

O/0010/23

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3673456  
BY INNEO SOLUTIONS GMBH  
TO REGISTER THE TRADE MARK:**



**IN CLASSES 9, 41 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 429320  
BY ARIANEGROUP HOLDING**

## **Background and pleadings**

1. On 26 July 2021, INNEO Solutions GmbH (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3673456 (“the contested mark”). The contested mark was published for opposition purposes on 17 September 2021. The contested mark claims a priority date of 4 February 2021.<sup>1</sup> Registration is sought for the following goods and services:

Class 9: Software for processing 3D data in the 3D web; Augmented and virtual reality software; Software for visualizing and compressing 3D data; Software for correcting material and representation errors; Software for creating and editing Web3D models; Processing software; Computer software, in particular in the fields of graphic data processing, the visualization of 3D data, the simulation of virtual reality and the enrichment of reality with additional information; Augmented reality software; Software for diagnosing and correcting errors; Software and software applications for mobile devices; Data processing software; 3D animation software; Software for data repair and data compression, in particular CAD data; Software for use on desktop and mobile devices; Software for designing a virtual trade fair presence; Software for editing 3D models; Software for creating digital manuals with 3D animations.

Class 41: Production of animations; Animation production services; Services in the field of education and training, in particular introduction and further training in the field of 3D data processing and 3D animation as well as software for enriched and virtual reality, software for visualizing and compressing 3D data and software for correcting material and display errors.

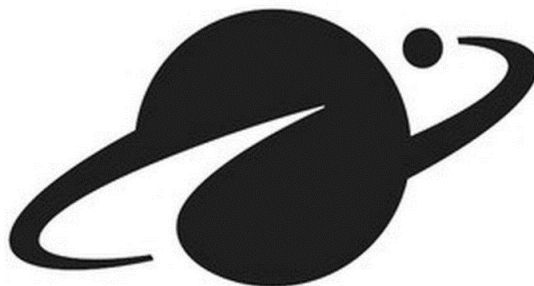
Class 42: Design of websites for virtual trade fair appearances; Design of 3D exhibition stands and exhibition halls; Design of digital showrooms, in particular showrooms that can be equipped using a configurator; IT consultancy, information and information services, namely in relation to 3D

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<sup>1</sup> Priority is claimed from German Trademark No. 30 2021 101 807

data processing and animation software and software for enriched and virtual reality, software for visualizing and compressing 3D data and software for correcting material and display errors; Development of computer software, in particular in the fields of graphic data processing, the visualization of 3D data, the simulation of a virtual reality and the enrichment of reality with additional information, for the visualization and compression of 3D data, for the correction of material and display errors; Development and programming of software, in particular 3D animation software; Development of software for enriched and virtual reality; Creation, further development and maintenance of software for 3D data processing and 3D animation as well as software for enriched and virtual reality.

2. On 17 December 2021, ArianeGroup Holding (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods and services of the application. To support its claim, the opponent relies upon its comparable UK trade mark number 801460629,<sup>2</sup> (“the earlier mark”) which consists of the following:



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<sup>2</sup> Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM or IR(EU). As a result of the opponent’s IR(EU) number 1460629 being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark now recorded on the UK trade mark register has the same legal status as if it had been applied for and registered under UK law, and retains its original international registration date as its filing date.

3. The earlier mark was filed<sup>3</sup> on 4 September 2018 and became registered on 13 September 2019. The earlier mark claims a priority date of 4 April 2018.<sup>4</sup> The earlier mark stands registered in respect of a wide range of goods and services in twelve classes, as set out in the Annex of this decision. However, for the purposes of the opposition, the opponent only relies upon the following:

Class 9: Scientific apparatus and instruments; measuring apparatus and instruments; control apparatus and instruments; detection apparatus and instruments; apparatus for recording, transmission, reproduction or processing of sound or images; electric sensors; electronic sensors; magnetic sensors; electrical, electronic and magnetic pressure, velocity, displacement, temperature, position or vibration sensors; apparatus and instruments for measuring the mechanical properties of materials; apparatus and instruments for measuring and monitoring the aging of materials; measuring and detection apparatus and instruments for tracking and monitoring the aging of materials; data processing equipment; computers; software (recorded programs); software containing launch calculation codes for aerospace propulsion systems and mechanisms; software for designing, testing, planning and monitoring of installations for the dismantling of materials and equipment containing energetic materials; downloadable computer software applications for mobile telephones; downloadable electronic publications; telecommunication apparatus; satellites; satellites for transportation.

Class 42: Engineering and technical consultancy services (services provided by engineers); analysis and expertise services (engineering works); scientific and industrial research in the fields of aerospace, aviation, aeronautics, composite materials and energetic equipment; chemical research; technical project studies; testing of machines; testing of materials; flight tests of airplanes, helicopters and spacecraft; testing of aerospace vehicle systems, equipment and parts; technical inspection of

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<sup>3</sup> The earlier mark derives from an IR(EU) that was designated for protection in the EU on 4 September 2018.

<sup>4</sup> Priority is claimed from French Trademark No. 4442854

systems, equipment and parts of aerospace vehicles; analysis, expertise and processing of the acquisition of technical data recorded during test campaign of systems, equipment and parts of aerospace vehicles (engineering works); design of spatial structures; design, installation, maintenance, update and rental of software; computer programming; design and maintenance of databases; research and development of new products for others.

4. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of the goods and services identified without having to establish genuine use.
5. The opponent essentially argues that the respective goods and services are identical or similar and that the marks are similar, giving rise to a likelihood of confusion.
6. The applicant filed a counterstatement denying the ground of opposition. The applicant denies that the competing marks are similar and that the respective goods and services are identical or similar. It also disputes the existence of a likelihood of confusion.
7. The opponent is professionally represented by Stobbs IP, whereas the applicant is professionally represented by Barker Brettell LLP. Only the opponent filed evidence in these proceedings. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter.<sup>5</sup> However, both parties filed written submissions in lieu of an oral hearing. This decision is taken following a careful perusal of the papers, keeping in mind all of the evidence and submissions.

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<sup>5</sup> I note that the opponent initially requested a hearing on 15 September 2022. However, on 22 September 2022 the opponent contacted the Tribunal via email to confirm that they did not wish for a hearing to take place.

8. 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

## **Evidence**

9. The opponent's evidence comprises the witness statement of Verity Rosher-Hutton, a Chartered Trade Mark Attorney at the opponent's representatives, dated 6 June 2022, together with Exhibits VRH01 to VRH04. The purpose of the evidence is to support claims to a close link between the fields of technical consultancy, IT, software development and engineering.

10. As noted above, the opponent also filed written submissions in lieu of a hearing. The applicant did not file evidence but did provide written submissions in lieu of a hearing.

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

## **Decision**

### **Section 5(2)(b)**

12. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

“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.”

### **Case law**

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

14. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,<sup>6</sup> the General Court (GC) stated that:

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<sup>6</sup> Case T-133/05

“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 fur 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”.

17. Regarding the interpretation of terms in specifications, 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”.

18. Moreover, in *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating 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”.

19. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).
20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the 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”.
21. 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. (as he then was), sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/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”.

22. The goods and services to be compared are those outlined in paragraphs 1 and 3 above.

#### Class 9

23. All of the applicant's terms in this class describe particular types of software. Consequently, they are encompassed by the opponent's term “software (recorded programs)”. As such the goods are *Merici* identical.

#### Class 41

*Services in the field of education and training, in particular introduction and further training in the field of 3D data processing and 3D animation as well as software for enriched and virtual reality, software for visualizing and compressing 3D data and software for correcting material and display errors.*

24. Software (recorded programs) is broad enough to encompass educational software sold by institutions to support their educational services. However, the applicant's above services and the opponent's software goods are intrinsically different in nature as one is a good and the other a service. The method of use is also likely to differ as users of the services will attend a scheduled course, whereas the users of the opponent's goods require direct user interaction with the goods themselves. Nevertheless, there is an overlap in intended purpose where the software is for educational purposes. The trade channels will overlap insofar as educational services that provide the training themselves could also provide the software to facilitate learning. There could also be a degree of competition as users could choose the applicant's education and training services or to purchase software that delivers the equivalent education and training. Furthermore, where the services relate to training specifically for software, there may be a degree of complementarity as software is essential to these services and it would be reasonable for consumers to believe that both the software and the educational services relating to software would lie with the same undertaking. Users will also

overlap whether they are members of the general public, or professional users. Therefore, I find that the goods and services are similar to a low degree.

*Production of animations; Animation production services*

25. The applied-for terms and the opponent's term "software (recorded programs)" fundamentally differ in nature as one is a good and the other is a service. The fact that the applicant's services may make use of software in the production of the animations is not determinative.<sup>7</sup> The intended purpose differs as the applicant's services are for producing animations potentially for use in videos, magazines or comic books, whereas software is an interactive program or operating system. The method of use is also unlikely to overlap as users of the applicant's services will approach a company for them to produce animations, whereas software is a product that the user will interact with on a computer or electronic device. The trade channels will differ; the opponent's goods would be sold by a retailer, whether at a physical store or online, whereas the applicant's services would be offered by a company that produces animation. Furthermore, the goods and services are not competitive in nature as software cannot perform the function of the services without the required expertise of the user. Nor is there complementarity between the goods and services as, although the use of software may facilitate the production of animations, consumers would not believe that companies that produce animations would also create software (even software used in the process of creating animations as they are different skill sets). Consequently, I find that these goods and services are dissimilar.

Class 42

*Development of computer software, in particular in the fields of graphic data processing, the visualization of 3D data, the simulation of a virtual reality and the enrichment of reality with additional information, for the visualization and compression of 3D data, for the correction of material and display errors; Development and programming of software, in particular 3D animation software; Development of software for enriched and virtual reality; Creation, further development and*

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<sup>7</sup> *Les Éditions Albert René v OHIM*, Case T-336/03 paragraphs 61 & 69

*maintenance of software for 3D data processing and 3D animation as well as software for enriched and virtual reality.*

26. The applicant's above terms include services for the creation, development and maintenance of certain software. Although expressed slightly differently, it is my view that they would be encompassed by the opponent's terms "design, installation, maintenance, update and rental of software; computer programming". Therefore, I find that the services are *Merit* identical.

*IT consultancy, information and information services, namely in relation to 3D data processing and animation software and software for enriched and virtual reality, software for visualizing and compressing 3D data and software for correcting material and display errors*

27. Within its written submissions the opponent states that "the appropriate interpretation of the term "services provided by engineers" in the Earlier Right would be inclusive of software engineers which may be a typical provider of the "IT consultancy, information and information services" included in the application." The word "engineer" is defined as "a person who uses scientific knowledge to design, construct, and maintain engines and machines or structures such as roads, railways, and bridges."<sup>8</sup> In my opinion, the average consumer would not interpret the word engineer to include specialist types of engineers, such as software engineers, chemical engineers or sound engineers, without an express reference to the specialism. To do so would construe the term beyond its ordinary and natural core meaning and would give a wide interpretation covering a vast range of activities, contrary to the caselaw quoted above. Therefore, in my view, the opponent's term "engineering and technical consultancy services (services provided by engineers)" would not include software engineers unless expressly stated. Instead, a better comparison would be the applicant's above services and the opponent's class 42 services "Design, installation, maintenance, update and rental of software". There is an expectation that those that design, install, maintain, update and rent software would also provide technical advice and support included

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<sup>8</sup> <https://www.collinsdictionary.com/dictionary/english/engineer>

within the applicant's services. Therefore, the provider and trade channels would be the same, as would the target users. There is a degree of complementarity between these services as technical information is essential and important to the installation and maintenance of software and consumers will believe that the responsibility for these services rests with the same undertaking. The intended purpose overlaps insofar as both services wish to ensure the effective and efficient running of the computer software, however, I acknowledge that the specific purpose is not the same. Overall, I find these services would be similar to a medium degree.

*Design of websites for virtual trade fair appearances; Design of 3D exhibition stands and exhibition halls; Design of digital showrooms, in particular showrooms that can be equipped using a configurator*

28. The applicant's above services relate to the design of websites and virtual 3D showrooms and exhibition stands and halls. These are different in nature to the opponent's class 42 services "design, [...] of software; computer programming", as the applicant's services specifically relate to designing virtual, digital and 3D environments, or websites for virtual trade fairs to take place, whereas the opponent's services are for designing software and computer programs. Given the difference in nature between the services the method of use will also differ as will the intended purpose. The applicant's services will be used for the purpose of designing websites for virtual trade fair appearances and virtual 3D representations of showrooms and exhibition halls whereas the opponent's services are for designing software or computer programs. Users are unlikely to be the same and, even where they overlap, this will be at too general a level to engage similarity. Trade channels will differ as companies that offer the design of websites or 3D virtual representations of showrooms and exhibition halls are unlikely to also offer services relating to the design of software or computer programming, including services for creating software used for producing 3D virtual environments. The services are not in competition as services for software design are unlikely to satisfy the need for a virtual 3D design of an exhibition stand. Neither are the services complementary in nature, as although software is likely to be used in the creation of websites for virtual trade fair appearances or 3D virtual representations,

consumers would not reasonably expect services designing these 3D virtual representations, to also design any software use in the process. Overall, I find that the services are dissimilar.

29. The opponent's "software (recorded programs)" does not put it in a more favourable position. The goods and services naturally differ in nature as one is a good and the other is a service. The method of use also differs as users will approach the service provider to design a website or 3D digital representation of a showroom, whereas users of the goods will directly interact with the software themselves to, for example, access, store or process data. Furthermore, the intended purpose is different; the core purpose of the applicant's services is to design a website or digital exhibition stand, whilst the intended purpose of software is to instruct a computer how to perform specific tasks, which may include enabling the user to access, store or process data, or, as has been seen above, learn new skills. Users may overlap, but only to a general degree. Trade channels will differ as companies that offer services to design websites or digital 3D exhibition halls would not typically produce and sell software products. The goods and services are not complementary and the fact that the applicant's services may make use of software to function is not determinative.<sup>9</sup> Although it is possible that users of the applicant's services could, instead, buy software to design their own website or 3D environment, I do not consider that this creates any material competition between the goods and services. This is particularly because this would require specific knowledge and expertise which prospective users of the applicant's services are unlikely to possess. Overall, I find that the goods and services are dissimilar.

30. I have also considered the other goods and services relied upon under the earlier mark and none puts the opponent in a more favourable position.

31. As some degree of similarity between the goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against services of the application that I have found to be dissimilar, namely:<sup>10</sup>

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<sup>9</sup> *Les Éditions Albert René v OHIM*, Case T-336/03 paragraphs 61 & 69

<sup>10</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.



Class 41: Production of animations; Animation production services

Class 42: Design of websites for virtual trade fair appearances; Design of 3D exhibition stands and exhibition halls; Design of digital showrooms, in particular showrooms that can be equipped using a configurator

### **The average consumer and the nature of the purchasing act**

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

33. 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. (as he then was) 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.”

34. Due to the nature of the goods and services at issue in these proceedings, relevant consumers are likely to include business or professional users as well as the general public.

35. In respect of the services, for business and professional users the cost is likely to vary, depending on the nature and type of packages required to suit the business/professional need. Overall, the frequency at which the services are provided is also likely to vary again depending on the size and demands of the business. The selection of services would be relatively important for business and professional consumers as they will wish to ensure that the products meet their professional needs, and they would be alert to the potential negative impact of choosing the wrong services on their business. Business and professional users are likely to assess the service provider's technical knowledge, their efficiency and the ease of use of the services. In light of the above, I find that the level of attention of business and professional users would be above average. The services are likely to be purchased directly from the service provider after viewing information in specialist magazines, brochures or on the internet. In these circumstances, visual considerations would dominate, however, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of services would involve discussions with sales representatives or word of mouth recommendations.

36. In respect of business users of the goods, the price of the goods in class 9 is likely to vary, depending on quantity, nature and type of goods required, but, overall, it is unlikely to be at the highest end of the scale. The goods are likely to be purchased not infrequently. The selection of the goods would be relatively important for consumers from the business community as they will wish to ensure that the products meet their business needs, for example, on a large scale with high demands. Accordingly, I find that the level of attention of members of the business community would be above average. The goods are available from physical retail establishments, (or their online equivalents), or business exhibitions, where they are likely to be purchased after viewing information on physical displays or on the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods would involve oral discussions with sales representatives.

37. For the general public, the purchase of these goods is likely to vary in frequency. For example, games software for computers or consoles are likely to be purchased regularly, whereas other types of software, such as, word processing software may only be purchased by the public once. The goods are likely to vary in price depending on the nature of the goods, but overall, they are unlikely to be overly expensive. The general public will consider factors such as cost, compatibility, functionality and the specification of the product. In light of the above, the general public will pay an average level of attention to the purchasing process. The goods are typically sold by brick-and-mortar retail establishments, or their online equivalents, where they will be purchased after viewing information on physical displays or the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as the general public may wish to discuss the products with sales assistants prior to purchasing the goods.

38. It is equally likely that some of the services – such as, for example, the education and training services in class 41 – will be purchased by the general public. These services are likely to be purchased more occasionally. The cost will vary depending on the type of course or class, from relatively modest to expensive. The general public will consider factors such as cost, duration, and impact on future income. Overall, I find that the general public would pay an average to high level of attention. The services are usually advertised online, or in brochures and purchased online or over the phone. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as the general public may wish to discuss the service products with a representative of the company either over the phone or in person prior to purchasing the services.

### **Comparison of the marks**

39. It is clear from *Sabel BV v. Puma AG*<sup>11</sup> 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

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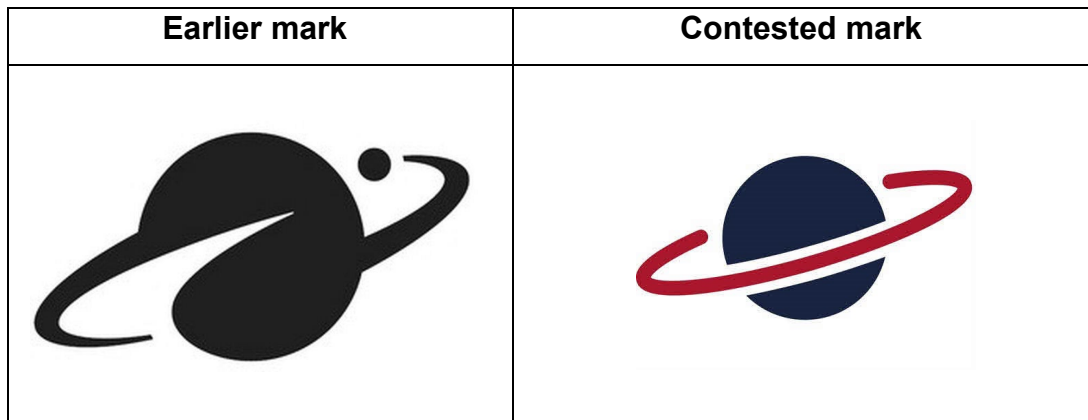
<sup>11</sup> Case C-251/95, paragraph 23

impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] 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.”

40. It would therefore be wrong to artificially 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.

41. The respective trade marks are shown below:



### Overall impressions

42. The earlier mark is a figurative mark consisting of a stylised sphere device with an incomplete ring around its centre. The ring element is broken at the front and tilts upwards. On the left-hand side, as the ring moves across the front of the sphere, a slice is removed from the sphere. There is also a small dot to the right-hand side of the sphere. The earlier mark is presented in black and white, but I am reminded

that the registration of a trade mark in black and white covers use of the mark in colour, provided it is not a complex colour arrangement.<sup>12</sup> Overall, the earlier mark will be recognised as a planet, with a moon orbiting it. The overall impression lies mainly in the sphere and the surrounding ring, with the small dot and the tilt of the ring playing a lesser role.

43. The contested mark is also a figurative mark which encompasses a navy sphere with an incomplete red ring around the centre of the sphere that breaks at the back. Where the ring crosses the sphere there is a white border either side of the red ring. The overall impression of the mark is dominated by the sphere and the ring in equal measure, whilst the colour arrangement plays a lesser role.

#### Visual comparison

44. The competing marks are similar as they both contain sphere devices with incomplete rings encircling them. However, the rings are broken at different points in the mark, at the front in the earlier mark and at the back of the sphere in the contested mark. Furthermore, the angle of the respective incomplete rings around the spheres also differs, in the earlier mark it is tilted upwards, giving the impression that the consumer is viewing the image from below looking upwards, whereas in the contested mark the consumer has more of a parallel view. The style also differs; the earlier mark is presented in a single colour, whilst the contested mark uses the colours navy, red and white to depict the sphere and its ring. Moreover, the earlier mark also has a small dot orbiting the large sphere which is not found in the contested mark. Taking into account the overall impressions, I find that the competing marks are visually similar to between a medium and high degree.

#### Aural comparisons

45. Where purely figurative marks are being compared, such as here, it is not appropriate for a conventional aural comparison to take place. Moreover, in a

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<sup>12</sup> Court of Appeal in *Specsavers* [2014] EWCA Civ 1294, at paragraph 4 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

comparison between two purely visual marks, not much importance should be attached to the fact that, if required to give the marks a name, consumers could call both parties' marks "planets". As a result, I find that the marks are aurally neutral.

### Conceptual comparison

46. Both marks contain a large sphere device with an incomplete ring around its centre which will clearly be recognised as a planet. However, in addition, the earlier mark also contains a small dot to the right-hand side of the larger sphere. Therefore, it includes the added concept of a moon orbiting the planet. The orbiting moon is a concept that is not found within in contested mark. Therefore, overall, I find that the competing marks are not conceptually identical, but similar to a high degree.

### **Distinctive character of the earlier mark**

47. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does

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

48. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods and services will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood of confusion.

49. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

50. Within its submissions, the opponent argues that the mark has no meaning in relation to the goods and services in question.<sup>13</sup>

51. However, the applicant argues that “The opponent’s mark consists of an image which is laudatory of the opponent’s goods/services and therefore, it is not particularly remarkable or distinctive. As such, the opponent’s mark has a low level of distinctive character for the goods/services covered by their registration.<sup>14</sup>

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<sup>13</sup> Opponent’s written submissions, page 12, paragraphs 67 -69

<sup>14</sup> Applicant’s written submissions, page 4.

52. Within its written submissions, the applicant has referred to other trade mark registrations containing planet devices registered for goods and services within classes 9, 41 and 42. In this connection, registration numbers have been provided as well as details of the mark and the goods and/or services held under the registration number. Moreover, in its submissions the applicant argues that “We appreciate that the office is not bound by previous precedent however, such a large number of registrations of figurative marks indicates that the public is accustomed to the use of planets as trademarks and is able to distinguish between them.”<sup>15</sup>

53. Firstly, I note that the applicant did not file its evidence in the appropriate format or at the appropriate time in these proceedings. It is, therefore, inadmissible. However, even if it was admissible, I must clarify that the existence of other earlier registered marks containing a planet device will not have any bearing on whether there exists a likelihood of confusion between the contested mark and the opponent’s earlier mark. This is because there is no evidence that the marks are in use and (despite the applicant’s claim) that consumers have become accustomed to differentiating between them. This is because there is no evidence before me that frequent use in the fields concerned does amount to a weakened distinctive character of the mark. On this point, in *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field

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<sup>15</sup> Applicant’s written submissions, page 13.



concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

54. The earlier mark is figurative and comprises a stylised sphere-shaped device with an incomplete ring around its centre which is broken at the front. The ring tilts upwards, giving the impression that the consumer is viewing the device from below. On the left-hand side, as the ring moves across the front of the sphere, a slice is removed from the sphere. There is also a small dot to the right-hand side of the sphere. Overall, the earlier mark will be perceived as a planet with a small moon orbiting it. In my view, the distinctive character lies in the combination of the sphere and ring which overall forms the impression of a planet. I disagree with the applicant’s claim that the earlier mark is laudatory of the goods and services relied on under the mark. In my view, the mark is not descriptive or suggestive of the goods or services relied upon by the mark. Overall, I consider that the earlier mark possesses at least a medium degree of inherent distinctive character.

### **Likelihood of confusion**

55. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor 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 also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be aware of 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 they have retained in their mind.

56. 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 and services down to the responsible undertakings being the same or related.

57. 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 that:

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

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

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

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

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

58. These examples are not exhaustive but provide helpful focus.

59. I have found that the applicant’s goods and services that are still in play are either identical or similar to those of the earlier mark. I have found that the average consumer of the goods and services will be either business users who will pay an above average level of attention or, the general public who would pay an average level of attention in relation to goods, but an average to high level of attention when purchasing services. I have found that the purchasing process will be largely visual. The overall impression of the respective marks is dominated by the sphere and surrounding ring which combine to form a planet. I have found that the earlier mark and the contested mark are visually similar to between a medium and high degree, aurally neutral and conceptually similar to a high degree. I have also found that the earlier mark has at least a medium level of inherent distinctive character.

60. I acknowledge that the marks differ as the respective rings around the spheres have different tilts and are broken in different places. In addition, the contested mark is presented in colour whereas the earlier mark appears in black and white, but as discussed above, the registration of a trade mark in black and white covers use of the mark in colour. The earlier mark also has a small dot signifying an orbiting moon that is not replicated in the contested mark. Nevertheless, the competing marks both contain a sphere with a ring around its centre which will be identified as a planet. These elements dominate the overall impressions and distinctiveness of the competing marks. In my opinion, taking into account the overall levels of similarity between the marks, the differences described are likely to be insufficient to distinguish between the competing marks given the principle of imperfect recollection. Therefore, it is likely that, consumers paying even a high level of attention during the purchasing process would misremember the marks for one another and fail to recall the presentational differences such as the presence of the orbiting moon in the earlier mark or differences in the tilt and break of the

ring, even for identical goods. Consequently, in my view there is a likelihood of direct confusion.<sup>16</sup>

## **Conclusion**

61. The opposition brought under section 5(2)(b) of the Act has been partially successful. Subject to any appeal against my decision, the application will be refused in respect of the following goods and services:

Class 9: Software for processing 3D data in the 3D web; Augmented and virtual reality software; Software for visualizing and compressing 3D data; Software for correcting material and representation errors; Software for creating and editing Web3D models; Processing software; Computer software, in particular in the fields of graphic data processing, the visualization of 3D data, the simulation of virtual reality and the enrichment of reality with additional information; Augmented reality software; Software for diagnosing and correcting errors; Software and software applications for mobile devices; Data processing software; 3D animation software; Software for data repair and data compression, in particular CAD data; Software for use on desktop and mobile devices; Software for designing a virtual trade fair presence; Software for editing 3D models; Software for creating digital manuals with 3D animations.

Class 41: Services in the field of education and training, in particular introduction and further training in the field of 3D data processing and 3D animation as well as software for enriched and virtual reality, software for visualizing and compressing 3D data and software for correcting material and display errors.

Class 42: IT consultancy, information and information services, namely in relation to 3D data processing and animation software and software for enriched and virtual reality, software for visualizing and compressing 3D data

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<sup>16</sup> In reaching my decision, I have considered the decision of Iain Purvis QC (as he then was) in *The Royal Academy of Arts v Errea Sport S.P.A.* BL O/010/16, paragraph 13, however, I do not believe the marks in the case before me to be so vastly different in style as to find that there would be no confusion.

and software for correcting material and display errors; Development of computer software, in particular in the fields of graphic data processing, the visualization of 3D data, the simulation of a virtual reality and the enrichment of reality with additional information, for the visualization and compression of 3D data, for the correction of material and display errors; Development and programming of software, in particular 3D animation software; Development of software for enriched and virtual reality; Creation, further development and maintenance of software for 3D data processing and 3D animation as well as software for enriched and virtual reality.

62. The application will proceed to registration in the UK in respect of the following services, against which the opposition has failed:

Class 41: Production of animations; Animation production services

Class 42: Design of websites for virtual trade fair appearances; Design of 3D exhibition stands and exhibition halls; Design of digital showrooms, in particular showrooms that can be equipped using a configurator

### **Costs**

63. As the opponent has achieved a greater measure of success, I direct that opponent is entitled to a contribution towards its costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016, with an appropriate reduction to reflect the degree of success. Applying this guidance, I award the opponent the following as a contribution toward costs:

Official fees <sup>17</sup>	£100
Preparing a notice of opposition and considering the applicant's counterstatement.	£175

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<sup>17</sup> The official fee connected with the filling of the Form TM7 is not subject to a reduction.

Filing Evidence	£450
Preparing written submissions	£275
<b>Total</b>	<b>£1,000</b>

64. Accordingly, I hereby order INNEO Solutions GmbH to pay ArianeGroup Holding the sum of **£1,000**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 5<sup>th</sup> day of January 2023**

**Sarah Wallace**  
**For the Registrar**

## **Annex**

- Class 1: Chemical products for use in industry and science; unprocessed artificial resins; unprocessed synthetic resins; unprocessed artificial and synthetic mineral resins; unprocessed plastics; fire-extinguishing compositions; adhesives for use in industry; chemical reagents other than for medical or veterinary use.
- Class 4: Fuels (including motor spirits); fuels (propellants); carburants; propellant compositions for rockets.
- Class 6: Common metals and their alloys; building materials of metal; Structured composite materials, essentially with a metal matrix; carbonaceous composite materials, essentially with a metal matrix; laminated materials made of successive layers of elastomers and reinforcing materials of metal or composites; metals plated with explosives; space structures of metal.
- Class 7: Motors and engines (other than for land vehicles); engines for air locomotion vehicles; airplane engines; aircraft engines; space vehicle engines; rocket engines; space launch vehicle engine; propulsion systems and mechanisms and component parts thereof for vehicles (except those for land vehicles); turbines other than for land vehicles; turbocompressors; air nozzles; mixers for aerospace propulsion; blowing machines for the compression, exhaustion and transport of gases; industrialization machines in the field of aeronautics and space; machines for the production of composite or non-composite parts in the field of aeronautics and space; machine tools; machines for producing and repairing parts for use in aeronautical and space propulsion systems; machines and machine tools for the dismantling of materials and equipment containing energetic materials; gas generators.

- Class 9: Scientific apparatus and instruments; measuring apparatus and instruments; control apparatus and instruments; detection apparatus and instruments; apparatus for recording, transmission, reproduction or processing of sound or images; electric sensors; electronic sensors; magnetic sensors; electrical, electronic and magnetic pressure, velocity, displacement, temperature, position or vibration sensors; apparatus and instruments for measuring the mechanical properties of materials; apparatus and instruments for measuring and monitoring the aging of materials; measuring and detection apparatus and instruments for tracking and monitoring the aging of materials; data processing equipment; computers; software (recorded programs); software containing launch calculation codes for aerospace propulsion systems and mechanisms; software for designing, testing, planning and monitoring of installations for the dismantling of materials and equipment containing energetic materials; downloadable computer software applications for mobile telephones; downloadable electronic publications; telecommunication apparatus; satellites; satellites for transportation.
- Class 12: Apparatus for locomotion by air; aircraft; space vehicles; air vehicles; launch vehicles; parts and fittings for all the aforesaid products, except tires; braking devices for air vehicles; airbags for vehicles [airbags]; protection devices via safety belts.
- Class 13: Pyrotechnic products; Pyrotechnic compounds; solid pyrotechnic products for rocket engines; propellant powders and solid propellants; explosive fuses; signal rockets; pyrotechnic transmission cords; pyrotechnic charges; pyrotechnic engines; pyrotechnic gas generators.
- Class 17: Semi-finished structured composite materials, essentially with a plastic matrix; semi-finished carbonaceous composite materials, essentially with a plastic matrix; insulating refractory materials; thermal protection systems and heat protection devices in the form of super structures and coatings; heat shields; caulking materials; insulating materials;



compositions for preventing the radiation of heat; insulating materials; insulating materials; erosion-resistant thermal protectors, namely, semi-finished products based on synthetic or artificial, mineral or organic resins, resistant to thermal or thermo-mechanical erosion, intended to coat and thermally protect (high temperatures) various structures such as doors, bulkheads, pipes or thruster nozzles.

Class 19: Non-metallic building materials; structured composite building materials, essentially with a ceramic matrix; carbonaceous composite building materials, essentially with a ceramic matrix; composite building materials with a ceramic matrix; refractory materials.

Class 37: Construction; construction of buildings relating to the fields of aviation, aerospace and aeronautics; servicing, repair and maintenance of air locomotion vehicles; repair, maintenance and dismantling services in the field of air locomotion vehicles and apparatus, as well as their engines and component parts; maintenance and repair of space vehicles; installation, maintenance and repair of data processing equipment; installation, maintenance and repair of telecommunication apparatus; installation, maintenance and repair of satellites; refueling services for air or space vehicles; air-to-air refueling services for air vehicles.

Class 39: Transport; air transport; travel organization; freighting; rental of space or air vehicles; traffic information; air traffic control services; airport services; GPS navigation services; storage of spacecraft, aircraft, helicopters and planes and their spare parts, for third-parties; satellite launching; launching and placing of third-party satellites in a predetermined orbit; salvaging, recovering, towing and salvaging services of air locomotion vehicles and apparatus.

Class 42: Engineering and technical consultancy services (services provided by engineers); analysis and expertise services (engineering works); scientific and industrial research in the fields of aerospace, aviation, aeronautics, composite materials and energetic equipment; chemical

research; technical project studies; testing of machines; testing of materials; flight tests of airplanes, helicopters and spacecraft; testing of aerospace vehicle systems, equipment and parts; technical inspection of systems, equipment and parts of aerospace vehicles; analysis, expertise and processing of the acquisition of technical data recorded during test campaign of systems, equipment and parts of aerospace vehicles (engineering works); design of spatial structures; design, installation, maintenance, update and rental of software; computer programming; design and maintenance of databases; research and development of new products for others.