

O/1214/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3839028

IN THE NAME OF BF1SYSTEMS LIMITED

TO REGISTER AS A SERIES OF TWO TRADE MARKS

AURIGADRIVE

AURIGA DRIVE

**IN CLASSES 9, 12, 28, 41
AND 42**

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 439729

BY AURIGA S.P.A.

BACKGROUND AND PLEADINGS

1. On 14 October 2022, BF1SYSTEMS LIMITED (“the applicant”) applied to register **AURIGADRIVE** and **AURIGA DRIVE** as a series of two trade marks in the United Kingdom. The application was accepted and published for opposition purposes on 23 December 2022, in respect of goods and services in classes 9, 12, 28, 41 and 42.

2. The application is opposed by AURIGA S.P.A. (“the opponent”). The opposition was filed on 15 March 2023 and is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in class 9 only and all the services in class 42 only of the application, as listed under paragraph 44 of this decision. The opponent relies upon the following comparable mark:



UK trade mark registration number 914198782

Filing date: 5 June 2015

Registration date: 20 August 2016

Registered in Classes 9, 42 and 45

Relying on goods and services in classes 9 and 42 only, as listed under paragraph 18 of this decision.

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent’s mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.¹

¹ See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

4. The opponent submits that the marks “are similar to an extent that approaches identity” and that the goods and services at issue are either identical or similar to a very high degree, leading to a likelihood of confusion in the marketplace. It requests that the contested application be refused in classes 9 and 42 with a cost order against the applicant.

5. The applicant filed a counterstatement denying the claims. It submits that the marks are sufficiently dissimilar and concern specialist goods and services which are not related. It requests that the application be allowed to proceed to registration, and it requests an award of costs in its favour.

6. During the evidence rounds, only the opponent filed evidence and only the applicant filed written submissions. Neither party requested a hearing, only the opponent filed written submissions in lieu of a hearing. The written submissions of each of the parties will be referred to as and where appropriate during this decision. This decision is taken following careful consideration of the papers on file.

7. In these proceedings, the opponent is represented by Harrison IP Limited and the applicant is represented by ip21 Limited.

EVIDENCE

8. The opponent filed evidence by way of a witness statement dated 9 October 2023 in the name of Vincenzo Fiore, who is the Chief Executive Officer of the opponent, alongside thirty two exhibits labelled **Exhibit VF1** to **Exhibit VF32** accordingly.

9. The main purpose of the evidence is to demonstrate that the earlier mark has been put to genuine use in the EU and the UK during the relevant period in relation to the goods and services relied upon.

10. I have read and considered all of the evidence and I will refer to the relevant parts at the appropriate points in the decision to the extent I consider necessary.

DECISION

11. 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.

12. The trade mark upon which the opponent relies qualifies as an earlier trade mark under Section 6(1) of the Act. The opponent's trade mark had completed the registration process more than five years before the application date of the contested mark, and, as a result, it is, in principle, subject to the provisions on use under Section 6A of the Act. I note that on filing its Form TM8 Notice of Defence and Counterstatement, the applicant has required the opponent to provide proof of use of the mark for all the goods and services on which it relies, being those in classes 9 and 42 only, for which I note that the opponent has made a statement of use.

Proof of Use

13. The relevant statutory provisions under Section 6A of the Act are as follows:

(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
 - (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.

14. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

15. Section 100 of the Act states that:

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

16. The relevant period during which genuine use must be shown is the five years ending with the application date of the contested application, which was 14 October 2022. The relevant period is therefore 15 October 2017 to 14 October 2022. As the opponent's mark is a comparable mark, the territory in which use must be shown is the EU (including the United Kingdom) between 15 October 2017 to 31 December 2020, being prior to IP completion day ("the first relevant period"), and the United Kingdom only from 1 January 2021 to 14 October 2022, being post IP completion day ("the second relevant period").

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

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

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the

goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

Evidence of use

18. Under the Section 5(2)(b) grounds, the opponent has claimed that use has been made of all of the goods and services on which it relies under classes 9 and 42. I must consider whether, or the extent to which, the evidence shows genuine use of the earlier mark in relation to those goods and the services, being:

Class 9 - Personal computers; Programs for computers; Games software; Software; Computer programs [downloadable software]; Computer programmes for data processing; Storage apparatus for computer data.

Class 42 - Software design and development; Support and maintenance services for computer software; Computer software technical support services.

19. The opponent has filed a large volume of evidence in these proceedings. Although I do not intend to summarise the content of each and every exhibit, I acknowledge that in his witness statement, Mr Fiore has provided his own brief explanation of the included exhibits, which I will factor into my assessment accordingly. I note the following from the opponent's evidence:

- The opponent, including predecessors in title, has been operating in Europe including the UK under the AURIGA name since 1992. Exhibit VF1, entitled AURIGA HISTORY, provides background, including a timeline of events from 1992 until 2023. I note the merger of the company Auriga Informatica with Auriganet in 2007 which resulted in Auriga SpA, being the opponent in these proceedings and the registered owner of the earlier mark.
- Mr Fiore states at point 8 of his witness statement that “As implied by the goods and services relied on..., the Earlier Mark is applied to - a world-leading payments and fintech technology system, comprising both software and hardware elements;...”.
- I note that Auriga have actively attended as exhibitors and as sponsors of various conferences and exhibitions held in the UK. This is supported by, inter alia, exhibits VF7, VF10, VF11 and VF12.
- The evidence includes several articles written by Auriga representatives (and in particular Mark Aldred) which highlight the work carried out by the company, as well as other articles and bulletins written by third parties which feature Auriga as “a leading European vendor of advanced multichannel banking software”.²

² At page numbered as 18 of exhibit VF3.

Form of the mark



20. The mark is registered for the figurative mark

21. Section 46(2) of the Act states that:

“... use of a trade mark includes use in a form (“the variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it is registered...”

22. As outlined in *Lactalis McLelland Limited v Arla Foods AMBA*, Case O/265/22,³ the use of the mark in a different form may also constitute use of the mark as registered.

23. As outlined in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12,⁴ the use of the mark encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

24. As submitted by the applicant, there are many incidences within the exhibits where the opponent’s mark appears in conjunction with the additional wording “the banking e-volution”:



25. Despite the differences in presentation of the marks shown above, to my mind the additional words make no material difference to the distinctiveness of the registered mark, with the combined word “AURIGA” and device element playing an independent, dominant role in the variant form of the mark which continues to indicate origin and may be relied upon by the opponent.

³ At [13 – 15]. See also *Hyphen GmbH v EUIPO*, Case T-146/15, at [28-32].

⁴ At [31 – 35].

Assessment on genuine use

26. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods and services at issue in the EU/UK during the relevant five-year period. In making my assessment, I must consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

27. The applicant submits that the opponent's evidence does not prove use of the earlier mark itself for the wide range of goods like software or personal computers because the mark is used with other word elements pointing to the kind of goods and services related with a special niche area of use in the field of financial services.⁵ As already addressed in paragraph 25, I consider that any relevant use of the variant form of the mark as shown within the evidence may be relied upon by the opponent.

28. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself. It is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof: see *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T- 415/09, paragraph 53. I acknowledge that, as per the principles outlined under paragraph 17 of this decision, use of the mark must be more than token, although that use need not always be quantitatively significant for it to be deemed genuine.⁶ I also bear in mind that it is not for me to assess economic success or large-scale commercial use, and that there is no *de*

⁵ See point 12 of the applicant's written submissions filed on 8 January 2024.

⁶ *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

minimis rule - even minimal use may qualify as genuine use if it is use warranted, in the economic sector concerned, to maintain or create market shares for the relevant goods.⁷

29. Case law does not specify particular types of documentation that must be adduced in evidence. When considering the evidence, I am entitled “to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive”: (see *PLYMOUTH LIFE CENTRE*, BL O/236/13, paragraph 22).

30. In response to the applicant’s submissions that the opponent has failed to establish genuine use of the earlier mark, in its submissions in lieu the opponent submits that “the evidence is comprehensive, incontrovertible, and speaks for itself on the question of genuine use of the Earlier Mark over the relevant period for these proceedings”.⁸ I also note that at point 9 of his witness statement, Mr Fiore states that he believes that “even a cursory internet search would reveal that the Earlier Mark is in widespread and genuine use in relation to the goods and services relied on, that it was so at all times during the Relevant Period, and that it has been in such use in the UK in particular for decades”. However, I can only make my decision based on the actual evidence that has been provided by the opponent in these proceedings to support its claim of genuine use.

31. The exhibits provided show the opponent’s presence at exhibitions and conferences in London. The evidence also includes several marketing articles and third party articles and bulletins which outline the role played by the opponent and its AURIGA technology in relation to banking. Exhibit VF1 mentions that the founding company Auriga Informatica specialised in consulting for the management and maintenance of software applications for ATM and Pos systems and then went on to design and develop its own software. The mark is shown within the evidence as registered and as the acceptable variant form (shown above under paragraph 24), and has been included in news and marketing articles and on the

⁷ *Naazneen Investments Ltd v OHIM*, Case T-250/13 at [49].

⁸ At point 16.

conference/exhibition promotions, as demonstrated below (taken from exhibit VF10, exhibit VF12, exhibit VF15 and exhibit VF19):

AURIGA WILL EXHIBIT AT

Stand 1

Self-Service Banking Europe

14th-15th May 2018 | Royal Lancaster London

#SSBE18 | www.rbrlondon.com/ssbe

Logos displayed: rbr EVENTS, alleninternational, Alogent, GENETEC, AURIGA, GLORY, AXIS COMMUNICATIONS, HORIZN.



Auriga is a specialist provider of innovative omnichannel solutions to banks and other financial institutions. Our solutions are founded on modern architectures and facilitate the rapid deployment of new distribution channels and services while lowering costs and building long-term competitive advantage.

www.aurigasp.com | e: marketing@aurigasp.com t: +39 080 56 92 111



Auriga is a leading supplier of software and technological solutions for the banking and payments industries, and a specialist provider of innovative omnichannel solutions to banks and other financial institutions.

AURIGA AND TRANSACTION SYSTEMS JOIN FORCES TO TRANSFORM BANKING SERVICES

Payments, Banking | 10.03.2020 | 12:02 pm



Auriga, a leading supplier of technological solutions for the omnichannel banking and payments industries, today announced a new strategic partnership with [Transaction Systems \(TRSYS\)](https://tr-sys.com/home/), a major international technology solutions provider helping financial and retail organizations embark on their journey towards digital transformation.

32. I remind myself that I must evaluate all the evidence submitted in an overall assessment, and that although pieces of evidence may be insufficient by themselves, they may contribute to proving use in combination.

33. The evidence provided in relation to genuine use of the marks is limited: although the evidence references that Auriga supplies software and technology within the banking sector, there is nothing to show the AURIGA mark on the goods and services at issue themselves. I also note the opponent's submissions that the evidence makes numerous references to the hardware aspect of the AURIGA technology, and it cites exhibits VF7, VF11 and VF12 as each depicting a computer terminal.⁹ However, while the photographs in the exhibits do show a computer terminal, they do not bear the AURIGA mark and from the exhibit it is not clear that the terminals are goods offered by the opponent or if they have been provided at the exhibition for use by the exhibitor. There is no evidence of the pertinent goods and services actually being offered for sale under the mark in the relevant territories during the relevant periods. No figures have been provided to confirm how much, if any, income was generated through participation at the exhibitions and conferences or as a direct result of the articles such as those which mention Auriga as a leading supplier of software and technological solutions for the banking and payments industries.¹⁰ I have no figures outlining the marketing budget or spend for the brand and I have no evidence relating to the size of the corresponding market or the percentage market share enjoyed by the opponent for the class 9 goods and class 42 services per se. I have not been furnished with any data to determine the sales or turnover of the goods and services offered under the mark in the relevant territories during the relevant periods. No invoices have been provided to establish actual sales of either the goods or the services relied upon under the mark for which genuine use has been claimed.

34. That being said, I note the ATM Software 2018 market data in relation to the Italian market as shown under exhibit VF8, and as referred to by Mr Fiore at point 17 of his witness statement where Mr Fiore states that "AURIGA technology was present in

⁹ Paragraph 21 of the opponent's written submissions in lieu of a hearing dated 7 March 2024.

¹⁰ Including exhibits VF15, VF19 and VF24.

70% of Italian ATMs in 2017”, which seems to me to be a substantial share of the ATM market.¹¹ Exhibit VF16 also shows that Auriga software was being used in Portugal’s second largest bank, with its network of over 500 branches. The exhibits also suggest use of the mark in relation to software and technology through the various articles and bulletins, which are written in English and therefore lead me to believe that they are targeted at an English speaking audience. Although there is nothing to say in which territory they were published,¹² the banking industry in the UK and the EU are at the heart of the articles. Evidence of the promotion of the Auriga brand is also clearly indicated through the opponent’s extensive participation, including sponsorship, at exhibitions and conferences which took place at different venues in London throughout the relevant periods. I note that the focus of these exhibitions was related to the banking industry, and in particular, branch transformation through technology, including ATM software. Considering the bigger picture, it seems highly likely that the opponent was using the mark in relation to banking-specific software during this time, as indicated by the exhibits showing the opponent in attendance at the various events.

35. There are many gaps in the evidence, however, having considered the evidence as a whole, on balance, it is my view that the opponent has done enough to demonstrate commercial exploitation of the earlier mark. I consider the evidence provided to be sufficient to allow me to find that there has been genuine use of the mark in relation to at least some of the goods within the relevant period and within the relevant territory.

Fair specification

36. The opponent is relying on a range of goods and services in classes 9 and 42, as listed under paragraph 18 of this decision.

¹¹ I note that the ATM Software 2021 market data is in relation to Western Europe, and in particular Austria, Belgium and Italy (exhibit VF25 and as referenced at point 34 of Mr Fiore’s witness statement) does not mention the UK which was the relevant territory at this time (the second relevant period).

¹² Those articles which were published online, including Auriga’s own, have either a .com or a .net domain rather than, for example, a .co.uk domain or European equivalent.

37. The applicant submits that none of the evidence provided shows the use of the earlier mark for goods such as *Personal computers; Games software; Storage apparatus for computer data*, and at best concern the niche market in the field of banking and finance.

38. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("*Thomas Pink*") at [52].

...

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("*Asos*") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

40. I do not consider that the opponent has provided any evidence of the class 42 services relied upon being offered to third parties. The references to the provision of “technology solutions” is vague and imprecise to the extent that it is not clear if the solution is the software itself or related services being offered by the opponent under the mark. There is no evidence of use of the goods provided under broad terms such as “software” under the class 9 specification. The evidence provided indicates use of the mark only in relation to software specific to banking, being software used in the operation and management of ATMs. Consequently, I consider that a fair specification of the opponent’s goods on which it may rely to be “*banking software for ATMs*”.

Section 5(2)(b)

41. Section 5(2)(b) is relied upon, which reads as follows:

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

(a) ...

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

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

42. I am guided by the following principles which 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, 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

43. As per my earlier findings, the opponent may rely only on “*banking software for ATMs*” in class 9.

44. The applicant’s opposed goods and services are as follows:

Class 9

Scientific, research, navigation, surveying, photographic, cinematographic, audio-visual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching,

transforming, accumulating, regulating or controlling the distribution or use of electricity; Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Recorded and downloadable media, computer software, blank digital or analogue recording and storage media; Computers and computer peripheral devices; data transmission apparatus; data capture apparatus; sensors; electrical and electronic apparatus and instruments for the capturing and transmission of data; computer software and hardware for the transmission of data; gauges; sensors for managing and monitoring vehicle and engine performance; electrical and electronic apparatus and instruments for the capturing and transmission of data; software for analysing data; sensors; computer software for assisting in the design of sports equipment; safety restraints [other than for vehicle seats and sports equipment]; clothing for protection against injury, accident, irradiation or fire; devices and software for establishing location and position including GPS; motor vehicle power locks; computer programs and software (recorded and/or downloadable); software; computer hardware; wire harness components; wiring harnesses; electric wiring harnesses; electrical harnesses; wiring looms; automotive electrical components; motor vehicle electric components; electric components; electro technical components; dashboard display components for use automotive vehicles, aerospace and marine applications; instrument panel components for use in automotive, aerospace and marine applications; protective cases for automotive vehicles, aerospace vehicles and marine vehicles electrical components; housing for electrical wires; carbon fibre housing for electrical wires; carbon fibre protective shell for packaging wires; ducts for housing electrical wires; cases adapted for electronic components; holders for electrical components; electric switches, connectors, conductors, semi-conductors, resistors, capacitors, transistors, diodes, terminals, connectors, cords, switches, resistors, fuses, inductors, transformers, magnetic inductors, batteries, fuel cells, circuits, relays, timers, transducers, sensors, detectors, and transmitters; computer software for assisting in the design of sports equipment; computer games; computer games software; downloadable electronic games; games cartridges for use with electronic games apparatus; computer joysticks; simulators; simulation software; sports training simulators; parts and fittings for all the aforesaid goods.

Class 42

Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; design and development of computer hardware and software; installation, maintenance, repair and upgrading of computer software; development of systems for the transmission of data; providing temporary use of on-line non-downloadable software for the transmission of data; engineering services;

engineering design and consultancy; development services, in particular in the field of motor sports; technical and professional consultancy services; tool design services; scientific and technological services and related research and design services; industrial analysis and research services; computer and software design and development; computer programming; computer software design; computer systems design; computer systems analysis; recovery of computer data; implementation and maintenance of computer software; design, engineering and consultation services relating to motor vehicles, motor vehicle parts, motor vehicle component systems, technical, technological, testing, consultative and advisory services thereto; design, engineering and consultation services relating to aerospace and marine vehicles, aerospace and marine vehicle parts, aerospace and marine vehicle component systems, technical, technological, testing, consultative and advisory services thereto; on-line services, namely, providing information relating to motor, aerospace and marine vehicles and motor, aerospace and marine vehicle parts and accessories; advisory services relating to design engineering; advisory services relating to the design of engineering products; computer aided design engineering services; computer assisted engineering design services; computer-aided design services; consultancy services relating to design; design services for products; design services relating to integrated circuits; design services relating to parts for engines; engineering project management services; engineering project studies; engineering services relating to the design of electronic systems; engineering services relating to engines and parts thereof; furnishing design services for the interiors of automobiles, aerospace and marine vehicles; illustration services (design); project management (technical support); provision of technical advice (provision of technical information, technical advice); technical assessments relating to design; engineering consultancy; consultancy for computer hardware and software and engineering project management; consultancy services relating to advanced engineering and materials technology; advisory services relating to design engineering; advisory services relating to industrial engineering; advisory services relating to the design of engineering products; advisory services relating to the safety of engineering products; Research, design and development in relation to bicycle technology; Information, advisory and consultancy services for the aforesaid.

45. Where the goods or services in the specification of one party are included in a broader term from the other party's specification, those goods or services are considered to be identical: See *Gérard Meric v OHIM*, Case T-133/05 at [29].

46. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

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

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

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

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

49. For the purposes of considering the issue of similarity of the goods, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.¹³

50. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"12. ... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary

¹³ Paragraph 5

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."

51. In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms: *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), at [56].

52. I note that some of the terms within the applicant's specification have been duplicated within the particular class, e.g. the term "sensors" (at large) appears twice within class 9, as does "*electrical and electronic apparatus and instruments for the capturing and transmission of data*". I will refer to each repeated (identical) term once only in the following comparison, however, the same reasoning will apply to all such identical terms.

53. I note that in its statement of grounds, the opponent submitted that the applicant's class 9 goods and its class 42 services are "a combination of identical (whether actually or notionally), near-identical, and/or similar to a very high degree" to those relied upon by the opponent. It went on to state that a "detailed, phrase-by-phrase comparison of the respective goods and services will be contained in the Opponent's written submissions at the appropriate juncture of the opposition...". In the written submissions which followed, the opponent provided a comparison table where certain of the applicant's goods and services have been highlighted in yellow as being considered identical to the goods and services then relied upon (prior to my findings on a fair specification on which the opponent may rely), with the opponent submitting that the remaining (i.e. unhighlighted goods and services) are "exceptionally broad" and that they are similar to a high or very high degree to those of the opponent. However, although at the time the submissions were filed the opponent was still relying on all of the earlier goods and services under classes 9 and 42, a 'detailed, phrase-by-phrase comparison' of those goods and services was not provided.

54. Taking guidance from Iain Purvis KC, sitting as Appointed Person in the *SmartX* trade mark decision,¹⁴ I note the opponent's written submissions and I will proceed to make my own comparison. As per *Separode*, I will approach the comparison of the goods and services at issue by grouping them collectively in as few groups as I consider logical. Further, where the terms listed are particularly wide or vague, I will endeavour to follow the principles outlined in *YouView* and *Skykick* by comparing what I consider to be the core meaning of the goods or services, without affording them neither a too liberal, nor an artificially narrow, interpretation.

55. Pursuant to section 60A of the Act, I am mindful of the fact that the goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes. I also note that in *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense.¹⁵ Meanwhile, in *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.¹⁶

The contested goods in class 9

Recorded and downloadable media, computer software, blank digital or analogue recording and storage media; computer software ... for the transmission of data; software for analysing data; computer programs and software (recorded and/or downloadable); software.

56. I consider that the applicant's broad terms could all encompass the opponent's "*banking software for ATMs*" and as such, the goods are identical as per the principle outlined in *Meric*. If I am wrong in this, then the goods at issue are at least similar in

¹⁴ BL O/0911/24, at [32].

¹⁵ At [24].

¹⁶ Paragraph 20

purpose and method of use, with an overlap in users and channels of trade. It would not be unreasonable for the average consumer to expect the goods at hand to originate from the same or economically related undertakings. As such, I consider them to be highly similar.

Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Computers and computer peripheral devices; data transmission apparatus; data capture apparatus; electrical and electronic apparatus and instruments for the capturing and transmission of data; computer ... hardware for the transmission of data; computer hardware; parts and fittings for all the aforesaid goods.

57. The applicant's above goods comprise hardware rather than software. Although the nature and purpose of these goods are different to the opponent's "*banking software for ATMs*", the software will be employed through the use of such computer hardware and peripherals. While I note that the opponent's goods are targeted specifically towards the banking industry, I see no reason why the applicant's hardware products could not be utilised by consumers in the same industry, resulting in an overlap in users of the respective software and hardware, with the opposing goods sharing the same channels of trade. The goods are not in competition and although they are important to each other, I do not consider them complementary to the extent that the average consumer would automatically expect them to originate from the same provider. Overall, I find the applicant's "*Computers and computer peripheral devices; data transmission apparatus; data capture apparatus; electrical and electronic apparatus and instruments for the capturing and transmission of data; computer hardware*" to be similar to the opponent's "*banking software for ATMs*" to a low to medium degree.

Computer software for assisting in the design of sports equipment; ... software for establishing location and position including GPS; computer games software; simulation software.

58. While the applicant's above goods are all computer software and as such there is an overlap with the opponent's "*banking software for ATMs*", the respective goods are

designed to be used for very different purposes and by different target users. The goods are neither complementary nor in competition, and, given their specific functions, they are unlikely to share channels of trade. Overall, I consider that any intrinsic connection between the goods is insufficient for an overall finding of similarity.

Scientific, research, navigation, surveying, photographic, cinematographic, audio-visual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; sensors; gauges; sensors for managing and monitoring vehicle and engine performance; sensors; safety restraints [other than for vehicle seats and sports equipment]; clothing for protection against injury, accident, irradiation or fire; devices ... for establishing location and position including GPS; motor vehicle power locks; wire harness components; wiring harnesses; electric wiring harnesses; electrical harnesses; wiring looms; automotive electrical components; motor vehicle electric components; electric components; electro technical components; dashboard display components for use automotive vehicles, aerospace and marine applications; instrument panel components for use in automotive, aerospace and marine applications; protective cases for automotive vehicles, aerospace vehicles and marine vehicles electrical components; housing for electrical wires; carbon fibre housing for electrical wires; carbon fibre protective shell for packaging wires; ducts for housing electrical wires; cases adapted for electronic components; holders for electrical components; electric switches, connectors, conductors, semi-conductors, resistors, capacitors, transistors, diodes, terminals, connectors, cords, switches, resistors, fuses, inductors, transformers, magnetic inductors, batteries, fuel cells, circuits, relays, timers, transducers, sensors, detectors, and transmitters; computer games; downloadable electronic games; games cartridges for use with electronic games apparatus; computer joysticks; simulators; sports training simulators; parts and fittings for all the aforesaid goods.

59. The applicant's remaining goods in class 9 include a wide variety of goods, some of which are clearly distinct to the opponent's software, such as, inter alia, "*protective cases for automotive vehicles, aerospace vehicles and marine vehicles electrical components*" and "*clothing for protection against injury, accident, irradiation or fire*".

While the above listed goods include some broad terms, some of which will be reliant on software in order to function, I do not think that any of the goods could be feasibly conceived as encompassing “*banking software for ATMs*”. Taking my guidance from the *YouView* and *Unicorn* judgements, pragmatically, I consider the applicant’s goods to be different in nature, purpose and method of use to those of the opponent, and the goods are neither in competition nor complementary. In the absence of evidence to the contrary, I find the applicant’s goods listed above and the opponent’s “*banking software for ATMs*” to be dissimilar.

The contested services in class 42

Providing temporary use of on-line non-downloadable software for the transmission of data; Information, advisory and consultancy services for the aforesaid.

60. While I acknowledge that services are not the same as goods, the applicant’s above services and the opponent’s “*banking software for ATMs*” in Class 9 may be in competition, with the user electing to either rent (use temporarily) the applicant’s software (which could encompass the opponent’s specific banking software) or alternatively choosing to purchase equivalent software as goods, with information and advice being provided in relation to either option. As such, there is likely to be an overlap in users and trade channels, although the precise method of use and nature of the goods and services will be different. Consequently, I consider the applicant’s “*Providing temporary use of on-line non-downloadable software for the transmission of data; Information, advisory and consultancy services for the aforesaid*” and the opponent’s “*banking software for ATMs*” to be similar to a medium degree.

Design and development of computer ... software; installation, maintenance, repair and upgrading of computer software; ... software design and development; computer software design; implementation and maintenance of computer software; consultancy for computer ... software ... ; Information, advisory and consultancy services for the aforesaid.

61. I consider that there will be an overlap in users and trade channels of the opponent’s “*banking software for ATMs*” in class 9 with the applicant’s services as

listed above, which could encompass services that are specifically tailored to banking software. While the goods and services are different in nature and method of use, they enjoy a symbiotic relationship, and I consider them to be complementary to the extent that the average consumer could reasonably expect the same or economically linked undertakings to provide both the goods and the design and development, installation, maintenance, repair and upgrading of those goods, as well as information and advice (consultancy) in relation to the respective goods and services. I therefore consider the earlier “*banking software for ATMs*” in Class 9 to be similar to the applicant’s services in Class 42 to a low to medium degree.

Computer programming; recovery of computer data; Information, advisory and consultancy services for the aforesaid.

62. While there is likely to be an overlap in end users, I consider this to be insufficient on its own to support a finding of similarity between software itself and computer programming or data recovery services. The methods and purpose of use as well as the channels of trade will be different, and I do not consider them to be complementary in a trade mark sense. I consider the applicant’s “*Computer programming; recovery of computer data; Information, advisory and consultancy services for the aforesaid*” to be dissimilar to the opponent’s “*banking software for ATMs*” in Class 9.

Design and development of computer hardware ... ; development of systems for the transmission of data; computer ... design and development; computer systems design; computer systems analysis; consultancy for computer hardware ... ; Information, advisory and consultancy services for the aforesaid.

63. The opponent’s “*banking software*” in class 9 is clearly different to the applicant’s “*Design and development of computer hardware ... ; development of systems for the transmission of data; computer ... design and development; computer systems design; computer systems analysis; consultancy for computer hardware ... ; Information, advisory and consultancy services for the aforesaid*” in class 42. The applicant’s above services relate directly to hardware and computer systems rather than the opponent’s software, and as such are further removed than the services considered earlier under paragraph 61. The nature, purpose and method of employ of the services

at issue are different, with different users to the opponent's "banking software for ATMs". I do not consider the goods and services to be either in competition or complementary, which I consider overall to be dissimilar.

... Technological services ... and design relating thereto; ... technological services and related ... design services; consultancy services relating to design; design services for products; technical and professional consultancy services; Information, advisory and consultancy services for the aforesaid.

64. The applicant's various technological, consultancy and design services are so broad that it is feasible that they could be offered in relation to the opponent's "banking software" in class 9. However, I again remind myself that the goods and services are not the same in nature, purpose or method of use, and, taking guidance from *Skykick*, and *RALEIGH INTERNATIONAL*, given the overly broad nature of the services and without evidence to the contrary, I find the applicant's services listed above and the opponent's "banking software for ATMs" to be too far removed to be considered similar.

Scientific ... services and research and design relating thereto; industrial analysis, industrial research and industrial design services; engineering services; engineering design and consultancy; development services, in particular in the field of motor sports; tool design services; scientific ... services and related research and design services; industrial analysis and research services; design, engineering and consultation services relating to motor vehicles, motor vehicle parts, motor vehicle component systems, technical, technological, testing, consultative and advisory services thereto; design, engineering and consultation services relating to aerospace and marine vehicles, aerospace and marine vehicle parts, aerospace and marine vehicle component systems, technical, technological, testing, consultative and advisory services thereto; on-line services, namely, providing information relating to motor, aerospace and marine vehicles and motor, aerospace and marine vehicle parts and accessories; advisory services relating to design engineering; advisory services relating to the design of engineering products; computer aided design engineering services; computer assisted engineering design services; computer-aided design services; design services relating to integrated circuits; design services relating to

parts for engines; engineering project management services; engineering project studies; engineering services relating to the design of electronic systems; engineering services relating to engines and parts thereof; furnishing design services for the interiors of automobiles, aerospace and marine vehicles; illustration services (design); project management (technical support); provision of technical advice (provision of technical information, technical advice); technical assessments relating to design; engineering consultancy; consultancy for ... engineering project management; consultancy services relating to advanced engineering and materials technology; advisory services relating to design engineering; advisory services relating to industrial engineering; advisory services relating to the design of engineering products; advisory services relating to the safety of engineering products; Research, design and development in relation to bicycle technology; Information, advisory and consultancy services for the aforesaid.

65. The applicant's remaining services in class 42 include a broad range of services which bear no clear link with the opponent's software in class 9, such as, inter alia, "furnishing design services for the interiors of automobiles, aerospace and marine vehicles". In the absence of evidence to the contrary, I find the applicant's services listed above and the opponent's "banking software for ATMs" to be dissimilar.

66. Under section 5(2)(b), a degree of similarity between the goods and/or services is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA. In relation to those goods and services which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of them, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

67. The average consumer is a legal construct, who is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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, at [26].

68. While the applicant's goods and services in common are unqualified, and could therefore include the general public, the opponent's goods are specifically in relation to banking software for ATMs, which are encompassed by the applicant's broader terms. As such the average consumer for the overlapping goods and associated services will be business consumers within the banking industry, and those goods and services are likely to be sourced from specialist providers, by both visual and aural means. Given the nature of the goods and services, overall, I would expect the level of attention paid during the selection and purchasing process to be between a medium to high degree.

Comparison of marks

69. 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 in *Bimbo SA v OHIM* Case C-591/12P, 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.”¹⁷

70. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks

¹⁷ Paragraph 34

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

71. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks
	<p style="text-align: center;"><u>Series of 2</u></p> <p style="text-align: center;">AURIGADRIVE</p> <p style="text-align: center;">AURIGA DRIVE</p>

Overall impression

72. The opponent's mark comprises the word AURIGA presented in a stylised black typeface in capital letters with a device element of a curved red line positioned to the left of the word and extending above and below the word as far as the letter R. I do not consider the stylisation of the word element to be particularly striking or to deviate greatly from a standard font. While the device element is unlikely to go unnoticed, it plays a lesser role in the overall impression of the mark, which I consider to be dominated by the word itself.

73. The applicant's mark has been accepted and published as a series of two marks, pursuant to section 41(2) of the Act. They each comprise identical elements, being the word(s) "AURIGADRIVE/AURIGA DRIVE", with the only difference being the space between the components AURIGA and DRIVE in the second mark of the series, which are conjoined in the first mark of the series. In my view, there is a natural break between the second letter A and the letter D in the first mark, which would lead the average consumer to perceive it as two separate words, "AURIGA" and "DRIVE". In *Usinor SA v OHIM*, Case T-189/05, the GC found that:

"62. ... it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd

Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57)”

The marks are presented in a standard black typeface in capital letters. As the marks contain no other elements, the overall impression therefore rests in the word(s) themselves. For convenience, I will from this point refer to the series in the singular, though my comments should be taken as referring equally to both marks in the series, unless expressed otherwise.

74. in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case.

Visual comparison

75. Both parties' trade marks comprise the same first six letters "A U R I G A", which appear in the same order in both marks, presented in capital letters in both, albeit that the word in the opponent's mark possesses a degree of stylisation. The word element of the opponent's mark is wholly encompassed within the applicant's mark, which contains the additional letters "D R I V E" following the common element, while the opponent's mark contains the additional device element as previously described. Although I do not consider that this device element will be overlooked by the average consumer, in my view it is the word element within the opponent's composite mark to which the eye is drawn. While the differing elements create a visual disparity, considering the marks as a whole, taking into account the position of the identical word element "AURIGA" at the beginning of the applicant's mark, I find there to be a medium degree of visual similarity between them.

Aural comparison

76. The common element in the competing marks is the word “AURIGA”, which would be pronounced identically in each mark as three syllables OAR-REE-GAH. Both word elements in the contested mark would be articulated, the whole being voiced as four syllables, OAR-REE-GAH-DRIVE. The device element in the opponent’s mark would not be voiced. Having considered the similarities and the differences, I find there to be a medium degree of aural similarity between the marks.

Conceptual comparison

77. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - *Case C-361/04 P Ruiz-Picasso and others v OHIM* [2006]¹⁸.

78. In the statement of grounds, the opponent submits that the word “AURIGA” has no meaning in English but is an Italian word meaning “charioteer”. In its counterstatement, the applicant submits that “AURIGA” has a “well-known meaning” being “a conspicuous constellation in the N hemisphere between the great Bear and Orion” (according to the Collins English dictionary). The applicant further submits that the mark “alludes to a charioteer in Latin”. However, while the word AURIGA may be dictionary-defined, the applicant has provided no evidence to support that a significant proportion of the average consumer would be aware of or attach any such meanings to the word AURIGA as submitted by the applicant. I note that the applicant also submits that the word “DRIVE”, (which is present only in the contested mark), cannot be taken in isolation and must always be considered in combination with AURIGA. To my mind, the words “AURIGA” and “DRIVE” do not naturally fit together. Regardless that the two components are conjoined in the first mark of the series, I consider that to a significant proportion of consumers, the “AURIGA” element of the applicant’s composite mark will be perceived as having an independent, distinctive significance: see *Whyte and Mackay Ltd v Origin Wine UK Ltd*,¹⁹ where Arnold J. (as he was then)

¹⁸ Paragraph 56.

¹⁹ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch).

considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson* in relation to such composite marks.

79. Although the dictionary-defined "DRIVE" element of the applicant's mark would have an easily recognisable concept when viewed in isolation, it is my view that the word "AURIGA" which is common to both marks will most likely be seen by a significant proportion of the average consumer as a wholly invented word with no such recognisable conceptual content and as such the marks overall are conceptually neutral.

Distinctive character of the earlier mark

80. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

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

"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)."

82. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented

words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

83. I note the applicant's submissions that the word "AURIGA" refers to a constellation, and that it also alludes to a charioteer in Latin, while the opponent has submitted it is an Italian word meaning "charioteer". To my mind, even if the average consumer were aware of the meaning of the word, it does not in any way evoke the goods at issue, being "*banking software for ATMs*". As considered earlier in this decision, I hold the view that a significant proportion of the average consumer of the goods would see the mark "AURIGA" as an invented word with no allusive qualities. As such, I consider the earlier mark to possess a high degree of inherent distinctiveness.

84. Earlier in this decision I considered the evidence filed by the opponent to support genuine use of the mark, which overall I considered to be limited in its extent. Even allowing that the evidence demonstrates enhanced distinctive character through use within the relevant period in the UK, being the territory relevant to the assessment of enhanced distinctiveness, given that I have already found the earlier mark to be inherently distinctive to a high degree, it is unlikely that any finding of enhanced distinctiveness greatly improves the opponent's already strong position on this front. I do not therefore intend to consider the evidence further.

Likelihood of confusion

85. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

86. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

87. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

88. Earlier in this decision, I found that the contested goods and services ranged between dissimilar to the opponent’s goods to identical as per the principle set out in *Meric* (or as an alternative, to be highly similar). I considered that the selection process would be made by a combination of visual and aural means, and that overall, the average consumer, being a business consumer within the banking industry who would most likely source the overlapping goods and services from specialist providers, would pay between a medium to high degree of attention during the selection process. I considered the competing trade marks to be visually and aurally similar to a medium degree. I noted the applicant’s submissions relating to the concept of the marks, and I acknowledged that the consumer would understand the concept of the word “DRIVE” when viewed in isolation. Further, in my view, a significant proportion of the relevant consumer would perceive the “AURIGA” element of the applicant’s composite mark as having an independent, distinctive significance, as per *Medion*. As the applicant has not provided any evidence to support its submissions, to my mind, the shared “AURIGA” element would be seen as conceptually neutral to a significant proportion of the average consumer. I found the earlier mark to be inherently distinctive to a high degree.

89. I have weighed up each of the competing factors in my decision, including the differences as well as the similarities between the competing marks. The average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. In spite of the degree of attention paid during the selection of the goods and services, given the high degree of inherent distinctive character of the earlier mark, as well as the degree of visual and aural similarity between the marks, in my view, the similarities between the marks are such that they are likely to be mistakenly recalled as each other. Consequently, I

consider there to be a likelihood of direct confusion in relation to all the opposed goods and services for which a degree of similarity was found.

CONCLUSION

90. The opposition under section 5(2)(b) succeeds in respect of the following goods and services only:

Class 9

Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Recorded and downloadable media, computer software, blank digital or analogue recording and storage media; Computers and computer peripheral devices; data transmission apparatus; data capture apparatus; computer software and hardware for the transmission of data; electrical and electronic apparatus and instruments for the capturing and transmission of data; software for analysing data; computer programs and software (recorded and/or downloadable); software; computer hardware; parts and fittings for all the aforesaid goods.

Class 42

Design and development of computer ... software; installation, maintenance, repair and upgrading of computer software; providing temporary use of on-line non-downloadable software for the transmission of data; ... software design and development; computer software design; implementation and maintenance of computer software; consultancy for computer ... software ... ; Information, advisory and consultancy services for the aforesaid.

91. Subject to any successful appeal, the application by BF1SYSTEMS LIMITED may proceed to registration for the remaining goods and services, as follows:

Classes 12, 28 and 41 in their entirety (unopposed)

Class 9

Scientific, research, navigation, surveying, photographic, cinematographic, audio-visual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-

saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; sensors; gauges; sensors for managing and monitoring vehicle and engine performance; sensors; computer software for assisting in the design of sports equipment; safety restraints [other than for vehicle seats and sports equipment]; clothing for protection against injury, accident, irradiation or fire; devices and software for establishing location and position including GPS; motor vehicle power locks; wire harness components; wiring harnesses; electric wiring harnesses; electrical harnesses; wiring looms; automotive electrical components; motor vehicle electric components; electric components; electro technical components; dashboard display components for use automotive vehicles, aerospace and marine applications; instrument panel components for use in automotive, aerospace and marine applications; protective cases for automotive vehicles, aerospace vehicles and marine vehicles electrical components; housing for electrical wires; carbon fibre housing for electrical wires; carbon fibre protective shell for packaging wires; ducts for housing electrical wires; cases adapted for electronic components; holders for electrical components; electric switches, connectors, conductors, semi-conductors, resistors, capacitors, transistors, diodes, terminals, connectors, cords, switches, resistors, fuses, inductors, transformers, magnetic inductors, batteries, fuel cells, circuits, relays, timers, transducers, sensors, detectors, and transmitters; computer software for assisting in the design of sports equipment; computer games; computer games software; downloadable electronic games; games cartridges for use with electronic games apparatus; computer joysticks; simulators; simulation software; sports training simulators; parts and fittings for all the aforesaid goods.

Class 42

Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; design and development of computer hardware...; development of systems for the transmission of data; engineering services; engineering design and consultancy; development services, in particular in the field of motor sports; technical and professional consultancy services; tool design services; scientific and technological services and related research and design services; industrial analysis and research services;

computer ... design and development; computer programming; computer systems design; computer systems analysis; recovery of computer data; design, engineering and consultation services relating to motor vehicles, motor vehicle parts, motor vehicle component systems, technical, technological, testing, consultative and advisory services thereto; design, engineering and consultation services relating to aerospace and marine vehicles, aerospace and marine vehicle parts, aerospace and marine vehicle component systems, technical, technological, testing, consultative and advisory services thereto; on-line services, namely, providing information relating to motor, aerospace and marine vehicles and motor, aerospace and marine vehicle parts and accessories; advisory services relating to design engineering; advisory services relating to the design of engineering products; computer aided design engineering services; computer assisted engineering design services; computer-aided design services; consultancy services relating to design; design services for products; design services relating to integrated circuits; design services relating to parts for engines; engineering project management services; engineering project studies; engineering services relating to the design of electronic systems; engineering services relating to engines and parts thereof; furnishing design services for the interiors of automobiles, aerospace and marine vehicles; illustration services (design); project management (technical support); provision of technical advice (provision of technical information, technical advice); technical assessments relating to design; engineering consultancy; consultancy for computer hardware ... and engineering project management; consultancy services relating to advanced engineering and materials technology; advisory services relating to design engineering; advisory services relating to industrial engineering; advisory services relating to the design of engineering products; advisory services relating to the safety of engineering products; Research, design and development in relation to bicycle technology; Information, advisory and consultancy services for the aforesaid.

COSTS

92. Both parties have enjoyed a share of success, with the greater part going to the applicant, who is, in principle, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 1/2023. I have made a

reduction to the costs to reflect the partial extent of the success. Applying the guidance in that TPN, I consider the following to be fair:

Considering the notice of opposition, and filing a counterstatement:	£400
Considering the evidence of the other side, and filing written submissions:	£1,000
Total:	£1,400

93. I therefore order AURIGA S.P.A. to pay BF1SYSTEMS LIMITED the sum of £1,400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 23rd day of December 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General