

o/845/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003486008

BY EXPEDE IT SOLUTIONS LIMITED

TO REGISTER THE TRADE MARK:

YADA

IN CLASSES 9, 35, 38, 41, 42 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 421364

BY YATTA SOLUTIONS GMBH

BACKGROUND AND PLEADINGS

1. On 1 May 2020, Expede IT Solutions Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 5 June 2020 and registration is sought for the goods and services set out in the Annex to this decision.

2. On 7 September 2020, the application was partially opposed by Yatta Solutions GmbH (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against the following goods and services of the application:

Class 9 Software; computer software; application software; cloud software; communication software; mobile software; application software for mobile phones; application software for computers; downloadable software in the nature of a mobile application; down-loadable cloud-based software; downloadable cloud-computing software; computer software platforms; computer software for data processing; computer software for processing information; computer software for database management; document management software; computer software that provides real-time information by combining information from various databases and presenting it in an easy-to-understand user interface dashboard; downloadable electronic mail software; downloadable instant messaging software; computer software for data and document capture, transmission, storage and indexing; computer software for booking events; computer software for use in storing electronic event tickets; computer software for use in ticket reservation and booking services for entertainment, sporting and cultural events; computer software for use in ticket reservation and booking services for recreational and leisure events.

Class 38 On-line communication services; computer communications for the transmission of information; data communication by electronic means; electronic network communications; transmission of data by electronic means; transfer of information and data via online services and the

internet; electronic order transmission; electronic order transmission services; electronic transmission of data; electronic transmission of messages; electronic transmission of documents; message sending and receiving services; provision of providing access to databases; provision of providing information for commercial purposes from a computer stored databank or via the internet; providing access to a global computer network for the transfer and dissemination of information; providing access to a global computer information network; providing an electronic mailbox; online messaging services.

Class 41 Organisation of events for educational purposes; advisory services in relation to educational events; publication of calendars of educational events.

Class 42 Software as a service (SaaS); platform as a service (PaaS); updating of computer software; software design; software development; updating of computer software; software as a service (SaaS) services for ticket reservation and booking services for entertainment, sporting and cultural events; software as a service (SaaS) services for use in ticket reservation and booking services for recreational and leisure events; software as a service (SaaS) services for use in for data and document capture, transmission, storage and indexing; platform as a service (PaaS) featuring computer software platforms for ticket reservation and booking services for entertainment, sporting and cultural events; platform as a service (PaaS) featuring computer software platforms for document capture, transmission, storage and indexing; platform as a service (PaaS) featuring computer software platforms for use in ticket reservation and booking services for recreational and leisure events.

Class 45 Online social networking services.

3. Under section 5(2)(b) the opponent relies upon the following trade mark:

Yatta

European Union trade mark no.007336886¹

Filing date 23 October 2008; registration date 15 July 2009.

Relying upon all the goods and services for which the earlier mark is registered, namely:

Class 9 Computer software, in particular software for software development; interfaces, software for databases and for the Internet.

Class 35 Organisational project management in the field of electronic data processing; providing databases, including updating and maintenance of data in databases; business management and organisation consultancy in the field of information technology.

Class 38 Electronic transmission of data via computer and communication networks and via the Internet.

Class 41 Providing of training; micro-publishing.

Class 42 Design, development and creating of computer hardware and computer software; installation and maintenance of software; technical project management in the field of electronic data processing, in particular with regard to software development; consultancy with regard to software development and software development processes.

4. Under section 5(2)(b) the applicant claims that there is a likelihood of confusion because of the close similarity of the marks and the identity/close similarity of the goods/services.

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

6. The opponent is represented by White & Case LLP and the applicant is represented by Hanna IP. Both parties filed evidence in chief and the opponent filed evidence in reply. Neither party requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE AND SUBMISSIONS

8. The opponent's evidence consists of the witness statement of Johannes Jacop, which is dated 5 March 2021. Mr Jacop is the Managing Director and Co-Founder of the opponent's company, a position that he has held since 2009. Mr Jacop's statement was accompanied by 3 exhibits (1-3).

9. The applicant's evidence consists of the witness statement of Martin Roots, which is dated 10 May 2021. Mr Roots is the Founder and Director of the applicant. Mr Roots' statement was accompanied by 20 exhibits.

10. The opponent filed evidence in reply in the form of the witness statement of Johannes Jacop, which is dated 12 July 2021. Mr Jacop's statement was accompanied by 2 exhibits (4-5).

11. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to it where necessary below.

DECISION

12. Section 5(2)(b) 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.”

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of IR 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.”

14. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. As the earlier trade mark had completed its registration process

more than five years before the application date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

15. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A(1) This section applies where

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(5A) [...]

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

16. Section 100 of the Act is also relevant, which reads:

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

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the application in issue i.e. 2 May 2015 to 1 May 2020.

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others

which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

19. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, are relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the

territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A de minimis rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

20. At paragraphs 57 and 58, the court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

21. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant’s challenge to the Board of Appeal’s conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant’s argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guilford, and thus a finding which still left open the possibility of conversion of the community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that “genuine use in the Community will in general require use in

more than one Member State” but “an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State.” On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon’s analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multifactorial one which includes the geographical extent of the use.”

22. The General Court (“GC”) restated its interpretation of *Leno Marken* in Case T398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark).

23. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them; and
- e. The geographical extent of the use show

Form of the mark

24. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that (my emphasis):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

25. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the subquestions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

26. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as required. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

27. Where the opponent's mark has been used as registered this will, clearly, be use upon which the opponent can rely. As the mark filed is a word mark, it may also be used in a range of standard fonts and colours, as well as in upper or lower case.

28. The opponent has also used its mark in the following variants:

1) 

2) 

3) 

29. Registration of a word only mark covers use in any standard typeface. Consequently, I consider that the slightly stylised font and lower case “y” in examples 1), 2) and 3) are covered by notional and fair use of the earlier mark. As noted above, use in combination with additional matter, such as the blue triangles device, is use upon which the opponent can rely (as explained in *Colloseum*). Consequently, example 1) is acceptable use of the opponent’s mark as registered.

30. The applicant argues that the wording PROFILES and ECLIPSE LAUNCHER BETA in examples 2) and 3) “materially alters the distinctive character of the mark in the form which it was originally registered”. However, as highlighted by the opponent, PROFILES and ECLIPSE LAUNCHER BETA are used to distinguish the different software products or services sold under the ‘yatta’ mark. The ‘yatta’ element in examples 2) and 3) is visible, retains an independent role and continues to indicate origin. Consequently, as per *Colloseum*, I consider both to be acceptable use of the opponent’s mark as registered.

Sufficient/genuine use

31. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²

32. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

33. As the earlier mark relied upon is an EUTM, I must consider the EU as the market in which the opponent is required to show genuine use.

34. Although the opponent provides evidence that they have used the Yatta mark in the EU since 2011, they have only submitted evidence of the past 5 years of trading under the Yatta mark. The following EU annual revenues earned by the opponent are provided:

2020	€3,418,253.68
2019	€3,522,119.59
2018	€3,030,350.50
2017	€2,064,143.33
2016	€1,605,774.34

35. The opponent also provides the following figures for advertising under the Yatta mark for the past 4 years in the EU:

2019	Eclipse.org: €48,750.00
2018	Eclipse.org: €63,000.00

² New Yorker SHK Jeans GmbH & Co KG v OHIM, T-415/09

2017	Google AdWords/Ads: €1,842.00 Eclipse.org: €69,150.00
2016	Google AdWords/Ads: €2,461.46 Eclipse.org: €36,000.00 Facebook: €100.00 Twitter: €40.00

36. In 2016, the opponent does provide the extra figure €1,649.57 for Google AdWords/Ads, however, this is followed by “maybe, not confirmed” and therefore I will not take these figures into account.

37. I note that none of the above figures are broken down into the goods and services for which the Yatta mark is used, nor am I provided with a breakdown of how many of each of the goods and services were sold.

38. The opponent has also provided website traffic graphs and figures from the EU and UK for 2016 to 2020 for both unique visitors and active users. As highlighted above, the opponent must show genuine use in the EU market. Therefore, I note the following figures provided by the opponent on Yatta unique visitors per year in EU-countries:

2016	31,761
2017	34,221
2018	31,331
2019	19,929
2020	3,017

39. The above does show a decline in EU unique visitors. However, the opponent’s monthly active users in the EU-countries graph does show an increase in users, with around 250 visitors in January 2016 increasing to approximately 2,000 by April 2020.

40. Exhibit 1 provided by Mr Jacop includes a picture of a Yatta stand from a conference, and screenshots of Yatta adverts, 2 of which are in German. It shows that the opponent is a ‘tech start up and software company’ which owns a product called

'PROFILES FOR ECLIPSE', but it does not sufficiently explain what this product is. The applicant also highlights that all the examples provided within exhibit 1 are undated or dated with the printing date 5 March 2021. However, the opponent dates the materials in this exhibit from the period of 2016 to 2019, which falls within the relevant period. Mr Jacop in his second witness statement also provides evidence that the 'Enterprise Hosting' advert in exhibit 1 was published in a similar design in the IT magazine JavaSpektrum in July 2016, and the advert at page 5 was also published in a similar design in the IT magazine JavaSpektrum in September 2018. However, Mr Jacop did not provide any information as to how many consumers purchased both editions of this magazine and its geographical spread.

41. Exhibit 2 is a series of screenshots from the opponent's website which details testimonials from some of the opponent's former clients and the awards that the opponent has won. I note the following:

- a) The Hewlett-Packard testimonial is about Cloud Service Automation (CSA) with UML Lab. I also note that the customer, Hewlett-Packard, is based within the US, and this project was worked on until its release in August 2012 which falls before the relevant period.
- b) The 1&1 testimonial does reference that the project was developed with the help of the opponent's consultants. In Mr Jacop's witness statement, he states that this project took place between January and March 2014. However, this falls before the relevant period.
- c) The Enercast GMBH article does reference that "Yatta Solutions provided support to enercast GmbH for the standardization and refactoring of the data model with UML Lab". The technical benefits gained from Yatta Solutions support was a "highly qualitative data model" and "highly scalable application through a new data model". However, the article is undated, and I also note that Mr Jacop's second witness statement dates this project in or around June 2011, which again falls before the relevant period.

- d) The B Braun Mesungen AG 'digitizing medical services to improve patient care' testimonial and article highlights that the opponent was involved in all the stages of software development. Although this article is undated, in Mr Jacop's second witness statement he provides evidence that the projects for this client commenced in August 2013 and continued until December 2018. I note that part of these dates, from August 2013 to 1 May 2015, fall outside of the relevant period.
- e) The last article is written in German without any translations. This is also undated.
- f) The opponent was awarded with best start-up of the year in 2010 by The German Association for the Facilitation of Research Transfer. This falls before the relevant period.
- g) The opponent was awarded both the ICT start-up of the year and the Hessian Start-Up Award of the year in 2011. These also fall before the relevant period.

42. Exhibit 3 is a selection of screenshots from the opponent's website. I note the following:

- a) The first screenshot is of the UML Lab tab on the opponent's website. UML Lab is "the modelling IDE for flexible modelling and programming". At the top of the page it provides a 30 day free trial for the modelling IDE. I note that there is no definition of what modelling IDE's are, however, the page is split into two sub-headings to describe the service. Firstly, "Modelling and programming all in one: reliable, simple and dynamic" which explains what UML Lab offers, including "fully flexible modelling and programming" and "comprehensive code generation templates". Secondly, "Customers benefit? Time, money and reliability" which explains how UML Lab offers a "cost-efficient and reliable solution for object-oriented software development". This screenshot is undated, although, Mr Jacop in his second witness statement provides evidence that this webpage has "been used in substantially the same way from 2010 to the present day".

- b) The second screenshot does demonstrate two products, the 'student edition' and 'academic edition' UML Lab licence product which use the Yatta mark on the packaging. However, I note that this screenshot is also undated.
- c) The third and fourth screenshots are in relation to Yatta ECLIPSE LAUNCHER. It is not clear what goods and services are provided under ECLIPSE LAUNCHER, although the fourth screenshot provides some information as to how PROFILES is 'here to help you develop great software'. Examples 1) and 2) of the marks are used prominently within these screenshots. Both screenshots are undated, but Mr Jacop provides evidence in his second witness statement that the webpage in the third screenshot was first published in 2016, and the webpage in the fourth screenshot was first published in 2017.

43. Exhibit 4 is a German brochure for the conference that was attended by the opponent, as shown in the photo in exhibit 1. Mr Jacop dates the conference from the 20 to 24 March 2017. In Mr Jacop's second witness statement, he provides translations of the German brochure. The conference was held by CeBIT which "is the world's largest and most important event in the computer sector". Pages 40 and 41 references the opponent's attendance, explaining that they develop "made to measure solutions for better software engineering" and that they support businesses with their software product development. I note that no information has been provided as to how many consumers from the EU attended this conference and how many received the brochure.

44. Exhibit 5 is an email newsletter for the Devovx IT conference which took place in March 2017. As highlighted by Mr Jacop, the advert, 'Tired of managing Eclipse setups?' which is on page 6 of Exhibit 1 appears within this newsletter. Although the conference takes place in San Jose, California in the US, Mr Jacop gives evidence that this conference is attended by thousands of people from the EU.

45. I note that in Mr Root's witness statement, he provides evidence under exhibits MR14 and MR15, that the opponent has done little to advertise its services under the Yatta mark because under a google search, the following was found:

- The opponent's webpage was found halfway down page 3 of the google search results dated 7 May 2021 (exhibit MR14).
- The opponent's LinkedIn page was found as the 34th result, on page 4, on a google search dated 24 August 2020.
- On the 24 August 2020, there was no further mention of the opponent within the Google search results until the final result found on page 6.

46. All of the above fall after the relevant period and therefore are not particularly informative.

47. Clearly, there are issues with the opponent's evidence. For example, the overall turnover figures provided are not broken down by goods and services. Further, I note that the opponent has provided evidence which is either undated or falls before or after the relevant period. However, taking the evidence as a whole into account, it is clear from the volume of sales, the screenshots from its website, the testimonials from clientele and the attendance to conferences such as Devoxx IT which was attended by thousands of people from the EU, I am satisfied that the opponent has put the Yatta mark to genuine use in the EU during the relevant period.

48. I must now consider whether, or to what extent, which the evidence shows use of the earlier marks in relation to the goods and services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

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

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

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of

protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

50. The goods and services for which the earlier mark is registered and upon which the opponent relies are a range of class 9, 35, 38, 41 and 42 goods and services.

51. However, as set out above, it is clear from the opponent’s evidence, including the UML Lab screenshots from its website, the exhibit 2 testimonials, specifically from Enercast GMBH and B Braun Mesungen, and exhibit 4, that use of the earlier mark is limited to software development. Although the above EU annual revenues are not broken down, I consider that a reasonable proportion of those figures are likely to apply to their core products in relation to software development. Consequently, I consider a fair specification of the mark to be:

Class 9 Computer software, in particular software for software development.

Class 42 Design, development and creating of computer software.

52. In the event I am wrong in my finding of proof of use, I will proceed with the rest of the decision as if the opponent had established genuine use for the full breadth of their specification.

Section 5(2) case law

53. For the purposes of the section 5(2)(b) opposition, I bear in mind the following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

54. The applicant's goods and services are set out in paragraph 2 of this decision. The opponent's goods and services are set out in paragraph 3 of this decision.

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut for 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.”

56. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

57. I note that at least some of the goods and services covered by the parties' respective specifications are identical. For example, the term "computer software, in particular software for software development" in the opponent's specification is self-evidently identical to "computer software" in the applicant's specification. For this reason, I will not undertake a full comparison of the goods and services above. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the opponent's mark. If the opposition fails, even where the goods and services are identical, it follows that the opposition will also fail where the goods and services are only similar.

The average consumer and the nature of the purchasing act

58. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

59. The average consumer for the goods and services will be both members of the general public and business users. The cost of purchase is likely to vary, but it is not likely to be at the very highest end of the scale. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. Even where the cost of the purchase is low, various factors will be taken into consideration such as suitability for the user’s particular needs, ease of use and reliability. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process. However, I recognise that the level of attention may be above medium where the goods and services are particularly technical in nature.

60. The goods and services are likely to be purchased from specialist retail outlets, their online equivalent or following inspection of a specialist catalogue. Alternatively, the goods and services may be purchased following perusal of advertisements. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods and services given that advice may be sought from a sales assistant or a recommendation may have been given through word-of-mouth.

Comparison of the trade marks

61. 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 the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

63. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
Yatta	YADA

64. The opponent's mark consists of the word 'Yatta'. There are no other elements to contribute to the overall impression which lies in the word itself.

65. The applicant's mark consists of the word YADA. There are no other elements to contribute to the overall impression which lies in the word itself.

66. Visually, the marks coincide in the presence of the letters Y and A at the beginning of both marks. They also coincide in the presence of the letter A at the end of the mark. These all act as visual points of similarity. However, the opponent's mark has the letters T and T in the middle, whereas the applicant's mark has the letter D in the middle of the mark. These act as visual points of difference. It is also noted that where the length of the parties' marks are short, differences are more likely to be noticed.³ Therefore, I consider the differences between the marks, in letters and in length, has a notable visual impact. Taking the above into account, I consider the marks to be visually similar to between a low and medium degree.

67. Aurally, I consider that the opponent's mark is likely to be pronounced as YA-TAH. I consider that the applicant's mark is likely to be pronounced as YA-DAH. The marks share the beginning syllable, and the "AH" of the second syllable. Consequently, I consider the marks to be aurally similar to between a medium and high degree.

68. Conceptually, the applicant submits that the meaning of YADA derives from the Sanskrit language, which when translated, means "wherever, whenever". However, I consider it unlikely that the mark will be recognised or understood by a significant proportion of average consumers. The applicant also submits that "yada yada" is a known English phrase which can be used as an exclamation which has preceded 'and so on' and 'blah blah blah'. In my experience, this is a used and recognisable phrase, however, I do not consider that this meaning would be assigned to the mark, especially as it is used singularly.

69. The applicant also argues that the word 'yatta' is a Japanese word, which when translated, means 'we did it' or 'hooray'. Such translations have been provided at exhibit MR17. To support this submission, the applicant has also attached exhibits MR18 to MR20 to demonstrate that the average consumer would have likely come across the use of the Japanese word through anime. I note the following:

³ Case T-274/09 *Deutsche Bahn v OHIM* EU:T:2011:451, [78] (ICE/IC4)

- MR17 contains an article called “Yatta vs Yokatta: what do they mean?”, dated 17 December 2015. The article is from the website learnjapaneseonline.info. I note that this is not a UK domain.
- MR17 also contains an article called “Japanese Grammar: Different ways of using yaru and suru” dated 11 September 2017. Yatta is referenced in section 3, when expressing joy/pride. It is unknown what website this article is from.
- MR18 is a United States Patent and Trademark Office decision. In this decision, it explores the meaning of YATTA. The applicant asserts that within this exhibit it shows “that translators assert that “yatta” has entered into the English language”. However, on page 4 of the decision, it writes that “due to the word’s popularity, some translators assert that “yatta” has entered into the English language” (underlined for emphasis). I have no evidence from translators before me in this case. The evidence also filed in the US case is different to the evidence before me, and the significance of the word was assessed in the US, not in relation to the UK average consumer.
- MR19 is an article called “Japanese anime is finally going mainstream in the UK. What’s going on- and why now?” dated 8 July 2017. This article is from the Radio Times. I note that there is no mention of the word yatta, nor is there any mention of the UK audience understanding Japanese, or specifically the word yatta, through anime.
- MR20 is an extract from statista.com regarding the monthly reach of the Radio Times magazine in the UK from October 2012 to March 2020 dated 2 March 2021. This is a supporting exhibit for MR19.

70. Although anime may be popular in the UK, the above exhibits do not demonstrate that the word ‘yatta’ and its meaning would have been taught through this medium to the UK public. Consequently, I do not consider that a significant proportion of average consumers would know this meaning.

71. I consider that both the opponent’s and the applicant’s marks, when viewed as a whole, are likely to be viewed as invented words which would be attributed no particular meaning. Taking the above into account, I consider the marks to be conceptually neutral.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

73. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

74. The opponent has not pleaded that its mark has acquired enhanced distinctiveness. However, for the sake of completeness, I will make a finding as to

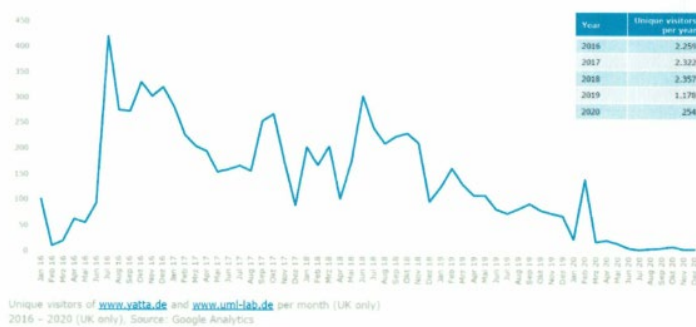
whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing enhanced distinctiveness is the UK market.

75. It is important to note that some of the evidence that was discounted in the proof of use section above, due to it falling before the relevant period, will be relevant to my enhanced distinctiveness assessment. It will, therefore, be taken into consideration.

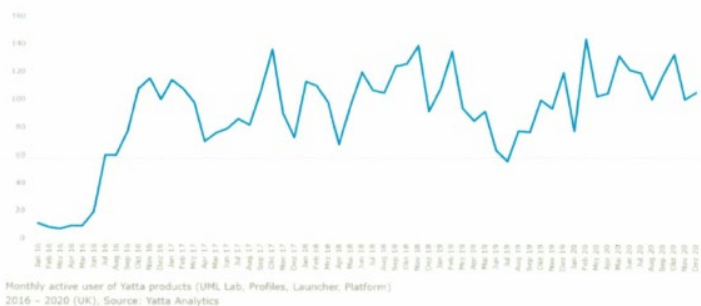
76. The opponent has provided sales figures to enable me to assess the extent of the use that has been made of the mark. Sales made since 2016 until 2020 have amounted to €13,640,641.44 in the EU. I have also been provided EU advertising figures for 2016 to 2020 which amount to €221,343.46. However, there does not appear to be any information as to what proportion of these relate to the UK market, if any. Consequently, without a breakdown, I am unable to establish the intensity of the use within the UK.

77. The only evidence provided by the opponent in relation to the UK are the following graphs and figures:

 Yatta unique visitors per month in UK only



 Yatta monthly active users in UK only



78. It is important to note that the amount of Yatta unique visitors per month in the UK has decreased from 2,259 in 2016 to 245 in 2020. In any event, these figures are relatively modest given the size of the market.

79. Taking all of the above into consideration, I do not consider the evidence sufficient to establish enhanced distinctiveness.

80. I now turn to the inherent distinctiveness of the opponent's mark. I consider the word Yatta will be viewed as an invented word which is neither allusive nor descriptive in relation to the goods and services for which the mark is registered. Therefore, I consider the opponent's mark to be inherently distinctive to a high degree.

Likelihood of confusion

81. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

82. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.

- I have found the marks to be aurally similar to between a medium and high degree.
- I have found the marks to be conceptually neutral.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I have identified the average consumer to be business users or members of the general public, who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process. However, I recognise that the level of attention may be above medium where the goods and services are particularly technical in nature.
- I will make my assessment on the basis that the parties' goods are identical.

83. As established above, both Yatta and YADA are invented words which have no particular meaning. They are both highly distinctive, and there will be no conceptual hook to assist in differentiating between the marks. These are clearly factors in favour of the opponent. However, I bear in mind that, where the length of the parties' marks are short, the differences are more likely to be noticed.⁴ Therefore, the differing letters - 'tt' and 'D' – will, therefore, have more of an impact. The result of this is that there is only between a low and medium degree of visual similarity between the marks, which will be particularly important given the predominantly visual purchasing process. Consequently, I do not consider that the average consumer would overlook the differing letters in the middle of the marks. This will particularly be the case given that the average consumer will be paying at least a medium degree of attention during the purchasing process. For that reason, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other, even when used on identical goods and services. Taking the above into account, I do not consider there to be a likelihood of direct confusion.

84. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

⁴ Case T-274/09 *Deutsche Bahn v OHIM* EU:T:2011:451, [78] (ICE/IC4)

“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.”

85. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicant’s trade mark was connected with the opponent or vice versa. They are not natural variants or brand extensions of each other. Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

86. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

87. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,250** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
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Preparing evidence and considering the opponent's evidence	£700
Preparing and filling written submissions in lieu	£350
Total	£1,250

88. I therefore order Yatta Solutions GmbH to pay Expede IT Solutions Limited the sum of £1,250. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 17th day of November 2021

L FAYTER

For the Registrar

ANNEX

The Applicant's Specification

Class 9

Software; computer software; application software; cloud software; communication software; mobile software; application software for mobile phones; application software for computers; downloadable software in the nature of a mobile application; down-loadable cloud-based software; downloadable cloud-computing software; computer software platforms; computer software for data processing; computer software for processing information; computer software for database management; document management software; computer software that provides real-time information by combining information from various databases and presenting it in an easy-to-understand user interface dashboard; downloadable electronic mail software; downloadable instant messaging software; computer software for data and document capture, transmission, storage and indexing; computer software for booking events; computer software for use in storing electronic event tickets; computer software for use in ticket reservation and booking services for entertainment, sporting and cultural events; computer software for use in ticket reservation and booking services for recreational and leisure events.

Class 35

Advertisement for others on the internet; advertisements (placing of-); advertisements (preparing of-); advertising; advertising, including on-line advertising on a computer network; advertising and advertisement services; advertising and marketing services; advertising by transmission of on-line publicity for third parties through electronic communications networks; advertising on the internet for others; advertising services provided via a database; advertising services provided over the internet; advertising services relating to the provision of business; advertising via electronic media and specifically the internet; business marketing and promotion services; digital advertising services; information services in relation to advertising; marketing the goods and services of others; on-line advertising on a computer network; promoting the goods and services of others via a global computer network.

Class 38

On-line communication services; computer communications for the transmission of information; data communication by electronic means; electronic network communications; transmission of data by electronic means; transfer of information and data via online services and the internet; electronic order transmission; electronic order transmission services; electronic transmission of data; electronic transmission of messages; electronic transmission of documents; message sending and receiving services; provision of providing access to databases; provision of providing information for commercial purposes from a computer stored databank or via the internet; providing access to a global computer network for the transfer and dissemination of information; providing access to a global computer information network; providing an electronic mailbox; online messaging services.

Class 41

Organisation of events for educational purposes; advisory services in relation to educational events; publication of calendars of educational events.

Class 42

Software as a service (SaaS); platform as a service (PaaS); updating of computer software; software design; software development; updating of computer software; software as a service (SaaS) services for ticket reservation and booking services for entertainment, sporting and cultural events; software as a service (SaaS) services for use in ticket reservation and booking services for recreational and leisure events; software as a service (SaaS) services for use in for data and document capture, transmission, storage and indexing; platform as a service (PaaS) featuring computer software platforms for ticket reservation and booking services for entertainment, sporting and cultural events; platform as a service (PaaS) featuring computer software platforms for document capture, transmission, storage and indexing; platform as a service (PaaS) featuring computer software platforms for use in ticket reservation and booking services for recreational and leisure events.

Class 45

Online social networking services.