O/1051/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 4019032 BY LENTON TECHNOLOGY LIMITED TO REGISTER THE TRADE MARK:

LEXARY

IN CLASSES 9, 35, 41 & 42

AND

OPPOSITION THERETO UNDER NO. 448624 BY LONGSYS ELECTRONICS (HK) CO., LIMITED

BACKGROUND & PLEADINGS

1. Lenton Technology Limited ("the applicant") applied to register the trade mark shown on the front page of this decision in the United Kingdom on 27 February 2024. It was accepted and published in the Trade Marks Journal on 17 May 2024. I note that on 19 September 2024 the applicant filed a Form TM21B, amending its specification as follows:

> **Class 9:** Downloadable computer software providing electronic databases consisting of word list compilations, dictionaries, pronunciations, and dialects; Downloadable computer software for language translation; Downloadable computer software for providing language analysis, statistics and trends; Downloadable computer software for making suggestions and edits to correct and improve writing skills; Downloadable computer software for spell-checks; Downloadable educational software related to English language teaching and learning; Downloadable educational software related to foreign-language teaching and learning; Downloadable software for mobile phones for educational and entertainment purposes involving language learning.
>
> **Class 35:** Subscription services for enhanced functionality of the software; Compilation of information into computer databases; Information and advisory services relating to the aforementioned.
>
> **Class 41:** Educational services; Educational services related to languages; Educational services, namely providing language teaching, language training, language proficiency testing and assessment services; Entertainment services related to language teaching, language training, language proficiency testing and assessment services; Providing online non-downloadable dictionaries; Providing on-line non-downloadable electronic monolingual and bilingual dictionaries, thesauri; Providing online translation services; Providing online interactive learning services,

namely educational games, quizzes, tutorials; Providing non-downloadable electronic publications related to language teaching and training; Information and advisory services relating to the aforementioned.

Class 42: Compilation of electronic dictionaries; Software as a service featuring educational software; Software as a service featuring electronic databases consisting of word list compilations, dictionaries, pronunciations, and dialects; Software as a service featuring educational software in the field of English language; Software as a service featuring educational software in the field of foreign languages; Software as a service for making suggestions and edits to correct and improve writing skills; Providing temporary use of online non-downloadable software for language translation; Providing temporary use of online non-downloadable software for making suggestions and edits to correct and improve writing skills; Providing temporary use of online non-downloadable software for educational use, namely software for use in teaching, practising, and learning vocabulary; Providing temporary use of online non-downloadable software for social media networking services; Platform as a service [PaaS] featuring computer software platforms for use in the fields of learning and educational tools; Online provision of web-based applications; Online provision of web-based software; Information and advisory services relating to the aforementioned.

2. On 16 July 2024, Longsys Electronics (HK) Co., Limited ("the opponent") opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act")[1]. For the purposes of these opposition proceedings,

[1] 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.

the opponent relies upon Class 9 goods for each of the following UK registered marks:

Trade Mark no.	UK00002258509 (‘509)
Trade Mark	LEXAR
Goods for which the mark is registered	**Class 9:** Photographic, cinematographic apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; sound, film and/or video recordings; digital communications apparatus and instruments; CD-roms; DVD's, computer software and apparatus for use in downloading, transmitting, receiving, editing, extracting, coding, decoding, playing, storing and organising data, encoding digital film data, digital cameras, digital film; chips, discs and tapes bearing or for recording computer programs and software; digital film cards, digital film reader; electronic publications; but not including signal conditioning devices and apparatus including delay lines, filter networks, time delay apparatus and goods of the same description thereof and component parts for the use in the products covered in above; notwithstanding the above stated exclusions Class 9 shall always cover digital film, memory card reader drivers, memory card portable readers, memory card desktop readers, memory sticks, digital media cards, digital memory cards, removable or embedded flash-based digital media, any type of non-volatile memory product (whether embedded or removable) and ancillary products, other similar products used in digital photography and related hand-held electronic devices including but not limited to MP3 Players, PDA's, cellular phones and digital camcorders.
Filing date	19 January 2001
Date of entry in register	27 February 2004

Trade Mark no.	UK00003647360 (‘360)
Trade Mark	
Goods for which the mark is registered	**Class 9:** Memory cards; Computer memory devices; Data processing equipment; Computer programs, downloadable; Computer peripherals; Integrated circuit cards; Solid state drives; USB flash drives; Chips [integrated circuits]; Semiconductors.
Filing date	26 May 2021
Date of entry in register	15 October 2021

3. Under Section 6(1) of the Act, the opponent’s marks clearly qualify as earlier trade marks. As the registration procedure for the earlier mark ‘509 was completed more than 5 years prior to the filing date of the contested application, it is subject to the proof of use conditions, as per Section 6A of the Act. The opponent made a statement of use in respect of all the goods under Class 9 it relies on. However, the earlier mark ‘360 has not been registered for five years or more before the filing date of the application, and as a result it is not subject to the proof of use requirements.

4. The opponent in its notice of opposition claims that the competing marks are visually, phonetically, and conceptually highly similar and the respective goods and services are identical and/or highly similar.

5. The applicant filed a counterstatement, denying the opponent’s claims. The applicant also requested that the opponent provides proof of use of its earlier mark ‘509 relied upon. Lastly, the applicant requested that the opposition be refused in its entirety and that costs be awarded in its favour.

Papers Filed and Representation

6. The opponent filed evidence in these proceedings. This comes in the form of a witness statement from Ms Tara Tang, the director of the opponent. Her witness statement is dated 9 December 2024 and is accompanied by 15 exhibits (Exhibit 1 – Exhibit 15). The purpose of the evidence is to prove use of the opponent's mark '509.

7. The applicant filed evidence in these proceedings. This comes in the form of a witness statement from Alexander James Lenton, the director and founder of the applicant. His witness statement is dated 7 February 2025 and is accompanied by four exhibits (AL1 – AL4). The evidence contains an undated screenshot of the applicant's website, and printouts of the competing marks as they appear on UK Trade Marks Registry. Although I have considered the applicant's evidence, no explanation as to their relevance is provided, and thus, I will say no more. Further, I note that the witness statement also contains submissions; however, I do not consider it too onerous a task to separate the opinions of Mr Lenton from his statements of fact. Therefore, I will adopt a pragmatic approach, treating the submissions as legal arguments and/or opinions rather than factual statements, even though they are nevertheless conveyed in a witness statement accompanied by a statement of truth. Lastly, Mr Lenton went on to say that he is not aware of any instances of actual confusion or association between the competing marks and their respective goods and services. However, absence of evidence of actual confusion has been held by the courts rarely to be significant as that may be a result of a wide variety of different factors.[2]

8. Only the opponent filed written submissions in lieu of a hearing on 17 April 2025. I have taken the evidence and submissions into account in reaching my decision and will refer to them below, where necessary.

[2] See *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, at [291].

9. No hearing was requested and so this decision is taken following a careful consideration of the papers.

10. In these proceedings, the applicant is represented by Basck Limited and the opponent by Sonder & Clay.

Preferred Approach

11. The earlier mark '360 has a broader specification that contains wider terms than the earlier mark '590,[3] which is subject to the proof of use requirement. I will proceed initially on the basis of the earlier mark '360, returning to the earlier mark '509, only if it becomes necessary to do so.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) of the Act states:

> "A trade mark shall not be registered if because-
>
> […]
>
> (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."

13. The principles, considered in this opposition, stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd*

[3] I also note that the specification of the earlier mark '509 contains two limitations, namely "…*but not including signal conditioning devices and apparatus including delay lines, filter networks, time delay apparatus and goods of the same description thereof and component parts for the use in the products covered in above; notwithstanding the above stated exclusions Class 9 shall always cover*...". (emphasis added)

Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation 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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* 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 complementary."

15. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

> "(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."

16. In *YouView TV Ltd v Total Ltd,* [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words of phrases in their ordinary and natural meaning are apt

to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 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."

18. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

> "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."

19. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it

were, the core of the possible meanings attributable to the rather general phrase."

20. The competing goods and services to be compared are shown in the following table:

Opponent's Goods	Applicant's Goods and services
Class 9: Memory cards; Computer memory devices; Data processing equipment; Computer programs, downloadable; Computer peripherals; Integrated circuit cards; Solid state drives; USB flash drives; Chips [integrated circuits]; Semiconductors	**Class 9:** Downloadable computer software providing electronic databases consisting of word list compilations, dictionaries, pronunciations, and dialects; Downloadable computer software for language translation; Downloadable computer software for providing language analysis, statistics and trends; Downloadable computer software for making suggestions and edits to correct and improve writing skills; Downloadable computer software for spell-checks; Downloadable educational software related to English language teaching and learning; Downloadable educational software related to foreign-language teaching and learning; Downloadable software for mobile phones for educational and entertainment purposes involving language learning. **Class 35:** Subscription services for enhanced functionality of the software; Compilation of information into computer databases; Information and advisory services relating to the aforementioned. **Class 41:** Educational services; Educational services related to languages; Educational services, namely providing language teaching, language training, language proficiency testing and assessment services; Entertainment services related to language teaching, language training, language proficiency testing and assessment services; Providing online non-downloadable dictionaries; Providing on-line non-downloadable electronic monolingual

	and bilingual dictionaries, thesauri; Providing online translation services; Providing online interactive learning services, namely educational games, quizzes, tutorials; Providing non-downloadable electronic publications related to language teaching and training; Information and advisory services relating to the aforementioned. **Class 42:** Compilation of electronic dictionaries; Software as a service featuring educational software; Software as a service featuring electronic databases consisting of word list compilations, dictionaries, pronunciations, and dialects; Software as a service featuring educational software in the field of English language; Software as a service featuring educational software in the field of foreign languages; Software as a service for making suggestions and edits to correct and improve writing skills; Providing temporary use of online non-downloadable software for language translation; Providing temporary use of online non-downloadable software for making suggestions and edits to correct and improve writing skills; Providing temporary use of online non-downloadable software for educational use, namely software for use in teaching, practising, and learning vocabulary; Providing temporary use of online non-downloadable software for social media networking services; Platform as a service [PaaS] featuring computer software platforms for use in the fields of learning and educational tools; Online provision of web-based applications; Online provision of web-based software; Information and advisory services relating to the aforementioned.

21. The opponent made lengthy submissions, which I will not reproduce here but have taken into consideration. In summary, the opponent claims that

the competing goods in Class 9 are identical, the competing goods and services in Classes 35 and 42 are highly similar, and similar in Class 41.

22. Mr Lenton states that:

> "7. It will be appreciated that the goods and services offered by the Applicant are of a different type than those offered by the Opponent. They are directed at segments of consumers interested in improving their language skills. Lenton Technology's commercial activities are primarily targeted at academics and non-native speakers, who have specific needs and a great deal of care while making a decision to use a product or service. They are very unlikely to be confused in such situations. It is extremely difficult to imagine that e.g. a consumer looking to enhance their language skills or train their vocabulary in foreign languages would instead buy a memory storage device.
>
> 8. In Class 09, the goods covered by Lenton Technology's mark focus on downloadable software for online dictionaries, while in the case of Longsys Electronics' marks – on storage devices.
>
> 9. Goods and services offered under the two marks would not coincide in terms of their trade channels.
>
> 10. The goods and services offered by the "LEXARY" mark may be offered in online libraries, or in the 'Education' segment of a retail store, whereas the goods and services by the Opponent are offered in electronic gadgets segments of a retail store."

23. While I acknowledge the applicant's position regarding its commercial activities and the consumer group it targets with its goods and services,[4] I note that I must consider the matter based on the terms that the parties have registered or seek to register. Therefore, the assessment that I will

[4] Marketing strategies, including the targeting of specific consumers, may be temporary and change over time. See *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P at [59] in this regard.

undertake between the competing specifications is a notional and objective one rather than a subjective one.[5]

24. Although the applicant has correctly highlighted in its counterstatement that the earlier specification does not contain any services in Classes 41 and 42, Section 60A of the Act stipulates that goods and services are not to be regarded as similar or dissimilar simply because they fall in the same or different Class.

25. The contested specification contains the word "*namely*" in more than one instance. Guidance on how to treat this word is contained in the addendum to the Trade Mark Registry's Classification Guide, which reads as follows:

> "Note that specifications including "namely" should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above "dairy products namely cheese and butter" would only be interpreted as meaning "cheese and butter" and not "dairy products" at large. This is consistent with the definitions provided in Collins English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are"." (emphasis added)

26. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.[6]

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[5] See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraph 22 and *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraphs 78 and 84.

[6] *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Class 9

Downloadable computer software providing electronic databases consisting of word list compilations, dictionaries, pronunciations, and dialects; Downloadable computer software for language translation; Downloadable computer software for providing language analysis, statistics and trends; Downloadable computer software for making suggestions and edits to correct and improve writing skills; Downloadable computer software for spell-checks; Downloadable educational software related to English language teaching and learning; Downloadable educational software related to foreign-language teaching and learning; Downloadable software for mobile phones for educational and entertainment purposes involving language learning

27. The contested goods are different types of software in relation to electronic databases, languages, etc. The contested terms are broad enough that would readily cover the earlier goods "*Computer programs, downloadable*". Thus, the competing goods are identical as per *Meric*.

Class 35

Subscription services for enhanced functionality of the software

28. The earlier mark is registered for "*Computer programs, downloadable"*, which I consider to be the best comparator. I first acknowledge that my comparison here entails goods against services, so it follows that there is a difference in nature and method of use. However, I consider that such goods and the above services would overlap in respect of users. In addition, there could be an overlap in trade channels. In addition, the earlier goods are important for the delivery of the contested services. In this respect, there is a relationship of indispensability between the respective goods and services to the extent that consumers would expect that the same undertaking is responsible for both goods and services enabling them to access enhnaced functionality software. Consequently, I consider the goods and services enjoy a complementary relationship. I do

not consider there to be any degree of competition between the competing terms. Overall, I find there is a low to medium degree of similarity.

Compilation of information into computer databases

29. I consider that the earlier terms "*Computer programs, downloadable; Data processing equipment*" are important to compile and input information into computer databases. These goods and services may coincide in users and channels of trade. I also consider that the earlier goods may be used to support the provision of the contested services where the nature of the goods plays an integral part in the delivery of the services. The consumers will also think that the competing goods and services lie with the same undertaking. Accordingly, I find that the respective goods and services are complementary in the sense described by the case law. Therefore, I find that these goods and services are similar to a low to medium degree.

Information and advisory services relating to the aforementioned

30. The contested services provide users with the necessary information and support for the respective services, namely "*Subscription services for enhanced functionality of the software*" and "*Compilation of information into computer databases*". I consider that the closest comparable term from the opponent's specification is "*Computer programs, downloadable*". Although the competing terms differ in nature, purpose, and method of use, there is a degree of complementarity. This is because such services typically support the use, implementation, or optimisation, *inter alia*, of computer programs and are often offered by the same providers and through the same trade channels. Therefore, consumers would believe that the same undertaking is responsible for both. There is also an overlap in users. I find that the competing terms are similar to a low degree.

Class 41

Educational services; Educational services related to languages; Educational services, namely providing language teaching, language training, language proficiency testing and assessment services; Entertainment services related to language teaching, language training, language proficiency testing and assessment services

31. I note the opponent's earlier goods "*Computer programs, downloadable*" are the closest comparator. The nature and method of use of these goods and services will differ. However, I consider that the earlier term is a broad term, which would encompass educational computer programs, and thus there is a sufficient degree of complementarity between the competing goods and services, as it is not unusual that a party offering educational services may provide educational computer programs, for example, for students to track progress, practice vocabulary and learn grammar rules, alongside those services. Therefore, the consumers would attribute responsibility for the respective goods and services to the same undertaking. There is also a potential for trade channels to be shared, as well as users of the educational services and computer programs. Overall, I find these goods and services to be similar to a medium degree.

Providing online non-downloadable dictionaries; Providing on-line non-downloadable electronic monolingual and bilingual dictionaries, thesauri; Providing online translation services; Providing online interactive learning services, namely educational games, quizzes, tutorials; Providing non-downloadable electronic publications related to language teaching and training

32. I will consider the contested terms against the earlier term "*Computer programs, downloadable*". Although this earlier term is broad, it can be readily interpreted to include all forms of programs running on a computer or a computing device, such as smartphones and tablets. Against this background, there is a degree of complementarity between the contested

terms and the earlier goods. This is in particular due to the potential that the contested services could be provided via the opponent's programs which would allow users to access dictionaries, thesauri, translation, and interactive learning materials online via a device. Therefore, the consumers will expect that the respective terms are offered by the same undertaking. In this regard, there may be an overlap in users and potentially trade channels. There is also a degree of competition, as users may choose to purchase downloadable programs or use online (non-downloadable) services based on their needs. I note that the nature is different, but the end purpose may coincide as the respective goods and services aim to make the content of the services available to the public. Taking all the above into account, I find that there is a medium degree of similarity.

Information and advisory services relating to the aforementioned

33. Following the same approach advanced in paragraph 30 of this decision, I consider that the competing services and goods, namely "*Computer programs, downloadable"*, are similar to a low degree.

Class 42

Compilation of electronic dictionaries

34. The contested term is comparable to the earlier term "*Computer programs, downloadable*" in Class 9. The nature and method of use of the competing goods and services are different, as the services are offered by a provider to the end users, whereas the goods in Class 9 concern physical products, (computer programs). I consider that the earlier goods are indispensable for the delivery of such services, and the consumers may believe that they are offered by the same undertaking. I, thus, consider that the respective goods and services are complementary. I find that the competing terms are similar to a medium degree.

Providing temporary use of online non-downloadable software for language translation; Providing temporary use of online non-downloadable software for making suggestions and edits to correct and improve writing skills; Providing temporary use of online non-downloadable software for educational use, namely software for use in teaching, practising, and learning vocabulary; Providing temporary use of online non-downloadable software for social media networking services

35. All these services involve the provision of temporary use of online non-downloadable software for language translation, making suggestions and edits to correct and improve writing skills, etc. The earlier term "*Computer programs, downloadable*" in Class 9 is the closest comparable term, which is a broad term that could also encompass computer programs in relation to language translation etc. Again, in this case, the use of the earlier goods could be integral and indispensable to the delivery of the services. Thus, there will be a degree of complementarity with the opponent's goods, as the average consumer may think that the goods and services are the responsibility of the same undertaking or economically linked undertakings. They may share the same users, and there will be some overlap in trade channels, as the earlier goods would be purchased from websites or app stores, sometimes directly from software developer websites offering such services. There is also a degree of competition, as users may choose to purchase downloadable programs or use non-downloadable software services based on their needs. However, the nature and method of use of the services are different to that of the goods themselves. Overall, I consider the competing goods and services to be similar to a medium degree.

Online provision of web-based applications; Online provision of web-based software

36. Following the same approach advanced in the preceding paragraph, I consider that the contested services and the earlier term "*Computer programs, downloadable*" will be similar to a medium degree in this case

as they share the same users, trade channels, and there is a degree of complementarity and competition between them.

Software as a service featuring educational software; Software as a service featuring electronic databases consisting of word list compilations, dictionaries, pronunciations, and dialects; Software as a service featuring educational software in the field of English language; Software as a service featuring educational software in the field of foreign languages; Software as a service for making suggestions and edits to correct and improve writing skills

37. The contested services enable the distribution of such software to users through online channels via a 'portal' or 'cloud'. In general, the above services are concerned with software that is rented or licensed, etc., rather than purchased outright. I consider that there is a similarity between the earlier goods "*Computer programs, downloadable*" in Class 9 and the contested services. I find that the earlier computer programs may include the same type of programs provided through the above services. The nature of the earlier goods differs from the applicant's services. The method of use will differ as the applicant's services will be accessed by consumers online via a portal or cloud, but the opponent's computer programs will be purchased and downloaded to a device. Trade channel overlap is possible as the same undertaking might provide both programs as goods and software as a service in the given fields. There will also be an overlap in users. The user will also assume that the goods and services originate from the same undertaking, especially as they are important and indispensable to one another, since the contested services cannot be provided without the earlier goods. Further, I consider there will be a degree of competition between the goods and services, as users may be faced with the choice of selecting the contested services to use via an online portal or purchasing the appropriate computer programs as goods. Therefore, I consider the competing goods and services to be similar to a medium degree.

Platform as a service [PaaS] featuring computer software platforms for use in the fields of learning and educational tools

38. The contested services are a type of cloud computing service that provides a cloud platform for developing, running and managing software applications in the fields of learning and educational tools. Following the same approach in the preceding paragraph, I consider that the earlier term "*Computer programs, downloadable*" in Class 9 and the contested services are similar to a medium degree.

Information and advisory services relating to the aforementioned

39. Again in this instance, the contested services are similar to a low degree to the opponent's "*Computer programs, downloadable"* for the same reasons as advanced in paragraph 30 of this decision.

Average Consumer and the Purchasing Act

40. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

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

41. The average consumer of the Class 9 goods will be a member of the general public and professionals/business users. Such goods are usually offered for sale in online stores, brochures, and catalogues, but I do not exclude entirely their availability in high street retail stores. The consumers will select the goods relying on the images displayed on the relevant web pages or mobile applications. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative when a purchase is made in a high street store. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the products to ensure software/ hardware compatibility with other components or systems or that the goods possess the required features. In this regard, the average consumer is likely to pay a medium degree of attention when selecting the goods at issue.

42. For the services at issue, the average consumer will be a member of the general public or business users/professionals. The consumers will select such services by looking through brochures, websites, or signs on a physical property so the visual element will be important. However, I do not discount the aural element, as word-of-mouth recommendations may influence consumers' decisions. The cost of some services will be relatively significant, such as software as a platform services, contributing to the selection process of the service provider. Given the more specialist nature of the services in play, especially those selected by business users, I consider that the average consumer will pay a slightly higher than a medium degree of attention in choosing the service provider.

Comparison of Trade Marks

43. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not

proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "[…] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

45. The marks to be compared are:

Earlier Mark	Contested Mark
	LEXARY

Overall Impression

46. The contested mark "LEXARY" is a word mark. Registration of a word mark protects the word itself.[7]

[7] See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

47. The earlier mark consists of the word element “Lexar” in a standard typeface and black bold font, with a highly stylised letter ‘X’, featuring a diagonal bar topped with a series of four black circles of varying sizes and a white circle at the intersection. Despite its stylisation, the ‘X’ letter will be readily understood as such. I consider that the word element “Lexar” will have the greatest weight in the overall impression, with the stylised ‘X’ letter making a lesser contribution in the overall impression.

Visual Comparison

48. The contested mark consists of six letters, whilst the earlier mark has five. I bear in mind that the beginnings of words tend to have more impact than the ends.[8] I note that the contested mark incorporates the entirety of the word of the earlier mark, namely “LEXAR-”, apart from the final letter ‘Y’. Although it is not legitimate to perform a comparison between a word mark and a stylised mark by considering specific ways in which the words might be presented, the typeface[9] and colour[10] in which the earlier mark is presented in this case do not provide a point of distinction in themselves. That said, I note that the presence/absence of the highly stylised “X” in the competing marks will be a point of difference. Taking into account the overall impression of the marks and the similarities and differences, I consider that the marks are visually similar to a medium to high degree.

Aural Comparison

49. The earlier mark will be pronounced as “LEKS-AR” whereas the contested as “LEKS-AR-EE”. The shared verbal elements “LEKS-AR” in the competing marks will be identically pronounced. However, the competing marks differ in the presence/absence of the last syllable “-EE”. Therefore, I find that there is a high degree of aural similarity.

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[8] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

[9] See *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22.

[10] See *Specsavers* [2014] EWCA Civ 1294; and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290.

Conceptual Comparison

50. 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] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

51. The applicant made no submissions as to the conceptual meaning of either mark. Nevertheless, I agree with the opponent's submissions that the verbal elements of the marks will be seen as invented terms, as no immediate perceptible meaning can be attributed to them. As a result, I find that the marks are conceptually neutral.

52. For completeness, I note that the highly stylised 'X' letter in the earlier mark, will be readily understood as such and will add no additional concept.

Distinctive Character of the Earlier Trade Mark

53. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> "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).
>
> 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)."

54. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

55. The opponent in its submissions in lieu of a hearing argues that the earlier mark possesses a high level of distinctiveness.

56. As described above in this decision, the earlier mark consists of the word element "Lexar" with a highly stylised letter 'X'. The mark will be perceived by consumers as an invented word and has no suggestive or allusive significance in relation to the goods for which it is registered. I find that the combination of the word element and the stylisation renders the mark as a whole inherently distinctive to a high degree.

Enhanced Distinctiveness

57. For completeness, I note that the opponent's evidence shows use of the earlier mark. That said, I find the evidence insufficient to demonstrate that the mark has acquired an enhanced degree of distinctive character through use in the UK for the relevant goods. I have no information about its annual sales, market share, and overall advertising expenditure within the relevant sector. In addition, there is very little supporting evidence of

promotional material targeting the UK audience[11] that suggests any extensive media coverage or intensive advertising and promotional activities in the UK. Consequently, the evidence is not sufficient to establish that the distinctiveness of the earlier mark has been enhanced through use.

Likelihood of Confusion

58. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.[12] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[13]

59. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

60. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Iain Purvis QC, sitting as the Appointed Person, explained that:

[11] Even when considering the social media posts from Exhibits 12-15, it is not specified in the witness statement whether these social media accounts where UK accounts targeting UK consumers.

[12] See *Canon Kabushiki Kaisha*, paragraph 17.

[13] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

> "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."

61. Earlier in this decision I have concluded that:

- the competing goods are identical and the services at issue are similar ranging from low to medium degree;
- the average consumer of the goods and services will be a member of the general public and business/professionals and the selection process is predominantly visual without discounting aural considerations. The level of attention paid for the goods will be medium. As for the services, the average consumer will pay a slightly higher than a medium degree of attention in choosing the service provider;
- the competing marks are visually similar to a medium to high degree, aurally similar to a high degree, and conceptually neutral;
- the earlier mark has a high degree of inherent distinctive character. The use is not sufficient to establish enhanced distinctiveness of the mark.

62. Taking into account the above factors, I find that there is a likelihood of direct confusion for identical goods. I bear in mind that consumers rarely

have a chance to compare marks side by side, and thus the presence/absence of the divergent letter 'Y' is likely to be overlooked or misremembered due to the principle of imperfect recollection. This is particularly the case because of its position at the end of the mark, which is considered less impactful, and the marks are conceptually neutral, which means that there is no conceptual hook to differentiate them. In addition, I consider that the stylisation of the letter "X" will also be overlooked, especially as it plays a lesser role in the overall impression. Thus, I find that the similarity between the marks coupled with the high distinctiveness of the earlier mark will result in the average consumer imperfectly recollecting the earlier mark and directly confusing it with the contested mark.

63. The above finding extends to the rest of the contested services that I have found to be similar to any degree of similarity on the basis of the interdependence principle.

Final Remark

64. As noted in paragraph 11 above, the earlier mark '509 has a more restricted specification than the earlier mark '360, and it is also subject to the proof of use requirement. In addition, I note that the opponent has not provided any evidence in relation to the turnover figures or marketing expenditure for the earlier mark '360. Therefore, I would not find this particularly helpful in assessing proof of use or enhanced distinctiveness of that mark. Consequently, I do not consider that the opposition based on the earlier mark '509 would have put the opponent in a stronger position.

Outcome

65. The opposition under Section 5(2)(b) succeeds and, subject to any successful appeal against this decision, the application will be refused.

COSTS

66. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Official fee	**£100**
Preparing a statement and considering the counterstatement	**£250**
Preparing evidence and considering and commenting on the other side's evidence	**£700**
Preparing submissions in lieu	**£350**
Total	**£1,400**

67. I, therefore, order Lenton Technology Limited to pay to Longsys Electronics (HK) Co., Limited the sum of £1,400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 12th day of November 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General