

BL O/1103/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3896758

BY DOOSIS LTD

TO REGISTER THE FOLLOWING TRADE MARK:

Doosis

IN CLASSES 9 AND 42

-AND-

THE OPPOSITION THERETO UNDER No. 442080

BY DECSIS - SISTEMAS DE INFORMACAO S.A.

Background and pleadings

1. On 4 April 2023, Doosis Ltd (“the Applicant”) applied to register the trade mark ‘Doosis’ in the UK. It was accepted and published in the Trade Marks Journal on 21 April 2023. Registration is sought for a variety of goods and services in Classes 9 and 42. A full list of the applied-for specification is included at Annex 1 to this decision.

2. On 21 July 2023, Decsis - Sistemas de Informacao S.A. (“the Opponent”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ The opposition is directed at all the applied-for goods and services.

3. The Opponent relies on its UK comparable trade mark (EU),² for the word mark ‘DECSIS’, trade mark registration number 912879151, which was filed on 14 May 2014 and became registered on 21 October 2014. For the purposes of the opposition, the Opponent relies on all the services for which its mark is registered. These are as follows:

Class 42:

IT services; Science and technology services.

4. By virtue of its earlier filing date, the trade mark upon which the Opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As it had been registered for more than five years at the filing date of the contested application, it is subject to the use conditions pursuant to section 6A of the Act, and as it is a comparable trade mark (EU) it is additionally subject to the provisions set out in Schedule 2A, Part 1, paragraph 7 of the Act. Accordingly, the Opponent made a statement that it has used its mark in relation to all the services for which its mark is registered.

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.

² Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

5. The Opponent claims that the contested mark is similar to its earlier mark and that the applied-for goods and services are similar or identical to the services for which the earlier mark is registered, giving rise to a likelihood of confusion.

6. Conceptually the Opponent submits that the marks are similar, submitting the following reasoning:³

“In the Opponent’s mark, DEC stands for Digital Equipment Corporation, the name of the company who created the very first “operating system” back in the 1960s. All modern operating systems are a descendant of the original DEC operating system and to this day, a computer operating system is still referred to as a “DEC”. [...] In the later TM Application, it can be easily surmised that the DOS element stands for Disk Operating Systems, an operating system used on a computer system with one or more disk drives. [...] The three letter combination S I S is an acronym that stands for Software Installation Script, a standard software installation package format, and it is a widely recognised acronym in the field of computing and software installation. SIS files are an archive, containing installation instructions, the application file (usually an .APP or .EXE file), and its dependencies. [...] In the context of the products and services in contention - class 9 and 42 - the conceptual meaning of DECSIS and DOOSIS is the same:

- Disk Operating System Software Installation Script for the Applicant’s mark and
- Digital Equipment Corporation Software Installation Script in the opponent’s mark.”

7. The Applicant filed a defence and counterstatement denying the claims made and submitted that “*the element SIS is a commonly used term in the field of software and IT*”.⁴ The Applicant requested that the Opponent prove use of the earlier mark in relation to all the goods and services for which the earlier mark is registered.

³ See the Form TM7. I note that these submissions contained internet links which I have omitted. This is because the tribunal does not access web links, and I cannot take the contents of those links into consideration (See the ‘Manual of trade marks practice – Tribunal section’ – paragraph 4.8.4.

⁴ See the Applicant’s Form TM8.

8. Both parties filed evidence. Neither party requested a hearing and only the Opponent filed written submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers before me.

9. The Opponent is represented by Adamson Jones and the Applicant is represented by Tidman Legal Limited.

EVIDENCE FILED

Opponent's evidence

10. The Opponent's evidence is provided in the witness statement of Manuel Alberto Sequeira da Silva, filed on 8 February 2024. Mr Sequeira da Silva is the Opponent's CEO, a position he has held since the company was founded. The purpose of his witness statement is to provide proof of use evidence of the earlier mark. His witness statement is accompanied by four exhibits labelled MASdS Annex 1 to MASdS Annex 4, which he states contain the following information:

- MASdS Annex 1 – “*screen shots of the Decsis website referring to [ISO Certifications]*”
- MASdS Annex 2 – “*a number of invoices/purchase orders*”
- MASdS Annex 3 – “*screen shots of the website [<https://en.decsis.eu/>] active between 2017-2023, obtained from the archiving website: ‘The wayback machine’*”
- MASdS Annex 4 – details of “*research, development and sponsorship*”

11. I have summarised the Opponent's evidence in the ‘proof of use’ section of my decision.

Applicant's evidence

12. The Applicant's evidence is provided in the witness statement of Paul Lapock, dated 26 April 2024. Mr Lapock is a director and shareholder of the Applicant, his witness statement is accompanied by four exhibits labelled PL1 to PL4, which he states contain the following information:

- PL1 – domain name registration details for ‘doosis.com’ (registered in 2013) and ‘doosis.co.uk’ (registered in 2021); and company incorporation documents for the Applicant (dated November 2021).
- PL2 – images taken from the Applicant’s website *“showing the mark used in relation to IT consultancy and software development services from as far back as 2013”*.⁵
- PL3 – *“a number of examples of organisations using the term SIS as part of their branding in the UK without apparent confusion”*.⁶
- PL4 – an article from Ibisworld.com to support his statement that the *“custom software development market [...] is valued at over £40 billion.”*⁷

13. A considerable proportion of Mr Lapock’s witness statement contains legal argument including submissions on the comparison of the respective goods and services and the respective marks. For instance:

- (1) with regard to the Opponent’s submissions on the conceptual comparison of the marks, Mr Lapock submits:

“The DOO element has no relation to DOS (Disk Operating Systems). I believe the DEC element of the Opponent’s mark refers to Digital Equipment Corporation Software Installation Script, whereas the DOO element in my Company’s Mark refers to “Do This” or “Do Systems”. As far as the common ending SIS is concerned, this element is an IT term commonly used by a number of organisations as part of their branding in the UK without apparent confusion. I exhibit at PL3 a number of examples of organisations using the term SIS as part of their branding in the UK without apparent confusion.”

- (i) I note that Exhibit PL3 includes use of ‘SIS’ as an acronym for the UK’s MI6 ‘Secret Intelligence Service’.

⁵ Paragraph 4 of Mr Lapock’s witness statement.

⁶ Paragraph 5 of Mr Lapock’s witness statement.

⁷ Paragraph 7 of Mr Lapock’s witness statement.

- (ii) One article included in Exhibit PL3 refers to ‘SIS’ in the context of ‘SIS application programming’ and ‘SIS programmable devices’,⁸ which suggest a software-related use. However, it does not clarify what ‘SIS’ stands for and, in any event, it is not used in a trade mark context.
- (iii) I am unable to agree with Mr Lapock’s determination based on this evidence, as it does not allow me to conclude with any certainty that ‘SIS’ is commonly used in the branding of IT organisations. Exhibit PL3 therefore does not support the point Mr Lapock is making.
- (2) Mr Lapock submits that he “*cannot see any actual evidence from the Opponent of confusion between my Company's mark and the Opponent's mark DECSIS*”. On this point, it must be noted that an absence of evidence of actual confusion will rarely influence the outcome of a case under section 5(2) of the Act – see Tribunal Practice Notice (TPN) 4/2009 with regard to ‘reliance on the absence of confusion in the marketplace’.
- (3) Mr Lapock also refers to use of the Applicant’s mark since 2013, implying an allegation of earlier rights, and provides Exhibits PL1 and PL2 to support his claim that use was established in 2013. However, such an allegation does not constitute a valid defence to an opposition under section 5(2)(b) of the Act. See: TPN 4/2009 regarding ‘defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark’; part 4.5 of the Registry’s Manual; and the related decision of Ms Anna Carboni, sitting as the Appointed Person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09.

DECISION

PROOF OF USE

14. In opposition proceedings, the registrar shall not refuse to register a trade mark by

⁸ Exhibit PL3, pages 32-33.

reason of an earlier trade mark registered for 5 or more years, unless the earlier trade mark has been put to genuine use.

Proof of use legislation

15. The relevant statutory provisions are as follows:

Section 6A

- (1) This section applies where—
 - (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
- (1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
 - (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
 - (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[...]

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

Schedule 2A, Part 1, paragraph 7

- (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.
- (2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—
 - (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
 - (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
- (3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—
 - (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
 - (b) the references in section 6A to the United Kingdom include the European Union.

Section 100⁹

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

Proof of use case law

16. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*¹⁰ as follows (my emphasis):

⁹ Section 100 of the Act makes it clear that the trade mark proprietor bears the burden of proving genuine use of its trade mark. In this regard see *Ferrari SpA v DU*, C-721/18, at paragraphs 73 to 83.

¹⁰ [2023] EWCA Civ 1247.

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

“106. [...] the principles may be summarised as follows:

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

107. [...] The General Court of the European Union has repeatedly held that **genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned**: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, **it should be provided with clear, precise, detailed and well-supported evidence** as to the nature of that use during the period in question from a person properly qualified to know. ...

22. ... **it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid.** That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. **A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive.** By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

17. I note that in *Awareness Ltd*, the Appointed Person goes on to say that (my emphasis):

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. **The evidence should make it clear, with precision, what specific use there has been** and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. **Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered [...].”**

18. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*.¹¹ He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.”

19. The genuine use provision is not there to assess economic success or large-scale commercial use.¹² An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹³

¹¹ Case BL O/424/14.

¹² *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

¹³ *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

20. As regards the territorial scope of the use of an EUTM, in *Walton International*,¹⁴ Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight principles he subsequently set out in *easyGroup Ltd*),¹⁵ added the further three principles when assessing genuine use in the EU:

“118. *The law with respect to genuine use in the Union.* Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark “in the Union”. In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50].”

21. Therefore, the Opponent can rely on its earlier trade mark only to the extent that the evidence filed establishes that the earlier trade mark had been put to genuine use in respect of the services for which it is registered, within the five years leading up to the date on which the contested trade mark application was filed. **The relevant period**

¹⁴ *Walton International Ltd & Anor v Verweij Fashion BV*, [2018] EWHC 1608 (Ch), (which is also a decision by Arnold LJ, or Arnold J as he then was, that predates his decision in *easyGroup Ltd*).

¹⁵ *Ibid.*, paragraphs 114 and 115.

in which the Opponent must establish use of the earlier mark is therefore 5 April 2018 to 4 April 2023.

22. As the earlier mark is a comparable mark (EU), use in the EU remains relevant since a part of the relevant five-year period falls prior to IP Completion Day (i.e. before 31 December 2020). Therefore the Opponent can rely upon use of the corresponding EUTM in the EU, including the UK, prior to IP Completion Day. However, any use after IP Completion Day (i.e. 1 January 2021) must relate solely to use in the UK.

Opponent's Evidence

23. I note the following from the Opponent's evidence:

- (1) Mr Sequeira da Silva's narrative evidence states that the Opponent began its activities on 1 July 1994 by entering into a Service Agreement with a manufacturer called **Digital Equipment Corporation ('DEC')** to provide Information and Communication Technologies ('ICT') Support and Maintenance services to this manufacturer; and that since then the Opponent has grown and diversified its offer in ICT services.
- (2) The Opponent's website shows the following list of companies / brands:¹⁶



- (3) According to Mr Sequeira da Silva's narrative evidence, "*the services provided under the DECSIS mark are*" as follows (which I take to be separate and distinct from the other marks in the "Companies – Brands" above):¹⁷

¹⁶ MASdS Annex 1.

¹⁷ Paragraph 5 of his Witness Statement.

- **Managed Services** - The Customer has at its disposal a technical management and support team with specialized know-how, which will work in partnership with its internal IT and business teams. Activities can be carried out in person or remotely from our service centers.
- **Data Center Services** - Based on robust and redundant infrastructure, Decsis Data Center ensures high availability and security for housing of Productive Environments, Disaster Recovery or Business Continuity.
- **Delivery & Support** - Specialist in advice, design, customization, installation and operational support of integrated Information and Communication Technologies solutions.
- **Development** - Development of innovative technology solutions based on cloud services and SaaS.
- **Authorized Service Centers** - Alongside with ICT equipment support services for the corporate market, Decsis's service offering includes multi-brand Authorized Service Centers, in particular for mobile devices such as mobile phones, tablets, laptops and other.

(4) Mr Sequeira da Silva also states that the Opponent has several industry certifications for the provision of its services in the following areas of information technology and communications:¹⁸

- Design and implementation of infrastructures and solutions;
- Managed services (including systems and application administration, network and infrastructure administration, backups and system recovery, cybersecurity, Systems and security monitoring);
- Data centre services in Évora;
- Delivery, support and maintenance, locally or remotely, networks & infrastructure, servers, storage & systems, workplace & software, voice & unified communications;
- End-user support, remote or in person;
- Development of business intelligence solutions;
- Repair centres;
- Network management centres;
- Housing services as colocation model in the Évora Data Center.

¹⁸ Witness statement of Mr da Silva, paragraph 6. Also see 'MASdS Annex 1' which are screenshots taken from the Opponent's website listing those certifications under the heading 'Decsis Management System'.

- (5) In his witness statement, Mr Sequeira da Silva refers to the Opponent, Decsis - Sistemas de Informacao S.A., as 'Decsis'. Consequently, the table below is provided in the witness statement as evidence that "Decsis [the company] has experienced consistently increasing revenue".¹⁹

Year	DECSIS turnover in the UK
2023	6.961,65€
2022	29.370,53€
2021	20.479,41€
2020	19.355,57€
2019	119.656,44€
TOTAL	195.823,60€ (EURO)

- (6) Mr Sequeira da Silva states that the Opponent provides services to consumers throughout the UK and refers to MASdS Annex 2 as evidence, noting that it contains "a number of invoices/purchase orders". This exhibit includes an untranslated table that appears to list invoice values for 'DECSIS-SISTEM.INFORMACIO SA' relating to eight 'GB' customers. The entries span from 1 January 2019 to 31 December 2023. Consequently, some fall outside the relevant period, as they extend beyond 4 April 2023. Below is an extract of the table by way of illustration (the yellow highlighting was added by the Opponent):

DECSIS-SISTEM.INFORMACAO SA -											Fri,22-Dec-2023 14:20									
ESTADISTICA DE FACTURACAO POR CLIENTE											EXP									
ENTRE 2019/01/01 E 2023/12/31											Moeda: EUR									
Cliente											T.D.	Nº Doc	Data Doc.	D. Vencim.	D.V.	Quantidade	Valor sem IVA	Val. Desconto	Val. Liq. sem IVA	Val. Doc.
Pais	GB	INGLATERRA	(Estrangeiro)																	
1888	0	EXCIS COMPLIANCE LTD	45	23	2022/01/03	2022/02/02	30		1.000	95.00			95.00	95.00						
			45	1034	2022/01/27	2022/03/28	60		8.000	3.379.50			3.379.50	3.379.50						
			45	1036	2022/01/27	2022/03/28	60		2.000	190.00			190.00	190.00						
			45	1080	2021/01/26	2021/03/27	60		2.000	550.00			550.00	550.00						
			45	1332	2023/01/31	2023/04/01	60		9.000	1.561.50			1.561.50	1.561.50						
			45	1986	2022/02/10	2022/03/12	30		3.000	592.00			592.00	592.00						
			45	2285	2022/02/15	2022/03/17	30		2.000	212.50			212.50	212.50						

¹⁹ Paragraph 8 of his Witness Statement. I note that the values contained therein appear to adopt the eurozone punctuation convention for currency, which differs from that used in the UK. Specifically, a comma (rather than a full stop) is used as the decimal separator, and a full stop (rather than a comma) is used as the thousands separator. For example, under the convention adopted in the evidence, the value of 'one thousand one hundred and ten euros and fifty cents' would be written as €1.110,50 whereas in the UK it would be written as €1,110.50.

- (7) A total of 14 invoices have been submitted,²⁰ dated between 2019 and 2023. Of these, 13 fall within the relevant period.²¹ Although some include the term ‘purchase order’ in their specification, each document is headed as an ‘invoice.’ All invoices are addressed to customers with UK addresses and display the ‘DECSIS’ brand prominently in the letterhead, as shown below:



- (8) Some of the relevant invoices do not clearly indicate in their ‘specification’ what services were rendered (see for example the invoices at pages 18, 20, 21, 23 and 25 of MASdS Annex 2), an extract of one of these is shown below by way of example:

Serviço Service	Designação Specification	Qtd Qty	Preço Price	%Desc %Disc	Valor Value	IVA VAT
67	PURCHASE ORDER NUMBER GBRPO-24113 HEXAWARE SUBSEA 7 SUPPORT IN LISBON PORTGAL ON 12TH DECEMBER S221205_000014 -GBRPO-24113 **IVA AUTO-LIQUIDAÇÃO/REVERSE CHARGE PRINCIPLE VAT OS ARTIGOS/SERVIÇOS FATURADOS FORAM COLOCADOS À DISPOSIÇÃO/PRESTADOS NESTA DATA	1.000	259.50		259.50	

- (9) The remaining invoices refer to: ‘onsite visits’ in Lisbon (Portugal); ‘engineer events’ in Lisbon with associated travel expenses e.g. a 2 hour ‘engineer event’ plus 1 hour travel is itemised as one combined, unportioned fee;²² ‘scheduled visits’ in Lisbon; and ‘annual retainers’ in Lisbon.
- (10) Mr Sequeira da Silva states that the Opponent spends €30,000 annually on advertising and promotion, citing only the following two areas of expenditure by way of example:²³
- (i) maintaining the website ‘decsis.eu’, which he states provides information about the Opponent’s services. MASdS Annex 3 is provided in support of this statement. Since this evidence consists of

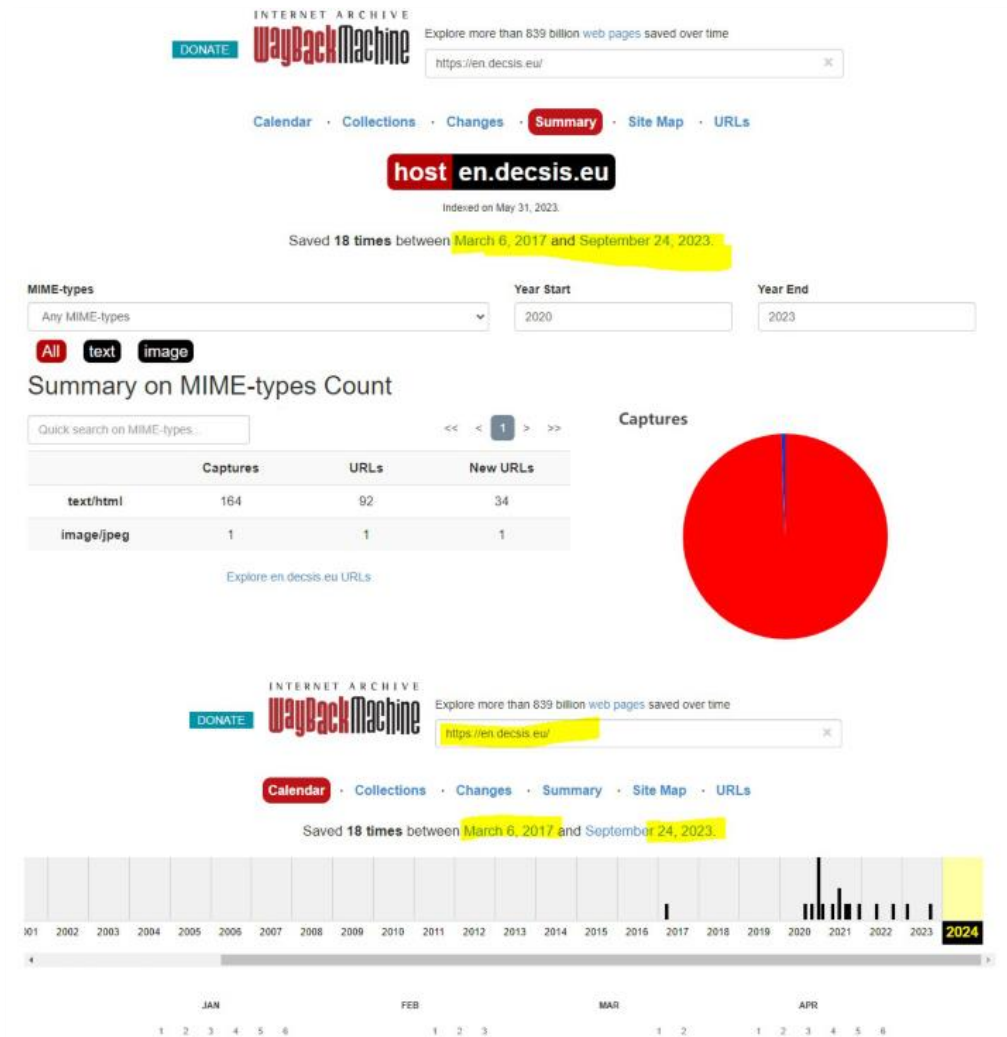
²⁰ MASdS Annex 2

²¹ The invoice at page 28 of MASdS Annex 2 is dated 18 July 2023 and is therefore outside of the relevant period.

²² See the invoices at pages 22 and 27 of MASdS Annex 2.

²³ Witness statement of Mr da Silva, paragraph 10.

only one page, I reproduce it below for ease of reference (the yellow highlighting was added by the witness):



- (ii) activities related to research, development, and sponsorship. In this regard, Mr Sequeira da Silva states that the “most notable project involving [the Opponent’s] IT expertise is in connection to the establishment of a dedicated supercomputer linked to the largest radio telescope in the world,” and that the Opponent provides its IT expertise to the University of Évora (Portugal) in relation to the same. MASdS Annex 4 is provided in support of this statement – it includes screenshots from two online articles with a 2020 date, announcing the inauguration of the ‘Oblivion’ supercomputer, acquired by the University of Évora and installed at the “DECSIS Data Center” in Évora. One article notes the supercomputer was acquired by the University to

support a Portuguese research consortium and the broader Portuguese scientific community.

Assessment and conclusion of the proof of use evidence

24. With regard to the turnover information contained in the table at paragraph 22(5), I must point out that it is not clear to me how “€6.961,65” in 2023 represents a “consistently increasing revenue” when compared with “€119.656,44” in 2019. Contrary to Mr Sequeira da Silva’s statement, the figures provided, as I understand them, appear to show that the company’s UK turnover declined year on year from 2019 to 2023 (from approximately 120 thousand Euros in 2019 to around 7 thousand Euros in 2023). This trend undermines any suggestion of sustained growth throughout the relevant period. There are, moreover, numerous other deficiencies in the Opponent’s evidence, which I address below.

25. In assessing the turnover, I take note I take note of the decision of Professor Philip Johnson sitting as the Appointed Person in *EROS BODYGLIDE* trade mark, BL O/0984/25, wherein he stated (my emphasis for clarity):

“26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. **This is why particularisation is so important as without it the figures provide no evidence of use** for either good A or good B. The same applies where the same good is sold under trade mark A and trade mark B.

27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient.

28. In this case [the witness] makes it clear that the sales figures are ‘across the full range of Body Glide products’ [...]. This evidence in itself means that the global figures do not establish use.”

26. No turnover figures are provided for 2018, even though the relevant period begins on 5 April 2018. The turnover figures supplied are annual totals and have not been apportioned. Therefore, since the relevant period ends at the start of the second quarter of 2023, I cannot assume that all turnover reported for 2023 falls within the relevant period.

27. The turnover table lacks clarity as to whether it relates specifically to the 'DECSIS' brand. Although the table is headed "*DECSIS turnover in the UK*", Mr Sequeira da Silva introduces this evidence as the *company's* revenue. This leaves it uncertain as to whether the figures represent turnover under the 'DECSIS' mark or the company's total revenue (which may include other brands). This ambiguity is reinforced by the Opponent's website evidence, which lists brands other than 'DECSIS.'

28. Some of the exhibited invoices include charges for travel expenses, therefore if the reported turnover figures simply aggregate the total value of the Opponent's invoices, it is conceivable that they may include amounts for ancillary items, such as travel expenses, rather than just the provision of the relevant services. It is also plausible that charges may have been made for parts or materials, which would likewise fall outside the scope of services covered by the registration.

29. Mr Sequeira da Silva's witness statement offers no clarification to assist in assessing the turnover, and MASdS Annex 2 does not corroborate the figures either. The untranslated table in this exhibit, which appears to show invoice values for *the company*, fails to identify the brand to which those invoices relate or specify the services rendered. None of the invoices exhibited enable me to determine what services were actually provided – even those referring to 'onsite visits', 'engineer events', and 'annual retainers' give no explanation of what these items cover. For example: what were the 'onsite visits' for? What is an 'engineer event'? What services does an 'annual retainer' include? I cannot be expected to speculate – the Opponent bears the responsibility of providing sufficient information which would enable me to answer these questions.

30. Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned. It was incumbent upon the Opponent to identify, with clarity and specificity, which services were provided

under the invoices relied upon. In the absence of such detail, I cannot ascertain whether the services fall within the scope of the registration, as they could equally relate to activities outside the relevant specification. Unsupported assertions or ambiguous documentation cannot discharge the burden of proving genuine use under the Act.

31. Crucially, taking all the foregoing into account, even if the turnover figures are, at best, assumed to relate exclusively to the 'DECSIS' brand, they cannot be treated as a reliable indication of revenue derived solely from the services for which use must be proven because the figures are presented globally. Thus, even on this most generous construction of the turnover evidence, the absence of particularisation prevents any meaningful assessment of which services the figures actually cover.

32. The Applicant's evidence indicates that the UK custom software development market alone is valued at over £40 billion.²⁴ This represents a niche segment of the wider UK IT services market and does not account for the broader IT services sector, which is likely to be significantly larger, and excludes the EU market, which would be larger still. Although no data is provided for the "*science and technology services*" sector, it is reasonable to infer that this market is also significant.

33. I acknowledge that the genuine use test imposes no *de minimis* threshold and does not measure economic success or large-scale commercial activity. Nevertheless, even if I were to disregard the significant deficiencies identified in the Opponent's turnover evidence (which I do not), the turnover shown appears minimal when considered against the likely size of the relevant markets, and therefore does not suggest any meaningful commercial presence in the relevant territories. This concern is heightened by the fact that, prior to IP Completion Day, the relevant markets were not confined to a single Member State, yet the Opponent's evidence is limited to UK turnover for the entire relevant period, despite the opportunity to rely on any EU turnover. That omission, together with the absence of any indication of the Opponent's market share, means that even on this best construction, the turnover evidence would likely fall short of establishing genuine use in a commercially significant context.

²⁴ Exhibit PL4.

34. No supporting evidence has been provided, such as invoices, to show how the annual advertising expenditure of €30,000 is allocated. Based on the material before me, the only apparent promotional activity relates to maintaining a ‘.eu’ domain website; and housing a supercomputer purchased by a Portuguese university – while it is stated that the Opponent provides expertise to the university in connection with this, I do not see how such activity promotes the earlier mark to the relevant consumer of the registered services. Moreover, maintaining a website alone does not demonstrate promotional activity in the UK or EU; likewise, merely showing that someone from the relevant territory accessed a website using the mark is insufficient to establish use unless there is evidence that the website was targeting customers in that territory for relevant services.²⁵

35. Certification to provide certain services is not, in itself, proof that those services were actually delivered, and although Mr Sequeira da Silva asserts that the Opponent offers a wide range of services and lists them in his witness statement, such broad statements require critical scrutiny when unsupported by corroborating evidence. In fact, the supporting material does not enable me to determine with certainty which of those services, if any, were provided during the relevant period.

36. In summary, the evidence suffers from multiple and significant deficiencies: the turnover figures are ambiguous as to whether they relate to the mark or the company as a whole, and even on the most generous interpretation (i.e. assuming they relate to the mark itself), they are global figures lacking any breakdown by services rendered, and the supporting material provides no assistance in their interpretation; the Opponent has provided no indication of its market share, and even on the best construction of the turnover evidence, the figures do not demonstrate any meaningful commercial presence in the relevant territories during the relevant period and show a year-on-year decline; the broad statements purporting to verify use are not supported by cogent evidence; and the reference to promotional activity is not persuasive and is inconclusive.

37. The evidence must clearly and precisely show the actual use made and, where that use is limited, explain why reliance on a broader category remains appropriate. Due to the evidential shortcomings, I cannot determine with certainty which services

²⁵ See to that effect the decision of the Appointed Person in *EROS BODYGLIDE* trade mark, BL O/0984/25 at [32].

were provided under the earlier mark during the relevant period. The evidence fails to establish genuine use for the broad categories of services, or for any narrower range. I am unable to identify a fair specification because the evidence is not sufficiently solid to evaluate the scope of protection, preventing me from naming any specific services rendered under the mark. Accordingly, I am not satisfied that the evidence is sufficient to establish genuine use of the earlier mark during the relevant period. The onus was on the Opponent to file evidence that was clear, solid, and conclusive; in my view, it has failed to do so. Accordingly, the Opponent has failed to prove genuine use of the earlier mark.

Final Remarks

38. As my finding is that the earlier mark has not been put to genuine use, there is no need to consider the claim under section 5(2)(b) as it is irrelevant to the outcome, because, under section 6A of the Act, the registrar shall not refuse to register the applied-for trade mark on the ground that there is an earlier trade mark if the use conditions of the earlier trade mark are not met.

39. However, for completeness, even assuming a best-case hypothetical scenario in which the Opponent establishes genuine use for a limited, fair specification and, as a result, identity and/ or similarity exists with certain of the Applicant's contested goods and services, I would still conclude that there is no likelihood of confusion. The marks 'DECSIS' and 'DOOSIS' differ clearly in their second and third letters ('EC' versus 'OO'), positioned at the beginning where consumer attention is focused. While both parties suggest the marks are technical acronyms, there is no conclusive evidence that the average consumer would recognise them as such; they would perceive the marks as whole words with no conceptual meaning. The shared ending 'SIS' does not dominate the overall impression and lacks sufficient distinctiveness to increase the likelihood of confusion – moreover, the similarities between the marks do not outweigh the visual and aural differences. Applying the principles of global assessment under EU case law,²⁶ and considering that the relevant consumer would exercise at least a medium to high degree of attention when selecting the goods and services, I would

²⁶ *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

find no likelihood of direct confusion under section 5(2)(b) of the Act according to this hypothetical scenario, and there would be no proper basis for a finding of indirect confusion either.

OUTCOME

40. The Opponent has failed to prove that the earlier mark was put to genuine use during the relevant period, accordingly, the earlier trade mark cannot be relied on as a basis for the opposition under section 5(2)(b) of the Act. The opposition therefore fails. Subject to appeal, trade mark application number 3896758 shall proceed to registration for all the goods and services applied for.

COSTS

41. The Applicant has been successful and is entitled to a contribution towards its costs, assessed in line with the scale set out in Tribunal Practice Notice (1/2023). In determining the amount, I have considered that the Applicant's evidence was largely unnecessary. In the circumstances, I award the Applicant £650, apportioned as follows:

Preparation of the Notice of Defence and Counterstatement	£250
Preparing evidence and considering the Opponent's evidence	£400
TOTAL	£650

42. I therefore order Decsis - Sistemas de Informacao S.A. to pay Doosis Ltd the sum of **£650**. 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 25th day of November 2025

Daniela Ferrari
For the Registrar

Annex 1

Applied-for goods and services

Class 9:	Software; Software testing software; Software reliability software; Computer software; Collaboration software platforms [software]; Computer software packages; Antivirus software; Software for computers; Enterprise software; Antispyware software; Multimedia software; Computer software development tools; Workflow software; Computer software applications; Programming software; Software applications; System software; Plugin software; Bioinformatics software; Antimalware software; Computer antivirus software; Downloadable computer software; Computer software for computer aided software engineering; Computer application software; Computer software platforms; Debugging software; Application software; Networking software; Encryption software; Computer e-commerce software; Computer software programs; Server-side software; Hardware testing software; Graphics software; Interface software; Telecommunications software; E-commerce software; Computer software for encryption; Downloadable software; Computer telephony software; Simulation software; Downloadable computer software applications; Computer software applications, downloadable; Computer programming software; Compiler software; Software compiler; Computer hardware for use in computer-assisted software engineering; Business software; Computer interface software; Platform software; Server software; Editing software; Operating software; Cryptography software; Accounting software; Downloadable computer security software; Computer operating software; Programs (Computer -) [downloadable software]; Computer programs [downloadable software]; Smartphone software; Gaming software; Software suites; Publishing software; Computer firewall software; Embedded software; Intranet software; Downloadable computer utility software; Security software; Optimisation software; Computer software for advertising; Downloadable computer software for blockchain technology; Computer graphics software; Software development tools; Mobile software; Educational computer software; Music software; Manufacturing software; Hardware reliability software; Utility software; Diagramming software; Computer software [programmes]; Communications software; CAD software; Testing software; Software for smartphones; Biometric software; Animation software; Computer game software; Computer software for database management; Assistive software; Downloadable software applications; Game software; Business technology software; Web site development software; Web server software; Web application software; Servers for web hosting; Web application and server software; Web development software; Web content management [WCM] software; Computer programs for using the internet and the worldwide web; Software for embedding online advertising on websites; Website development software.
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Class 42:

Development of computer hardware and software; Computer software development; Development of computer software; Computer software integration; Computer software consultancy; Consultancy (Computer software -); Software engineering; Computer software consulting; Software authoring; Computer hardware and software design; Design of computer hardware and software; Software development in the framework of software publishing; Design of computer software; Software design (Computer -); Computer software (Design of -); Computer software design; Computer software engineering; Software development; Development of software; Computer software installation; Installation of computer software; Computer software (Installation of -); Update of computer software; Testing of computer software; Software design; Design of software; Rental of computer hardware and software; Duplication of computer software; Installation of software; Software installation; Configuration of computer software; Development of computer database software; Design and development of computer hardware and software; Computer software maintenance; Computer software (Maintenance of -); Maintenance of computer software; Leasing of computer software; Services for the design of computer software; Computer software design services; Design of computer database software; Developing computer software; Upgrading of computer software; Software (Updating of computer -); Updating of computer software; Computer software (Updating of -); Development of computer software application solutions; Computer software programming services; Hiring of computer software; Software as a service [SaaS] featuring software for machine learning; Computer software research; Web site design; Design of web sites; Internet web site design services; Web hosting; Hosting of web sites; Hosting web sites; Creation of internet web sites; Design of web pages; Programming of web pages; Compilation of web pages for the Internet; Web site design services; Hosting of web portals; Hosting web portals; Web portal design; Web site hosting services; Design of home pages and web sites; Web page design services; Web site design consultancy; Graphic design for the compilation of web pages on the internet; Hosting of customized web pages; Web site design and creation services; Programming of customized web pages; Web hosting services; Design and creation of homepages and web pages; Hosting the web sites of others; Hosting the computer sites (web sites) of others; Design, creation and programming of web pages; Design and updating of home pages and web pages; Servers (Rental of Web -); Rental of web servers; Designing and developing web pages; Creating electronically stored web pages for online services and the internet; Installing web pages on the internet for others; Creation and maintenance of web sites; Design and creation of web sites for others; Design and graphic arts design for the creation of web pages on the Internet; Design and creating web sites for others; Providing temporary use of on-line non-downloadable software for web site development; Design of Internet pages; Hosting on-line web facilities for others; Design of homepages and Internet pages; Commissioned writing of computer programs, software and code for the creation of web pages on the Internet; Maintenance of websites and hosting on-line web facilities for others; Creating and maintaining

	<p>web sites; Design and maintenance of web sites for others; Hosting websites on the Internet; Hosting the web sites of others on a computer server for a global computer network; Managing web sites for others; Managing the web sites of others; Creating and maintaining computer sites (web sites) for others; Creating web pages for others; Homepage and webpage design; Designing and implementing network web pages for others; Providing temporary use of non-downloadable software applications accessible via a web site; Providing information in the field of interior design via a web site; Consultancy relating to the design of home pages and Internet sites; Hosting online web facilities for others for sharing online content; Hosting of mobile websites; Designing and creating web sites for others; Designing and implementing web sites for others; Design and creation of homepages and Internet pages; Hosting on-line web facilities for others for managing and sharing on-line content; Design and graphic arts design for the creation of web sites; Creation and maintenance of web sites for others; Webpage design services; Creating, designing and maintaining web sites; Consultancy relating to the design of homepages and Internet pages; Computer site design; Creating and designing web pages for others; Computer website design; Creating and maintaining customized web pages; Website design; Creating, maintaining and hosting the web sites of others; Hosting computer websites; Hosting of portals on the internet; Design of websites; Design of homepages and websites; Hosting of e-commerce platforms on the Internet; Electronic site authoring; Creating and maintaining web sites for others; Maintaining (Creating and -) web sites for others; Creating or maintaining web sites for others; Hosting of digital content on the Internet; Website design services; Hosting an online website for creating and hosting micro websites for businesses; Updating Internet pages; Designing and developing webpages on the internet; Hosting of websites; Hosting websites; Design and development of homepages and websites; Website hosting services; Consultancy relating to the creation of homepages and Internet pages; Hosting online web facilities for others for conducting interactive discussions; Elaboration and maintenance of web sites for third parties; Hosting internet sites for others; Programming of software for Internet portals, chatrooms, chat lines and Internet forums.</p>
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