

O-642-20

TRADE MARKS ACT 1994









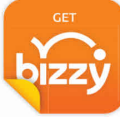


**IN THE MATTER OF TRADE MARK APPLICATION NOS. 3352819, 3362116,
3362117, 3362119, 3362123, 3362126 & 3362128
BY STARTMONDAY INNOVATIONS LIMITED**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER NOS.
416362, 416364, 416365, 416366, 416367, 416369 & 416378 BY BIZY, LLC**

BACKGROUND & PLEADINGS

1. On 12 November 2018 and 19 December 2018, Startmonday Innovations Limited (“the applicant”) filed seven trade mark applications, all of which consist of a series of two trade marks. A summary of the applications is as follows:

Trade mark no.	Trade marks	Classes applied for
3352819	BIZZY LABS & BIZZYLABS	9, 35, 36, 38, 41, 42 & 45
3362116	 & 	9 & 35
3362117	 & 	9 & 35
3362119	 & 	9 & 35
3362123	 & 	9 & 35,
3362126	 & 	9 & 35
3362128	.bzy & 	9, 35, 36, 38, 41, 42 & 45

2. The specifications of all the applications in classes 9, 35, 38, 41, 42 and 45 are identical, with the specifications in class 36 only differing to the extent that application

no. 3352819 contains the phrase “authentication and verification services in relation to online payment or transfer of funds” which does not appear in trade mark no. 3362128. As application no. 3352819 contains all of the goods and services contained in the various applications, a full list of the goods and services in this application is shown in Annex A.

3. On 16 May 2019, the applications were opposed by Bizy, LLC (“the opponent”); I shall return to the extent of the oppositions below. The oppositions are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon all the goods and services (shown in paragraph 17) in an International Registration designating the European Union (“IREU”) no. 1170489 for the word **BIZY** which designated the EU on 9 July 2013 (claiming an international convention priority date of 11 January 2013 from an earlier filing in the United States) and for which protection in the EU was granted on 15 December 2014.

4. The applicant filed counterstatements in which, inter alia, it denies there is a likelihood of confusion.

5. In these proceedings, the opponent is represented by Wilson Gunn (“WG”). Although originally represented by Trade Mark Wizards Limited (who completed the counterstatements), from 3 October 2019, the applicant has represented itself. Although neither party filed evidence or asked to be heard, the opponent elected to file written submissions (dated 3 February 2020) in lieu of attendance at a hearing.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act 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.

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.”

7. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. The trade mark upon which the opponent is relying qualifies as an earlier trade mark under the above provisions. Given the interplay between the date on which the

opponent's trade mark was granted protection and the application dates of the trade marks being opposed, the earlier trade mark is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent can rely upon all the goods and services claimed without having to demonstrate that it made genuine use of them.

Case law

9. The following principles are gleaned from the decisions of the courts of the European Union 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 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 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 will wrongly 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

10. Question 4 of the Form TM7 (Notice of opposition) reads:

“Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark you have listed at Q1?”

11. In response to that question, the opponent ticked the box which reads “Some goods and services” and added “See continuation sheet.” Attached to the various Forms TM7 were continuation sheets in which the opposed goods and services were identified. On 1 June 2020, I wrote to WG, stating:

“The above set of consolidated proceedings has been passed to me to issue a decision from the papers. Having reviewed the papers, it appears there is a discrepancy between the goods and services originally opposed and those referred to in your written submissions dated 3 February 2020.

A review of the seven Notices of opposition indicates that the opponent is opposing a range of goods and services in classes 9, 35, 36 and 42, details of which are provided in continuation sheets attached to the various Forms. Having reviewed these continuation sheets and compared them with the written submissions mentioned, it appears that in the latter, all of the goods in class 9 are being opposed and reference is made to various services in classes 35 and 42 which it appears were not the subject of the original oppositions. In addition, the references to “the contested services” in paragraphs 14, 15, 16 and 17 of the written submissions, suggest that the “contested services” listed are the only services to which the opponent now objects.

It is possible that I have misunderstood the position. However, before I can proceed, I would be grateful if you could review the position and provide clarification. Given the current disruption, **a period of 1 month from the date of this letter is allowed for this purpose.** Such clarification should be copied to the applicant, **who is then allowed a further 1 month from the date it receives the opponent's clarification, in which to comment.** At the conclusion of those periods, I will review the matter and advise the parties how I intend to proceed.”

12. WG responded in an email dated 22 June 2020 (copied to the applicant by WG on 23 June). WG stated:

“Having carefully reviewed the issues raised by you, I have revised our written submissions accordingly, and these are attached. You will note that only page 8 required revision.

Apart from services in Class 36, the Opponent maintains its opposition to all the contested services in Classes 35 and 42 as listed in the Notices of Opposition. Further, those services not listed in the Notices of Opposition have been removed from the submissions.”

13. Although the applicant had until 23 July 2020 in which to comment, this period was extended to 30 July 2020 under the Interrupted Days provisions implemented by the IPO following the Covid outbreak in March 2020. The applicant elected not to comment on the opponent's revised submissions.

14. On 22 September 2020, I wrote to WG again. The operative part of that letter reads as follows:

“I have now reviewed the opponent’s amended written submissions in light of the goods and services originally identified by it in its Notices of opposition. In your email of 22 June, you state:

“Apart from services in Class 36, the Opponent maintains its opposition to all the contested services in Classes 35 and 42 as listed in the Notices of Opposition...”.

A list of all the contested goods and services as identified by the opponent in its Notices of oppositions are shown in bold in the Annex to this letter.

It appears to me that in its amended written submissions the opponent is maintaining the approach it adopted in its original written submission i.e. by suggesting that it is opposing all of the goods in class 9, rather than only those goods identified by it in its original Notices of opposition (as shown in bold in the Annex). In addition, insofar as class 36 is concerned, in your email of 22 June, you use the words “Apart from services in class 36”. Consequently, it is not clear to me if the opponent is maintaining its opposition against all of the services in class 36 originally identified in its Notices of opposition, or only those services in class 36 identified in paragraph 15 of its amended written submissions. Finally, in paragraph 17 of its amended submissions, the opponent indicates it is opposing “installation, maintenance and repair of computer software” in class 42. However, as far as I can tell, these services do not appear in the list of services originally opposed.

Before I can proceed, I need further clarification on the points mentioned. The opponent is allowed seven days from the date of this letter to provide such clarification which, as before, should be copied to the applicant who is then allowed seven days from its receipt of same in which to comment.”

15. WG responded to that request in an email dated 29 September 2020 in which, inter alia, it stated:

“As a result of your comments which have been taken on board I attach a second revision of our written submissions. Please note the revisions are in red and deleted goods in Class 9 and services in Class 42 are shown as being struck through.

With regard to the contested services in Class 36, paragraph 15 has been amended to make it clear that the opponent is maintaining its opposition to all those services identified in the Notices of Opposition.

Turning to Class 42, tautology appears to be in play. The Notices of Opposition identify the contested services as “installation and maintenance of computer software” and consequently we have deleted “and repair” from paragraph 17.”

16. The applicant did not respond to the opponent’s revised submissions either by the deadline set or by the date of the issuing of this decision. I begin by noting that the opponent is not opposing the services in classes 38, 41 and 45 (which only appear in application nos. 3352819 and 3362128).

17. On the basis of the response provided by WG in its second amended written submissions mentioned above, and in the absence of any request to amend the pleadings, the goods and services being opposed are only those identified in the Notices of opposition. Thus the comparison I am required to make is as follows:

The opponent’s goods and services	The applicant’s goods and services being opposed (as identified in the Notices of opposition)
Class 9 - Downloadable computer software, namely collaboration software	Class 9 - Computers; software; computer software; mobile application software;

<p>for the conception, facilitation, analysis, evaluation and execution of ideas, knowledge, processes and procedures.</p> <p>Goods and services limited to: Downloadable computer software, namely, collaboration software for sharing data and information between users engaged in the conception, facilitation, evaluation and execution of ideas, knowledge, processes and procedures.</p> <p>Class 42</p> <p>Providing temporary use of non-downloadable software, namely collaboration software for the conception, facilitation, analysis, evaluation, and execution of ideas, knowledge, processes and procedures.</p> <p>Goods and services limited to: Providing temporary use of non-downloadable software, namely, collaboration software for sharing data and information between users engaged in the conception, facilitation, evaluation and execution of ideas, knowledge, processes and procedures.</p>	<p>downloadable software; downloadable publications; computer programs used in the field of electronic commerce transactions; software relating to digital and virtual currency; software for digital and virtual currency, merchant services, exchange of digital and virtual currency to traditional currency, digital and virtual currency and taxes, digital and virtual currency and barter transactions, acquiring digital and virtual currency, the use of digital and virtual currency electronically, and the use of digital and virtual currency as an alternative to traditional currency to obtain goods or services; computer software for use in the monitoring and control of computer and online activity; computer software for providing online transaction security; computer software for use in recruitment; computer software and downloadable computer software, namely, utility software; computer software for providing software updates; user manuals and instructional guides supplied with all of the foregoing; computer software to enable secure transmission of digital information over the Internet and other modes of communication between</p>
---	---

	<p>computing devices; computer software for use in analysis and reporting; application software for cloud computing services; computer software for application and database integration; internet servers; knowledge management software; data analysis software; databases; electronic databases; computer databases; data encryption apparatus; data encoding apparatus; recorded data files; data exchange units; time data generators; data transmission networks; data processing programs; data storage media; data communications software; software for online messaging; apparatus and software for capturing, recording, reproducing, manipulating and transmitting data, images and sounds; video capture software; video recording software; machine learning software; self-educating computer software; computer software for data analytics and application for use in management of data and information; computer software for analysing market information; downloadable computer software for remote monitoring and analysis; downloadable computer software for data analysis, recommendation and decision</p>
--	---

	<p>support based on data analysis and compilation, data mining, knowledge management and research, business process and data optimization, automation of predictive analytic processes, optimization of predictive analytic business decisions, advertising optimization and personalization, document management, business intelligence information gathering and analysis, forecasting and reporting of possible predictive outcomes, application of company and market data and data analytics, accounting and financial reporting and analysis, budgeting, enterprise management, data extraction, data monitoring, statistical compilation of market data, economic forecasting, and market analysis; multi-media software for use in creating presentations, managing databases and accessing and displaying information; software for managing information and documents, including the management of calendars, deadlines, events and letters; application software for mobile computing devices.</p> <p>Class 35 - Advertising; marketing; recruitment services; personnel recruitment, placement services;</p>
--	---

	<p>computerised data verification in relation to the field of recruitment; recruitment advice; freelance recruitment; employment agency and recruitment services, including employment agency and recruitment services provided on-line from a computer database or the Internet; workforce management services; human resource consulting; staffing and outsourcing services; business consultation services in the fields of personnel management, placement and relocation, employee attraction, retention and analysis programmes; recruitment information services; recruitment consultancy services; provision of incentive schemes; business introductory and meetings services and business networking schemes; information relating to business introductory services; information relating to business networking and meetings; provision of trade information, including such services provided electronically; business research services; compilation and systemisation of information into computer databases; data compilation including electronic data compilation; computerised file managing; marketing and promotional services;</p>
--	--

	<p>recruitment advertising services; on-line advertising on a computer network; provision of space on web sites for advertising goods and services, including the provision of job boards in electronic formats; publication of advertisements, including job advertisements; marketing research and marketing studies; business intelligence information gathering and analysis; information and advisory services relating to all the aforementioned services.</p> <p>Class 36 - Virtual currency exchange transaction services for transferable electronic cash equivalent units having specified cash value; provision of prepaid cards and tokens; electronic financial services provided by means of the internet; credit card services; money transfer services; electronic funds transfer services; processing payments to and from third parties; financial transaction services; providing secure commercial transactions and payment options via electronic communications networks; financial transaction services using a mobile device; person-to-person financial services via electronic communications networks; clearing and reconciling</p>
--	---

	<p>financial transactions via electronic communications networks; payment services; electronic payment services; electronic wallet services (payment services); processing electronic payments; payment processing; payment administration services; financial transfers and transactions; payment and receipt of money as agents; currency dealing; financial services provided by mobile telephone connections, near field communication connections, retail point of sale connections and the internet, namely, mobile money transfers; mobile purchasing, namely, providing electronic processing of credit card, debit card, prepaid gift card, stored value card and electronic payments via mobile phone for allowing consumers pay bills and purchase goods and services of others; electronic payment services; automated payment services; processing of payment transactions via the Internet; money transfer services; electronic funds transfer services; automated payment services; payment transaction card services; electronic payment services; credit card and payment card services; financial payment services; information services</p>
--	--

relating to the payment of accounts; payment processing and administration services; all the above services limited to the field of a cryptographically protected virtual currency system, for facilitating digitally recorded financial transactions within an organized, internet-based virtual community, business or social network; authentication and verification services in relation to online payment or transfer of funds.

Class 42 - Data mining in relation to recruitment; electronic data storage and data back-up services; coding of messages; database design and development in relation to recruitment; Installation and maintenance of computer software; creating and maintaining web sites; hosting computer sites; computer network services; technical consultancy services relating to information services; computer programming; hosting and maintenance of cloud services and networks; providing temporary use of non-downloadable computer software to enable users to program, organize and access audio, video, text, multimedia content and third-party computer software programs; Internet services, namely,

	creating indexes of information, sites, and other resources available on global computer networks for others, searching and retrieving information, and other resources available on global computer networks and other electronic communication networks for others; design and development of computer hardware and software; computer software design; design and development of webpages; consultancy in the field of computer hardware and computer software; application service provider featuring application programming interface (API) software for recruitment; software as a service (SAAS) services, featuring software for data analysis; optimization of predictive analytic business decisions; technical data analytics.
--	--

18. 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:

“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”.

19. 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.

20. 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. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words 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."

21. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term "computer software". In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) 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.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

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

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

23. 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 “complementary” means:

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

24. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

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

“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”.

26. I note that the opponent’s goods and services have been limited to those shown above in bold. Both specifications include the word “namely”, as do the applicant’s specifications in classes 9, 36 and 42. The addendum to the Trade Mark Registry’s Classification Work Manual contains the following:

“Including, for example, namely, as well as, in particular, specifically i.e.

While not desirable in specifications since it encourages tautology, such wording should usually not be changed. Such terms are not allowable in Class 35 (with the exception of “namely” see below) for specifications covering retail services as they do not create the legal certainty that is required. However, in other class the terms may be allowed. For example we would allow:

Biocides including insecticides and pesticides Paper articles of stationery in particular envelopes Dairy products namely cheese and butter

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

27. Approached on that basis, the opponent’s specifications are to interpreted as follows:

Class 9 - Downloadable collaboration software for sharing data and information between users engaged in the conception, facilitation, evaluation and execution of ideas, knowledge, processes and procedures.

Class 42 - Providing temporary use of non-downloadable collaboration software for sharing data and information between users engaged in the conception, facilitation, evaluation and execution of ideas, knowledge, processes and procedures.

28. I am satisfied that the average consumer will understand that be it downloadable or not, the opponent’s collaboration software allows computers to work together to allow multiple users to access, for example, shared files, databases etc.

29. In *Separode Trade Mark* BL O-399-10, the Appointed Person stated:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for

registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

I will deal with the matter on a class-by-class basis adopting the approach mentioned above.

The applicant’s goods in class 9

30. In its written submissions, the opponent has identified those goods in class 9 it considers to be identical in bold; those it considers to be similar are, inter alia, underlined. For the sake of convenience, I have incorporated the same markings below. In relation to the goods in class 9, the opponent states:

“12. The law requires that goods or services be considered identical where one party’s description of its goods or services encompasses the specific goods or services covered by the other party’s description (and vice versa): see *Gérard Meric v OHIM*, Case T33/05, GC. It is clear from this ruling that the emboldened contested goods, all being software of one kind or another, are identical to the earlier goods.

13. Most, if not all, of the italicised/underlined contested goods are similar to the earlier goods inter alia on account of being complementary, the relevant public (end users) being the same, and frequently being available through the same trade channels.”

31. The applicant’s specification includes:

Software; computer software; mobile application software; downloadable software; Computer programs used in the field of electronic commerce transactions; software relating to digital and virtual currency; software for

digital and virtual currency, merchant services, exchange of digital and virtual currency to traditional currency, digital and virtual currency and taxes, digital and virtual currency and barter transactions, acquiring digital and virtual currency, the use of digital and virtual currency electronically, and the use of digital and virtual currency as an alternative to traditional currency to obtain goods or services; computer software for use in the monitoring and control of computer and online activity; computer software for providing online transaction security; computer software for use in recruitment; computer software and downloadable computer software, namely, utility software; computer software for providing software updates; computer software to enable secure transmission of digital information over the Internet and other modes of communication between computing devices; computer software for use in analysis and reporting; application software for cloud computing services; computer software for application and database integration; knowledge management software; data analysis software; data processing programs; data communications software; software for online messaging; software for capturing, recording, reproducing, manipulating and transmitting data, images and sounds; video capture software; video recording software; machine learning software; self-educating computer software; computer software for data analytics and application for use in management of data and information; computer software for analysing market information; downloadable computer software for remote monitoring and analysis; downloadable computer software for data analysis, recommendation and decision support based on data analysis and compilation, data mining, knowledge management and research, business process and data optimization, automation of predictive analytic processes, optimization of predictive analytic business decisions, advertising optimization and personalization, document management, business intelligence information gathering and analysis, forecasting and reporting of possible predictive outcomes,

application of company and market data and data analytics, accounting and financial reporting and analysis, budgeting, enterprise management, data extraction, data monitoring, statistical compilation of market data, economic forecasting, and market analysis; multi-media software for use in creating presentations, managing databases and accessing and displaying information; software for managing information and documents, including the management of calendars, deadlines, events and letters; application software for mobile computing devices

32. Various terms in the applicant's specification are broad enough to include the opponent's goods (for example, "software", "computer software", "mobile application software" and "downloadable software"); such goods are to be regarded as identical on the *Meric* principle. The applicant's specification also includes a range of software for specific purposes. Although the intended purpose of such goods may differ from those of the opponent, the nature is the same, they may target the same users, pass thorough the same trade channels and may have a complementary relationship with the opponent's goods and services. As a consequence, the applicant's software for specific purposes is, in my view, similar to the opponent's goods and services to at least a medium degree.

33. The applicant's specification also includes:

Computers; downloadable publications; user manuals and instructional guides supplied with all of the foregoing; internet servers; databases; electronic databases; computer databases; data encryption apparatus; data encoding apparatus; recorded data files; data exchange units; time data generators; data transmission networks; data storage media; apparatus for capturing, recording, reproducing, manipulating and transmitting data, images and sounds

34. The opponent argues that the above goods are similar to its goods and services “on account of inter alia being complementary, the relevant public (end users) being the same, and frequently being available through the same trade channels.” Although the nature of the opponent’s goods and services will differ from those shown above, there may be an overlap in the users, intended purpose and trade channels. To be complementary in the sense outlined in the case law, there must be “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”. In my view (which I do not regard as atypical), the average consumer (to which I will return shortly) will be very familiar with the well-established commercial link between undertakings which conduct a trade in both computer software and computer hardware. As the applicant’s goods mentioned above are, inter alia, either items of computer hardware or are for storing or processing of data, there is also, in my view, a complementary relationship between the opponent’s goods and services and all of the goods in the application listed above resulting in, at least, a low degree of similarity.

Class 35

35. In relation to the applicant’s services in class 35, the opponent states:

“14. The contested services as listed in the Notices of Opposition are similar to both the earlier services and goods. These services in Class 35 usually target the same users, are sold frequently through the same distribution channels and may often be produced or provided by the same undertakings. In some cases these services are also complementary, in particular, but not exclusively, *computerised data verification in relation to the field of recruitment; compilation and systemisation of information into computer databases; data compilation including electronic data compilation;*”

36. I begin by reminding myself of the comments in *Avnet*. The applicant's specification in this class includes a wide range of services which include, for example, "advertising", "marketing", "recruitment", "provision of trade information" and "business research". While the average consumer for such services may include members of the general public, the average consumer is, in my view, more likely to be a business user. The intended purpose of such services is, broadly speaking, to assist undertakings who wish to improve their effectiveness or efficiency, whereas the intended purpose of the opponent's collaborative software is to allow users to, for example, share data and information. Although the nature, intended purpose and method of use of the competing goods and services differs, the users of the competing goods and services may overlap. That level of generality tells one little.

37. In its submissions, the opponent states that the applicant's services in this class are similar to its goods and services as they "...are sold frequently through the same distribution channels and may often be produced or provided by the same undertakings". There is, however, no evidence that undertakings providing the bulk of the services in this class also conduct a trade in software, that "one is indispensable or important for the use of the other..." or that "customers may think that the responsibility for those [goods/services] lies with the same undertaking". Without such evidence I am not in a position to judge whether the opponent's submission has merit. As a consequence, with the exception of the services in this class shown below, I find there is no meaningful degree of similarity between the opponent's goods and services and the remainder of the services in this class.

Computerised data verification in relation to the field of recruitment; compilation and systemisation of information into computer databases; data compilation including electronic data compilation; computerised file managing; information and advisory services relating to all the aforementioned services

38. As the opponent's software is for, inter alia, sharing data and information, there is, in my view, a likely overlap in, at least, the users, intended purpose and trade channels. There is also likely to be a complementary relationship between the competing goods and services in the sense outlined in the case law. Considered overall, there is at least a low degree of similarity between the opponent's goods and services and those shown above.

Class 36

39. In relation to the applicant's services in class 36, the opponent states:

“15. The contested services as listed in the Notices of Opposition, including *providing secure commercial transactions and payment options via electronic communications networks*, are similar to both the earlier services and goods. These services in Class 36 are invariably enabled by the use of software (downloadable or non-downloadable) and usually target the same users; they are also complementary.”

40. Once again, I begin by reminding myself of the comments in *Avnet*. While the users may be the same, the nature, intended purpose and method of use appears to differ. For the reasons outlined above in relation to the bulk of the services in class 35, I reach the same conclusion in relation to all the services in this class, i.e. there is no meaningful degree of similarity between the competing goods and services.

Class 42

41. In relation to the applicant's services in class 42, the opponent states:

“16. The contested services *providing temporary use of non-downloadable computer software to enable users to program, organize and access audio*,

video, text, multimedia content and third-party computer software programs; application service provider featuring application programming interface (API) software for recruitment; software as a service (SAAS) services, featuring software for data analysis are included in the broader category of, or overlap with, the earlier services in Class 42. Therefore, they are identical.

17. The remaining contested services as listed in the Notices of Opposition are similar to both the earlier services and goods. These services in Class 42 usually target the same users, are sold through the same distribution channels and are often produced or provided by the same undertakings. In many cases these services are also complementary, in particular, but not exclusively, *Installation and maintenance of computer software; computer programming; installation, maintenance and repair of computer software; design and development of computer hardware and software; computer software design; consultancy in the field of computer hardware and computer software.*”

42. I agree with the opponent that its services in class 42 are broad enough to include the following services in the applications which are, as a consequence, to be regarded as identical on the *Meric* principle:

Providing temporary use of non-downloadable computer software to enable users to program, organize and access audio, video, text, multimedia content and third-party computer software programs; software as a service (SAAS) services, featuring software for data analysis

43. The opponent’s collaborative software is for sharing data and information. Given the likely overlap in the users, intended purpose, trade channels and complementary relationship, there is, in my view, at least a low degree of similarity between the opponent’s goods and services and the following services in the applications:

Data mining in relation to recruitment; electronic data storage and data back-up services; coding of messages; database design and development in relation to recruitment; Installation and maintenance of computer software; creating and maintaining web sites; hosting computer sites; computer network services; technical consultancy services relating to information services; computer programming; hosting and maintenance of cloud services and networks; Internet services, namely, creating indexes of information, sites, and other resources available on global computer networks for others, searching and retrieving information, and other resources available on global computer networks and other electronic communication networks for others; design and development of computer hardware and software; computer software design; design and development of webpages; consultancy in the field of computer hardware and computer software; application service provider featuring application programming interface (API) software for recruitment; optimization of predictive analytic business decisions; technical data analytics

The average consumer and the nature of the purchasing act

44. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods and services I have found to be identical or similar. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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.”

45. The average consumer of the goods and services I have found to be identical or similar is either a member of the general public or a business user. For both sets of consumers the selection process is, I think, likely to be largely visual in nature with the goods and services being selected from, where appropriate, bricks-and-mortar outlets or on-line. However, aural considerations in the form of, for example, requests/enquiries to suppliers of the goods and services at issue and word-of-mouth recommendations must not be ignored. The average consumer to which the various goods and services will be directed differs as does the potential cost and complexity of the purchasing decision. As a consequence, the degree of care the average consumer will display when selecting the goods and services at issue will also vary. I shall return to this point when I consider the likelihood of confusion.









Comparison of trade marks

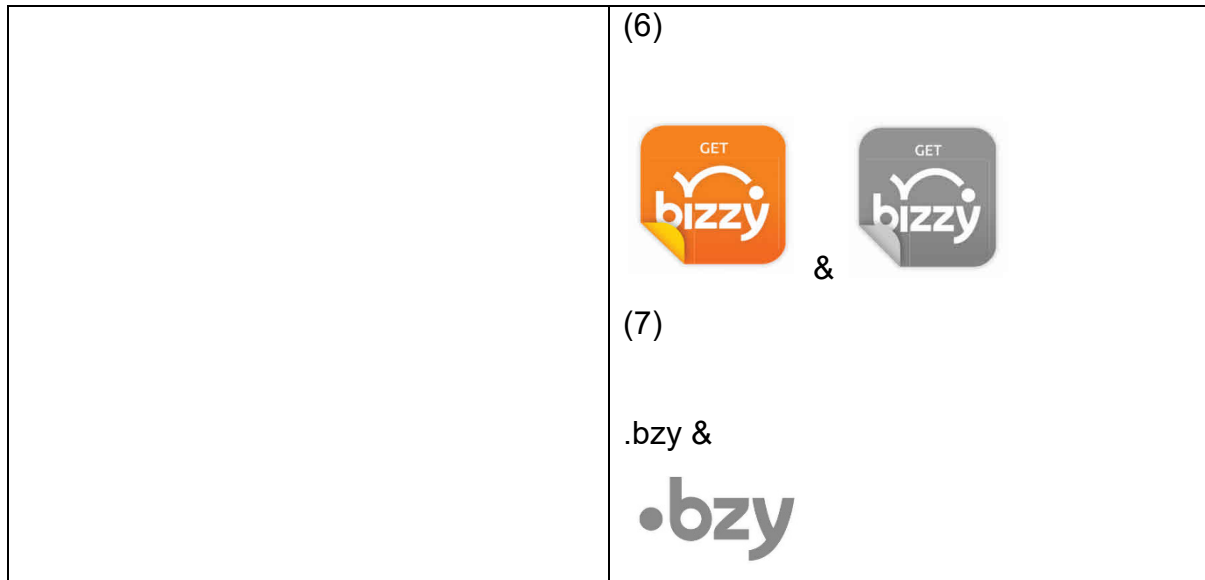
46. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed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

47. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade marks
BIZY	<p>(1) BIZZY LABS & BIZZYLABS</p> <p>(2)  & </p> <p>(3)  & </p> <p>(4)  & </p> <p>(5)  & </p>



Overall impression - the opponent's trade mark

48. This consists of the word "BIZY" presented in block capital letters. The overall impression it conveys and its distinctiveness lies in the single word of which it is composed.

Overall impression – the applicant's trade marks

Trade marks no. (1)

49. These consist of the words "BIZZY" and "LABS" presented as one word and two words respectively. Even when presented as one word, I think the average consumer will readily appreciate that the trade mark consists of the words "BIZZY" and "LABS" conjoined. In its written submissions, the opponent argues that the word "LABS" constitutes "non-distinctive wording", although it does not explain why it considers that to be the case. I infer the opponent is suggesting that the average consumer will interpret the word "LABS" as meaning laboratories i.e. "a building or a room where scientific experiments, analyses, and research are carried out" – collinsdictionary.com

refers. While the opponent's argument may have some force in relation to some of the opposed goods and services, it does not, in my view, apply to them all. Although both words will contribute to the overall impression the applicant's trade marks convey, given its positioning as the first word in both trade marks, it is the word "BIZZY" that will, in my view, have the highest relative weight in the overall impression conveyed and it is in this word the majority of the distinctive character lies.

Trade marks nos. (2) & (3)

50. These consist of the word "bizzy" presented in lower case in a slightly stylised but unremarkable font. The word "bizzy" is either presented in orange or grey and in trade mark no. 2, there is an abstract device presented in yellow and orange or light and dark grey which appears above the word. Irrespective of the colour in which the abstract device is presented, given its positioning and distinctive credentials, it will contribute to both the overall impression trade mark no. 2 conveys and its distinctiveness. However, even in the trade marks in which the abstract device is present, it is the word "bizzy" which will have the highest relative weight in both the overall impression conveyed and the trade mark's distinctive character. That conclusion is stronger still in relation to trade mark no. 3 which consists of the word "bizzy" alone presented in orange/grey.

Trade marks nos. (4), (5) and (6)

51. These consist of trade mark no. 2 accompanied by other components (albeit with the word "bizzy" and the abstract device presented in white). The first additional component is the device of a predominantly orange/grey square in which the bottom left hand corner (presented in yellow/light grey) is slightly raised. Although the device of a square will contribute to the overall impression conveyed, acting as it does as a background upon which the word and abstract device are presented and notwithstanding the raised bottom left hand corner which, in my view, is likely to go unnoticed by the average consumer, any distinctive contribution this device may make

is, at best, low. In addition, trade mark nos. (5) and (6) contain the words “APPLY WITH” or “GET” respectively, presented in white in block capital letters above the word “bizzy” and in much smaller text. Even if these words are noticed, I agree with the opponent that they are likely to be regarded by the average consumer as “non-distinctive” in nature. Although the abstract device will contribute to both the overall impression the trade marks convey and their distinctiveness, once again, it is the word “bizzy” which will have the highest relative weight in the overall impression conveyed and it is in that word the majority of the distinctiveness lies.

Trade marks no. (7)

52. These consist of the letters/word “bzy” presented in lower case and in a slightly stylised font in the colour grey. In the first trade mark in the series, the letters are preceded by a full stop and in the second trade mark by a circular device presented in grey. The presence of the full stop/grey circle makes the totality of both trade marks reminiscent of part of a top level domain name. It is, I think, self-evident, that it is the letters/word “bzy” which will dominate the overall impression conveyed and it is in those letters/word the distinctiveness lies.

53. I will bear all of the above conclusions in mind when conducting the visual, aural and conceptual comparison which follows.

Visual comparison

The opponent’s trade mark and trade marks no. (1)

54. The opponent’s trade mark consists of a single word consisting of four letters, whereas the applicant’s trade marks consist of one word/two words consisting of nine letters/five and four letters respectively. The first three letters of the competing trade marks are the same and the fourth letter in the applicant’s trade marks is a further letter

“Z”. All of the trade marks contain a letter “Y”, albeit in the fourth letter position in the opponent’s trade mark and in the fifth letter position in the applicant’s trade marks. Weighing the similarities and differences including the positioning of the letters in common, results in what I regard as a medium degree of visual similarity.

The opponent’s trade mark and trade marks no. (2)

55. The applicant’s trade marks differ to its first trade mark in that the word “bizzy” is presented in lower case in the colours shown, the word “LABS” is not present but the abstract device is. As notional and fair use of the opponent’s trade mark would include its use in, for example, lower or title case and in a range of colours, those factors do not assist the applicant. When considered overall, it also results in a medium degree of visual similarity.

The opponent’s trade mark and trade marks no. (3)

56. Bearing my comments above in mind, it results in what I regard as a high degree of visual similarity between the competing trade marks.

The opponent’s trade mark and trade marks nos. (4), (5) and (6)

57. Bearing my comments above in mind, it results in what I regard as a lower than medium degree of visual similarity between the competing trade marks.

The opponent’s trade mark and trade marks no. (7)

58. Bearing my comments above in mind, it results in what I regard as a high degree of visual similarity between the competing trade marks.

Conceptual comparison

59. In its written submissions, the opponent states:

“22. Conceptually, the dominant and distinctive components of the respective marks are identical to the extent that the average consumer will associate them with the English word ‘busy’, which is pronounced identically to the respective marks. The addition of non-distinctive wording does not detract from the concept of ‘busy’.”

60. I agree that the opponent’s trade mark is likely to evoke the “busy” concept in the mind of the average consumer. Although the word “LABS” in trade mark no. 1 introduces a concept alien to the opponent’s trade mark, the various device components present in the applicant’s trade mark no. 2 and nos. 4-6 are unlikely to convey any concrete concept to the average consumer. Although the words present in the applicant’s trade marks nos. 5 and 6 are also alien to the opponent’s trade mark, any concepts they may create are likely to be descriptive/non-distinctive in nature. As to the word “BIZZY”/“bizzy” in the applicant’s trade marks, once again I agree with the opponent that the concept conveyed by these words will be equated with the word busy. In my view, the opponent’s trade mark is conceptually similar to trade mark no.1 to a medium degree and conceptually identical to trade mark nos. 2-6.

61. As for trade mark no. 7, as I mentioned earlier, the inclusion of a full stop/circular device is most likely to evoke the concept of a top level domain name. As to the component which follows the dot/circular device, this may be construed in different ways. For example, some average consumers may construe it as the letters “b-z-y” while others may interpret it as, for example, an alternative way of referring to the word “busy”. In the first scenario, there is no conceptual similarity and in the second, a high degree. I shall return to this point when I consider the likelihood of confusion.

Aural comparison

62. It is well-established that when a trade mark consists of a combination of words and figurative components, it is by the word components that the trade marks are most likely to be referred to. That is the approach I shall adopt.

63. I am satisfied that the average consumer will pronounce the opponent's trade mark and the word "BIZZY"/"bizzy" in the applicant's trade marks as it would the word "busy". As the word "LABS" in trade marks no. 1 will be well-known to the average consumer, its pronunciation is predictable. Given their non-distinctive/descriptive qualities, I am satisfied that the average consumer is most unlikely to articulate the words "APPLY WITH" or "GET" in the applicant's trade marks nos. 5 and 6. Proceeding on that basis, I think there is a medium degree of aural similarity between the opponent's trade mark and trade mark no.1 and aural identity with trade marks nos. 2-6.

64. Insofar as trade mark no.7 is concerned, some average consumers may articulate the trade mark as "dot-bee-z-why" while others may articulate it as "dotbusy". In the first scenario, there is no aural similarity and in the second, a high degree. Once again, I shall return to this point when I consider the likelihood of confusion.

Distinctive character of the earlier trade mark

65. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other

undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

66. As the opponent has filed no evidence, I have only the inherent characteristics of its trade mark to consider. Even though the word “busy” is likely to be regarded as descriptive/non-distinctive in relation to a wide range of goods and services, the degree of distinctiveness created by replacing the letters “U-S” with the letters “I-Z” is, in my view, sufficient to render the earlier trade mark inherently distinctive, albeit to only a below medium (but not low) degree.

Conclusion in relation to the services with no meaningful degree of similarity

67. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

68. Consequently, for those services in Annex D there can be no likelihood of confusion and the opposition to such services fails accordingly.

Likelihood of confusion

69. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact 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.

70. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

71. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained:

“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.”

72. Earlier in this decision, I reached the following conclusions:

- The opposed goods in class 9 are either identical to the opponent's goods and services or where not identical, similar to at least a low degree;
- The applicant's services in class 35 discussed in paragraph 38 are similar to the opponent's goods and services to at least a low degree;
- The opposed services in class 42 are either identical to the opponent's services or where not identical similar to at least a low degree;
- The average consumer is a member of the general public or business user who, while not forgetting aural considerations, will select the goods and services at issue by predominantly visual means whilst paying a varying degree of attention during that process;
- The opponent's trade mark is visually, aurally and conceptually similar to the applicant's trade marks no. 1 to a medium degree;
- The opponent's trade mark is visually similar to the applicant's trade marks no. 2 to a medium degree and aurally and conceptually identical;
- The opponent's trade mark is visually similar to the applicant's trade marks no. 3 to a high degree and aurally and conceptually identical;
- The opponent's trade mark is visually similar to the applicant's trade mark nos. 4, 5 and 6 to a lower than medium degree, and aurally and conceptually identical;

- The opponent's trade mark is visually similar to the applicant's trade marks no. 7 to a high degree, and for some average consumers aurally and conceptually similar to a high degree;
- The opponent's earlier trade mark is possessed of a below medium (but not low) degree of inherent distinctive character.

73. Insofar as the average consumer is concerned, I shall proceed on the basis most favourable to the applicant i.e. that he/she will pay a high degree of attention to the selection of all the goods and services, thus making him/her less prone to the effects of imperfect recollection. I also remind myself that where not identical, I have characterised the degree of similarity between the opponent's goods and services and the applicant's goods and services as being of "at least a low degree"; I shall return to this point below. With the exception of trade marks no. 7, all of the competing trade marks convey the "busy" concept in a very similar and somewhat unusual manner i.e. by consisting of or containing a word which begins with the letters "BIZ"/"biz" (with the letter "Z"/"z" repeated in the applicant's trade marks) followed by a letter "Y"/"y".

74. However, notwithstanding the below medium degree of inherent distinctiveness the opponent's trade mark enjoys, the medium degree of visual, aural and conceptual similarity between the opponent's trade mark and trade marks no.1, is, in my view, likely to result in indirect confusion. It follows that I reach the same conclusion in relation to trade marks no. 2 which, in addition to being visually similar to a medium degree, are aurally and conceptually identical. Insofar as trade marks no.3 are concerned, the high degree of visual similarity and aural and conceptual identity is likely to lead to direct confusion. Insofar as trade marks nos. 4-6 are concerned, there is only a lower than medium degree of visual similarity with the opponent's trade mark. However, as the competing trade marks are aurally and conceptually identical, there is a likelihood of indirect confusion. Finally, as trade marks no.7 are visually highly similar to the opponent's trade mark and, in my view, for a significant number of average consumers

also aurally and conceptually highly similar, there is a likelihood of, at least, indirect confusion. Having reached those conclusions on the basis of, inter alia, goods and services which I have characterised as being similar to at least a low degree, it follows that if, on appeal, it is felt I have underestimated the degree of similarity between the competing goods and services, the likelihood of confusion is even stronger.

Overall conclusion

75. The unopposed goods and services shown in Annex B to this decision may proceed to registration regardless. The oppositions have succeeded in relation to the goods and services shown in Annex C and failed in relation to the services shown in Annex D. Subject to any successful appeal, the applications will be refused in relation to the goods and services shown in Annex C and will proceed to registration in relation to the services shown in Annex D.

Costs

76. The oppositions have:

- succeeded in relation to all the opposed goods in class 9;
- failed in relation to the bulk of the opposed services in class 35;
- failed in relation to all the opposed services in class 36;
- succeeded in relation to all the opposed services in class 42.

77. Approaching the matter on a “rough and ready” basis and as both parties have achieved what I regard as a roughly equal measure of success, I direct that both parties should bear their own costs.

Dated this 17th day of December 2020

C J BOWEN

For the Registrar

No. 3352819

Class 9 - Computers; software; computer software; mobile application software; downloadable software; downloadable publications; computer programs used in the field of electronic commerce transactions; software relating to digital and virtual currency; software for digital and virtual currency, merchant services, exchange of digital and virtual currency to traditional currency, digital and virtual currency and taxes, digital and virtual currency and barter transactions, acquiring digital and virtual currency, the use of digital and virtual currency electronically, and the use of digital and virtual currency as an alternative to traditional currency to obtain goods or services; computer hardware; computer networks; computer hardware and firmware; computer hardware and software for managing, securing and operating networks and computers via firewalls; backup software; antivirus software; resource monitoring software; computer software for providing network, internet, and computer security; computer software for providing intrusion detection and prevention; computer software for scanning, detecting, and removing viruses, worms, Trojan horses, adware, spyware, and other malware; computer software for use in the monitoring and control of computer and online activity; computer software for providing online transaction security; computer optimization software; computer software for use in recruitment; computer software to prevent, diagnose, and repair computer problems; computer maintenance software; computer software for the back-up, storage, restoration and recovery of data, folders, and files; computer software and downloadable computer software, namely, utility software; computer software for providing software updates; user manuals and instructional guides supplied with all of the foregoing; computer hardware and peripherals; computer software to enable secure transmission of digital information over the Internet and other modes of communication between computing devices; computer software to integrate managed security services, namely public key infrastructure services; computer software for use in analysis and reporting; application software for cloud computing services; computer software for application and database integration; computer software for remote management of computer terminals or servers connected by computer networks, computing terminals, computing workstations; internet servers; mobile phones; internet phones; wireless receivers; wireless transmitters; satellite receivers; electronic and optical communications instruments and components; digital transmitters; knowledge management software; data analysis software; databases; data terminals; data networks; data buffers; data banks; data cartridges; data transmitters; data switches; data cables; data processors; electronic databases; computer databases; data encryption apparatus; data encoding apparatus; recorded data files; data exchange units; time data generators; data transmission networks; data processing programs; data storage media; data protection backup units; apparatus for data storage; airborne data acquisition instruments; electronic data processing equipment; data communications software; database management software; software for online

messaging; apparatus and software for capturing, recording, reproducing, manipulating and transmitting data, images and sounds; magnetic data carriers and encoders; video capture software; video recording software; machine learning software; self-educating computer software; artificial intelligence apparatus; artificial intelligence software; computer software for data analytics and application for use in management of data and information; computer software for analysing market information; downloadable computer software for remote monitoring and analysis; downloadable computer software for data analysis, recommendation and decision support based on data analysis and compilation, data mining, knowledge management and research, business process and data optimization, automation of predictive analytic processes, optimization of predictive analytic business decisions, advertising optimization and personalization, document management, business intelligence information gathering and analysis, forecasting and reporting of possible predictive outcomes, application of company and market data and data analytics, accounting and financial reporting and analysis, budgeting, enterprise management, data extraction, data monitoring, statistical compilation of market data, economic forecasting, and market analysis; electronic publications; downloadable electronic publications; downloadable instruction manuals in electronic form; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other networks (including web-sites); multi-media software for use in creating presentations, managing databases and accessing and displaying information; software for managing information and documents, including the management of calendars, deadlines, events and letters; application software for mobile computing devices, providing an internet search engine for obtaining job listings, resume postings, and other job search information.

Class 35 - Advertising; marketing; recruitment services; personnel recruitment, placement services; document reproduction; data processing verification; computerised data verification in relation to the field of recruitment; recruitment advice; freelance recruitment; providing an on-line commercial information directory on the internet; employment agency and recruitment services, including employment agency and recruitment services provided on-line from a computer database or the Internet; workforce management services; human resource consulting; staffing and outsourcing services; contract staffing services; business consultation services in the fields of personnel management, placement and relocation, employee attraction, retention and analysis programmes; recruitment information services; recruitment consultancy services; provision of incentive schemes; advertising optimization and personalization; business introductory and meetings services and business networking schemes; information relating to business introductory services; information relating to business networking and meetings; provision of trade information, including such services provided electronically; business research services; recruitment agency services; compilation and systemisation of information into computer databases; data compilation including electronic data compilation; computerised file managing; document reproduction; data retrieval services; marketing and promotional services; recruitment advertising services; up-dating advertising material; rental of advertising space; rental of

advertising time on communication media; on-line advertising on a computer network; compilation of advertisements for use as web pages on the Internet; provision of space on web sites for advertising goods and services, including the provision of job boards in electronic formats; publication of advertisements, including job advertisements; arranging newspapers and magazine subscriptions for others; news clipping services; publication of publicity texts; marketing research and marketing studies; accountancy services and book-keeping services; organisation, arranging and conducting of exhibitions; trade shows; trade fairs and expositions for business purposes; arranging and conducting of business to business and business to consumer fairs, forums and events within the context of exhibitions; trade shows and expositions for business purposes; arranging and conducting of job fairs for business purposes; provision and dissemination of information relating to the aforesaid services including materials relating to exhibitions, trade shows and expositions; promotion of trade shows and trade fairs for trade purposes; retail services and online retail services connected with the sale of software, computer and mobile application software, mobile applications; arranging and conducting job fairs; business intelligence information gathering and analysis; conventions, expositions and events organisation in relation to recruitment; information and advisory services relating to all the aforementioned services.

Class 36 - Financial and monetary services; banking services; insurance services, fundraising and sponsorship; cash management namely facilitating and tracking transfers of electronic cash equivalents; virtual currency exchange transaction services for transferable electronic cash equivalent units having specified cash value; provision of prepaid cards and tokens; real estate services; electronic financial services provided by means of the internet; credit card services; money transfer services; electronic funds transfer services; processing payments to and from third parties; foreign exchange transactions; financial transaction services; providing secure commercial transactions and payment options via electronic communications networks; financial transaction services using a mobile device; person-to-person financial services via electronic communications networks; clearing and reconciling financial transactions via electronic communications networks; banking and financial services; business banking; consumer banking; electronic banking via electronic communications networks; payment services; electronic payment services; electronic wallet services (payment services); processing electronic payments; payment processing; payment administration services; financial transfers and transactions; payment and receipt of money as agents; currency dealing; currency trading; exchange services (currency); brokerage of currency; swaps of currency rates; currency exchange rate quotations; financial services provided by mobile telephone connections, near field communication connections, retail point of sale connections and the internet, namely, mobile banking and mobile money transfers; mobile purchasing, namely, providing electronic processing of credit card, debit card, prepaid gift card, stored value card and electronic payments via mobile phone for allowing consumers pay bills and purchase goods and services of others; electronic payment services; automated payment services; processing of payment transactions via the Internet; money transfer services; electronic funds transfer services; bill payment

services; automated payment services; payment transaction card services; electronic payment services; credit card and payment card services; financial payment services; information services relating to the payment of accounts; processing of payments for banks; payment processing and administration services; all the above services limited to the field of a cryptographically protected virtual currency system, for facilitating digitally recorded financial transactions within an organized, internet-based virtual community, business or social network; authentication and verification services in relation to online payment or transfer of funds.

Class 38 - Telecommunication; telecommunication for electronic commerce transactions via telecommunications systems or data communication systems; providing access to computer databases where users can search and obtain information concerning electronic commerce transactions; communications services; telecommunications services; satellite and digital communications services; broadcasting services; access time to global computer networks (rental of -); computer network communications services; providing access to communications networks; communications network services; advice, information and consultancy services relating to the aforesaid services; communications by computer terminals; computer aided transmission of messages and images; electronic mail; providing telecommunications connections to a global computer network; providing user access to a global computer network [service providers]; telecommunications routing and junction services; interactive telecommunications services; telecommunication of information (web pages), computer programs and data; providing telecommunications connections to the Internet or data bases; provision of telecommunication access to world-wide web facilities and structures; communication by computer terminals; communication by fibre optic networks; facsimile transmission; message sending; paging services; rental of modems; data communication services by electronic means; rental of telecommunication equipment; electronic message sending, receiving and forwarding services; collection, transmission and delivery of data by electronic means; collection, transmission and delivery of mail messages, still picture and/or moving picture information such as characters, messages, music and images, telegrams, information and data by mechanical, electronic, telephone, telex, cable, computer and satellite means; transmission, broadcast and reception of audio, video, still and moving images and data whether in compressed or uncompressed form and whether in real or delayed time; electronic messaging, conferencing and order-transmission services; video conferencing services; communication by electronic bulletin board that enables users to perform a real-time interactive talk between a computer terminal and an electronic bulletin board containing still picture and moving picture information and voice information such as characters; providing electronic bulletin boards and message boards for transmission of messages; provision of discussion forums; transmission of music, films, interactive programmes, videos, electronic computer games; transmission of information relating to on-line shopping and general retail services; video-on-demand transmission services; news agency services; providing access to computer database on the global computer network for searching and retrieving information, data, web sites

and resources available on computer networks; providing user access to a computer database containing electronic publications, bulletin boards, database and information accessible via computer; operation of chat rooms (chat room services); multiple user access to global computer information networks for the transfer and dissemination of a wide range of information; data streaming; data transmission; data transmission and data broadcasting; providing access to online computer databases; providing of reports relating to communications; providing virtual facilities for real-time interaction among computer users; providing online facilities for real-time interaction with other computer users; data broadcasting services; international data transfer; international data transmission; online document delivery via global computer network; electronic data interchange; electronic data transmission; electronic data communications; telematic [data communication] services; data bank interconnection services.

Class 41 - Education, providing of training, and entertainment services, in relation to all types of currency, including digital and virtual currency; educational services in relation to all types of currency, including digital and virtual currency; education services for acceptance of digital and virtual currency for businesses, merchant services, exchange of digital and virtual currency to traditional currency, digital and virtual currency and taxes, digital and virtual currency and barter transactions, acquiring digital and virtual currency, the use of digital and virtual currency electronically, and the use of digital and virtual currency as an alternative to traditional currency to obtain goods or services; publication services; publication of printed matter; publication of books; publication of excerpts from books; publishing services, in particular publishing of books and media content in digital format; providing pre-recorded audio, audio-visual, and multimedia works featuring entertainment, movies, television, audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals, exhibitions, sports instruction, clubs, radio, comedy, contests, visual works, games, gaming, festivals, museums, parks, cultural events, concerts, publishing, animation, current events, fashion shows, and multimedia presentations via the internet or other computer or communications networks; organisation of events, conferences, competitions and seminars; organisation of exhibitions for cultural purposes; organising, arranging, planning, co-ordinating, running, composing, scheduling, delegating, managing, hosting and conducting events, special events, annual events, in relation to recruitment, namely assemblies, auditions, interviews, gatherings, webinars, seminars, on-line seminars, teleseminars, symposiums, meetings, meetups, workshops; education; providing of training; education and training services including provision of seminars and workshops; entertainment; sporting and cultural activities; photography; photography services; photography services in relation to magazines and books; special event planning; organising events for entertainment purposes; organising of cultural and arts events; arranging and conducting of exhibitions; provision and dissemination of information relating to all the aforesaid services including materials relating to exhibitions; provision and dissemination of information, assistance and advice for exhibition and conference attendants, visitors and exhibitors all relating to exhibitions, including all such

information and advice provided electronically, including on a website; provision of information relating to education, entertainment and sport including the provision of such services electronically, audio and video production; video recording services; video editing services; information and advisory services relating to all the aforesaid services.

Class 42 - Testing, authentication and quality control of data; conversion of images and text from physical to electronic media; mathematical research services; design of mathematical models in relation to the field of recruitment; graphic design services; data mining in relation to recruitment; electronic data storage and data back-up services; coding of messages; reconstitution of databases; database design and development in relation to recruitment; Installation and maintenance of computer software; development of computer hardware; creating and maintaining web sites; hosting computer sites; computer network services; technical consultancy services relating to information services; data security services; disaster recovery services for computer systems and data communications systems; computer industrial analysis and research services; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; hosting and maintenance of cloud services and networks; providing temporary use of non-downloadable computer software to enable users to program, organize and access audio, video, text, multimedia content and third-party computer software programs; Internet services, namely, creating indexes of information, sites, and other resources available on global computer networks for others, searching and retrieving information, and other resources available on global computer networks and other electronic communication networks for others; scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer software design; computer system design; design and development of webpages; hosting webpages for others; hosting computer application software for searching and retrieving information from databases and computer networks; providing technical information at the specific request of end-users by means of telephone or global computer network; computer services relating to customized searching of computer databases and websites; research and development services; design and development of self-educating computer software; recovery of computer data; consultancy in the field of computer hardware and computer software; providing software as a service (SaaS) for enabling others to upload and manage data for determining and predicting patterns in the data; application service provider featuring application programming interface (API) software for recruitment; software as a service (SAAS) services, featuring software for data analysis; data mining; optimization of predictive analytic business decisions; technical data analytics.

Class 45 - Identity validation services; identity verification services; providing authentication of personal identification information [identification verification services]; consultancy in the field of data theft and identity theft; personal legal affairs consultancy.

Goods and services not being opposed

Class 9 - Computer hardware; computer networks; computer hardware and firmware; computer hardware and software for managing, securing and operating networks and computers via firewalls; backup software; antivirus software; resource monitoring software; computer software for providing network, internet, and computer security; computer software for providing intrusion detection and prevention; computer software for scanning, detecting, and removing viruses, worms, Trojan horses, adware, spyware, and other malware; computer optimization software; computer software to prevent, diagnose, and repair computer problems; computer maintenance software; computer software for the back-up, storage, restoration and recovery of data, folders, and files; computer hardware and peripherals; computer software to integrate managed security services, namely public key infrastructure services; computer software for remote management of computer terminals or servers connected by computer networks, computing terminals, computing workstations; mobile phones; internet phones; wireless receivers; wireless transmitters; satellite receivers; electronic and optical communications instruments and components; digital transmitters; data terminals; data networks; data buffers; data banks; data cartridges; data transmitters; data switches; data cables; data processors; data protection backup units; apparatus for data storage; airborne data acquisition instruments; electronic data processing equipment; database management software; magnetic data carriers and encoders; artificial intelligence apparatus; artificial intelligence software; electronic publications; downloadable electronic publications; downloadable instruction manuals in electronic form; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other networks (including web-sites); providing an internet search engine for obtaining job listings, resume postings, and other job search information.

Class 35 - Document reproduction; data processing verification; providing an on-line commercial information directory on the internet; contract staffing services; advertising optimization and personalization; recruitment agency services; document reproduction; data retrieval services; up-dating advertising material; rental of advertising space; rental of advertising time on communication media; compilation of advertisements for use as web pages on the Internet; arranging newspapers and magazine subscriptions for others; news clipping services; publication of publicity texts; accountancy services and book-keeping services; organisation, arranging and conducting of exhibitions; trade shows; trade fairs and expositions for business purposes; arranging and conducting of business to business and business to consumer fairs, forums and events within the context of exhibitions; trade shows and expositions for business purposes; arranging and conducting of job fairs for business purposes; provision and dissemination of

information relating to the aforesaid services including materials relating to exhibitions, trade shows and expositions; promotion of trade shows and trade fairs for trade purposes; retail services and online retail services connected with the sale of software, computer and mobile application software, mobile applications; arranging and conducting job fairs; conventions, expositions and events organisation in relation to recruitment; information and advisory services relating to all the aforementioned services.

Class 36 - Financial and monetary services; banking services; insurance services, fundraising and sponsorship; cash management namely facilitating and tracking transfers of electronic cash equivalents; real estate services; foreign exchange transactions; banking and financial services; business banking; consumer banking; electronic banking via electronic communications networks; currency trading; exchange services (currency); brokerage of currency; swaps of currency rates; currency exchange rate quotations; financial services provided by mobile telephone connections, near field communication connections, retail point of sale connections and the internet, namely, mobile banking; bill payment services; processing of payments for banks; all the above services limited to the field of a cryptographically protected virtual currency system, for facilitating digitally recorded financial transactions within an organized, internet-based virtual community, business or social network.

Class 38 – all services.

Class 41 – all services.

Class 42 - Testing, authentication and quality control of data; conversion of images and text from physical to electronic media; mathematical research services; design of mathematical models in relation to the field of recruitment; graphic design services; reconstitution of databases; development of computer hardware; data security services; disaster recovery services for computer systems and data communications systems; computer industrial analysis and research services; repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; scientific and technological services and research and design relating thereto; industrial analysis and research services; computer system design; hosting webpages for others; hosting computer application software for searching and retrieving information from databases and computer networks; providing technical information at the specific request of end-users by means of telephone or global computer network; computer services relating to customized searching of computer databases and websites; research and development services; design and development of self-educating computer software; recovery of computer data; providing software as a service (SaaS) for enabling others to upload and manage data for determining and predicting patterns in the data; data mining.

Class 45 – all services.

Goods and services in relation to which the oppositions have succeeded

Class 9 - Software; computer software; mobile application software; downloadable software; Computer programs used in the field of electronic commerce transactions; software relating to digital and virtual currency; software for digital and virtual currency, merchant services, exchange of digital and virtual currency to traditional currency, digital and virtual currency and taxes, digital and virtual currency and barter transactions, acquiring digital and virtual currency, the use of digital and virtual currency electronically, and the use of digital and virtual currency as an alternative to traditional currency to obtain goods or services; computer software for use in the monitoring and control of computer and online activity; computer software for providing online transaction security; computer software for use in recruitment; computer software and downloadable computer software, namely, utility software; computer software for providing software updates; user manuals and instructional guides supplied with all of the foregoing; computer software to enable secure transmission of digital information over the Internet and other modes of communication between computing devices; computer software for use in analysis and reporting; application software for cloud computing services; computer software for application and database integration; knowledge management software; data analysis software; data processing programs; data communications software; software for online messaging; software for capturing, recording, reproducing, manipulating and transmitting data, images and sounds; video capture software; video recording software; machine learning software; self-educating computer software; computer software for data analytics and application for use in management of data and information; computer software for analysing market information; downloadable computer software for remote monitoring and analysis; downloadable computer software for data analysis, recommendation and decision support based on data analysis and compilation, data mining, knowledge management and research, business process and data optimization, automation of predictive analytic processes, optimization of predictive analytic business decisions, advertising optimization and personalization, document management, business intelligence information gathering and analysis, forecasting and reporting of possible predictive outcomes, application of company and market data and data analytics, accounting and financial reporting and analysis, budgeting, enterprise management, data extraction, data monitoring, statistical compilation of market data, economic forecasting, and market analysis; multi-media software for use in creating presentations, managing databases and accessing and displaying information; software for managing information and documents, including the management of calendars, deadlines, events and letters; application software for mobile computing devices;_Computers; downloadable publications; internet servers; databases; electronic databases; computer databases; data encryption apparatus; data encoding apparatus; recorded data files; data exchange units; time data generators; data transmission networks; data storage media;

apparatus for capturing, recording, reproducing, manipulating and transmitting data, images and sounds.

Class 35 - Computerised data verification in relation to the field of recruitment; compilation and systemisation of information into computer databases; data compilation including electronic data compilation; computerised file managing; information and advisory services relating to all the aforementioned services.

Class 42 - Providing temporary use of non-downloadable computer software to enable users to program, organize and access audio, video, text, multimedia content and third-party computer software programs; software as a service (SAAS) services, featuring software for data analysis; Coding of messages; Installation and maintenance of computer software; computer programming; design and development of computer hardware and software; computer software design; consultancy in the field of computer hardware and computer software; Data mining in relation to recruitment; Electronic data storage and data back-up services; database design and development in relation to recruitment; Creating and maintaining web sites; hosting computer sites; computer network services; technical consultancy services relating to information services; hosting and maintenance of cloud services and networks; Internet services, namely, creating indexes of information, sites, and other resources available on global computer networks for others, searching and retrieving information, and other resources available on global computer networks and other electronic communication networks for others; design and development of webpages; application service provider featuring application programming interface (API) software for recruitment; optimization of predictive analytic business decisions; technical data analytics

Services in relation to which the oppositions have failed

Class 35 – Advertising; marketing; recruitment services; personnel recruitment, placement services; recruitment advice; freelance recruitment; employment agency and recruitment services, including employment agency and recruitment services provided on-line from a computer database or the Internet; workforce management services; human resource consulting; staffing and outsourcing services; business consultation services in the fields of personnel management, placement and relocation, employee attraction, retention and analysis programmes; recruitment information services; recruitment consultancy services; provision of incentive schemes; business introductory and meetings services and business networking schemes; information relating to business introductory services; information relating to business networking and meetings; provision of trade information, including such services provided electronically; business research services; marketing and promotional services; recruitment advertising services; on-line advertising on a computer network; provision of space on web sites for advertising goods and services, including the provision of job boards in electronic formats; publication of advertisements, including job advertisements; marketing research and marketing studies; business intelligence information gathering and analysis; information and advisory services relating to all the aforementioned services.

Class 36 – all services.