

**O/1026/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3999193**

**BY UBT (EU) LTD**

**TO REGISTER THE FOLLOWING TRADE MARK:**



**IN CLASSES 9, 35, 38 AND 42**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO**

**UNDER NO. 448483**

**BY ADP, INC.**

## BACKGROUND AND PLEADINGS

1. On 8 January 2024, UBT (EU) Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was published for opposition purposes on 5 April 2024, and registration is sought for goods and services in classes 9, 35, 38 and 42.<sup>1</sup>

2. On 5 July 2024, the application was opposed in full by ADP, Inc. (“the opponent”), on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following earlier comparable United Kingdom Trade Mark (“UKTM”)<sup>2</sup> for its opposition:

‘ADP STREAMLINE’

UKTM 905253471

Filing date: 10 August 2006

Registration date: 4 October 2007

For the purpose of these proceedings the opponent relies upon all the goods and services in classes 9, 35, 36 and 42.<sup>3</sup>

3. The opponent claims that the marks are highly similar and that the goods and services are identical or similar, resulting in a likelihood of confusion.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. By virtue of its earlier filing date, the above mark constitutes as an earlier mark in accordance with section 6 of the Act. As the mark was registered more than five years prior to the date the contested mark was filed, the mark is potentially subject to proof of use in accordance with section 6A of the Act. However, the applicant expressly ticked ‘no’ on its Form TM8, the defence and counterstatement, to the question as to

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<sup>1</sup> See goods and services comparison.

<sup>2</sup> Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent’s mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same. See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

<sup>3</sup> See goods and services comparison.

whether the opponent was required to submit proof of use. Accordingly, as the opponent is not put to proof of use of its earlier mark it may rely upon all the goods and services identified in its pleadings.

6. Neither party filed evidence and neither party requested a hearing. Both parties filed written submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers.

7. The opponent is represented by Kilburn & Strode LLP, whereas the applicant is not professionally represented.

## **PRELIMINARY ISSUES**

8. In its counterstatement, the applicant denies that its mark breaches section 5(2) of the Act on the basis that there are already various other trade marks on the register which use the word 'Streamline'. Furthermore, the applicant points to the differing target markets of the parties, submitting that this will prevent a likelihood of confusion.

9. In *O2 Holdings Limited, O2 (UK) Limited v Hutchinson 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Accordingly, I must carry out a notional assessment based upon the parties' respective marks and the goods and services contained in their specifications. The actual activities carried out by the parties are not relevant to my assessment. Furthermore, the existence of other trade marks on the register is also not relevant to the decision I must make.<sup>4</sup>

10. Additionally, in its counterstatement the applicant claims that its mark has been in use since 2016, without any objection or confusion, nor has the opponent provided any evidence of such confusion occurring.

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<sup>4</sup> *Zero Industry Srl v OHIM*, Case T-400/06

11. With regards to an absence of any evidence of actual confusion, in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

12. I have no evidence before me of how (or to what extent) the applicant's mark has been used in practice. Consequently, it is impossible to assess whether the absence of evidence of confusion is due to the fact that the marks at issue are not confusingly similar or due to other matters relating to the way in which the marks have been used (or not, as the case may be). Therefore, this line of argument does not assist the applicant.

13. In its written submissions,<sup>5</sup> the applicant makes reference to section 5(1) of the Act, stating that there is no likelihood of confusion between the marks and the goods and services at issue under this ground. However, as the opposition is based on section 5(2)(b) only, the applicant was not required to provide any submissions in relation to the section 5(1) ground. Accordingly, I will say no more on the matter of section 5(1).

## **RELEVANCE OF EU LAW**

14. 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.

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<sup>5</sup> Written submissions in lieu of a hearing, dated 31 March 2025.

## DECISION

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

15. Section 5(2)(b) of the Act read 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 of association with the earlier trade mark.”

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

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

18. In *Canon*, Case C-39/97, the CJEU stated that:

“23. In assessing the similarity of the goods or services concerned, ... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

19. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82. ...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

may think that the responsibility for those goods lies with the same undertaking”.

21. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.<sup>6</sup>

22. In the case of goods and services, the terms used should not be interpreted widely but confined to the core of the possible meanings attributable to the terms: *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) [2024] UKSC 36*, at [365].

23. Pursuant to section 60A of the Act, I am mindful of the fact that the goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes. I also note that in *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense.

24. The competing goods and services are as follows:

#### Applicant's goods and services

Class 9      Software; Communication software for connecting computer network users; Communication software for connecting global computer networks; Computer application software; Computer application software for mobile telephones; Computer firewall software; Computer programs for using the internet and the worldwide web; Computer software; Computer software applications, downloadable; Computer software for administration of local area networks; Computer software for business purposes; Computer software for controlling self-service terminals; Computer software for controlling the operation of audio and video devices; Computer software for Global Positioning Systems; Computer software for mobile phones; Computer software for

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<sup>6</sup> Paragraph 5

monitoring the use of computers and the internet by children; Computer software for the creation of firewalls; Computer software for use in providing multiple user access to a global computer information network; Computer software [programmes]; Computer software programs; Computer software to maintain and operate computer system; Downloadable application software; Downloadable applications for use with mobile devices; Downloadable computer security software; Downloadable computer software for remote monitoring and analysis; Downloadable computer utility programs; Downloadable computer utility software; Downloadable software; Electronic data processing equipment; Electronic devices used to locate lost articles employing the global positioning system or cellular communication networks; Internet access software; Software; Software drivers; Software for diagnostics and troubleshooting; Software for mobile phones; Software for searching and retrieving information across a computer network; Software for tablet computers; none of the aforesaid goods provided in connection with processing, handling or authorising financial transactions, transfer of funds, card payments, voucher schemes or customer discount schemes, banking services, payment card service.

Class 35    Compilation of statistics [for business or commercial purposes]; Compilation and systemization of information into computer databases; Compilation of statistics [for business or commercial purposes]; Computerised auditing; Obtaining business statistics [for others]; none of the aforesaid services provided in connection with processing, handling or authorising financial transactions, transfer of funds, card payments, voucher schemes or customer discount schemes, banking services, payment card services.

Class 38    Internet access services; Communications by computer; Communications by mobile telephones; Internet access services; none of the aforesaid services provided in connection with processing, handling or authorising financial transactions, transfer of funds, card payments, voucher schemes or customer discount schemes, banking services, payment card services.

Class 42    Software as a service; Administration of user rights in computer networks; Analytical services relating to computer programmes; Analytical services relating to computers; Information technology support services; Installation and

customisation of computer applications software; Installation and maintenance of computer programs; Installation and maintenance of computer software; Installation and maintenance of database software; Installation and maintenance of Internet access software; Installation and maintenance services for software; Installation, maintenance and repair of computer software; Installation, maintenance and repair of software for computer systems; Installation, maintenance and updating of computer software; Installation, maintenance and updating of database software; Installation, maintenance, repair and servicing of computer software; Installation, maintenance, updating and upgrading of computer software; Installation of computer programs; Installation of computer software; Installation of database software; Installation of Internet access software; Installation of software; Installation, repair and maintenance of computer software; Installation, setting up and maintenance of computer software; Installation, updating and maintenance of computer software; Installing computer programs; Machine condition monitoring; Maintenance and upgrading of computer software; Maintenance of and updating of computer software; Maintenance of computer software; Modifying of computer programs; Programming (computer-); Programming of educational software; Programming of Internet security programs; Programming of web pages; Services for the updating of computer programmes; Services for updating computer software; Software as a service; Software as a service [SaaS]; Software authoring; Software consultancy services; Software consulting services; Software creation; Software customisation services; Software design; Software design and development; Software design (Computer -); Software design for others; Software development; Software development services; Software engineering; Software engineering services for data processing programs; Software installation; Software maintenance services; Software research; Software (Updating of computer -); Update of computer software; Updating Internet pages; Updating of computer programs; Updating of computer programs for third parties; Updating of computer software; Updating of software; Updating of software data bases; Upgrading of computer software; none of the aforesaid services provided in connection with processing, handling or authorising financial transactions, transfer of funds, card payments, voucher schemes or customer discount schemes, banking services, payment card services.

## Opponent's goods and services

Class 9 Computer hardware; computer software; communications hardware; computer peripheral apparatus; computer networks; data, databases, instructional material and computer software manuals, all being recorded magnetically, optically or electronically; data, information, software, manuals, audio, video and other media or multimedia, all being downloadable from the Internet; electronic publications; electronically, magnetically or optically encoded cards.

Class 35 Providing business consulting and business professional services to businesses, employers, dealers and manufacturers, all in the field of computing, data processing and data management; business management services; provision of employment and personnel advice and support for the running of businesses; business advisory and consulting services relating to compliance with statutory, industry or best practice provisions; computerised data-base management services; statistical information services for business purposes; computer and employment agency services relating to personnel; personnel and business investigation, survey, research and audit services; benefits administration, pension record keeping, and unemployment compensation management services; electronic preparation, filing and reporting of payroll tax; compiling and organizing employee benefits, job and job placement, compensation, and educational opportunity information for others; providing jobs and job placement information for others; consulting services in the field of employee benefits, jobs and job placement; information and advisory services relating to the aforesaid services.

Class 36 Providing employee benefits and compensation information for others; consulting services in the fields of employee benefits and compensation.

Class 42 Application service provider services; providing temporary use of non-downloadable computer software in the field of employment for use by employers to provide payroll preparation, tax, preparation, tax filing services, human resources management services, payroll tax debiting services, tax payment processing services, and the administration of employee benefit plans; information and advisory services relating to the aforesaid services; design, creation, maintenance and hosting of a

website or website portal for recording or providing information about employee benefits, job and job placement, compensation, and educational opportunity; hosting computer software applications for use by others; installation and maintenance of computer software; consultancy, design, testing, research, technical support and information in the field of computing, websites and website hosting; software writing services; licensing of software and other intellectual property; information and advisory services relating to the aforesaid services, including the provision of such services on-line from a computer network or via the Internet or extranets.

Applicant's goods and services - limitations

25. For the avoidance of doubt, I do not consider the limitations to the applicant's specification in classes 9, 35, 38 and 42 to be relevant to my comparison of the parties' goods and services.

*Class 9*

Software; Communication software for connecting computer network users; Communication software for connecting global computer networks; Computer application software; Computer application software for mobile telephones; Computer firewall software; Computer programs for using the internet and the worldwide web; Computer software; Computer software applications, downloadable; Computer software for administration of local area networks; Computer software for business purposes; Computer software for controlling self-service terminals; Computer software for controlling the operation of audio and video devices; Computer software for Global Positioning Systems; Computer software for mobile phones; Computer software for monitoring the use of computers and the internet by children; Computer software for the creation of firewalls; Computer software for use in providing multiple user access to a global computer information network; Computer software [programmes]; Computer software programs; Computer software to maintain and operate computer system; Downloadable application software; Downloadable applications for use with mobile devices; Downloadable computer security software; Downloadable computer software for remote monitoring and analysis; Downloadable computer utility programs; Downloadable computer utility software; Downloadable software; Internet access

software; Software; Software drivers; Software for diagnostics and troubleshooting; Software for mobile phones; Software for searching and retrieving information across a computer network; Software for tablet computers

26. The above contested terms are all various forms of software and are therefore considered identical with the opponent's broad term *computer software* contained in class 9 of its specification, in line with the principle set out in *Meric*.

#### Electronic data processing equipment

27. The contested goods are types of electrically powered physical hardware that collect, process, and store data, for example, computers, including desktops, laptops, tablets, servers, mainframes, along with peripherals, such as scanners, printers, and monitors, etc. As such, I find that these goods are included in the broad term *computer hardware* contained in the opponent's class 9 goods, and therefore are considered identical in line with the principle set out in *Meric*.

#### Electronic devices used to locate lost articles employing the global positioning system or cellular communication networks

28. Broadly speaking, the above contested goods are tracker type devices that utilise the global positioning system (GPS) or mobile communication networks to determine the geographical position of an object or person, etc. Such devices contain a computer (microcontroller or processor) that receives and processes data from satellites, along with other components such as digital storage and transmitters, in order to determine and communicate a location, for example. Accordingly, the contested goods are included in the broad term *computer hardware* contained in the opponent's class 9 goods and are therefore considered identical in line with the principle set out in *Meric*. However, if I am wrong in my analysis, then I find that the respective goods are similar to a high degree, on the basis that the goods are likely to share a similar purpose and can coincide in producers, channels of trade and end users.

## Class 35

### Compilation of statistics [for business or commercial purposes]; Obtaining business statistics [for others]

29. In general, the above contested services involve the gathering and putting together of numerical facts or data for statistical purposes. There is a clear overlap between these services and the opponent's *statistical information services for business purposes* contained in its class 35 specification. Therefore, these services are identical based on the principle set out in *Meric*.

### Compilation and systemization of information into computer databases

30. Broadly speaking, the contested services are a form of data processing on the basis that they involve, for example, the collection and compilation of data into a computer database. As such, I find that these services are encompassed by the opponent's broad terms *providing business consulting and business professional services to businesses, employers, dealers and manufacturers, all in the field of computing, data processing and data management and computerised data-base management services* contained in class 35 of its specification and are therefore identical based on the principle set out in *Meric*. However, if I have been too generous in my analysis, then I find that the respective services are similar to a high degree, on the basis that they are likely to share a similar purpose and can coincide in producers, channels of trade and end users.

### Computerised auditing

31. In general, auditing involves an official financial inspection of a company or individual's financial records/accounts and processes, in order to, for example, verify their accuracy and ensure they comply with appropriate regulations, etc. As regards a computerised audit, a computerised system is used to conduct the audit by using technology to collect and gather data and conduct the audit operations. Accordingly, I am of the view that the contested services are encompassed by the opponent's broad term *personnel and business investigation, survey, research and audit services*,

contained in class 35 of its specification. Therefore, the services are considered identical in line with the principle set out in *Meric*.

### *Class 38*

#### Communications by computer

32. The contested services concern the exchange of digital data between computers or devices over a network communication channel. Whilst I acknowledge that these services are not the same as goods, I consider that they share a degree of similarity with the opponent's *computer software* in class 9 of its specification, because of the close relationship between software and the ability to provide the communication services. The applicant's services may be delivered using bespoke software for the purpose and as part of the delivery of its services. The consumer may have an expectation that the software they require to access the communication services will be designed, installed and, where necessary, repaired by the communications deliverer. Consequently, they may share trade channels and be complementary. Overall, I consider that these goods and services at issue share between a low and medium degree of similarity.

#### Communications by mobile telephones

33. The above contested services fall within the ambit of telecommunication services and/or mobile phone services. The consumer will require equipment to access these services. The equipment and services are sold (or hired) through the same channels, often as part of the same package, and there is a complementary relationship between them, such that the consumer may think responsibility for them lies with the same undertaking and the required equipment, such as the opponent's *communications hardware*, in Class 9 of its specification, will be indispensable for the full use of the contested service because without such services, the equipment is redundant. In general, mobile phone service providers provide the communications hardware, such as a mobile phone, alongside or with the service. Therefore, there is likely to be an overlap in purpose, channels of trade, provider and user. Accordingly, I find the goods and services at issue to be similar to between a low and medium degree.

### Internet access services

34. Broadly speaking, the above contested services are a type of communication service which allows users to connect to the internet and access online services, such as electronic mail, websites, portals, and social networks, etc., via devices such as computers, tablets and smartphones. The opponent's *computer hardware* and *communications hardware* in class 9 of its specification are essential to such services on the basis that consumers will use *computer hardware* and *communications hardware* such as computers, smart phones, hubs and routers, for example, to access the above contested services. Furthermore, internet access providers typically provide their customers with the hardware equipment required to enable them to access the Internet. Such hardware will usually display the company's logo, and therefore, customers will more than likely draw the conclusion that the goods and services are provided by the same undertaking. Therefore, I find that the goods and services are complementary. Whilst it is acknowledged that these goods and services have different natures, they have shared purposes and can coincide in distribution channels and users. Accordingly, I find that the goods and services at issue are similar to between a low and medium degree.

### *Class 42*

Installation and maintenance of database software; Installation and maintenance of Internet access software; Installation of computer programs; Installation of database software; Installation of Internet access software; Installing computer programs; Installation and maintenance of computer programs; Installation and maintenance of computer software; Installation and maintenance services for software; Installation of computer programs; Installation of computer software; Installation of software; Installation and maintenance of database software; Installation of database software; Maintenance of computer software; Software installation; Software maintenance services

35. I find that the above contested services are either identical, directly equivalent to, or overlap with, the opponent's *installation and maintenance of computer software*,

contained in class 42 of its specification. Therefore, the services at issue are considered identical either because they are worded the same, or under the principle outlined in *Meric*.

Installation and customisation of computer applications software; Installation, maintenance and repair of computer software; Installation, maintenance and repair of software for computer systems; Installation, maintenance and updating of computer software; Installation, maintenance and updating of database software; Installation, maintenance, repair and servicing of computer software; Installation, maintenance, updating and upgrading of computer software; Installation, repair and maintenance of computer software; Installation, setting up and maintenance of computer software; Installation, updating and maintenance of computer software; Maintenance and upgrading of computer software; Maintenance of and updating of computer software; Modifying of computer programs; Services for the updating of computer programmes; Services for updating computer software; Software (Updating of computer -); Update of computer software; Updating of computer programs; Updating of computer programs for third parties; Updating of computer software; Updating of software; Upgrading of computer software

36. I find that the above services overlap with or encompass the opponent's *installation and maintenance of computer software* in class 42 of its specification. As such, the respective services are identical in line with the principle set out in *Meric*.

Software as a service; Software as a service [SaaS]

37. Broadly speaking, software as a service (SaaS) is software that is rented or licensed rather than purchased outright. Accordingly, rather than buying software and paying for periodic upgrades, etc., SaaS is subscription based and upgrades are delivered automatically during the subscription period. Accordingly, the opponent's *computer software* present in class 9 of its specification, may include the same type of software provided through the contested SaaS services. On this basis, the users are likely to coincide, and the goods and services would overlap in purpose, and the method of use would be similar. Furthermore, the goods and services may be in competition with each other, and the average consumer may expect them to come

from the same undertaking. As such, I find that the competing goods and services are similar to at least a medium degree.

Programming (computer-); Programming of educational software; Programming of Internet security programs

38. Broadly speaking, programming concerns the act of writing a program or set of instructions that a computer follows in order to perform a particular task. Whilst services are not the same as goods, I consider the opponent's *computer software* in class 9 of its specification, to be the end result of its programming. As such, I find that there exists a complementary relationship between the goods and services, on the basis that without the above services there would be no software end product. Therefore, I do not consider it unreasonable for the consumer to believe that the goods and services derive from the same or related undertakings. Overall, I find there to be a low degree of similarity between the above services and the opponent's *computer software*.

Programming of web pages

39. The contested services involve the process of writing codes to create websites, etc. As such, I find that these services overlap with the opponent's *design, creation, maintenance and hosting of a website or website portal for recording or providing information about employee benefits, job and job placement, compensation, and educational opportunity and consultancy, design, testing, research, technical support and information in the field of computing, websites and website hosting*. Therefore, I consider the respective services to be identical in line with the principle set out in *Meric*.

Software creation; Software design; Software design and development; Software design (Computer -); Software design for others; Software development; Software development services; Software engineering; Software engineering services for data processing programs; Software authoring; Software research

40. The above services, broadly speaking, concern the creation and/or development of *computer software*. Whilst services are not the same as goods, I consider the

opponent's *computer software* in class 9 of its specification to be the end result of its creation and/or development. Therefore, I find that there exists a complementary relationship between the respective goods and services, because without the above services there would be no software end product. Whilst I acknowledge that the nature, purpose and method of use of the goods and services at issue is different, there may be an element of competition, with the consumer selecting either bespoke goods from the designer or choosing specific software already on the market. As such, I do not consider it unreasonable for the consumer to believe that the goods and services derive from the same or related undertakings. Overall, I find there to be a medium degree of similarity between the above services and the opponent's *computer software*.

#### Software customisation services

41. The above services concern the process of tailoring a software application to meet specific user or business needs, either by creating a completely new custom application or by modifying an existing one. As such I consider that there is a clear overlap between these services and the opponent's *installation and maintenance of computer software* on the basis that software maintenance involves, amongst other things, the process of modifying and updating software. Therefore, the services are identical in line with the principle set out in of *Meric*. However, if I have been too generous in my analysis, then I find the respective services to be similar to a high degree, on the basis that they share a similar purpose and can coincide in producers, channels of trade and end users.

#### Software consultancy services; Software consulting services

42. Broadly speaking, the ordinary meaning of 'consultancy' is the giving of advice. Whilst the above contested services would not necessarily include *installation and maintenance of computer software*, present in the opponent's class 42 specification, it may include advice about the installation and maintenance of software, on the basis that an undertaking providing consultancy services in relation to software would also likely be advising on installation and maintenance methods, etc. Accordingly, I

consider there to be an overlap in user and trade channels. Therefore, I find the services at issue to be similar to a low degree.

#### Administration of user rights in computer networks

43. The contested services involve managing a user's permissions, to, for example, control their access to a system, control their ability to install/uninstall software, change settings, and access data, etc. These technical services will likely be provided by an IT administrator responsible for the secure and reliable operation of an organisation's computer systems. Accordingly, I find that these services share a degree of similarity with the opponent's *hosting computer software applications for use by others; installation and maintenance of computer software and consultancy, design, testing, research, technical support and information in the field of computing, websites and website hosting* in Class 42 of its specification. I find that these services overlap in nature and purpose, can be provided by the same undertakings and can be aimed at the same consumers. Therefore, the respective services are similar to a medium degree.

#### Analytical services relating to computer programmes; Analytical services relating to computers

44. The contested services are technical IT services and broadly relate to, amongst other things, the collection, examination and interpretation of data, etc. I find that these services share a degree of similarity with the opponent's *consultancy, design, testing, research, technical support and information in the field of computing, websites and website hosting* in Class 42 of its specification. These services can overlap in nature and purpose, can be provided by the same undertakings and can be aimed at the same consumer. Therefore, I find the respective services to be similar to between a low and medium degree.

#### Information technology support services

45. In general, the above services are usually aimed at businesses to identify, for example, the information/computer technology needs of an organisation, and to

ensure that hardware, software, networks, and data systems function smoothly and securely. These services will be provided by specialists, such as IT specialists, who are able to provide advice regarding a wide range of computer-based technology, such as providing technical support regarding software products, for example, installation assistance and remote troubleshooting, etc. I am of the view that these services are encompassed by, or overlap with the opponent's broad term *consultancy, design, testing, research, technical support and information in the field of computing, websites and website hosting* in Class 42 of its specification. Accordingly, I find that the respective services are identical in line with the principle set out in *Meric*. However, if I am wrong in my analysis, then I find that the respective services are similar to a high degree, on the basis that the services are likely to share a similar purpose and can coincide in producers, channels of trade and end users.

#### Updating Internet pages

46. Broadly speaking, this service involves, amongst other things, the process of modifying the content, design, or functionality of a website or web page. I find that this service overlaps with the opponent's *design, creation, maintenance and hosting of a website or website portal for recording or providing information about employee benefits, job and job placement, compensation, and educational opportunity*; Accordingly, I consider that the respective services are identical in line with the principle set out in *Meric*. However, if I am wrong in my analysis, then I find that the respective services are similar to a high degree, on the basis that they are likely to share a similar purpose and can coincide in producers, channels of trade and end users.

#### Machine condition monitoring

47. This service involves the process of assessing the health and performance of hardware systems, such as servers and network equipment, in order to detect any faults or inefficiencies, and identify any potential issues or abnormal behaviour with regards to cybersecurity and improve system reliability. I am of the view that these services are encompassed by the broad term *consultancy, design, testing, research, technical support and information in the field of computing, websites and website*

*hosting*, present in class 42 of the opponent's specification. The respective services are therefore identical in line with the principle set out in *Meric*. However, if I am wrong in my analysis, then I find that the respective services are similar to a high degree, on the basis that the services are likely to share a similar purpose and can coincide in producers, channels of trade and end users.

#### Updating of software data bases

48. The contested services are a type of IT maintenance service, carried out in order to, amongst other things, maintain the smooth running and performance of software databases by ensuring that they remain accurate, relevant, and functional, etc. I am of the view that these services share a degree of similarity with the opponent's *hosting computer software applications for use by others; installation and maintenance of computer software and consultancy, design, testing, research, technical support and information in the field of computing, websites and website hosting* in Class 42 of its specification. I find that these services overlap in nature and purpose, can be provided by the same undertakings and can be aimed at the same consumers. Therefore, I find the respective services to be similar to a medium degree.

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

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

50. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well

informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

51. The average consumer for the goods and services may be either a member of the general public or a business user. Whilst the goods and services will vary in price, the average consumer is likely to consider various factors. When selecting the goods, the average consumer will consider factors such as functionality, compatibility with existing systems and any particular features. When selecting the services, the average consumer will consider factors such as customer service standards and technical expertise. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process. However, I recognise that a higher level of attention may be paid, particularly for the services where a bespoke product is being developed.

52. The goods and services are likely to be purchased following perusal of signage on packaging, physical premises and in advertisements. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and word-of-mouth recommendations may be made.

### **Comparison of the marks**


53. It is clear from *Sabel BV v. Puma AG* 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is

sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

55. The trade marks to be compared are as follows:

The opponent's mark	The applicant's mark
ADP STREAMLINE	 <b>Streamline</b> <sup>3</sup>

### Overall impression

56. The opponent's mark consists of the letters 'ADP' and the word 'STREAMLINE', presented in a standard, uppercase typeface. As the meaning of 'ADP' is unknown, it is more distinctive than the ordinary dictionary word 'STREAMLINE'.

57. The applicant's mark contains the word 'Streamline' followed by a small numeral '3'. 'Streamline' is presented in a standard, bold sentence case typeface and the number '3' is presented in a smaller, grey superscript typeface, set slightly above the 'Streamline' line of type. To the left of the word 'Streamline' sits a small, black circular device containing a grey and white, wavy decorative element. The eye is naturally drawn to the elements of the mark that can be easily read,<sup>7</sup> and so, due to its size, it is the word 'Streamline' which plays the greater role in the overall impression of the

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<sup>7</sup> *MigrosGenossenschafts-Bund v EUIPO*, T-68/17

mark, with the number '3' element playing a slightly lesser role. Although the device element will not be overlooked, I find that it plays a lesser role than the verbal elements.

#### Visual comparison

58. The marks coincide in the word 'STREAMLINE/Streamline'. However, the addition of the letters 'ADP' in the opponent's mark, and the device and number '3' element in the applicant's mark, act as points of visual difference. With regards to the differences at the start of the marks, I keep in mind that the beginnings of marks tend to make more of an impact than the ends.<sup>8</sup> As for the difference in letter case between the marks, I bear in mind that the opponent's mark is a word mark so could be used in any font. In my view, the marks are visually similar to a medium degree.

#### Aural comparison

59. The opponent's mark is likely to be pronounced as 'ay-dee-pee-stream-line', whereas the applicant's mark will likely be pronounced as 'stream-line-three'. The device element in the applicant's mark will not be articulated. Accordingly, 'streamline' in the marks is aurally identical. However, the pronunciation of 'ADP' in the opponent's mark, and the numeral '3' in the applicant's mark are points of aural difference between them. Therefore, I find that the marks are aurally similar to a medium degree.

#### Conceptual comparison

60. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

61. Conceptually, the ordinary dictionary word 'STREAMLINE/Streamline' will be given the same meaning in both marks, i.e. to make something simpler and more efficient.

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<sup>8</sup> *El Corte Ingles, SA v OHIM* Cases T-183/02 and T184/02

The letters 'ADP' in the opponent's mark are not pronounceable as a word and therefore are likely to be perceived as an acronym/abbreviation with no particular meaning. Therefore, the conceptual position of these letters will be neutral. As for the numeral three element in the applicant's mark, whilst it will be recognised as a number, taking the mark as a whole, I am not convinced that this element will convey any particular conceptual message to the average consumer other than perhaps it being a reference to a particular series or version number, etc. The decorative element in the applicant's mark, will be perceived as just that, and therefore will not convey any particular conceptual message. Overall, due to the presence of 'STREAMLINE/Streamline' in the marks, I find them to be conceptually similar to a medium degree.

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

62. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

63. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it, however, the opponent has not pleaded that the distinctiveness of its mark has been enhanced through use, nor has it filed any evidence to support such a finding. Consequently, I have only the inherent position to consider.

64. With regards to the letters ‘ADP’, as previously stated, I am of the view that they will be viewed as an acronym/abbreviation with no particular meaning. I therefore find this element to be inherently distinctive to between a medium and high degree. As for the ordinary dictionary word ‘STREAMLINE’, I recognise that in the context of the goods and services at issue, this may allude to the concept that they will make things simpler and more efficient for the user, for example. Accordingly, I consider this element to be inherently distinctive to between a low and medium degree. Accordingly, taking the mark as a whole, I consider it to be inherently distinctive to a medium degree.

### **Likelihood of confusion**

65. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful 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.

66. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and the goods and services down to the responsible undertakings being the same or related.

67. Earlier in the decision I found that:

- The marks are visually, aurally and conceptually similar to a medium degree.
- The similarity of the parties' goods and services vary between identical and similar to a low degree.
- The earlier mark has a medium degree of inherent distinctive character for the goods and services at issue.
- The average consumer would include members of the general public and business users, paying at least a medium level of attention, and who will source the goods and services at issue by both visual and aural means.

68. Taking into account the above, particularly the visual differences between the marks, namely the addition of the letters 'ADP' present in the opponent's mark, and the addition of the device and numeral '3' elements in the applicant's mark, along with the level of attention paid by the average consumer in relation to the goods and services at issue, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. Accordingly, I do not consider there to be a likelihood of direct confusion.

69. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar*

*Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he then was), 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)”.

70. These examples are not exhaustive but provide helpful focus.

71. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [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.

72. I acknowledge that a finding of indirect confusion should not be made merely because the respective marks share a common element. However, it is not sufficient that a mark merely calls to mind another mark:<sup>9</sup> this is mere association not indirect confusion.

73. In order to find indirect confusion in this case, it would be necessary to conclude that the average consumer will notice the common element ‘STREAMLINE/Streamline’ in the marks, while at the same time recalling the differences between them and assume that the marks are from the same or related undertaking. However, I do not think that this is likely.

74. In my view, in terms of the goods and services at issue, the common element ‘STREAMLINE/Streamline’, being an ordinary dictionary word, meaning, ‘to make something simpler and more efficient’, is not particularly distinctive. Furthermore, I bear in mind that the addition of the letters ‘ADP’ in the opponent’s mark, and the device and numeral ‘3’ elements in the applicant’s mark are not non-distinctive additions. Taking all of this into account, to my mind, the applicant’s mark is not a logical brand extension, sub-brand or rebrand, etc., of the earlier mark ‘ADP STREAMLINE’ (or vice versa). Even taking into account the identity of some of the goods and services at issue, I find that there is no proper basis for a finding of indirect confusion. Whilst I acknowledge that the marks both contain the word ‘STREAMLINE/Streamline’, in my view, this word is not so strikingly distinctive that the average consumer would assume that no-one else, but the opponent would be using it in a

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<sup>9</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

trade mark. Rather, I am of the view that the average consumer will put the presence of this common element down to coincidence rather than economic connection, and therefore, I can see no reason why consumers would believe that the marks originate from the same or economically linked undertakings. Consequently, I do not consider there to be a likelihood of indirect confusion.

## CONCLUSION

75. The opposition based upon section 5(2)(b) of the Act has been unsuccessful and the contested mark may proceed to registration in full.

## COSTS

76. The applicant has been successful and is entitled to an award of costs. As the applicant had not instructed professional representatives, they were invited by the Tribunal to indicate whether they intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. On 31 March 2025, the applicant submitted a pro-forma for the following award of costs:

Preparing evidence/written submissions and considering and commenting on the other side's evidence/written submissions	
Description of activity	Time spent in hours/minutes
Consideration of opposition Statement - S.Taylor, Solicitor	1 hour
Preparation of counterstatement - S.Taylor, Solicitor	4 hours
Preparation of final submission - S.Taylor, Solicitor	4 hours
<b>TOTAL</b>	10 hours

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77. With consideration of the above, I am guided in this decision by the scale of costs set out in Tribunal Practice Notice (“TPN”) 1/2023 above, as well as the guidance on how costs should be allocated to unrepresented parties such as the applicant.

<sup>10</sup> It is noted that the applicant has incorrectly calculated the total number of hours as 10 hours, rather than 9 hours.

78. First and foremost, I remind myself that the Tribunal awards costs on a contributory rather than a compensatory basis. It is important to note that only costs which have been incurred during, and as part of, these proceedings are relevant, such as filing official forms, evidence, written submissions etc.

79. I also take into account Mr Hobbs QC's (as he then was) comments in *Amaro*, O/257/18:

“17. [...] an award of costs is required to reflect the effort and expenditure to which it relates without inflation for the purpose of imposing a financial penalty by way of punishment on the paying party. The determination of a ‘reasonable’ amount to award must depend on the nature and circumstances of the case at hand.”

80. It is important to note that only costs which have been incurred during, and as part of, these proceedings are relevant, such as filing official forms, evidence, written submissions etc. Accordingly, I have set out below my assessment on the applicant's claim made. As outlined in TPN 1/2023, I will make the award of costs on the basis of £19 per hour, which is the minimum rate of compensation allowed under The Litigants in Person (Costs and Expenses) Act 1975 (as amended).

81. In accordance with Annex A of TPN 1/2023, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement (5 hours):	£95
Preparing written submissions in lieu of a hearing (4 hours):	£76
<b>Total</b>	<b>£171</b>

82. I therefore order ADP, Inc. to pay UBT (EU) Ltd the sum of £171. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 4<sup>th</sup> day of November 2025**

**Sam Congreve  
For the Registrar**