

O/1168/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. 3926866
IN THE NAME OF XAN LABS INTERNATIONAL LTD
IN RESPECT OF THE TRADE MARK



NOW.UK

IN CLASSES 9, 38 & 42

AND

THE OPPOSITION THERETO UNDER NO. 443633
BY SKY UK LIMITED

Background and pleadings

1. Xan Labs International Ltd (“the applicant”) applied to register the UK trade mark no. 3926866 shown on the cover page of this decision, in the UK on 26 June 2023. It was accepted and published in the Trade Marks Journal on 14 July 2023 in respect of the following goods and services:

Class 9: NO2 sensors; particle sensors; air quality sensors; weather stations; weather data sensors; pollution sensors; gas sensors; temperature sensors; humidity sensors; air pressure sensors; emissions sensors; artificial intelligent sensors for monitoring air quality; artificial intelligent sensors for monitoring weather; traffic control devices; traffic tracking devices; pedestrian monitoring devices; camera monitoring devices; close circuit television and devices; radios; antennas; microwave signaling devices; traffic monitoring devices; devices for counting pedestrians, cyclists or vehicles; parking monitors; queue detection monitors; artificial intelligent tracking systems; road use monitoring and tracking devices; smart tracking devices; incident detection devices; smart devices for monitoring or analyzing traffic, pedestrians, cyclists and pollution or weather conditions; artificial intelligence devices and instruments for monitoring and processing data for logistics, weather, traffic, pollution and urban or town management; devices and instruments for detecting and interacting with standard short-range wireless interconnection of mobile electronic devices, phones, computers, and other electronic communications instruments and devices; devices and instruments for detecting and interacting with connected autonomous vehicles; CCTV systems, including display and storage devices and instruments; devices and instruments for video analytics; electronic instruments and devices for traffic management or traffic monitoring; networking instruments and devices; instruments and devices for building a communications network or communications mesh; software for use in or with the aforementioned instruments and devices; components, parts and fitting for all the aforesaid.

Class 38: Internet communication services enabling electronic devices to exchange data automatically; Rental of access time to a database server;

Digital communications services; Digital transmission services; Providing internet access; Internet communication services; Internet based telecommunication services between devices; Transmission of data via the Internet enabling electronic devices to exchange data automatically; Arranging access to databases on the internet; Wireless transfer of data via the Internet; Providing access to portals on the Internet; Providing access to information via the Internet; Digital transmission of data via the Internet; Providing access to platforms on the Internet; Providing access to web sites on the internet; Electronic transmission of computer programs via the internet; Providing user access to portals on the Internet; Providing user access to platforms on the Internet; Providing access to Internet portals for third parties; Transmission of data by means of the Internet; Provision of access to data via the Internet; Telecommunication services provided via Internet platforms and portals; Providing telecommunications links to the Internet or databases; Providing telecommunication connections to the internet or databases; Providing telecommunications connections to the internet or databases; Providing user access to computer networks and the Internet; Provision of access to computer networks and the internet; Transferring information and data via computer networks and the Internet; Providing telecommunications connections or links to the internet or databases; Transfer of information and data via online services and the Internet; Transferring and disseminating information and data via computer networks and the Internet; Electrical data transmission over a global remote data processing network, including the internet; Provision of telecommunication access and links to computer databases and to the internet; providing access to a server enabling electronic devices embedded with software, sensors, actuators and network connectivity to exchange data facilitating devices to be sensed or controlled remotely.

Class 42: Server administration; Server hosting; Remote server administration; Rental of a database server (to third parties); Rental of software for computer networks and servers enabling electronic devices to exchange data automatically; Programming of software for computer networks and servers enabling electronic devices to exchange data automatically; Design and development of software for computer networks and servers enabling electronic

devices to exchange data automatically; Rental of memory space on servers for hosting electronic bulletin boards; Hosting the web sites of others on a computer server for a global computer network; Providing temporary use of on-line non-downloadable operating software for computer networks and servers; Research relating to the computerised automation of technical processes; Research relating to the computerised automation of administrative processes; Research relating to the computerised automation of industrial processes.

2. On 16 October 2023, Sky UK Limited (“the opponent”) opposed the trade mark on the basis of section 5(2)(b)¹ of the Trade Marks Act 1994 (“the Act”). This is on the basis of its three trade mark registrations below:

1. UK Registration no. 3127306

NOW

Filing date: 19 August 2015 Registration date: 21 June 2019

Relying on the following goods and services:²

Class 9: Apparatus for transmission of sound or images but not including any such apparatus with the sole function of recording, transmitting or reproducing music or musical performances; Computer software supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus but not including computer software with the primary function of composing, recording, reproducing or transmitting music or musical performances; Computer peripheral devices supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus; Computer software, recorded supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus but not including computer programs with the primary function of

¹ The opponent originally also relied upon 5(3) and 5(4)(a) of the Act, but these grounds were dropped within the course of the proceedings.

² I note the specifications relied upon by the opponent are not always worded exactly as they are on the register, however, where these differ, I note the opponent has relied upon narrower terms than those for which it holds protection, and as such it is entitled to rely on these within the proceedings.

composing, recording, reproducing or transmitting music or musical performances; electrical and electronic apparatus for use in the reception of satellite, terrestrial or cable broadcasts; computer software to enable searching of data; encoded programs for data processing and broadband telecommunications; telephone and radio modems; apparatus for decoding encoded signals; computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information; computer programs; computer software and telecommunications apparatus to enable connection to databases and the Internet; computer software supplied from the Internet but not including computer software with the primary function of composing, recording, reproducing or transmitting music or musical performances; network termination equipment; wired and/or wireless computer network routers, modems, firewalls and/or bridges; computer software and computer programs for distribution to, and for use by, viewers of a digital television channel for the viewing and purchase of goods and services; computer programs for interactive television electronic publications other than music related electronic publications; communication apparatus and instruments; data storage apparatus, equipment and instruments; electrical telecommunications and/or communications and/or broadcast and/or broadband transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; electronic telecommunications and/or communications and/or broadcast and/or transmission instruments and apparatus; motion pictures; parts and fittings for all the aforesaid goods; e-sell through products, namely downloadable media content other than music content, including video and films and television programmes provided by internet or wireless transmission; parts and fittings for all of the above.

Class 42: Design and development of computer hardware and software supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus; Computer programming supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus; Computer rental; Computer software design supplied as part of or in connection with broadband telecommunications

and/or television streaming apparatus; Rental of computer software supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus; online technical storage facilities, online storage of files, data, photographs, graphics, documents, videos, images, audio files, audio-visual files, visual files, computer files, computer applications and information for others, electronic data storage services for personal and business use, and services for the electronic storage and organization of files, images, audio, video, photos, drawings, audio-visual, text, documents and data, but excluding business relocation services; design, drawing and commissioned writing all for the compilation of web pages on the Internet; hosting websites; installation, rental and maintenance of computer software supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus; analysis and monitoring of broadband telecommunication services; rental or leasing of computer hardware or software.

2. UK Registration no. 3354900

NOW TV

Filing date: 20 November 2018 Registration date: 5 April 2019

Relying on the following goods and services:

Class 9: Wireless local area network devices; broadband telecommunications hubs; routers; software for browsing, streaming, viewing and/or organising audio, visual and/or audio visual content; software for audio, visual and/or audio visual entertainment content user interfaces and/or electronic programme guides.

Class 38: Providing fixed line telephony services; providing broadband services; providing access to the internet; information, advice and customer support services relating to all the aforesaid services.

Class 42: Providing temporary use of non-downloadable software for browsing, streaming, viewing, and/or organising audio, visual and/or audio visual content; software as a service for browsing, streaming, viewing and/or

organising audio, visual and/or audio visual content; information, advice and customer support services relating to all the aforesaid services.

3. UK Registration no. 3635507



Filing date: 30 April 2021 Registration date: 18 March 2022

Relying on the following goods and services:

Class 9: Apparatus for transmission of sound or images but not including any such apparatus with the sole function of recording, transmitting or reproducing music or musical performances; computer programmes [programs], recorded supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus but not including computer programs with the primary function of composing, recording, reproducing or transmitting music or musical performances; computer programs [downloadable software] supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus but not including computer programs with the primary function of composing, recording, reproducing or transmitting music or musical performances; wireless local area network devices; hubs; routers; software for browsing, streaming, viewing audio, visual and/or audio visual entertainment content; software for audio, visual and/or audio visual entertainment content user interfaces and/or electronic programme guides; telephone and radio modems; computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus; computer software supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus but not including

computer software for use in connection with the primary function of composing, recording, reproducing or transmitting music or musical performances; computer software and broadband telecommunications apparatus to enable connection to databases and the internet; broadband telecommunications network termination equipment; wired and/or wireless computer network routers, modems, firewalls and/or bridges supplied as part of or in connection with broadband telecommunications; electronic broadband telecommunications and/or broadband communications and for broadband transmission instruments and apparatus.

Class 38: Broadband telecommunications; cellular telephone communication via a broadband telecommunications network; broadband communications by computer terminals; broadband communications by fiber [fibre] optic networks; broadband communications by telephone; information about broadband telecommunication; providing broadband telecommunications connections to a global computer network; providing access to the internet via a broadband telecommunications network; information, advice and customer support services relating to all the aforesaid services; providing user access to global computer broadband telecommunications networks; rental of access time to global computer broadband telecommunications networks; rental of broadband modems; rental of broadband telecommunication equipment; broadband telecommunications routing and junction services; broadband telecommunications mobile and fixed telecommunications services; broadband communications services; broadband transmission and broadband communication services; broadband telecommunications services over the internet including but not limited to services provided using voice over internet protocol (VOIP); provision of access and/or connectivity to broadband networks whether fixed, portable or wireless; providing access to broadband telecommunications infrastructures for other operators; hiring, rental and leasing of broadband communications apparatus; broadband telecommunication services relating to the internet; broadband telecommunication of information (including web pages); provision of location based services for broadband telecommunications and broadband communications apparatus and instruments; provision of broadband

telecommunications links to computer databases and websites on the internet enabling access to the internet via a broadband telecommunications network; provision of broadband services; providing access to internet websites to mobile telephone users via a broadband telecommunications network; broadband telecommunications information; telephonic or telephone broadband communications services; wireless broadband communication services; consultancy, information and advisory services relating to all the aforesaid services provided on-line from a computer database or via a helpline or the internet; none of the aforesaid services listed in this class being provided in connection with musical sound recordings, downloadable music, musical compositions or musical performances.

Class 42: Providing temporary use of non-downloadable software for browsing, streaming or viewing audio, visual and/or audio visual entertainment content; software as a service for browsing, streaming, viewing and/or organising audio visual entertainment content; information, advice and customer support services relating to all the aforesaid services; design and development of computer hardware and software supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus; computer programming; computer services for interactive broadband communications; installation, rental and maintenance of computer software supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus; computer services for accessing a broadband communications or computer network; computer services for accessing and retrieving information, messages, text, sound, images and data via a computer or computer network; none of the aforesaid services listed in this class being provided in connection with musical sound recordings, downloadable music, musical compositions or musical performances.

3. By virtue of their earlier filing dates, the above marks constitute earlier marks in accordance with section 6 of the Act. As the marks had not yet been registered for a period of five years at the date on which the earlier mark was filed, the opponent is not

required to prove use of the same, and may rely upon the full specifications to the extent they are set out in its pleadings.

4. The opponent argues that the respective goods and services are identical or similar and that the marks are highly similar. As such, the opponent submits that there exists a likelihood of confusion, including a likelihood of association between the same.

5. The applicant filed a counterstatement denying the marks are highly similar, denying the goods and services are identical or similar, and denying there will be a likelihood of confusion between the marks.

6. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Whilst the applicant requested extensions to the deadline to file its own evidence, these were ultimately refused following a case management conference that took place before myself on 11 December 2024. A letter detailing the reasons for the refusal was sent to the parties on 13 December 2024. The refusal was primarily based on the lack of any persuasive reasoning provided by the applicant for the extension requests.

7. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

8. The opponent is represented in these proceedings by Dentons UK and Middle East LLP. The applicant is represented by Beck Greener LLP.

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

10. The opponent filed its evidence in the form of a witness statement in the name of Nisha Parkash, the Head of Domain Management at the opponent. The statement introduces 11 exhibits, namely Exhibit NP1 to Exhibit NP11, and goes to the opponent's and applicant's use of the marks. The statement is dated 30 July 2024.

Section 5(2)(b)

11. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

12. Section 5A of the Act is as follows:

“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.”

13. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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.

The principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

14. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, 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”.

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that there is complementarity where:

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

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

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

19. With this in mind, the contested goods and services are as follows:³

Contested goods and services

Class 9: NO2 sensors; particle sensors; air quality sensors; weather stations; weather data sensors; pollution sensors; gas sensors; temperature sensors; humidity sensors; air pressure sensors; emissions sensors; artificial intelligent sensors for monitoring air quality; artificial intelligent sensors for monitoring weather; traffic control devices; traffic tracking devices; pedestrian monitoring devices; camera monitoring devices; close circuit television and devices; radios; antennas; microwave signaling devices; traffic monitoring devices; devices for counting pedestrians, cyclists or vehicles; parking monitors; queue detection monitors; artificial intelligent tracking systems; road use monitoring and tracking devices; smart tracking devices; incident detection devices; smart devices for monitoring or analyzing traffic, pedestrians, cyclists and pollution or weather conditions; artificial intelligence devices and instruments for monitoring and processing data for logistics, weather, traffic, pollution and urban or town management; devices and instruments for detecting and interacting with standard short-range wireless interconnection of mobile electronic devices, phones, computers, and other electronic communications instruments and devices; devices and instruments for detecting and interacting with connected autonomous vehicles; CCTV systems, including display and storage devices and instruments; devices and

³ The goods and services relied upon by the opponent are set out at paragraph 2 of this decision.

instruments for video analytics; electronic instruments and devices for traffic management or traffic monitoring; networking instruments and devices; instruments and devices for building a communications network or communications mesh; software for use in or with the aforementioned instruments and devices; components, parts and fitting for all the aforesaid.

Class 38: Internet communication services enabling electronic devices to exchange data automatically; Rental of access time to a database server; Digital communications services; Digital transmission services; Providing internet access; Internet communication services; Internet based telecommunication services between devices; Transmission of data via the Internet enabling electronic devices to exchange data automatically; Arranging access to databases on the internet; Wireless transfer of data via the Internet; Providing access to portals on the Internet; Providing access to information via the Internet; Digital transmission of data via the Internet; Providing access to platforms on the Internet; Providing access to web sites on the internet; Electronic transmission of computer programs via the internet; Providing user access to portals on the Internet; Providing user access to platforms on the Internet; Providing access to Internet portals for third parties; Transmission of data by means of the Internet; Provision of access to data via the Internet; Telecommunication services provided via Internet platforms and portals; Providing telecommunications links to the Internet or databases; Providing telecommunication connections to the internet or databases; Providing telecommunications connections to the internet or databases; Providing user access to computer networks and the Internet; Provision of access to computer networks and the internet; Transferring information and data via computer networks and the Internet; Providing telecommunications connections or links to the internet or databases; Transfer of information and data via online services and the Internet; Transferring and disseminating information and data via computer networks and the Internet; Electrical data transmission over a global remote data processing network, including the internet; Provision of telecommunication access and links to computer databases and to the internet; providing access to a server enabling electronic devices embedded with software, sensors, actuators and network connectivity to exchange data facilitating devices to be sensed or controlled remotely.

Class 42: Server administration; Server hosting; Remote server administration; Rental of a database server (to third parties); Rental of software for computer networks and servers enabling electronic devices to exchange data automatically; Programming of software for computer networks and servers enabling electronic devices to exchange data automatically; Design and development of software for computer networks and servers enabling electronic devices to exchange data automatically; Rental of memory space on servers for hosting electronic bulletin boards; Hosting the web sites of others on a computer server for a global computer network; Providing temporary use of on-line non-downloadable operating software for computer networks and servers; Research relating to the computerised automation of technical processes; Research relating to the computerised automation of administrative processes; Research relating to the computerised automation of industrial processes.

20. I note at this point, that opponent has provided evidence relating to the use of its marks as well as some evidence relating to the applicant's use of the contested mark. I also note the applicant has provided submissions on the parties' respective markets, stating in particular:

“12. Furthermore, paragraphs 18 -20 of the Counterstatement explains that the Applicant is in the business of providing goods that relate to infrastructure, typically purchased by government organisations, such as local authorities, law enforcement agencies or large businesses. However, the Counterstatement explains that the goods for which the earlier marks are registered are primarily intended for general consumption among the broader consuming public. This has not been denied by the witness or challenged in any way.

13. The witness confirms that she has carefully read through the Counterstatement and in the absence of challenging these statements of fact, they must be treated as being genuine and true.”

21. The applicant then goes on to assess the similarity of a few select goods and services relied upon with its own.

22. Whilst both the evidence and the submissions from the parties have been noted, I emphasise at this point that I must consider the goods and services as applied for and relied upon and conduct a notional assessment of similarity based on the same, regardless of any areas of difference (or cross over) when it comes to the respective parties actual and current business areas. Further, I do not consider that the fact that the opponent's witness has not expressly denied the applicant's comments in its counterstatement about the typical consumer of its own applied for goods and services and the consumer to whom the opponent's registered goods⁴ are primarily targeted, means I must treat these findings as fact, for reasons I will outline below.

23. Firstly, I do not consider that it is necessary for the opponent's witness to expressly deny every aspect of the applicant's case in its TM8 in order for me to consider the same and reach my own conclusions on factors which are integral to my assessment of a likelihood of confusion. This applies in respect of users, whether considered within a notional comparison of the goods and services or otherwise. I consider that the filing of the TM8 signifies the close of the pleadings stage, and whilst I note that there may be certain accusations or statements that, where left unanswered, may result in me giving additional weight to the claims, I do not consider that a lack of response to a comment on the typical or primary users of the goods or services is sufficient for me to put aside my own requirement to make a notional assessment, including an assessment of whether users of goods will be shared. If this were the case, a comment in a TM8 stating that the goods are dissimilar would then need to be denied by the opponent again in the later stages of proceedings, which would on that basis then need to be denied again by the applicant during its own evidence rounds, and so on. This is clearly not practical or required. Further, I note that an acceptance that the users will "typically" or "primarily" include a particular group is not particularly instructive across wide specifications such as those to be compared in this instance. Finally, I note in any case, it would clearly be nonsensical on a notional assessment of, for example, the applicant's services *providing internet access* and the opponent's clearly identical services *providing access to the internet* to reach a conclusion (based

⁴ I note the applicant does not specifically mention the opponent's services when making this statement, but I consider it likely it was its intention to do so.

on the applicant's statements and the lack of further comment from the opponent's witness) that these services are engaged with by entirely disparate users.

24. I also note at this stage that the opponent has provided me with a table highlighting *some* areas where it considers that identity or similarity between goods and services in the specifications exist. I note the opponent has not provided specific reasoning in this table, and as such it is often of little assistance to my assessment. Further, I note the opponent's reference to the same being "non-exhaustive". I therefore proceed with my assessment by identifying where in my view, any obvious similarity between the goods and services lies, but considering the lack of reasoning supplied by the opponent, I do not consider it necessary to specifically justify any areas where I have not agreed with its general statement of similarity or identity, over and above any usual considerations that takes place in all assessments of this nature.

25. With the above in mind, I begin with the assessment of similarity of the applicant's class 9 goods below.

Class 9

26. The application includes the following goods in class 9:

NO2 sensors; particle sensors; air quality sensors; weather stations; weather data sensors; pollution sensors; gas sensors; temperature sensors; humidity sensors; air pressure sensors; emissions sensors; artificial intelligent sensors for monitoring air quality; artificial intelligent sensors for monitoring weather.

27. The above goods are all sensors, which I consider will detect levels or substances or humidity and pressure for example in the air and likely offer an alarm or reading in relation to the same. I do not consider the above goods to be included within the opponent's earlier goods relied upon. I note that whilst the opponent has submitted these goods are (at least) similar to its earlier goods and services relied upon, it has not provided me with any submissions confirming on what basis any similarity should be found. I see no reason why these goods would significantly overlap in nature, purpose, or method of use with the opponent's earlier goods or services. I do not

consider these to be in competition or complementary to the earlier goods and services, and I do not consider that there would be a particular overlap in trade channels or users at more than a very general level. Overall, I find the above goods to be dissimilar to the opponent's earlier goods and services relied upon. Further, I find this also to be true to the extent that the term *components, parts and fitting for all the aforesaid* applies to these goods as included at the end of the applicant's class 9 specification.

28. The opponent submits goods included within the applicant's class 9 are identical or similar to goods covered by its earlier marks. In particular, I note the opponent has highlighted its earlier marks cover:

Apparatus for transmission of sound or images but not including any such apparatus with the sole function of recording, transmitting or reproducing music or musical performances.

Computer peripheral devices supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus.

29. The applicant's class 9 goods include:

Radios; antennas; and microwave signaling devices.

30. It is my view these are all *apparatus for transmission of sound or images* such as those included with the opponent's specification. I consider these to all be identical in accordance with the principles set out in *Meric*.

31. Further, to the extent that the term *components, parts and fitting for all the aforesaid* as included at the end of the applicant's class 9 specification applies to these terms, it will be in my view identical to the *parts and fittings for all the aforesaid goods* included in the opponent's specification in class 9 insofar as it is applied to the earlier *apparatus for transmission of sound or images* highlighted.

32. The applicant's goods also include:

CCTV systems, including display and storage devices and instruments; close circuit television and devices; camera monitoring devices.

33. Again, I find these to be included, at least to an extent, within the opponent's earlier term *apparatus for transmission of sound or images but not including any such apparatus with the sole function of recording, transmitting or reproducing music or musical performances*. Further, I consider these to fall within the opponent's earlier term [...] *audio visual instruments and apparatus*. I therefore consider these goods identical to those covered by the opponent in accordance with the principles set out in *Meric*. Further, on this basis to the extent that the term *components, parts and fitting for all the aforesaid* as included at the end of the applicant's class 9 specification applies, I consider these again to be identical to it's the opponent's *parts and fittings for all the aforesaid goods* as applied to the opponent's earlier identical goods.

34. However, I note the opponent has submitted in its table provided with its final written submissions, only that these goods are similar to its earlier goods. If I am therefore wrong to consider these identical, I nonetheless agree with the opponent that they will be similar. I note this on the basis that the earlier goods will, in my view, include cameras designed for the purpose of transmitting sound and images to another device, as well as other devices designed to send and/or receive those images. The nature, purpose and method of use of these goods will therefore be shared with the CCTV systems outlined as well as the camera monitoring devices. It also seems likely there may be an element of competition between the same due to the overlap in functionality between them, or where there is no competition, there may be complementarity on the basis the goods may be used together, and the consumer would believe they derive from the same undertaking. This is apparent for example, in the case of a camera designed to capture and transmit images to a camera monitoring device, making these goods important or essential to one another to the extent that the consumer would likely believe they derive from the same economic undertaking. I consider that users and trade channels will likely be shared. Overall, if or where these goods are not considered identical, I find them similar to the earlier goods to a high degree. Further, to the extent that the term *components, parts and fitting for all the aforesaid* as included at the end of the applicant's class 9 specification applies and the

earlier terms are considered not to be identical, I consider nonetheless that these will be of a very similar nature to the opponent's *parts and fittings for all the aforesaid goods*, and will likely share users and trade channels and they still may all be used together, and I find these similar to a medium degree to the opponent's earlier goods.

35. Next, I consider the applicant's class 9 goods below, which the opponent submits are identical to its earlier goods, including those outlined previously at paragraph 28:

Traffic monitoring devices; devices for counting pedestrians, cyclists or vehicles; parking monitors; queue detection monitors; artificial intelligent tracking systems; road use monitoring and tracking devices; smart tracking devices and electronic instruments and devices for traffic management or traffic monitoring.

36. I consider the above goods are all designed for monitoring and/or tracking vehicles or people. Whilst they are therefore likely designed to collect, store or even transmit data or create alerts, I do not consider they are necessarily designed to transmit sound or images, nor do I consider these to be computer peripheral devices. Whilst I consider it is possible these may include elements which do transmit sound and/or images, I do not consider these goods to fall within the ordinary and natural meaning of the opponent's earlier goods as such, and it is my view that a finding of identity in this respect would be to consider this term too broadly. I therefore do not find these goods to be identical to the opponent's earlier goods in accordance with the principles set in *Meric*.

37. However, I consider that the opponent's earlier goods *apparatus for transmission of sound or images [...]* will include goods such as cameras designed to transmit images, which may be used to observe particular vehicles, traffic or pedestrians for example. I consider that there may be a small element of overlap in nature with both sets of goods being electronics which may include overlapping features. The goods may also be used together in pursuit of a similar purpose as part of a larger overall set up, and I consider there will be a possible overlap in trade channels and users, with entities such as councils likely seeking a range of equipment for the purpose of road or town safety or management, for example. Overall, I consider these goods similar to

the opponent's earlier *apparatus for transmission of sound or images but not including any such apparatus with the sole function of recording, transmitting or reproducing music or musical performances* to a medium degree. Further, to the extent that the term *components, parts and fitting for all the aforesaid* as included at the end of the applicant's class 9 specification applies to these goods, I consider these similar to the opponent's earlier goods *parts and fittings for all the aforesaid goods* to between a low and medium degree, considering their similar nature, and shared trade channels and users.

38. Further to the above, I consider the same logic to apply to the goods applicant's following class 9 goods:

Traffic control devices; traffic tracking devices; pedestrian monitoring devices; incident detection devices; smart devices for monitoring or analyzing traffic, pedestrians, cyclists and pollution or weather conditions; artificial intelligence devices and instruments for monitoring and processing data for logistics, weather, traffic, pollution and urban or town management.

39. I find these all to be similar to the earlier goods *apparatus for transmission of sound or images but not including any such apparatus with the sole function of recording, transmitting or reproducing music or musical performances* to a medium degree. Further, to the extent that the term *components, parts and fitting for all the aforesaid* as included at the end of the applicant's class 9 specification applies to these goods, I consider these similar to the opponent's earlier goods *parts and fittings for all the aforesaid goods* to a low to medium degree, considering their similar nature, and shared trade channels and users.

40. Next I consider the applicant's contested goods in class 9 below:

Devices and instruments for video analytics.

41. The opponent's earlier goods include *computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information*. I consider that devices and instruments for video analytics will include the

opponent's earlier apparatus and instruments for searching electronic information, and they will therefore be identical in accordance with the principles set out in *Meric*. On this basis, I also find identity between the applicant's term *components, parts and fitting for all the aforesaid* as included at the end of the applicant's class 9 specification to the extent applies to these goods, and the opponent's earlier *parts and fittings for all the aforesaid goods*.

42. However, if I am wrong in my findings above, I note these goods will share a similar purpose, both being for the purpose of scanning and identifying aspects of electronic data, and there will likely be an overlap in trade channels and possibly users for that reason. If not identical, these goods may well be used together to firstly search for and then analyse information within a video for example, and there will likely be an element of overlap in nature. Overall, if the goods are not considered identical, I find them to be similar to a medium degree. Further, to the extent that the term *components, parts and fitting for all the aforesaid* as included at the end of the applicant's class 9 specification applies to these goods and they are not considered identical, I consider these similar to the opponent's earlier goods *parts and fittings for all the aforesaid goods* also to a low to medium degree considering the likely overlap in nature, trade channels and users.

43. The opponent's earlier marks cover the goods *communication apparatus and instruments; network termination equipment and wired and/or wireless computer network routers, modems, firewalls and/or bridges* for example. It is my view these are identical to the applicant's following contested goods, in accordance with the principles set out in *Meric*:

Networking instruments and devices; instruments and devices for building a communications network or communications mesh; devices and instruments for detecting and interacting with standard short-range wireless interconnection of mobile electronic devices, phones, computers, and other electronic communications instruments and devices; devices and instruments for detecting and interacting with connected autonomous vehicles.

44. Further, to the extent that the term *components, parts and fitting for all the aforesaid* as included at the end of the applicant's class 9 specification applies to these goods, I consider there to be identity between these and the opponent's earlier *parts and fittings for all the aforesaid goods* as applied to its own goods mentioned above.

45. The applicant's goods include the following term at the end of its class 9 specification:

Software for use in or with the aforementioned instruments and devices.

46. The opponent's earlier goods include *computer software supplied from the Internet but not including computer software with the primary function of composing, recording, reproducing or transmitting music or musical performances*. This will include software for use with all of the applicant's class 9 instruments and devices, and I therefore consider this term identical to the opponent's earlier goods in accordance with the principles set out in *Meric*.

Class 38

47. The opponent's earlier marks cover the following services in class 38:

Providing broadband services; providing access to the internet.

Broadband telecommunications.

Broadband communications by computer terminals; broadband communications by fiber [fibre] optic networks; providing broadband telecommunications connections to a global computer network; providing access to the internet via a broadband telecommunications network; broadband transmission and broadband communication services; broadband telecommunication services relating to the internet; provision of broadband telecommunications links to computer databases and websites on the internet enabling access to the internet via a broadband telecommunications network; provision of broadband services; wireless broadband communication services.

48. It is my view that the applicant's following contested services are identical to those outlined above as covered by the earlier marks, either self-evidently, or in accordance with the principles outline in *Meric*:

Class 38: Internet communication services enabling electronic devices to exchange data automatically; Digital communications services; Providing internet access; Internet communication services; Internet based telecommunication services between devices; Arranging access to databases on the internet; Providing access to portals on the Internet; Providing access to information via the Internet; Providing access to platforms on the Internet; Providing access to web sites on the internet; Providing user access to portals on the Internet; Providing user access to platforms on the Internet; Providing access to Internet portals for third parties; Provision of access to data via the Internet; Telecommunication services provided via Internet platforms and portals; Providing telecommunications links to the Internet or databases; Providing telecommunication connections to the internet or databases; Providing telecommunications connections to the internet or databases; Providing user access to computer networks and the Internet; Provision of access to computer networks and the internet; Providing telecommunications connections or links to the internet or databases; Provision of telecommunication access and links to computer databases and to the internet.

49. Next, I consider the applicant's following services in class 38:

Digital transmission services; Transmission of data via the Internet enabling electronic devices to exchange data automatically; Wireless transfer of data via the Internet; Digital transmission of data via the Internet; Electronic transmission of computer programs via the internet; Transmission of data by means of the Internet; Transferring information and data via computer networks and the Internet; Transfer of information and data via online services and the Internet; Transferring and disseminating information and data via computer networks and the Internet; Electrical data transmission over a global remote data processing network, including the internet.

50. I consider that the opponent's services cover *broadband transmission [...] services* in class 38. It is my view that broadband transmission services will include the services for the transmission of data via broadband internet. I therefore consider these to be identical to the services outlined above in accordance with the principles set out in *Meric*. However, if I am wrong in this respect, I still consider the services above and broadband transmission services to be concerned with the transmission of data via the internet. The nature of the services will therefore be somewhat similar. Further, I consider that the purpose, that being for the transmission of data from one digital location to another will be shared. Users will likely be shared by way of the general public and/or professionals, and there may be an overlap in trade channels. The method of use will be shared to the extent that the services are all likely to be engaged with an accessed via a computer of some kind. If the services are not considered identical, I still find them to be similar to at least a medium degree.

51. That leaves the following contested services in class 38:

Rental of access time to a database server; providing access to a server enabling electronic devices embedded with software, sensors, actuators and network connectivity to exchange data facilitating devices to be sensed or controlled remotely.

52. To my knowledge, a "server" is an item of computer hardware that is responsible for storing and transmitting information between a computer network and/or a database. The opponent's earlier specification covers *rental or leasing of computer hardware or software* in class 42, and this will in my view, include the rental of servers. I am guided against a finding of identity in this instance, by the fact these services fall into different classes within the specifications and are therefore clearly intended to cover a different scope of services. However, I consider that the rental of a server will share a very similar purpose to the rental of access time or the provision of access to one. The services will be of a similar nature and the trade channels and users will likely overlap due to this, and I consider there is likely to also be an element of competition between these services due to their shared purpose. Overall, I therefore consider these services highly similar.

53. However, in case I am wrong in my considerations above, I note it is also my view that the opponent's earlier class 9 goods *computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information* will include servers such as are described by the contested services. I consider that the servers themselves will be essential to the services for allowing access to, or the rental of access to the same, and the consumer may well believe that the same entity is responsible for offering the services themselves in addition to allowing access to the same. I therefore consider there to be complementarity between the goods and services. Further, I note that the user and trade channels may well be shared. The nature, purpose and method of use will differ, and it is unlikely there will be significant competition between the servers themselves and the provision of access to the same. Overall, I consider the goods and services to be similar to a medium degree.

Class 42

54. As outlined above, I consider the opponent's class 9 goods *computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information and computer software [...] to enable connection to databases and the Internet* will include servers. The applicant's contested services in class 42 include:

Server administration; Server hosting; Remote server administration.

55. I consider that the servers themselves are all essential to the provision of the services outlined above, to the extent that the consumer may believe the goods and services derive from the same economic entity. For example, the entity supplying a server may well provide administration and hosting in respect of the same. I therefore find the goods and services to be complementary. I note the nature, purpose and method of use of the goods and services will not be shared, however, trade channels and users are likely to overlap. Overall, I consider these services to be similar to the opponent's earlier services to a medium degree.

56. The applicant's services in class 42 also include:

Rental of software for computer networks and servers enabling electronic devices to exchange data automatically; Rental of a database server (to third parties); Rental of memory space on servers for hosting electronic bulletin boards.

57. The opponent's earlier services include the following in class 42:

Rental or leasing of computer hardware or software.

58. It is my view that the applicant's goods outlined all fall within the opponent's services above and are therefore identical in accordance with the principles set out in *Meric*.

59. However, if I am wrong in my finding of identity in respect of the applicant's *rental of memory space on servers for hosting electronic bulletin boards*, I nonetheless find these highly similar to the opponent's earlier *rental of computer hardware* which in my view will include the rental of servers. I find the nature of the rental of memory space on servers and the rental of servers themselves to be highly similar, and the purpose to also overlap. Further, I consider there to be competition between the rental of servers themselves and the rental of memory space on servers, due to the overlap in purpose. The users and trade channels are also likely to be shared, but there is no complementarity between the services as such.

60. The applicant's services include the following in class 42:

Programming of software for computer networks and servers enabling electronic devices to exchange data automatically.

61. The opponent's earlier goods include *computer programming* in class 42. It is my view that the applicant's goods fall within the category of *computer programming* and are therefore identical in accordance with the principles set out in *Meric*.

62. The applicant's specification also includes the following services in class 42:

Design and development of software for computer networks and servers enabling electronic devices to exchange data automatically.

63. The opponent's earlier services include *design and development of computer hardware and software supplied as part of or in connection with broadband telecommunications and/or television streaming apparatus* in class 42. I consider that software supplied *in connection with broadband telecommunications and/or television streaming apparatus* as included within the opponent's earlier specification may cover a range of items, including software for networks and servers allowing devices to exchange data automatically. I therefore consider these identical in accordance with the principles set out in *Meric*. However, if I am wrong in this finding, I still find the services similar to at least a medium degree. I find this on the basis that the nature of the services for the design and development of software will overlap, there is an element of overlap in purpose of the services, and the trade channels will likely overlap. Further, there may be a general overlap in users insofar as businesses are concerned. However, if the services are not considered identical, I do not consider these in competition or complementary.

64. The applicant's services in class 42 also include:

Hosting the web sites of others on a computer server for a global computer network.

65. The opponent's earlier services in this class includes *hosting websites*. These are identical to the applicant's services in accordance with the principles set out in *Meric*.

66. The applicant's class 42 services also cover the following:

Providing temporary use of on-line non-downloadable operating software for computer networks and servers.

67. I compare this with the opponent's earlier *rental or leasing of computer hardware or software*. It is my view that rental or leasing services are essentially services for

providing temporary use of an item. I therefore consider that the rental of software covered by the opponent's earlier specification will include the applicant's services as set out above and are therefore identical in accordance with the principles set out in *Meric*. However, if I am wrong in finding identity between these services, I nonetheless find them similar to a very high degree. I consider that the nature of the services for the provision of access of services will be highly similar to that for the rental or leasing of software. Further, I consider the purpose will be shared, and as such there will likely be competition between the same. I also note that users and trade channels will likely be shared.

68. The applicant's specification covers the following services in class 42:

Research relating to the computerised automation of technical processes;
Research relating to the computerised automation of administrative processes;
Research relating to the computerised automation of industrial processes.

69. It is not apparent to me that there will be similarity between these types of research services and the opponent's earlier goods and services. I am not convinced, without further submissions or evidence on this point, that there will be an overlap in nature, purpose, method of use, trade channels or users at more than a general level. Further, I am not convinced that these services are in competition or would be complementary to those relied upon by the opponent. I therefore consider the applicant's services above to be dissimilar to those relied upon by the opponent.



Comparison of marks

70. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

72. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
<p>NOW</p> <p>NOW TV</p> 	

73. The first earlier mark comprises the single word NOW. It is in this word and the mark as a whole that the overall impression resides.

74. The second earlier mark comprises the two elements NOW TV. Being at the beginning of the mark where elements tend to make a bigger impact on the consumer,⁵ I find that the word NOW is both more dominant and more distinctive than TV, and this element plays the largest role in the overall impression of the mark.

⁵ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

75. The third mark is the word NOW in a slightly stylised font inside a black box. Again, it is the word NOW that plays the greatest role in the marks overall impression, with the stylisation and banal black box playing at best, a small role in the same.

76. The contested mark comprises the two main elements, NOW and UK. Whilst UK is clearly the largest element within the mark, it is my view that it is not distinctive on its own for goods and services rendered in the UK (even if it is considered as part of a web address). "NOW" is in my view the most distinctive element of the mark, and therefore plays the greatest role within the overall impression of the same. I also note the full stop following NOW, which may be considered by some consumers as indicative of a dot in a web address, however, either way it plays a minimal role in the overall impression of the mark as a whole.

Visual comparison

77. Visually, all three earlier marks share the word NOW with the contested mark. They all differ on the basis that none of the marks include the initials UK, or the additional full stop.

78. The first earlier mark is a word mark and may be used in the colour red and in the same font as the NOW element in the contested mark. It is arguably also true that it may be presented vertically, but even if I am wrong in this respect, weighing up the similarities and differences, I consider the marks similar visually to a medium degree.

79. The second earlier mark is also a word mark, and so again the NOW element may be used in a similar visual style as it is in the contested mark. In both cases, the word NOW is followed by two letters, albeit two different letters. I note the particular combination of the vertical and horizontal layout for the contested mark and consider this acts as a point of visual difference, as does the full stop. However, overall, I consider the marks visually similar to a medium degree.

80. In respect of the third earlier mark, I note that the word NOW is presented in a stylised font. However, I do not consider that the stylisation chosen is particularly notable, and it does not add considerably to the visual differences. The black square

border, as well as the full stop and the large letters UK previously mentioned do act as points of visual difference, and overall I consider the marks to be visually similar to just below a medium degree.

Aural comparison

81. All of the earlier marks share the first word and syllable NOW. This is placed at the beginning of all of the marks where it will have more impact on the consumer. The contested mark also includes a second verbal element, that being the two syllables made up of the individual letters 'U-K'. The second earlier mark follows the same rhythm aurally, and it is also followed by two letters and two syllables, those being "T-V", however, the letters themselves are aurally different. The first and third contested marks do not contain a second element. Overall, I consider all three earlier marks to be aurally similar to the contested mark to a medium degree.

Conceptual comparison

82. Conceptually, all three earlier marks and the contested mark include the word NOW, meaning at the present time, or immediately. This is the only concept present in the first and third earlier mark. The second earlier mark also conveys the concept of television, and the mark as a whole conveys the notion of television that is up to date or immediately available.

83. The contested mark conveys two concepts, those being of NOW as described, and of the United Kingdom. In my view these elements remain distinct and do not together convey a separate overall meaning. Whilst the dot placed in the mark will in my view result in *some* consumers considering the mark to also be a UK website address, this does not mean the concept of NOW or UK will not also still be conveyed as described. Further, considering its size and the layout of the contested mark, it is in my view likely this dot will go unnoticed by a further significant portion of consumers. I find the first and third earlier marks conceptually similar to at least a medium degree to the contested mark, whilst I consider the second earlier mark to still be conceptually similar to just below a medium degree by way of the shared concept of now, but considering the earlier mark's overall meaning and the concept of UK.

Average consumer and the purchasing act

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

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

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

86. In this instance, there are a large number of relevant similar goods and services to consider. I note the opponent has submitted that the average consumer will be a member of the general public who will purchase the goods with “no special degree of attention or care”. I agree that there will be a selection of goods and service that are primarily or at least jointly targeted at the general public, such as, for example, computer software related to telecommunications and streaming, and internet broadband services. I consider that when choosing software and services, the general public may consider the reliability, speed and functionality of the goods or services offered. I would expect a medium level of attention to be paid. Where large businesses are purchasing these types of goods and services, they will likely be purchased on a larger scale and there will likely be more severe consequences if less reliable goods or services or those with limited or inappropriate functionality are selected, such as a

loss of business time and money. I therefore consider that professional consumers will likely pay between a medium and high level of attention to the same.

87. There are also a number of goods and services that will primarily be targeted at professional consumers, rather than the general public. For example, those such as CCTV and traffic monitoring systems, and services for the design and development of software for example. I consider that factors such as functionality, reliability and reputation may be considered in respect of the same, and I consider that where the similar goods and services are targeted at professional consumers, between a medium and high level of attention will be paid in respect of the same.

88. The goods and services will primarily be purchased visually, being available for purchase on websites or being the subject of visual advertisements. However, I consider that verbal recommendations may also play a part in the purchasing process, and purchases may be made over the phone. I therefore cannot completely discount the aural considerations.

Distinctive character of the earlier trade marks

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee 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).”

90. The distinctive and dominant element of the first and third earlier mark is the word NOW. I have set out the concept of this element earlier in this decision, and note that it conveys the meaning of the present time or of immediacy. In the context of the goods and services, I note this is not highly distinctive inherently, with it at least alluding to goods and services being fast, immediate or up to date. I do not consider that the stylisation or black box present in the third earlier mark adds materially to its inherent distinctiveness, and overall, I consider both the first and third earlier mark to be inherently distinctive to a low degree.

91. I note the second earlier mark includes the additional element TV. Overall, I have already found this mark will convey to the consumer the concept of current or immediate television. Whilst I note that not all of the earlier goods are streaming goods or services, even where they are not, the mark will still allude to the provider of the services also providing services for immediate or current television, as well as, for example, broadband services, and so in any case I do not consider it overly distinctive. Nonetheless, I consider the use of NOW to be more unusual and distinctive than TV in the circumstances, and overall, I consider the mark to again be inherently distinctive to a low degree in respect of all of the goods and services, by virtue of the inclusion of this element.

92. The opponent has also provided evidence in these proceedings. I would therefore normally at this point, consider whether the distinctiveness of the earlier marks has been enhanced through the use of the same. However, when considering this question, it is the perception of the UK consumer at the relevant date, that being the

filing date of the application, that is key. The opponent has filed not filed any material evidence showing the use of its mark in the UK dating from prior to the relevant date, and I note the opponent has filed minimal evidence of its use in any case. I do not consider the opponent to have shown that the distinctiveness of the earlier mark had been enhanced at the relevant date through the use of the same.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

93. Prior to reaching a decision under section 5(2), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 13 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier marks will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.⁶ I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that how the goods and services are obtained may have a bearing on how likely the consumer is to be confused.

94. In respect of section 5(2)(b) of the Act, there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between

⁶ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.⁷

95. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

96. In this case, I found the goods and services to range from identical to dissimilar. Where the goods and services are dissimilar, there can be no likelihood of confusion under section 5(2)(b), and the opposition must fail in respect of the same.⁸ The opposition therefore fails in respect of the following goods and services:

Class 9: NO2 sensors; particle sensors; air quality sensors; weather stations; weather data sensors; pollution sensors; gas sensors; temperature sensors; humidity sensors; air pressure sensors; emissions sensors; artificial intelligent sensors for monitoring air quality; artificial intelligent sensors for monitoring weather; components, parts and fitting for all the aforesaid.

Class 42: Research relating to the computerised automation of technical processes; Research relating to the computerised automation of administrative processes; Research relating to the computerised automation of industrial processes.

97. I therefore continue to consider the opposition in respect of the remaining similar and identical services. I found the earlier marks to all be visually, aurally and conceptually similar to the contested mark to a medium degree, or just below a medium degree. I found all of the earlier marks to be distinctive to a low degree, and I did not find the evidence shows the distinctiveness had been enhanced through use at the relevant date. I found the average consumer will include both members of the general public and professionals, all of whom will pay either a medium or between a

⁷ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

⁸ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

medium and high degree of attention to the purchases made. Considering all of the factors, and particularly the notable differences created visually and aurally between the marks by virtue of the large element UK in the contested mark, which in my view will not go unnoticed or be forgotten, I do not consider there to be a likelihood of direct confusion present between the three earlier marks and the contested mark in this instance. I therefore move on to consider the likelihood of indirect confusion.

98. In *L.A. Sugar* (cited above) Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

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).”

99. I note that the examples above were intended to be illustrative and are not exhaustive. I also keep in mind *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for

concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

100. Further, I also consider *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), in which Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

101. I consider again, all of the factors in this case. Whilst I note it is inherently distinctive only to a low degree, I still found the element NOW to be the most distinctive element of all of the earlier marks and the contested marks. In *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, Emma Himsworth K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHC 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or

are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

100. With the above in mind, I note that I do not consider UK in the contested mark to hold distinctive character for goods and services rendered in the UK. I note this to be the case even where this is considered indicative of a web address, as I find it will simply convey to consumers that any goods and services are available online. Further I consider that TV in the second earlier mark will also be indicative of the types of services offered by the entity responsible for the mark. Whilst I note in the second earlier mark the use of NOW combined with TV conveys to the consumer the overall concept of immediate or current television services, the elements do not form a unit that is more than the sum of its parts, and in the context of the mark as a whole NOW remains the more distinctive element of the mark and maintains an independent role within the same. With consideration to this, it is my view that across all of the marks, the element NOW is the only element capable of indicating origin to the consumers.

102. Whilst I keep in mind the low level of distinctiveness held by NOW, it is my view that the comparison between the first and third earlier mark and the contested mark in the circumstances of this case fall into category b of those set out in *L.A. Sugar* as well as into the exception highlighted at 6(a) in *Face2FaceHR Partners* set out above. It is my view on this basis that there is a likelihood of indirect confusion between these marks in respect of all of the similar goods and services. Further, in respect of the comparison with the second earlier mark, whilst this may not fall directly within category b as identified, it is my view that the consumer will nonetheless identify NOW as an independent indication of origin across all the marks. Considering the additional elements of the marks hold little or no distinctiveness, it would, in my view, be perfectly logical (and likely) for consumers to conclude that the contested mark is simply used as a sub-brand of the earlier mark to indicate the UK branch of the earlier goods and services, or that the earlier mark is being used as a sub brand of the contested mark to indicate a more limited range of goods or services. I therefore find it likely consumers will conclude the marks derive from the same economic origin. Therefore, with consideration to all of the relevant factors, it is my view that there is a likelihood of indirect confusion in respect of all of the goods and services found to be similar in this instance.

103. I consider at this stage, that within its final written submissions, the applicant has proposed that the following limitation be applied to its goods and services, should a likelihood of confusion be found:

“all of the aforementioned [services] relating to pollution, traffic, meteorology and urban or town management”.

104. Tribunal Practice Notice 1/2012 sets out the practice for adding limitations to specifications proposed by the parties to overcome a likelihood of confusion in defended proceedings as follows:

3.2.2 Defended Proceedings

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

- a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;
- b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner.

If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

- c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

- d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered "men's and boys' clothing", thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the 'blue pencilling' approach or the 'save for' type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is

successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal."

105. I note the applicant's proposed limitation to its specification spans all three of its classes. However, whilst I have given thought to this, I do not consider it to be an appropriate solution to the conflict between the marks in this instance.

106. The first problem faced by the applicant, is that in the majority of cases the opponent's own goods and services are not limited to use within a particular field. For example, where I have found the earlier class 38 services *providing access to the internet* to be identical to contested *providing access to the internet via a broadband telecommunications network* in class 38, this conflict will not be removed should the later services read *providing access to the internet via a broadband telecommunications network; all of the aforementioned services relating to pollution, traffic, meteorology and urban or town management.* This is the case in respect of the majority of goods and services compared.

107. Further, I note there are occasions where I have already found similarity between the applicant's goods and the opponent's goods where the applicant's goods are already clearly limited to use in a particular field, for example in the case of those such as *smart devices for monitoring or analyzing traffic, pedestrians, cyclists and pollution or weather conditions* and so again, there is no reason that the limitation suggested by the applicant would remove the conflict in those instances case either.

108. Whilst I have therefore considered the limitation suggested by the applicant in this instance, I do not consider it appropriate (or sufficient) to apply this limitation rather than simply take a blue line approach to remove the conflict between the goods and services.

Final Remarks

109. The opposition has been successful in respect of all of the goods and services found to be similar in this instance, those being:

Class 9: Traffic control devices; traffic tracking devices; pedestrian monitoring devices; camera monitoring devices; close circuit television and devices; radios; antennas; microwave signaling devices; traffic monitoring devices; devices for counting pedestrians, cyclists or vehicles; parking monitors; queue detection monitors; artificial intelligent tracking systems; road use monitoring and tracking devices; smart tracking devices; incident detection devices; smart devices for monitoring or analyzing traffic, pedestrians, cyclists and pollution or weather conditions; artificial intelligence devices and instruments for monitoring and processing data for logistics, weather, traffic, pollution and urban or town management; devices and instruments for detecting and interacting with standard short-range wireless interconnection of mobile electronic devices, phones, computers, and other electronic communications instruments and devices; devices and instruments for detecting and interacting with connected autonomous vehicles; CCTV systems, including display and storage devices and instruments; devices and instruments for video analytics; electronic instruments and devices for traffic management or traffic monitoring; networking instruments and devices; instruments and devices for building a communications network or communications mesh; software for use in or with the aforementioned instruments and devices; components, parts and fitting for all the aforesaid.

Class 38: Internet communication services enabling electronic devices to exchange data automatically; Rental of access time to a database server; Digital communications services; Digital transmission services; Providing internet access; Internet communication services; Internet based telecommunication services between devices; Transmission of data via the Internet enabling electronic devices to exchange data automatically; Arranging access to databases on the internet; Wireless transfer of data via the Internet; Providing access to portals on the Internet; Providing access to information via

the Internet; Digital transmission of data via the Internet; Providing access to platforms on the Internet; Providing access to web sites on the internet; Electronic transmission of computer programs via the internet; Providing user access to portals on the Internet; Providing user access to platforms on the Internet; Providing access to Internet portals for third parties; Transmission of data by means of the Internet; Provision of access to data via the Internet; Telecommunication services provided via Internet platforms and portals; Providing telecommunications links to the Internet or databases; Providing telecommunication connections to the internet or databases; Providing telecommunications connections to the internet or databases; Providing user access to computer networks and the Internet; Provision of access to computer networks and the internet; Transferring information and data via computer networks and the Internet; Providing telecommunications connections or links to the internet or databases; Transfer of information and data via online services and the Internet; Transferring and disseminating information and data via computer networks and the Internet; Electrical data transmission over a global remote data processing network, including the internet; Provision of telecommunication access and links to computer databases and to the internet; providing access to a server enabling electronic devices embedded with software, sensors, actuators and network connectivity to exchange data facilitating devices to be sensed or controlled remotely.

Class 42: Server administration; Server hosting; Remote server administration; Rental of a database server (to third parties); Rental of software for computer networks and servers enabling electronic devices to exchange data automatically; Programming of software for computer networks and servers enabling electronic devices to exchange data automatically; Design and development of software for computer networks and servers enabling electronic devices to exchange data automatically; Rental of memory space on servers for hosting electronic bulletin boards; Hosting the web sites of others on a computer server for a global computer network; Providing temporary use of on-line non-downloadable operating software for computer networks and servers;

110. The opposition fails in respect of the goods and services found to be dissimilar, those being:

Class 9: NO2 sensors; particle sensors; air quality sensors; weather stations; weather data sensors; pollution sensors; gas sensors; temperature sensors; humidity sensors; air pressure sensors; emissions sensors; artificial intelligent sensors for monitoring air quality; artificial intelligent sensors for monitoring weather; components, parts and fitting for all the aforesaid.

Class 42: Research relating to the computerised automation of technical processes; Research relating to the computerised automation of administrative processes; Research relating to the computerised automation of industrial processes.

111. Subject to any successful appeal, the application will proceed to registration in respect of the dissimilar goods and services only.

COSTS

112. Both parties have achieved a measure of success in these proceedings. However, the opponent has achieved a greater measure of success than the applicant, and is therefore entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1280 as a contribution towards the cost of the proceedings. This figure includes a reduction to account for the applicant's partial success. The sum is calculated as follows, in accordance with Tribunal Practice Notice 1/2023:

Official fee:	£100 ⁹
Preparing and filing the TM7:	£300
Preparing and filing the evidence:	£800 ¹⁰

⁹ Whilst an official fee of £200 was paid, the opponent dropped the additional grounds and proceeded only on the basis of section 5(2)(b) of the Act. I therefore consider it appropriate only to account for the official fee relating to this part of the opposition.

¹⁰ I have included in this figure an amount for attending the case management conference relating to the applicant's request for an extension of time to submit its own evidence.

Preparing and filing the final written submissions:	£400
Reduction to account for the applicant's partial success:	-£320
Total:	£1280

113. I therefore order Xan Labs International Ltd to pay Sky UK Limited the sum of £1280. 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 16th day of December 2025

R. Le Breton
For the Registrar