

**O/1079/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO. 3701775**

**IN THE NAME OF BAKER HUGHES, A GE COMPANY, LLC**

**AND**

**TRADE MARK APPLICATION NO. 3701777**

**IN THE NAME OF BAKER HUGHES HOLDINGS LLC**

**AND**

**OPPOSITION THERETO UNDER NOS 431541 & 431549**

**BY BMC SOFTWARE, INC.**

## **BACKGROUND AND PLEADINGS**

1. This decision concerns oppositions brought in the name of BMC Software, Inc. (“BMC”) against two trade mark applications. The oppositions are both now based on s. 5(2)(b) of the Trade Marks Act 1994 (“the Act”) only.

2. The first trade mark in issue is application number 3701775, for the following figurative mark (“the ’775 mark”):



3. The application relates to goods and services in a wide range of classes. However, the opposition is directed against all of the goods in class 9 and all of the services in class 42 only. The contested goods and services are set out in full at annexe 1 to this decision. Broadly speaking, they concern equipment and software for a range of purposes, certain types of software as a service (“SaaS”) provision, and various testing, measuring, evaluation, design and consultation services, mainly in the fields of oil and gas or for wider industrial application.


4. The ’775 mark is an application filed pursuant to Article 59 of The Agreement on the Withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (“the Withdrawal Agreement”). The application was filed in the UK on 27 September 2021 and the applicant is Baker Hughes, a GE Company, LLC. The European Union trade mark upon which the application was based (EU18218929) has a filing date of 1 April 2020 and claims a priority date of 4 October 2019 from a US trade mark.

5. The second application in issue is trade mark application number 3701777, for the following trade mark (“the ’777 mark”):



6. The '777 mark was filed in the UK on 27 September 2021. The applicant for this trade mark is Baker Hughes Holdings, LLC. Like the '775 mark, the '777 mark was filed pursuant to Article 59 of the Withdrawal Agreement. EU trade mark number 18316242, upon which the '777 mark is based, has a filing date of 1 October 2020. The '777 mark is applied for in respect of a range of goods and services in classes 9 and 42, all of which are opposed. The goods and services are almost completely encompassed by the '775 mark's specification. They are set out in full at annexe 1 to this decision.

7. BMC relies upon the following earlier trade mark for both of its oppositions:

Trade mark	Relevant dates	Specification
<p data-bbox="204 1155 424 1189">UK 801258896</p>  <p data-bbox="204 1621 584 1928">Mark description/limitation: "The mark consists of a stylized double helix in orange. Colour Claimed: A stylized double helix in orange."</p>	<p data-bbox="608 1155 960 1240">Filing date: 3 December 2014</p> <p data-bbox="608 1301 960 1386">Priority date: 31 October 2014</p> <p data-bbox="608 1447 960 1532">Registration date: 8 June 2016</p>	<p data-bbox="983 1155 1390 1574">Registered in classes 9 and 42; all goods and services relied upon (see annexe 2; broadly, software for a range of purposes; software consultancy/ maintenance/ programming and software as a service).</p>

8. BMC asserts that the marks at issue are similar and that the goods and services are identical or similar. It says that there is a likelihood of confusion and therefore asks that the application for the contested marks be refused under s. 5(2)(b).

9. The applicants for the trade marks both filed counterstatements in defence of their respective applications. Notwithstanding the fact that the applications are owned by different entities, their counterstatements are substantially identical. The applicants deny that the applications offend under s. 5(2)(b). In particular, they deny that the marks are similar and that the goods and services are identical. The applicants also put BMC to proof of any similarity between the goods and services and deny that there is a likelihood of confusion.

10. It is unnecessary for me to distinguish between the applicants and I will refer to them individually and collectively as “Baker Hughes”.

11. A hearing was held before me, by videoconference, on 7 December 2023. BMC was represented by Hastings Guise of Fieldfisher LLP; Baker Hughes was represented by Rachel Wilkinson-Duffy of Baker & McKenzie LLP.

### **RELEVANT DATES**

12. Paragraph 25(2) of Schedule 2A of the Act sets out the relevant date for establishing which right takes precedence in the case of an application filed under Article 59 of the Withdrawal Agreement. It reads:

“25.—(1) This paragraph applies where a person who has filed an existing EUTM application or a successor in title of that person applies for registration of the same trade mark under this Act for some or all of the same goods or services.

(2) Where an application for registration referred to in sub-paragraph (1) is made within a period beginning with IP completion day and ending with the end of the relevant period—

(a) the relevant date for the purposes of establishing which rights take precedence is the earliest of—

(i) the filing date accorded pursuant to Article 32 to the existing EUTM application;

(ii) the date of priority (if any) accorded pursuant to a right of priority claimed pursuant to Article 35 in respect of the existing EUTM application; and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom which commenced in the period between the date referred to in paragraph (a) and the date of the application under this Act.”

13. The EU trade mark upon which the '775 mark is based has a priority date of 4 October 2019. Under the above provisions, that is the relevant date for the purposes of assessing the relative rights of the parties in the opposition against the '775 mark.

14. The EU trade mark upon which the '777 mark it is based does not have a priority date. Accordingly, the relevant date for assessing the opposition against the '777 mark is the filing date of the EU trade mark, namely 1 October 2020.

### **PROOF OF USE**

15. As the earlier mark had not been registered for five years at the relevant dates in these proceedings, it is not subject to the use provisions at s. 6A. Consequently, BMC may rely upon all of the goods and services it has identified without showing that the trade mark has been put to use.

### **EVIDENCE**

16. Both parties filed evidence. For BMC, evidence is given by Hastings Guise, a solicitor and Partner at Fieldfisher LLP and BMC's professional representative. Mr Guise provides two witness statements, with exhibits, the second in response to Baker Hughes' evidence. Mr Guise's evidence is aimed at showing that companies provide both technical equipment and software, and that the parties operate in the same fields.

17. For Baker Hughes, Rachel Wilkinson-Duffy, a partner at Baker & McKenzie and Baker Hughes's professional representative, provides evidence going to Baker

Hughes' background. Ms Wilkinson-Duffy also exhibits a trade mark decision from proceedings in Mexico.

18. Also for Baker Hughes, Kerry Flora, a Production Coordinator at Temple Translations Ltd, provides an English translation of the Mexican trade mark decision filed by Ms Wilkinson-Duffy.

19. None of the witnesses was cross-examined. I have read all of the evidence and will refer to it as I consider appropriate in the course of this decision.

### **SECTION 5(2)(B)**

20. The relevant parts of s. 5 read as follows:

“5.— (2) A trade mark shall not be registered if because—

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

[...]

5A—

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

21. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323; *Marca Mode CV v*

*Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339; *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594; *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333; and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:<sup>1</sup>

(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

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<sup>1</sup> 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, s. 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. This is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

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.

### **Average consumer and the nature of the purchasing act**

22. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect: *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). 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 or services in question: *Lloyd Schuhfabrik Meyer*.

23. The parties were agreed that the relevant public will be professionals rather than the general public. Mr Guise submitted that the purchasing process is likely to be through a procurement process and that purchasers will display a reasonably high level of attention. Ms Wilkinson-Duffy accepted that procurement teams would be part of the relevant public but I did not understand her to accept that this will always be the case.

24. I agree that the average consumer of the goods and services at issue will be a professional. I also agree that the software and SaaS services will be purchased through procurement processes, though I do not consider that that will universally be the case. In smaller businesses, goods and services may be purchased by businesspeople without such a process; it is also possible that, for example, technical specialists or research scientists working in the field of oil and gas will identify the goods and services required, particularly if they are not for widespread application across the business, even if the purchase orders are drawn up by a finance/procurement department. The average consumer therefore includes technical specialists, businesspeople and procurement teams. The purchasing process, whether through a procurement team or otherwise, is likely to be dominated by visual considerations; even where there are recommendations or discussions about the goods and services which may play a part, this is unlikely to be the predominant means of selection. Rather, websites, brochures, written technical information and detailed bids will be reviewed prior to purchase. The level of attention will be at least reasonably high, given the specialised nature of the goods and services; in certain instances, such as where a business is purchasing software or SAAS for general application across the business, or where it concerns safety monitoring, the level of attention may be higher still.

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

25. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, the court stated at paragraph 23 of its judgment that:

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

26. Other factors, identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case) [1996] R.P.C. 281 are, so far as relevant to the

present oppositions, the users of the goods and services and the trade channels through which the goods and services reach the market.

27. Complementarity may be the sole basis for the existence of similarity between goods: *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2008:338, the General Court said that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

28. Words in specifications must be given their ordinary and natural meaning: *YouView Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12]. Where services are concerned, Jacob J. (as he then was) warned in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 against construing specifications for services too widely, saying:

“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.”

29. Lastly, where goods or services are encompassed by a wider term in the opposing specification, they may be regarded as identical: *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, EU:T:2006:247.

30. The goods and services to be compared are shown below:

<b>Earlier specification</b>	<b>Contested specifications (the specification for the '777 mark is underlined)</b>
Class 9: Computer software and computer application software for mobile devices, desktop devices, and web applications for use in the field of general business processes, namely, as a help desk solution allowing a user to identify and resolve problems associated with the user's computer network; computer software for	Class 9: Measurement and control apparatus for use in the oil and gas field; measuring, detecting and monitoring instruments for industrial applications; nondestructive testing equipment used in industrial applications; downloadable <u>computer software for use in data collection, transmission, integration,</u>

use in maintaining a database of problems and solutions identified on a user's computer network; computer software, namely, system management software focused on the provisioning, configuration, and change management of data center infrastructure; computer software and programs for managing computer systems, databases, and applications, namely providing data management, information technology process automation, application management, storage and performance optimization, and recovery of mainframe and distributed systems computers, and the databases, business applications, programs, and systems that operate therein; computer software for computer systems and computer network management, namely, software for computer network monitoring and computer system diagnostics; computer software and computer application software for mobile devices, desktop devices, and web applications, namely, software for managing, deploying, and removing software applications, maintaining software inventories, maintaining software license compliance, and managing application security on mobile devices, desktop devices, and cloud computing networks; computer software and computer application software for mobile devices, desktop devices, and web applications, namely software for use as a virtual concierge that provides awareness of and access to available services, content, and alerts; computer software and computer application software for mobile devices, desktop devices, and web applications that provides a virtual help desk and self-help computer and software support services; computer software and computer application software for mobile devices, desktop devices, and web applications that provides real-time, integrated service management of other computer software, information systems, computer hardware, computer networks, and information databases; computer software and computer application software for mobile devices, desktop devices, and web applications that provides real-time alerts and updates for end-to-end performance management; computer software and computer application software for mobile devices that provides access to applications and services through a mobile

visualization, analysis and storage in the field of oil and gas; downloadable computer software for use in connection with a network of physical objects, devices, vehicles, and buildings which are embedded with electronics, software, sensors and network connectivity all of which enable these objects, devices, vehicles, and buildings to collect and exchange and report data in the field of oil and gas; downloadable software for use in measuring and analyzing data retrieved from oil and gas wells; measurement and control equipment for oil and gas, aerospace, automotive, power and energy industries; electronic and telemetry instruments for use in the oil and gas industry; electronic and telemetry instruments for use in the oil and gas industry, namely, pulsers and pulse decoding technology, wired pipe technology, sensors, detectors, fluid analyzers, calibrators.

operating system and interface; computer software and computer application software for desktop devices that provides access to applications and services through a desktop operating system and interface; computer software and computer application software for web-based devices that provides access to applications and services through a web-based system and interface; computer software and computer application software for mobile devices, desktop devices, and web applications that provides synchronization of applications and content across platforms and devices; computer software and computer application software for mobile devices, desktop devices, and web applications that delivers user-specific information about usage, compliance, location, applications, devices, and location-aware services and resources; computer software and computer application software for mobile devices, desktop devices, and web applications that delivers location-aware service, updates, and notifications; computer software and computer application software for mobile devices, desktop devices, and web applications that provides appointment scheduling and appointment notifications; computer software and computer application software for mobile devices, desktop devices, and web applications, to manage a concierge service; computer software and computer application software for mobile devices, desktop devices, and web applications that provides secure access and storage of documents.

Class 42: Consulting services relating to research and design of computer hardware and computer software for others; technical consulting services, namely, troubleshooting of computer hardware and software problems via phone, email and in person; maintenance services for computer software; computer programming services for others in the field of general business processing; software as a service (SAAS) services featuring computer software for use in the field of general business processes, namely, as a help desk solution allowing a user to identify and resolve problems associated with the user's computer network and to maintain a database of identified problems and solutions; computer consulting services in

Class 42: Oil and gas completion and testing services; exploration and searching of oil and gas; providing industrial measurement and control services; technical assessment, evaluation and optimization for turbine, compressor, centrifugal pump use in oil and gas and industrial applications; software as a service [SAAS] services featuring software that combines autonomic computing and cognitive artificial intelligence engineering technology for use in the oil and gas industry; software as a service [SAAS] services featuring software for use in collecting, analyzing, and delivering data and information to optimize performance in the industrial process, equipment and production systems across the upstream, midstream and downstream segments of the

the field of system management software focused on the provisioning, configuration and change management of data center infrastructure; software as a service (SAAS) services featuring, computer software, namely system management software focused on the provisioning, configuration and change management of data center infrastructure; software as a service (SAAS) services featuring computer software and programs for managing computer systems, databases and applications, namely providing data management, information technology process automation, application management, storage and performance optimization and recovery of mainframe and distributed systems computers and the database and business applications, programs, and systems that operate therein; remote and on-site monitoring of computer systems; software as a service (SAAS) services featuring computer software for computer systems and computer network management, namely, software for computer network monitoring and computer system diagnostics; software as a service (SAAS) services featuring software for managing, deploying, and removing software applications, maintaining software inventories, maintaining software license compliance, and managing application security on mobile devices, desktop devices, and cloud computing networks; software as a service (SAAS) services featuring software for use as a virtual concierge that provides awareness of and access to available services, content, and alerts; software as a service (SAAS) services featuring software that provides a virtual help desk and self-help computer and software support services; software as a service (SAAS) services featuring software that provides real-time, integrated service management of other computer software, information systems, computer hardware, computer networks, and information databases; software as a service (SAAS) services featuring software that provides real-time alerts and updates for end-to-end performance management; software as a service (SAAS) services featuring software that provides access to applications and services through a mobile operating system and interface; software as a service (SAAS) services featuring

oil and gas industry; consulting services related to the design of turbines and compressors and related equipment in the oil, gas and industrial industries; measurement and inspection services in the oil and gas, aerospace, automotive, chemical, power and energy industries; consulting, design and commissioning and integration services for industrial control systems; well measurement and monitoring services in the oil and gas field; measurement and monitoring services of chemical and petrochemicals.

<p>software that provides access to applications and services through a desktop operating system and interface; software as a service (SAAS) services featuring software that provides access to applications and services through a web-based system and interface; software as a service (SAAS) services featuring software that provides synchronization of applications and content across platforms and devices; software as a service (SAAS) services featuring software that delivers user-specific information about usage, compliance, location, applications, devices, and location-aware services and resources; software as a service (SAAS) services featuring software that delivers location-aware service, updates, and notifications; software as a service (SAAS) services featuring software that provides appointment scheduling and appointment notifications; software as a service (SAAS) services featuring software that manages a concierge service; software as a service (SAAS) services featuring software that provides secure access and storage of documents.</p>	
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31. BMC has only identified a limited number of conflicts with any specificity. I will begin with those, inferring that BMC considers the earlier goods and services it has identified to be its best case. As for the rest, I will base my comparison on what I consider reasonably to be the closest goods/services. I will say that I have found it difficult to unpick the meaning of and to compare what are rather convoluted terms in these specifications, without any assistance from the parties. BMC’s submissions across the board are that the users, nature and trade channels are “satisfied” (by which I understand it to mean that they are the same or overlap). It says that the uses of the goods and services will overlap and that, even if the products are not necessarily substitutable, they “form part of the technology ecosystem in which a given oil or gas business chooses to operate”. Consequently, it asserts that they must be at least highly complementary.

32. Before launching into the comparison proper, I should also mention that BMC has provided evidence that the parties have some customers in common and of third

parties selling both technical apparatus and software.<sup>2</sup> There is also some evidence about Baker Hughes' activities, including its marketing and collaborations with other companies,<sup>3</sup> and about BMC's business.<sup>4</sup> In addition, there was some discussion at the hearing about the sectors in which the parties operate. However, none of this is particularly helpful for the comparison I must make. The evidence of common customers does not identify the goods/services which were purchased. That is problematic for BMC because such evidence does not demonstrate a meaningful overlap in goods/service provision or in users. A hospital will be a consumer of both radiology equipment and paperclips. That does not mean that the average consumer of radiology equipment is materially similar to the average consumer of paperclips, or that a paperclip business will normally provide radiology equipment, even though the providers of the respective goods will have a common customer. In addition, the evidence of businesses selling both technical equipment and software does not clearly concern the specific goods and services which I have to compare. Similarly, the fact that Baker Hughes has collaborated with software companies is of limited assistance because it does not go to the particular terms at issue and because the collaboration is described as "unique" (i.e., not typical). Lastly, regarding Baker Hughes' submission that the parties operate in discrete sectors, that is only relevant if such differences are apparent from the terms of the respective specifications.

## **Class 9**

(Downloadable) computer software for use in data collection, transmission, integration, visualization, analysis and storage in the field of oil and gas;  
(downloadable) software for use in measuring and analyzing data retrieved from oil and gas wells

33. In relation to the first of the above terms, there is a difference between the contested specifications, in that the '775 mark is for "downloadable" software and the '777 mark is simply for "software". However, as BMC has identified certain types of

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<sup>2</sup> Confidential exhibit HG4; exhibit HG1. See also Guise 2, §5.

<sup>3</sup> HG2-HG3; RWD1-RWD2.

<sup>4</sup> HG5-HG6.

“software” at large (downloadable software being a subset), my findings below apply equally to both specifications.

34. BMC relies upon “computer software and programs for managing computer systems, databases, and applications, namely providing data management, information technology process automation, application management, storage and performance optimization, and recovery of mainframe and distributed systems computers, and the databases, business applications, programs, and systems that operate therein”. The “data management” software/programs appear to be the closest to the contested goods. As I understand it, “data management” at large is the process of gathering, processing, storing and analysing data, often all of the data created by an organisation. However, the earlier mark’s coverage does not extend to data management software at large: the earlier goods are limited by their context, namely “computer software and programs for managing computer systems, databases, and applications, namely providing data management [...] of mainframe and distributed systems computers, and the databases, business applications, programs, and systems that operate therein”. In the context of the term as a whole, this seems to me to mean that the data management software in issue manages data as part of a computer system, for example to ensure that tasks are processed in the correct order or that data is consolidated where appropriate, to keep the whole system running smoothly. I do not think that it means database software with which a user could create a database and filter it to show trends or groupings (e.g., customer data grouped by location).

35. The contested goods are both types of software for managing data, broadly speaking. However, neither is, in my judgement, likely to be construed as meaning behind-the-scenes software which manages data as part of a computer system; they are likely to be taken as user-facing software for recording, sharing and analysing data. There is plainly some similarity of purpose but there are also clear differences. The nature of the software will, similarly, share some attributes but there will also be differences because of the end uses of the respective goods. Mr Guise submitted that it is unlikely that businesses would have separate procurement processes for different types of software and that both parties’ goods and services will be purchased by IT procurement teams; Ms Wilkinson-Duffy accepted that in some businesses,

procurement teams may procure both specialist and generalist IT. There is no evidence of how common either practice is but, for these goods, an overlap in users would not be surprising. It could be the case that specialists would select the goods but that is not necessarily the case.

36. Mr Guise also submitted that the channels of trade are “relatively consistent” because the goods may reach the average consumer through a procurement process. I do not agree. I do not consider that a procurement process is itself a channel of trade, any more than taking goods to a register is a channel of trade. The goods are not likely to be made available through the same market channels and are most likely to be sold directly by the manufacturer. Where the goods are purchased by procurement departments, they will be subject to separate procurement exercises. There does not appear to be any obvious reason why these goods would be competitive. I have no evidence to demonstrate whether data management software for computer systems etc. would be considered closely connected to the contested software but it seems to me unlikely that they would be considered to be produced by the same undertakings, given that one is for the internal management of computer systems and the other is a user-facing software. They are not complementary. There is a lower-than-average level of similarity.

(Downloadable) computer software for use in connection with a network of physical objects, devices, vehicles, and buildings which are embedded with electronics, software, sensors and network connectivity all of which enable these objects, devices, vehicles, and buildings to collect and exchange and report data in the field of oil and gas

37. For the same reasons as above, the slight difference between the contested specifications matters not.

38. As I read the above term, the contested software is for use with various physical objects which themselves have embedded sensors etc., which allow the physical objects to collect, exchange and report data. The purpose of the software, as opposed to that of the physical objects, is not entirely clear but it seems to me that it would be understood as connecting the physical objects and enabling the collection, exchange and reporting of the data those objects provide. In respect of the objects with which

the software is used, I acknowledge that “devices” may in some contexts mean hardware devices. However, the physical objects/devices in question are “embedded with electronics, software, sensors and network connectivity [...]” and can “collect and exchange and report data in the field of oil and gas”. The use of “and” suggests that the physical objects etc. contain all of these features and are capable of all the identified actions. I am not aware hardware devices would do so: even if, for example, a printer were to contain electronics, software, sensors and have network connectivity, it would not on a normal reading be capable of collecting or reporting data. In context, I think that the “devices” in the contested term would be understood as “instruments” rather than computer hardware.

39. BMC says that the contested goods are identical or highly similar to two terms in the earlier specification. The first is “computer software and computer application software for mobile devices, desktop devices, and web applications that provides real-time, integrated service management of other computer software, information systems, computer hardware, computer networks, and information databases”. “Integrated service management” suggests that the purpose of the software is for managing the named systems and assets, which would include, for example, IT incident management, management of software and systems and management of hardware (e.g., replacement programmes). The purpose of the earlier goods therefore differs from that of the contested software, the former being a tool for managing IT systems and assets, the latter being to connect and facilitate the gathering of data provided by specific physical objects. The mere fact that the respective goods are software does not, in my view, give rise to more than a superficial similarity in nature: software covers a very wide range of goods with vastly different applications whose only similarity is that they are made from code. I accept that there may be some overlap in users resulting from the purchase by procurement teams but I see no reason why there may not also be separate procurement teams for general business systems IT on the one hand and specialist software on the other, or why technical specialists, such as engineers, would not in fact be the users selecting technical software.

40. Although I agree that the goods may be selected by means of a procurement process, I do not think that this amounts to shared channels of trade, because the differences in the specific application of the goods means that they are likely to be

subject to totally separate procurement exercises. The channels through which the goods reach the market will be different. The goods are not in competition, nor are they complementary. If these goods have any degree of similarity, it is low.

41. The second term upon which BMC relies is “computer software and computer application software for mobile devices, desktop devices, and web applications that delivers user-specific information about usage, compliance, location, applications, devices, and location-aware services and resources”. The purpose of this software appears to be to provide specific information about a user of IT equipment and applications, such as browsing history and location, as well as providing to the user services and resources dependent on location, such as WiFi or GPS. The competing types of software appear to be capable of both taking and reporting information from connected apparatus and, conversely, sending information to that apparatus. The information may itself overlap (e.g., location). However, the contested software does not collect the data, the physical objects etc. do so. The objects themselves are different from those with which the earlier mark’s software is used. There is some overlap in nature and purpose. As with the goods considered above, the only intersection in users is likely to be where procurement teams purchase both specialist and generalist software; this does not amount to shared channels of trade. These goods are not complementary and they are not competitive. There is a lower-than-average degree of similarity.

Measurement and control apparatus for use in the oil and gas field; measuring, detecting and monitoring instruments for industrial applications; nondestructive testing equipment used in industrial applications; measurement and control equipment for oil and gas, aerospace, automotive, power and energy industries; electronic and telemetry instruments for use in the oil and gas industry; electronic and telemetry instruments for use in the oil and gas industry, namely, pulsers and pulse decoding technology, wired pipe technology, sensors, detectors, fluid analyzers, calibrators

42. BMC has made no specific submissions about these goods. All of the earlier goods are software, whilst the above are all types of apparatus and equipment. I can see nothing in the earlier goods or services which has any obvious points of similarity with the above goods. They are dissimilar.

## **Class 42**

Software as a service [SAAS] services featuring software that combines autonomic computing and cognitive artificial intelligence engineering technology for use in the oil and gas industry

43. The first term said by BMC to be identical or highly similar to the above services is “software as a service (SAAS) services featuring computer software and programs for managing computer systems, databases and applications, namely providing data management, information technology process automation, application management, storage and performance optimization and recovery of mainframe and distributed systems computers and the database and business applications, programs, and systems that operate therein”.

44. I have found above that the purpose of BMC’s services is to provide various types of software, including data management software, through which computer systems, databases and applications can be managed. Although data will be used and manipulated in the contested software services, all computing software could be said to be about data of some description and that is not sufficient, in my view, to establish a material similarity of purpose. The contested services provide engineering technology software which combines artificial intelligence and autonomic computing. I do not think that such software would, on a normal reading, be construed as being data management software. On the contrary, it appears to be sophisticated software with certain self-managing characteristics for designing engineering solutions. In my view, the purpose of the competing services is different. There may be a high-level overlap in nature but I see no reason why there would be competition. Users are only likely to coincide in businesses with a single procurement team for all IT services; otherwise, they will differ. Channels of trade are likely to be distinct. I have no evidence to show that these services are closely connected and it is not obvious to me that they would be used together or that they would be sufficiently allied to give rise to complementarity. In any event, the consumer is not likely to assume that the services are provided by the same entities. There is a low degree of similarity.

45. I recognise that the earlier specification includes SaaS relating to “information technology process automation”. However, as I read this term, it relates to the

automation of computer processes (e.g., which query is resolved first) or potentially to automation of the process for users, such as the replacement of staffed IT helpdesks with a series of automatically generated questions to direct a call. I do not think that this means the purpose is the same or similar to the contested services. I can see no other basis on which this part of the specification would improve BMC's position.

46. I do not think that BMC's position is any stronger in relation to the other term identified, namely "software as a service (SAAS) services featuring software that provides real-time, integrated service management of other computer software, information systems, computer hardware, computer networks, and information databases". As I have already held, this software is for managing a business's IT systems and assets; the SaaS provision has the same purpose but through different means. This purpose is different from that of the contested services. For the reasons given above, any overlap in nature is limited. Users are only likely to coincide where there is a single procurement team. There are no other points of similarity. These services are not similar. If that is not right, there is a low degree of similarity.

Software as a service [SAAS] services featuring software for use in collecting, analyzing, and delivering data and information to optimize performance in the industrial process, equipment and production systems across the upstream, midstream and downstream segments of the oil and gas industry

47. I will start with the earlier mark's "software as a service (SAAS) services featuring computer software and programs for managing computer systems, databases and applications, namely providing data management, information technology process automation, application management, storage and performance optimization and recovery of mainframe and distributed systems computers and the database and business applications, programs, and systems that operate therein". As I have held, the "data management" software covers the data management of various computer systems and the applications/systems which they contain. The contested services doubtless involve data collection etc., which can broadly be described as data management, but in relation to "the industrial process, equipment and production systems", not in relation to computer systems etc. Whilst both sets of services will provide data management at some level, there are also significant differences in purpose and, given the different aims of the services, there are likely to be differences

in nature. There may be an overlap in users. The channels of trade will be discrete and there is no competition. It is not clear to me that the respective services would be important or essential for one another's use. The services are similar to a lower-than-average degree.

48. I do not think that "software as a service (SAAS) services featuring software that provides real-time, integrated service management of other computer software, information systems, computer hardware, computer networks, and information databases", represents a stronger case for BMC. Integrated service management SaaS for the named systems would extend to improving the performance of those systems, in all probability following the collection and processing of information (data). However, any similarity of purpose ends there. The systems and equipment subject to the optimisation/improvement software services are entirely different; doubtless computers and related goods will be used in industry, including the oil and gas fields, but the contested software services are aimed at improving the end industrial processes, equipment and production systems, not at improving the software or computer systems which control such processes etc. Although both specifications concern software services, there is only a superficial overlap in nature because the different end results will affect the nature of the software services themselves. As with most of the above goods and services, there is some potential for overlap in users but it will not always, or even usually, be the case that the users coincide. For the same reasons as above, the overlap in users due to selection by procurement does not equate to shared channels of trade. I can see no basis on which these services would be in competition or complementary. If there is any similarity at all, it is at a low level.

Oil and gas completion and testing services; exploration and searching of oil and gas; providing industrial measurement and control services; technical assessment, evaluation and optimization for turbine, compressor, centrifugal pump use in oil and gas and industrial applications; measurement and inspection services in the oil and gas, aerospace, automotive, chemical, power and energy industries; well measurement and monitoring services in the oil and gas field; measurement and monitoring services of chemical and petrochemicals

49. I understand "completion" to mean the process of readying a well for production. BMC has not identified any goods or services which are said to be identical or similar

to the above. I can see none. The only potential point of similarity is that the goods may be selected by the same users but that is insufficient for there to be similarity overall. There is no similarity between these services and any of the earlier goods or services.

Consulting services related to the design of turbines and compressors and related equipment in the oil, gas and industrial industries

50. There are no specific submissions about these services. The earlier mark includes “consulting services relating to research and design of computer hardware and computer software for others”. Consulting services are intended to provide advice. There is therefore similarity of purpose at a high level of generality. However, the specific intended purpose of consulting services can be dramatically different and the expertise of the consultants will also vary accordingly. I consider that to be the case here: the contested services relate to equipment for heavy industry, whilst the former are IT services. I do not think the fact that both are consulting services makes them similar, nor does the fact that both may be purchased by procurement teams. I can see no other basis for similarity. These services are not similar.

Consulting, design and commissioning and integration services for industrial control systems

51. The closest term in the earlier specification again appears to be “consulting services relating to research and design of computer hardware and computer software for others”. “Industrial control systems” incorporate electronic controls, instruments and physical equipment to control the industrial process. This will include software and hardware to monitor and regulate the process. Neither service is completely encompassed by the other but there is a clear overlap in both nature and purpose. Users may be the same and channels of trade may intersect. The services are not in competition but there is complementarity, since advice about hardware and software is an important part of the contested services and the consumer may consider the services to be provided by the same undertaking. They are similar to an above average degree.

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

52. In *Lloyd Schuhfabrik Meyer*, 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).”




53. The mark is not a very basic geometric shape but nor is it particularly intricate. Its inherent distinctive character is lower than average. Although there is some evidence of BMC’s activities, Mr Guise did not submit before me that the earlier mark has enhanced distinctiveness through use. The evidence is either not dated or dated after the relevant dates and/or does not clearly concern the UK. There is also nothing going to the level of sales of particular goods or services under the mark. If I needed to decide the point, I would find that the evidence is insufficient to establish that there is enhanced distinctive character.

## Comparison of trade marks

54. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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.”

55. The trade marks to be compared are:

Earlier trade mark	Contested trade marks
	 <p data-bbox="1168 1467 1385 1505">(the '775 mark)</p>  <p data-bbox="1157 1803 1375 1841">(the '777 mark)</p>

56. BMC's position is that the marks are abstract logos with no verbal elements and that there can be no aural or conceptual comparison. Mr Guise submitted that the

shape of the marks is closely similar and that the main distinguishing elements are colour and the way the shapes are presented. Baker Hughes's position is that its mark originates from a Möbius strip. Ms Wilkinson-Duffy submitted that the contested marks have soft, curved angles and contrasts, while the earlier mark is a simple one-dimensional geometric shape with sharp angles; colour is relied upon as an important distinguishing feature.

57. All of the competing marks are devices with no other elements. Their overall impression is contained in those devices.

58. The earlier mark consists of two parallel lines, bent in the middle at approximately a right angle. Their highest point is at the top left of the mark; they run downwards to the right in a diagonal line, then curve back and down in a diagonal line to the left. The outer edge of the bend is curved and the ends of the lines are joined by a straight line, vertical in the presentation, with rounded outer corners. The device is orange. I agree with Ms Wilkinson-Duffy that a significant proportion of average consumers will see this device as two-dimensional, a little like a stylised "W" rotated through ninety degrees. However, I also consider that a significant proportion of consumers will perceive it as more three-dimensional in character, rather like a representation of a paper clip which has been opened out and laid on its side. I will focus on the latter group of average consumer, for whom the marks will be more similar.

59. The '775 mark also consists of two parallel lines, bent in the middle and joined at the ends. Like the earlier mark, they run from top left, downwards to the right and then double back, angling downwards to the left. The angle of the bend is approximately 45°. The outer edge of the bend is curved and the lines which join the longer lengths are rounded. The uppermost line of the device is presented in a medium green colour and the lower line is a darker green. At the curved ends of the lines, where upper and lower meet, both green colours are shown next to one another, tapering, which suggests a twist.

60. I do not agree with Baker Hughes that the marks are entirely dissimilar. Both consist of two parallel lines, bent in the centre and joined at the ends, which run diagonally down to the right, then the left. The left-hand side of the marks, which in both cases is where the upper and lower lines are joined, is wider than the right-hand

side, where the lines bend. However, there are differences between the marks. The '775 mark is more compact than the earlier mark: the bend in the parallel lines is more acute and the lines themselves are also closer together, with less white space between them, though I do not think that the average consumer would notice or retain these individual features. The parallel lines in the '775 mark are also at a shallower diagonal angle than those of the earlier mark. I accept that for those who see both marks as 3D representations, the marks could be perceived from the same perspective (i.e., the lines running down from left to right could be perceived as further away from, and those from right to left as closer to, the viewer). However, whilst I do not think that many people would recognise the '775 mark as being based on a Möbius strip, I do think that the shading at the joined ends would be noticed and taken as indicating a rotation, which is absent from the earlier mark. Where a mark is registered in colour, the proper comparison is between the marks as represented on the register. Here, there is an obvious difference in colour: first, orange and green are very different colours; second, the earlier mark is composed of a solid colour and the '775 mark has two shades. Overall, there is a lower-than-average degree of visual similarity between the marks.

61. The parties accept that an aural comparison is not possible. I agree. The aural position is neutral.

62. Baker Hughes does not accept that the marks have no conceptual meaning. Ms Wilkinson-Duffy submitted that the colours of the respective marks suggest certain characteristics (e.g., green is refreshing). There is, however, no reason to believe—and no evidence to show—either that the average consumer would characterise the colours in issue in any particular way, or that, if they did, this would translate to a concrete conceptual meaning. I have already indicated that I do not think many people would recognise the '775 mark as a Möbius strip. The rounded edges in the trade mark evoke something round in cross-section, not a flat strip. Combined with a fold in the middle which makes it more difficult to follow the track of each line and shading which is noticeable but not dominant, I do not think that the average consumer would immediately perceive the mark as a Möbius strip, even if they have scientific or technical expertise. I do not rule it out completely but, for the vast majority of

consumers, neither mark conveys a concept. Therefore, the conceptual position is also neutral.

63. Turning to the '777 mark, this mark is a black-and-white version of the '775 mark. The lines described above have a fairly thick black outline around a white centre. Where the '775 mark shows the two green colours juxtaposed and tapering (indicating a rotation), the '777 mark has a black line, the same width as the outline. This tapers at the same point, also indicating a twist. In my view, the same points of similarity and difference apply in relation to the overall shape and configuration as in the comparison above. As regards the colour of the marks, the Court of Appeal has stated on two occasions since the CJEU's judgment in *Specsavers International Healthcare Limited & Ors v Asda Stores Limited*, case C-252/12, EU:C:2013:497, that registration of a trade mark in black and white covers use of the mark in colour: see *Specsavers International Healthcare Ltd & Ors v Asda Stores Ltd* [2014] EWCA Civ 1294 at [5] and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290 at [47]. This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter). The earlier mark is orange and the '777 mark is in black-and-white outline but could be used in orange. However, such notional fair use would not extend to the colouring of the contested mark in solid orange so, while colour per se is not a relevant point of difference, the fact that one shape is solid and the other is in outline is. There is also a lower-than-average level of visual similarity for this mark. For largely the same reasons as above, the aural and conceptual positions are neutral.

### **Likelihood of confusion**

64. Whether there is a likelihood of confusion is a global assessment, which must take into account all of the factors considered above. The likelihood of confusion must be determined from the perspective of the average consumer, who will rely on their imperfect recollection of the trade marks. The competing factors must be balanced against one another, meaning, for example, that a greater degree of similarity between the trade marks may be offset by less similarity between the goods and services, or vice versa.

65. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Iain Purvis QC (now KC), again 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).”

66. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

67. For an opposition based on s. 5(2)(b) to succeed, there must be some similarity between the respective goods and services.<sup>5</sup> Accordingly, I dismiss the opposition against the '775 mark for the goods and services I have found to be dissimilar.

68. BMC's principal case on confusion was put on the basis of indirect confusion. None of the specific examples identified by Mr Purvis was relied upon but it is well established that those categories of indirect confusion are not exhaustive.<sup>6</sup> Mr Guise submitted that indirect confusion would occur because businesses refresh logos and it is entirely foreseeable that the average consumer would either assume that the corporate colour has changed or will assume that the mark is used by a different part of the business or as a collaboration. I accept, of course, that businesses will update their logos. However, while there is some similarity between the trade marks, the differences go beyond a difference in colour. The level of visual similarity between the competing trade marks overall is lower than average. Although there is no conceptual connection between the marks, there is also no conceptual hook to assist the average consumer in distinguishing the marks. It is relevant that the average consumer will choose the goods and services with a reasonably high degree of care (at least) and that the earlier mark is distinctive to a lower-than-average degree. Taking all of the competing factors into account, I find that the differences between the competing marks are sufficient to avoid the average consumer believing that the trade marks are variants used by the same or connected undertakings, even for goods and services

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<sup>5</sup> *Waterford Wedgwood plc v OHIM*, C-398/07 P, EU:C:2009:288 at [34].

<sup>6</sup> See *Liverpool Gin* at [12].

similar to an above average degree. BMC's submission that the marks would be seen as the result of a collaboration takes the matter no further, in my view. There is no obvious reason why a collaboration would involve the alteration of a logo; collaborations more typically involve co-branding. It is also very unlikely that the average consumer would attempt to identify one or more logos in a given figurative trade mark and I do not think that the contested trade mark would do more than bring the earlier mark to mind. That is not the same as causing confusion.<sup>7</sup> My finding of no likelihood of confusion applies even where there is an above average degree of similarity between the services; where there is less similarity, it is even less likely that the average consumer would be confused. It follows that I would have found that there is no likelihood of confusion for those goods and services which I have found to be dissimilar, even if they were similar to an above average degree.

69. Direct confusion was not pressed but nor was it dropped entirely. It was submitted that a colour-blind average consumer may mistake the marks for one another. There is no evidence to show the frequency of colour blindness in the UK general population or to persuade me that colour-blind businesspeople or technical specialists are a relevant class of average consumer of the goods and services at issue. BMC's reliance on and submissions regarding indirect confusion appear to suggest that it accepts that the average consumer will appreciate the differences between the marks. This appears to be an acceptance that (other than for the colour blind), the average consumer will not simply mistake the marks for one another and, by extension, that there is no direct confusion. Absent any other basis for finding that there is direct confusion, I dismiss this claim. For the sake of completeness, on balance, I would have found no likelihood of direct confusion. Despite the similarities between the marks, there are sufficient differences, even for services similar to an above average degree, bearing in mind that the average consumer is attentive to a reasonably high degree, that the marks will not simply be mistaken for one another.

70. For essentially the same reasons, I also find that there is no likelihood of confusion in respect of the '777 mark. The level of similarity between the trade marks, considered against the similarity between the goods and services and the distinctive character of the earlier mark, is not sufficient to cause the average consumer paying a reasonably

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<sup>7</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

high degree of attention to think that the goods and services are provided by the same or connected undertakings or that either mark is a variant of the other.

71. There is no likelihood of confusion, direct or indirect, in respect of either the '775 mark or the '777 mark.

**Conclusion**

72. The oppositions are dismissed and the applications will proceed to registration.

**Costs**

73. Baker Hughes has been successful and is entitled to an award of costs, sought on the scale (TPN 2/2016 refers). I award costs to Baker Hughes, calculated as follows:

Considering the notices of opposition and filing the counterstatements:	£700
Preparing evidence and considering BMC's evidence:	£1,000
Preparation for and attendance at hearing:	£800
<b>Total:</b>	<b>£2,500</b>

74. I order BMC Software, Inc. to pay Baker Hughes, a GE Company, LLC and Baker Hughes Holdings, LLC, jointly and severally, the sum of £2,500. 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 13<sup>th</sup> day of November 2024**

**Heather Harrison**

**For the Registrar**

## **ANNEXE 1**

### **THE CONTESTED GOODS AND SERVICES**

#### **UK trade mark number 3701775**

Class 9: Measurement and control apparatus for use in the oil and gas field; measuring, detecting and monitoring instruments for industrial applications; nondestructive testing equipment used in industrial applications; downloadable computer software for use in data collection, transmission, integration, visualization, analysis and storage in the field of oil and gas; downloadable computer software for use in connection with a network of physical objects, devices, vehicles, and buildings which are embedded with electronics, software, sensors and network connectivity all of which enable these objects, devices, vehicles, and buildings to collect and exchange and report data in the field of oil and gas; downloadable software for use in measuring and analyzing data retrieved from oil and gas wells; measurement and control equipment for oil and gas, aerospace, automotive, power and energy industries; electronic and telemetry instruments for use in the oil and gas industry; electronic and telemetry instruments for use in the oil and gas industry, namely, pulsers and pulse decoding technology, wired pipe technology, sensors, detectors, fluid analyzers, calibrators.

Class 42: Oil and gas completion and testing services; exploration and searching of oil and gas; providing industrial measurement and control services; technical assessment, evaluation and optimization for turbine, compressor, centrifugal pump use in oil and gas and industrial applications; software as a service [SAAS] services featuring software that combines autonomic computing and cognitive artificial intelligence engineering technology for use in the oil and gas industry; software as a service [SAAS] services featuring software for use in collecting, analyzing, and delivering data and information to optimize performance in the industrial process, equipment and production systems across the upstream, midstream and downstream segments of the oil and gas industry; consulting services related to the design of turbines and compressors and related equipment in the oil, gas and industrial industries; measurement and inspection services in the oil and gas, aerospace, automotive, chemical, power and energy industries; consulting, design and

commissioning and integration services for industrial control systems; well measurement and monitoring services in the oil and gas field; measurement and monitoring services of chemical and petrochemicals.

**UK trade mark number 3701777**

Class 9: Computer software for use in data collection, transmission, integration, visualization, analysis and storage in the field of oil and gas; computer software for use in connection with a network of physical objects, devices, vehicles, and buildings which are embedded with electronics, software, sensors and network connectivity all of which enable these objects, devices, vehicles, and buildings to collect and exchange and report data in the field of oil and gas.

Class 42: Software as a service (SAAS) services featuring software that combines autonomic computing and cognitive artificial intelligence engineering technology for use in the oil and gas industry; software as a service (SAAS) services featuring software for use in collecting, analyzing, and delivering data and information to optimize performance in the industrial process, equipment and production systems across the upstream, midstream and downstream segments of the oil and gas industry.

## **ANNEXE 2**

### **THE EARLIER MARK**

#### **UK trade mark number 801258896**

Class 9: Computer software and computer application software for mobile devices, desktop devices, and web applications for use in the field of general business processes, namely, as a help desk solution allowing a user to identify and resolve problems associated with the user's computer network; computer software for use in maintaining a database of problems and solutions identified on a user's computer network; computer software, namely, system management software focused on the provisioning, configuration, and change management of data center infrastructure; computer software and programs for managing computer systems, databases, and applications, namely providing data management, information technology process automation, application management, storage and performance optimization, and recovery of mainframe and distributed systems computers, and the databases, business applications, programs, and systems that operate therein; computer software for computer systems and computer network management, namely, software for computer network monitoring and computer system diagnostics; computer software and computer application software for mobile devices, desktop devices, and web applications, namely, software for managing, deploying, and removing software applications, maintaining software inventories, maintaining software license compliance, and managing application security on mobile devices, desktop devices, and cloud computing networks; computer software and computer application software for mobile devices, desktop devices, and web applications, namely software for use as a virtual concierge that provides awareness of and access to available services, content, and alerts; computer software and computer application software for mobile devices, desktop devices, and web applications that provides a virtual help desk and self-help computer and software support services; computer software and computer application software for mobile devices, desktop devices, and web applications that provides real-time, integrated service management of other computer software, information systems, computer hardware, computer networks, and information databases; computer software and computer application software for mobile devices, desktop devices, and web applications that provides real-time alerts and updates for

end-to-end performance management; computer software and computer application software for mobile devices that provides access to applications and services through a mobile operating system and interface; computer software and computer application software for desktop devices that provides access to applications and services through a desktop operating system and interface; computer software and computer application software for web-based devices that provides access to applications and services through a web-based system and interface; computer software and computer application software for mobile devices, desktop devices, and web applications that provides synchronization of applications and content across platforms and devices; computer software and computer application software for mobile devices, desktop devices, and web applications that delivers user-specific information about usage, compliance, location, applications, devices, and location-aware services and resources; computer software and computer application software for mobile devices, desktop devices, and web applications that delivers location-aware service, updates, and notifications; computer software and computer application software for mobile devices, desktop devices, and web applications that provides appointment scheduling and appointment notifications; computer software and computer application software for mobile devices, desktop devices, and web applications, to manage a concierge service; computer software and computer application software for mobile devices, desktop devices, and web applications that provides secure access and storage of documents.

Class 42: Consulting services relating to research and design of computer hardware and computer software for others; technical consulting services, namely, troubleshooting of computer hardware and software problems via phone, email and in person; maintenance services for computer software; computer programming services for others in the field of general business processing; software as a service (SAAS) services featuring computer software for use in the field of general business processes, namely, as a help desk solution allowing a user to identify and resolve problems associated with the user's computer network and to maintain a database of identified problems and solutions; computer consulting services in the field of system management software focused on the provisioning, configuration and change management of data center infrastructure; software as a service (SAAS) services featuring, computer software, namely system management software focused on the

provisioning, configuration and change management of data center infrastructure; software as a service (SAAS) services featuring computer software and programs for managing computer systems, databases and applications, namely providing data management, information technology process automation, application management, storage and performance optimization and recovery of mainframe and distributed systems computers and the database and business applications, programs, and systems that operate therein; remote and on-site monitoring of computer systems; software as a service (SAAS) services featuring computer software for computer systems and computer network management, namely, software for computer network monitoring and computer system diagnostics; software as a service (SAAS) services featuring software for managing, deploying, and removing software applications, maintaining software inventories, maintaining software license compliance, and managing application security on mobile devices, desktop devices, and cloud computing networks; software as a service (SAAS) services featuring software for use as a virtual concierge that provides awareness of and access to available services, content, and alerts; software as a service (SAAS) services featuring software that provides a virtual help desk and self-help computer and software support services; software as a service (SAAS) services featuring software that provides real-time, integrated service management of other computer software, information systems, computer hardware, computer networks, and information databases; software as a service (SAAS) services featuring software that provides real-time alerts and updates for end-to-end performance management; software as a service (SAAS) services featuring software that provides access to applications and services through a mobile operating system and interface; software as a service (SAAS) services featuring software that provides access to applications and services through a desktop operating system and interface; software as a service (SAAS) services featuring software that provides access to applications and services through a web-based system and interface; software as a service (SAAS) services featuring software that provides synchronization of applications and content across platforms and devices; software as a service (SAAS) services featuring software that delivers user-specific information about usage, compliance, location, applications, devices, and location-aware services and resources; software as a service (SAAS) services featuring software that delivers location-aware service, updates, and notifications; software as a service (SAAS) services featuring software that provides appointment scheduling

and appointment notifications; software as a service (SAAS) services featuring software that manages a concierge service; software as a service (SAAS) services featuring software that provides secure access and storage of documents.