-line computer services; professional consultancy services in the field of message sending, message receiving and data transmission; database and Internet information services; telecommunication services enabling individuals and businesses to send and receive messages via email, instant messaging or a website on the internet in the field of general interest via a global network and other computer

and communications networks; telecommunication services enabling individuals and businesses to transmit messages, comments information and other user generated content via a global computer network; telecommunication services enabling online and real time interaction between and among users of computers; communication services by way of telephone; on-line information services; advisory services, provision of information and preparation of reports, all relating to telecommunications; computerised consultation of telephone directories; provision of telephone directory services; providing access to an online interactive website containing users comments concerning various businesses and service providers; chat room services for social networking; provision of online chat rooms and electronic bulletin boards for transmission of messages relating to all the aforesaid services; provision of information all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

#### Class 41

Education; providing of training; entertainment; sporting and cultural activities; information and advisory services relating to education, training, entertainment, sport, recreation, cultural activities, theatre, television, music, news and publishing; publishing services; publication of business directories, business reviews, market analysis and research; publication of books, reviews, directories, guides, maps, magazines, manuals and other printed matter; preparation of reports relating to publishing services; publishing of reviews; education, training, instruction and study services; arranging, conducting and organising seminars and educational, recreational and instructional conventions, conferences, congresses, exhibitions and demonstrations; entertainment services; entertainment services, including reservation, booking and ticketing services for entertainment; booking and ticketing services by electronic and computer means; electronic database services for films, theatre and entertainment; provision of film finding facilities, cinema information, film previews and critiques, film industry gossip; information relating to entertainment, education, training, sport, recreation, news and publishing provided on-line from computer databases or web sites on the Internet; reservation, booking and ticketing

services for entertainment; electronic game services and competitions provided by means of the Internet; news programme services; news reporting services in the nature of news analysis and news commentary; database, on-line, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

#### Class 42

Design and development of computer software; writing, updating and maintenance of computer software; computer services; website design services; computer database consultancy services and design of computer databases; providing technical information, advisory and consultancy services in the field of Internet technology and software; provision of information on-line from a computer database or the Internet; compilation, analysis, retrieval and provision of information; leasing of access time to computer databases and to on-line computer services; storage of information; storage of data; storage of business and commercial information; storage of messages and data; interactive database information services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information and advisory services provided on-line from a computer database or the Internet; computer database consultancy services and design of computer databases; hire, rental and leasing of computers and data processing installations and of apparatus and installations for use therewith; computer systems analysis; recovery of computer data; planning (design) and design services all relating to telecommunications networks, apparatus and instruments; professional consultancy services in the field of data network apparatus and instruments; information technology services; computer and software consultancy services; scientific consultancy services; testing services; research and development services; inspection services; systems integration services; computer and telecommunications systems and network analysis; hire, rental and leasing of computer and data processing software; financial information disaster recovery services; providing and hosting a website on the internet for the purpose of networking; hosting an online website community for users to share

information to form virtual communities, and to engage in business or social networking; computer systems integration services relating to wholesale and retail financial services; information and advisory services relating to the weather; hosting an online interactive website containing users comments concerning various businesses and service providers; database, on-line, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

Class 45

Online social networking services; social networking services provided via an Internet website; providing a website on the internet for the purpose of social networking; information, advisory and consultancy services relating to all the aforesaid services.

## ANNEX 4

### *The opponent's first mark*

#### Class 9

Telecommunications goods; video cassettes; audio cassettes; computer software in the field of digital marketing; mobile and fixed telephone apparatus and instruments; pagers; computer software in the field of digital marketing and publications in electronic form supplied online from databases or from facilities provided on the Internet (including web sites); computer software in the field of digital marketing to enable connection to databases and to the Internet; computer software in the field of digital marketing to enable searching of data; phone cards and electronic cards all for use with communications apparatus and instruments; debit cards, credit cards and charge cards; answering machines; compact disc players; video phones; electronic notice boards; aerials, cables and ducts all for electrical, telecommunications or optical signal transmissions; dealer boards; electronic trading systems in the fields of digital marketing; parts and fittings for all the aforesaid goods.

#### Class 35

Business advisory, consultancy, research and information services (being information falling in class 35 including statistical information); receipt, processing, storage, display, recording or retrieval of data in the field of digital marketing; compilation, provision, storage and retrieval of business and commercial information; marketing, promotional and advertising services; data processing and database services in the field of digital marketing; telephone answering services and message handling services; production, preparation and presentation of advertising matter; compilation and publication of directories, being directories of advertising material, market analysis and research; compilation and transcription of data in the field of digital marketing; preparation of business reports; sales promotion; database management services; electronic database services for the provision of business information; compilation of advertisements for use as web pages; business information, advertising and

promotional services provided on-line from a computer database or by means of web pages on the Internet; compilation and systematization of information into computer databases; business customer relationship management and problem solution services; organisation, operation, management, sale and supervision of promotional, incentive and loyalty schemes; import and export services; database, on-line, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services.

### Class 38

Telecommunications services; cellular communication services; mobile communications services; digital communications services; satellite transmission services; communications by fibre optic networks; collection, transmission, processing and storage of messages and data in the field of digital marketing; remote data access services; electronic data interchange services; telecommunication of information (including web pages); electronic mail services; providing access to databases and information via the Internet; transmitting information via the worldwide web; provision of telecommunication access and links to computer databases and to the Internet; data communications services; communication by computer terminals; services for the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; transmission and processing of data from remote locations to mobile telephones; on-line information services (being information falling in class 38); telephone messaging services; hire and rental of telecommunications apparatus, installations and instruments; advisory and information services relating to cellular communications tariffs, advisory and information services relating to the provision of voice and data communications services; paging services; monitoring, organisation and analysis of call information; call screening services; call diversion and call re-routing services; multiple message sending services; call recording services; facsimile transmission services; call barring services; call alerting services; advisory services, provision of information and preparation of reports, all relating to telecommunications; telecommunication and dissemination of information in audio or visual form; telecommunication services

relating to the receipt, processing, storage, display, recording, retrieval or transmission of data (in the field of digital marketing).

*The opponent's second mark*

### Class 9

Computer software; application software; computer software, including search engine software, database management software, website development software, software for electronic financial transactions, application software and software for the creation of mobile Internet applications and client interfaces; computer software recorded on tapes, discs and cards; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the internet (including web sites); computer software and telecommunications apparatus (including modems) to enable connection to databases and to the internet; computer software to enable searching of data; computer software to enable searching of data; downloadable software for providing consumer information, namely rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; computer games and computer games software; web pages downloadable from the Internet; computer databases; apparatus and instruments for recording, transmission, reception, processing, retrieval, reproduction, manipulation, analysis, display and print-out of sound, images and/or data; digital communications apparatus and instruments; telecommunications apparatus and equipment; telecommunications goods; mobile and fixed telephone apparatus and instruments; facsimile machines; answering machines; pagers; switchboards; data communications goods; satellite communications goods; data terminals; remote access on-line information apparatus and instruments, all being electronic; aerials, cables and ducts all for electrical, telecommunications or optical signal transmissions; magnetic data carriers; magnetic and optical data media, namely magnetic discs, optical discs, floppy discs, magnetic tapes, magnetic cards, optical cards, integrated circuit cards, optical data carriers; compact discs; CD-ROMs; video cassettes; audio cassettes; DVDs and other digital recording media; compact disc players; video phones and video game cartridges;

electronic memory cards, phone cards and electronic cards all for use with communications apparatus and instruments; downloadable electronic publications; electronic notice boards; dealer boards (circuits); user (work) stations; electronic trading systems apparatus; debit cards, credit cards and charge cards; parts and fittings for all the aforesaid goods.

### Class 35

Advertising, marketing and promotional services; production, preparation and presentation of advertising matter; distribution of advertising, marketing and promotional material; distribution of printed advertising matter; provision of advertising space in printed and online media; providing an online commercial information directory on the Internet; advertising services provided over the Internet; display advertising; banner advertising; electronic billboard advertising; pay per click advertising; provision of advertising space in a classified directory specialising in advertising and information, these services also provided from a web site and by telecommunications means; sales promotion; search engine marketing services; search engine optimisation; compilation of advertisements for use as web pages; production of video recordings for advertising and marketing purposes; business advisory and consultancy services; research and information services, including analysis of market research data and statistics, and business investigations; business information services; compilation of business directories; market analysis and research; providing an online searchable database for the provision of business information, including rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; business management services; compilation, provision and retrieval of business and commercial information; compilation and systemisation of information into computer databases; systemisation of information into databases and data processing services; telephone answering services and message handling services; compilation and transcription of data; preparation of business reports; electronic database services for the provision of business information; data processing services; receipt, processing, recording or retrieval of data; collection and processing of messages and data; data processing

and database services; database management services; database management services, including receipt, processing, compilation, systemisation, recording or retrieval of data; compilation of information; organisation, operation and management of promotional, incentive and loyalty schemes; provision of an on-line platform to facilitate business networking and the sharing of commercial information; business customer relationship management and problem solution services; expert, professional consultancy services in relation to advertising; providing a market place for the advertisement of services, all being provided via an Internet portal; providing a market place for the advertisement of goods to buy and sell, all being provided via an Internet portal; providing information about import and export agencies and international trade; import and export services; retail services in the field of software; business advisory services relating to cellular communications tariffs; database, online, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

### Class 38

Telecommunications services; cellular communications services; mobile communications services; digital communications services; satellite transmission services; communications by fibre optic networks; telecommunication and transmission of information (including web pages), computer programs and other data, including in audio or visual form; electronic mail services; services for the collection, transmission, processing and storage of messages and data; remote data access services; electronic data interchange services; data communications services; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; provision of telecommunication access and links to computer databases and to the Internet; communication by computer terminals; the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; providing access to computer databases and to online computer services; leasing access time to computer databases and to online computer services; professional consultancy

services in the field of telecommunications; telecommunication services enabling online and real time interaction between and among users of computers and mobile devices; display, transmission and processing of data from remote locations to mobile telephones; telephone messaging services; hire and rental of telecommunications apparatus, installations and instruments; advisory and information services relating to the provision of voice and data communications services; paging services; monitoring, organisation and analysis of call information; call screening services; call diversion and call re-routing services; multiple message sending services; call recording services; facsimile transmission services; call barring services; call alerting services; advisory services, provision of information and preparation of reports, all relating to telecommunications; telecommunication and dissemination of information in audio or visual form; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; providing access to computer databases and to online computer services; leasing access time to computer databases and to on-line computer services; professional consultancy services in the field of message sending, message receiving and data transmission; database and Internet information services; telecommunication services enabling individuals and businesses to send and receive messages via email, instant messaging or a website on the internet in the field of general interest via a global network and other computer and communications networks; telecommunication services enabling individuals and businesses to transmit messages, comments information and other user generated content via a global computer network; telecommunication services enabling online and real time interaction between and among users of computers; communication services by way of telephone; on-line information services; advisory services, provision of information and preparation of reports, all relating to telecommunications; computerised consultation of telephone directories; provision of telephone directory services; providing access to an online interactive website containing users comments concerning various businesses and service providers; chat room services for social networking; provision of online chat rooms and electronic bulletin boards for transmission of messages relating to all the aforesaid services; provision of

information all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

## **ANNEX 5**

### *The opponent's third mark*

#### Class 9

Computer software; application software; computer software, including search engine software, database management software, website development software, software for electronic financial transactions, application software and software for the creation of mobile Internet applications and client interfaces; computer software recorded on tapes, discs and cards; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the internet (including web sites); computer software and telecommunications apparatus (including modems) to enable connection to databases and to the internet; computer software to enable searching of data; computer software to enable searching of data; downloadable software for providing consumer information, namely rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; computer games and computer games software; web pages downloadable from the Internet; computer databases; apparatus and instruments for recording, transmission, reception, processing, retrieval, reproduction, manipulation, analysis, display and print-out of sound, images and/or data; digital communications apparatus and instruments; telecommunications apparatus and equipment; telecommunications goods; mobile and fixed telephone apparatus and instruments; facsimile machines; answering machines; pagers; switchboards; data communications goods; satellite communications goods; data terminals; remote access on-line information apparatus and instruments, all being electronic; aerials, cables and ducts all for electrical, telecommunications or optical signal transmissions; magnetic data carriers; magnetic and optical data media, namely magnetic discs, optical discs, floppy discs, magnetic tapes, magnetic cards, optical cards, integrated circuit cards, optical data carriers; compact discs; CD-ROMs; video cassettes; audio cassettes; DVDs and other digital recording media; compact disc players; video phones and video game cartridges; electronic memory cards, phone cards and electronic cards all for use with

communications apparatus and instruments; downloadable electronic publications; electronic notice boards; dealer boards (circuits); user (work) stations; electronic trading systems apparatus; debit cards, credit cards and charge cards; parts and fittings for all the aforesaid goods.

### Class 35

Advertising, marketing and promotional services; production, preparation and presentation of advertising matter; distribution of advertising, marketing and promotional material; distribution of printed advertising matter; provision of advertising space in printed and online media; providing an online commercial information directory on the Internet; advertising services provided over the Internet; display advertising; banner advertising; electronic billboard advertising; pay per click advertising; provision of advertising space in a classified directory specialising in advertising and information, these services also provided from a web site and by telecommunications means; sales promotion; search engine marketing services; search engine optimisation; compilation of advertisements for use as web pages; production of video recordings for advertising and marketing purposes; business advisory and consultancy services; research and information services, including analysis of market research data and statistics, and business investigations; business information services; compilation of business directories; market analysis and research; providing an online searchable database for the provision of business information, including rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; business management services; compilation, provision and retrieval of business and commercial information; compilation and systemisation of information into computer databases; systemisation of information into databases and data processing services; telephone answering services and message handling services; compilation and transcription of data; preparation of business reports; electronic database services for the provision of business information; data processing services; receipt, processing, recording or retrieval of data; collection and processing of messages and data; data processing and database services; database management services; database management

services, including receipt, processing, compilation, systemisation, recording or retrieval of data; compilation of information; organisation, operation and management of promotional, incentive and loyalty schemes; provision of an on-line platform to facilitate business networking and the sharing of commercial information; business customer relationship management and problem solution services; expert, professional consultancy services in relation to advertising; providing a market place for the advertisement of services, all being provided via an Internet portal; providing a market place for the advertisement of goods to buy and sell, all being provided via an Internet portal; providing information about import and export agencies and international trade; import and export services; retail services in the field of software; business advisory services relating to cellular communications tariffs; database, online, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

#### Class 38

Telecommunications services; cellular communications services; mobile communications services; digital communications services; satellite transmission services; communications by fibre optic networks; telecommunication and transmission of information (including web pages), computer programs and other data, including in audio or visual form; electronic mail services; services for the collection, transmission, processing and storage of messages and data; remote data access services; electronic data interchange services; data communications services; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; provision of telecommunication access and links to computer databases and to the Internet; communication by computer terminals; the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; providing access to computer databases and to online computer services; leasing access time to computer databases and to online computer services; professional consultancy services in the field of telecommunications; telecommunication services enabling

online and real time interaction between and among users of computers and mobile devices; display, transmission and processing of data from remote locations to mobile telephones; telephone messaging services; hire and rental of telecommunications apparatus, installations and instruments; advisory and information services relating to the provision of voice and data communications services; paging services; monitoring, organisation and analysis of call information; call screening services; call diversion and call re-routing services; multiple message sending services; call recording services; facsimile transmission services; call barring services; call alerting services; advisory services, provision of information and preparation of reports, all relating to telecommunications; telecommunication and dissemination of information in audio or visual form; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; providing access to computer databases and to online computer services; leasing access time to computer databases and to on-line computer services; professional consultancy services in the field of message sending, message receiving and data transmission; database and Internet information services; telecommunication services enabling individuals and businesses to send and receive messages via email, instant messaging or a website on the internet in the field of general interest via a global network and other computer and communications networks; telecommunication services enabling individuals and businesses to transmit messages, comments information and other user generated content via a global computer network; telecommunication services enabling online and real time interaction between and among users of computers; communication services by way of telephone; on-line information services; advisory services, provision of information and preparation of reports, all relating to telecommunications; computerised consultation of telephone directories; provision of telephone directory services; providing access to an online interactive website containing users comments concerning various businesses and service providers; chat room services for social networking; provision of online chat rooms and electronic bulletin boards for transmission of messages relating to all the aforesaid services; provision of information all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

## **ANNEX 6**

### *The opponent's third mark*

#### Class 9

Computer software; application software; computer software, including search engine software, database management software, website development software, software for electronic financial transactions, application software and software for the creation of mobile Internet applications and client interfaces; computer software recorded on tapes, discs and cards; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the internet (including web sites); computer software and telecommunications apparatus (including modems) to enable connection to databases and to the internet; computer software to enable searching of data; computer software to enable searching of data; downloadable software for providing consumer information, namely rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; computer games and computer games software; web pages downloadable from the Internet; computer databases; apparatus and instruments for recording, transmission, reception, processing, retrieval, reproduction, manipulation, analysis, display and print-out of sound, images and/or data; digital communications apparatus and instruments; telecommunications apparatus and equipment; telecommunications goods; mobile and fixed telephone apparatus and instruments; facsimile machines; answering machines; pagers; switchboards; data communications goods; satellite communications goods; data terminals; remote access on-line information apparatus and instruments, all being electronic; aerials, cables and ducts all for electrical, telecommunications or optical signal transmissions; magnetic data carriers; magnetic and optical data media, namely magnetic discs, optical discs, floppy discs, magnetic tapes, magnetic cards, optical cards, integrated circuit cards, optical data carriers; compact discs; CD-ROMs; video cassettes; audio cassettes; DVDs and other digital recording media; compact disc players; video phones and video game cartridges; electronic memory cards, phone cards and electronic cards all for use with

communications apparatus and instruments; downloadable electronic publications; electronic notice boards; dealer boards (circuits); user (work) stations; electronic trading systems apparatus; debit cards, credit cards and charge cards; parts and fittings for all the aforesaid goods.

#### Class 16

Paper, cardboard; printed matter; bookbinding material; photographs; stationery; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed publications; printed directories; printed newsletters; books; booklets, leaflets, brochures and manuals; posters; maps; directories; directory covers; directory covers made from paper and cardboard; printed tickets, coupons and vouchers; advertising and promotional materials; advertisements; wrapping and packaging materials; plastic for packaging and wrapping goods; cling film for palletization; plastic polythene bags; tapes and cards, all for the recordal of computer programs and of data; computer programs in printed form; parts and fittings for all the aforesaid goods.

#### Class 35

Advertising, marketing and promotional services; production, preparation and presentation of advertising matter; distribution of advertising, marketing and promotional material; distribution of printed advertising matter; provision of advertising space in printed and online media; providing an online commercial information directory on the Internet; advertising services provided over the Internet; display advertising; banner advertising; electronic billboard advertising; pay per click advertising; provision of advertising space in a classified directory specialising in advertising and information, these services also provided from a web site and by telecommunications means; sales promotion; search engine marketing services; search engine optimisation; compilation of advertisements for use as web pages; production of video recordings for advertising and marketing purposes; business advisory and consultancy services; research and information services, including

analysis of market research data and statistics, and business investigations; business information services; compilation of business directories; market analysis and research; providing an online searchable database for the provision of business information, including rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; business management services; compilation, provision and retrieval of business and commercial information; compilation and systemisation of information into computer databases; systemisation of information into databases and data processing services; telephone answering services and message handling services; compilation and transcription of data; preparation of business reports; electronic database services for the provision of business information; data processing services; receipt, processing, recording or retrieval of data; collection and processing of messages and data; data processing and database services; database management services; database management services, including receipt, processing, compilation, systemisation, recording or retrieval of data; compilation of information; organisation, operation and management of promotional, incentive and loyalty schemes; provision of an on-line platform to facilitate business networking and the sharing of commercial information; business customer relationship management and problem solution services; expert, professional consultancy services in relation to advertising; providing a market place for the advertisement of services, all being provided via an Internet portal; providing a market place for the advertisement of goods to buy and sell, all being provided via an Internet portal; providing information about import and export agencies and international trade; import and export services; retail services in the field of software; business advisory services relating to cellular communications tariffs; database, online, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

### Class 38

Telecommunications services; cellular communications services; mobile communications services; digital communications services; satellite transmission

services; communications by fibre optic networks; telecommunication and transmission of information (including web pages), computer programs and other data, including in audio or visual form; electronic mail services; services for the collection, transmission, processing and storage of messages and data; remote data access services; electronic data interchange services; data communications services; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; provision of telecommunication access and links to computer databases and to the Internet; communication by computer terminals; the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; providing access to computer databases and to online computer services; leasing access time to computer databases and to online computer services; professional consultancy services in the field of telecommunications; telecommunication services enabling online and real time interaction between and among users of computers and mobile devices; display, transmission and processing of data from remote locations to mobile telephones; telephone messaging services; hire and rental of telecommunications apparatus, installations and instruments; advisory and information services relating to the provision of voice and data communications services; paging services; monitoring, organisation and analysis of call information; call screening services; call diversion and call re-routing services; multiple message sending services; call recording services; facsimile transmission services; call barring services; call alerting services; advisory services, provision of information and preparation of reports, all relating to telecommunications; telecommunication and dissemination of information in audio or visual form; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; providing access to computer databases and to online computer services; leasing access time to computer databases and to on-line computer services; professional consultancy services in the field of message sending, message receiving and data transmission; database and Internet information services; telecommunication services enabling individuals and businesses to send and receive messages via email, instant messaging or a website on the internet in the field of general interest via a global network and other computer

and communications networks; telecommunication services enabling individuals and businesses to transmit messages, comments information and other user generated content via a global computer network; telecommunication services enabling online and real time interaction between and among users of computers; communication services by way of telephone; on-line information services; advisory services, provision of information and preparation of reports, all relating to telecommunications; computerised consultation of telephone directories; provision of telephone directory services; providing access to an online interactive website containing users comments concerning various businesses and service providers; chat room services for social networking; provision of online chat rooms and electronic bulletin boards for transmission of messages relating to all the aforesaid services; provision of information all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

#### Class 41

Education; providing of training; entertainment; sporting and cultural activities; information and advisory services relating to education, training, entertainment, sport, recreation, cultural activities, theatre, television, music, news and publishing; publishing services; publication of business directories, business reviews, market analysis and research; publication of books, reviews, directories, guides, maps, magazines, manuals and other printed matter; preparation of reports relating to publishing services; publishing of reviews; education, training, instruction and study services; arranging, conducting and organising seminars and educational, recreational and instructional conventions, conferences, congresses, exhibitions and demonstrations; entertainment services; entertainment services, including reservation, booking and ticketing services for entertainment; booking and ticketing services by electronic and computer means; electronic database services for films, theatre and entertainment; provision of film finding facilities, cinema information, film previews and critiques, film industry gossip; information relating to entertainment, education, training, sport, recreation, news and publishing provided on-line from computer databases or web sites on the Internet; reservation, booking and ticketing

services for entertainment; electronic game services and competitions provided by means of the Internet; news programme services; news reporting services in the nature of news analysis and news commentary; database, on-line, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

#### Class 42

Design and development of computer software; writing, updating and maintenance of computer software; computer services; website design services; computer database consultancy services and design of computer databases; providing technical information, advisory and consultancy services in the field of Internet technology and software; provision of information on-line from a computer database or the Internet; compilation, analysis, retrieval and provision of information; leasing of access time to computer databases and to on-line computer services; storage of information; storage of data; storage of business and commercial information; storage of messages and data; interactive database information services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information and advisory services provided on-line from a computer database or the Internet; computer database consultancy services and design of computer databases; hire, rental and leasing of computers and data processing installations and of apparatus and installations for use therewith; computer systems analysis; recovery of computer data; planning (design) and design services all relating to telecommunications networks, apparatus and instruments; professional consultancy services in the field of data network apparatus and instruments; information technology services; computer and software consultancy services; scientific consultancy services; testing services; research and development services; inspection services; systems integration services; computer and telecommunications systems and network analysis; hire, rental and leasing of computer and data processing software; financial information disaster recovery services; providing and hosting a website on the internet for the purpose of networking; hosting an online website community for users to share

information to form virtual communities, and to engage in business or social networking; computer systems integration services relating to wholesale and retail financial services; information and advisory services relating to the weather; hosting an online interactive website containing users comments concerning various businesses and service providers; database, on-line, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

Class 45

Online social networking services; social networking services provided via an Internet website; providing a website on the internet for the purpose of social networking; information, advisory and consultancy services relating to all the aforesaid services.

## ANNEX 7

Online business directories; printed business directories; advertising services; database services; publishing services; publication of directories; digital marketing services; website design services; website building services; website development services; search engine optimisation (SEO) services; advertising, marketing and promotional services.

Computer software; application software; computer software, including search engine software, database management software, website development software, software for electronic financial transactions, application software and software for the creation of mobile Internet applications and client interfaces; computer software recorded on tapes, discs and cards; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the internet (including web sites); computer software and telecommunications apparatus (including modems) to enable connection to databases and to the internet; computer software to enable searching of data; computer software to enable searching of data; downloadable software for providing consumer information, namely rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; computer games and computer games software; web pages downloadable from the Internet; computer databases; apparatus and instruments for recording, transmission, reception, processing, retrieval, reproduction, manipulation, analysis, display and print-out of sound, images and/or data; digital communications apparatus and instruments; telecommunications apparatus and equipment; telecommunications goods; mobile and fixed telephone apparatus and instruments; facsimile machines; answering machines; pagers; switchboards; data communications goods; satellite communications goods; data terminals; remote access online information apparatus and instruments, all being electronic; aerials, cables and ducts all for electrical, telecommunications or optical signal transmissions; magnetic data carriers; magnetic and optical data media, namely magnetic discs, optical discs, floppy discs, magnetic tapes, magnetic cards, optical cards, integrated circuit cards, optical data carriers;

compact discs; CD-ROMs; video cassettes; audio cassettes; DVDs and other digital recording media; compact disc players; video phones and video game cartridges; electronic memory cards, phone cards and electronic cards all for use with communications apparatus and instruments; downloadable electronic publications; electronic notice boards; dealer boards (circuits); user (work) stations; electronic trading systems apparatus; debit cards, credit cards and charge cards; parts and fittings for all the aforesaid goods.

Paper, cardboard; printed matter; bookbinding material; photographs; stationery; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed publications; printed directories; printed newsletters; books; booklets, leaflets, brochures and manuals; posters; maps; directories; directory covers; directory covers made from paper and cardboard; printed tickets, coupons and vouchers; advertising and promotional materials; advertisements; wrapping and packaging materials; plastic for packaging and wrapping goods; cling film for palletization; plastic polythene bags; tapes and cards, all for the recordal of computer programs and of data; computer programs in printed form; parts and fittings for all the aforesaid goods.

Advertising, marketing and promotional services; production, preparation and presentation of advertising matter; distribution of advertising, marketing and promotional material; distribution of printed advertising matter; provision of advertising space in printed and online media; providing an online commercial information directory on the Internet; advertising services provided over the Internet; display advertising; banner advertising; electronic billboard advertising; pay per click advertising; provision of advertising space in a classified directory specialising in advertising and information, these services also provided from a web site and by telecommunications means; sales promotion; search engine marketing services; search engine optimisation; compilation of advertisements for use as web pages; production of video recordings for advertising and marketing purposes; business

advisory and consultancy services; research and information services, including analysis of market research data and statistics, and business investigations; business information services; compilation of business directories; market analysis and research; providing an online searchable database for the provision of business information, including rankings, ratings, reviews, referrals and recommendations in relation to businesses and service providers; business management services; compilation, provision and retrieval of business and commercial information; compilation and systemisation of information into computer databases; systemisation of information into databases and data processing services; telephone answering services and message handling services; compilation and transcription of data; preparation of business reports; electronic database services for the provision of business information; data processing services; receipt, processing, recording or retrieval of data; collection and processing of messages and data; data processing and database services; database management services; database management services, including receipt, processing, compilation, systemisation, recording or retrieval of data; compilation of information; organisation, operation and management of promotional, incentive and loyalty schemes; provision of an on-line platform to facilitate business networking and the sharing of commercial information; business customer relationship management and problem solution services; expert, professional consultancy services in relation to advertising; providing a market place for the advertisement of services, all being provided via an Internet portal; providing a market place for the advertisement of goods to buy and sell, all being provided via an Internet portal; providing information about import and export agencies and international trade; import and export services; retail services in the field of software; business advisory services relating to cellular communications tariffs; database, online, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

Telecommunications services; cellular communications services; mobile communications services; digital communications services; satellite transmission

services; communications by fibre optic networks; telecommunication and transmission of information (including web pages), computer programs and other data, including in audio or visual form; electronic mail services; services for the collection, transmission, processing and storage of messages and data; remote data access services; electronic data interchange services; data communications services; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; provision of telecommunication access and links to computer databases and to the Internet; communication by computer terminals; the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; providing access to computer databases and to online computer services; leasing access time to computer databases and to online computer services; professional consultancy services in the field of telecommunications; telecommunication services enabling online and real time interaction between and among users of computers and mobile devices; display, transmission and processing of data from remote locations to mobile telephones; telephone messaging services; hire and rental of telecommunications apparatus, installations and instruments; advisory and information services relating to the provision of voice and data communications services; paging services; monitoring, organisation and analysis of call information; call screening services; call diversion and call re-routing services; multiple message sending services; call recording services; facsimile transmission services; call barring services; call alerting services; advisory services, provision of information and preparation of reports, all relating to telecommunications; telecommunication and dissemination of information in audio or visual form; telecommunication services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; providing access to computer databases and to online computer services; leasing access time to computer databases and to on-line computer services; professional consultancy services in the field of message sending, message receiving and data transmission; database and Internet information services; telecommunication services enabling individuals and businesses to send and receive messages via email, instant messaging or a website on the internet in the field of general interest via a global network and other computer

and communications networks; telecommunication services enabling individuals and businesses to transmit messages, comments information and other user generated content via a global computer network; telecommunication services enabling online and real time interaction between and among users of computers; communication services by way of telephone; on-line information services; advisory services, provision of information and preparation of reports, all relating to telecommunications; computerised consultation of telephone directories; provision of telephone directory services; providing access to an online interactive website containing users comments concerning various businesses and service providers; chat room services for social networking; provision of online chat rooms and electronic bulletin boards for transmission of messages relating to all the aforesaid services; provision of information all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

Education; providing of training; entertainment; sporting and cultural activities; information and advisory services relating to education, training, entertainment, sport, recreation, cultural activities, theatre, television, music, news and publishing; publishing services; publication of business directories, business reviews, market analysis and research; publication of books, reviews, directories, guides, maps, magazines, manuals and other printed matter; preparation of reports relating to publishing services; publishing of reviews; education, training, instruction and study services; arranging, conducting and organising seminars and educational, recreational and instructional conventions, conferences, congresses, exhibitions and demonstrations; entertainment services; entertainment services, including reservation, booking and ticketing services for entertainment; booking and ticketing services by electronic and computer means; electronic database services for films, theatre and entertainment; provision of film finding facilities, cinema information, film previews and critiques, film industry gossip; information relating to entertainment, education, training, sport, recreation, news and publishing provided on-line from computer databases or web sites on the Internet; reservation, booking and ticketing services for entertainment; electronic game services and competitions provided by

means of the Internet; news programme services; news reporting services in the nature of news analysis and news commentary; database, on-line, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

Design and development of computer software; writing, updating and maintenance of computer software; computer services; website design services; computer database consultancy services and design of computer databases; providing technical information, advisory and consultancy services in the field of Internet technology and software; provision of information on-line from a computer database or the Internet; compilation, analysis, retrieval and provision of information; leasing of access time to computer databases and to on-line computer services; storage of information; storage of data; storage of business and commercial information; storage of messages and data; interactive database information services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information and advisory services provided on-line from a computer database or the Internet; computer database consultancy services and design of computer databases; hire, rental and leasing of computers and data processing installations and of apparatus and installations for use therewith; computer systems analysis; recovery of computer data; planning (design) and design services all relating to telecommunications networks, apparatus and instruments; professional consultancy services in the field of data network apparatus and instruments; information technology services; computer and software consultancy services; scientific consultancy services; testing services; research and development services; inspection services; systems integration services; computer and telecommunications systems and network analysis; hire, rental and leasing of computer and data processing software; financial information disaster recovery services; providing and hosting a website on the internet for the purpose of networking; hosting an online website community for users to share information to form virtual communities, and to engage in business or social networking; computer systems integration services relating to wholesale and

retail financial services; information and advisory services relating to the weather; hosting an online interactive website containing users comments concerning various businesses and service providers; database, on-line, interactive database and Internet information, advisory and consultancy services, all relating to the aforesaid services; information, advisory and consultancy services relating to all the aforesaid services.

Online social networking services; social networking services provided via an Internet website; providing a website on the internet for the purpose of social networking; information, advisory and consultancy services relating to all the aforesaid services.