

BL O/0126/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003668140

BY X CYBER GROUP LTD

TO REGISTER THE TRADE MARK:

PANDORA'S BOX

Pandora's Box

(SERIES OF 2)

IN CLASSES 9, 35, 36, 41, 42 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 428709

BY PANDA SECURITY, S.L.

BACKGROUND AND PLEADINGS

1. On 13 July 2021, X Cyber Group Ltd (“the applicant”) applied to register the series of 2 trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 10 September 2021 and registration is sought for the goods and services set out in the Annex to this decision.

2. The application was partially opposed by Panda Security, S.L. (“the opponent”) on 2 December 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against classes 9, 41 and 42 of the application.

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

PANDA

UK registration no. UK00801027040

Filing date 20 October 2009; Registration date 16 December 2010.

Priority dates 22 April 2009 and 18 May 2009.¹

(“The First Earlier Mark”)

Panda Dome

UK registration no. UK00801425441

Filing date 28 February 2018; Registration date 4 March 2019.

Priority date 1 September 2017.

(“The Second Earlier Mark”)

4. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent’s First and

¹ There are 2 priority dates deriving from 2 earlier Spanish PANDA marks. The different goods and services claim priority from those different dates. However, I note that nothing turns on this.

Second Earlier Marks were automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

5. The opponent relies upon all of the goods and services for which its earlier marks are registered, as set out in the Annex to this decision.

6. The opponent claims that the marks are so similar, and that the goods and services are either identical or so similar, that there exists a clear likelihood of confusion.

7. The applicant filed a counterstatement denying the claims made.

8. Both parties filed evidence in chief and written submissions. The opponent also filed evidence and submissions in reply. A hearing took place before me on 13 December 2022. The Opponent was represented by Mr Jerry Bridge-Butler of Baron Warren Redfern. The applicant was represented by Ms Kendal Watkinson of Hogarth Chambers. I make this decision having taken full account of all the papers, referring to them as necessary.

9. 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

10. The opponent's evidence consists of the joint witness statement of Mr Aitor Otsoa and Ms Ana Barrón dated 18 May 2022. Mr Otsoa and Ms Barrón are, respectively, the Business Controller and the Accounting, Treasury and Tax Manager of the opponent, a position which they have held, respectively, since June 2012 and November 2003. Mr Otsoa's and Ms Barrón's statement was accompanied by 11 exhibits (PANDA1-PANDA11).

11. The applicant's evidence consists of the witness statement of Mr Philip Robbins dated 19 July 2022. Mr Robbins is the General Counsel and the Chief Compliance Officer for the applicant. Mr Robbin's statement was accompanied by 1 exhibit (XCYBER01).

12. The opponent's evidence further consists of the witness statement of Ms Valerie Maureen Conlon BA (Hons), a translator to RWS Group Limited, dated 16 September 2022. I note that this statement provides an English language translation of the original Spanish documents entitled **EXHIBIT PANDA03** and **PANDA11** of the witness statement of Mr Otsoa and Ms Barrón. Ms Conlon's statement was accompanied by 2 exhibits (VC1-VC2).

13. Firstly, I note that **exhibit PANDA02** contains extracts from the annual accounts and management reports for the opponent prepared by KPMG for 2016 to 2018. These documents are in Spanish, however, Mr Otsoa and Ms Barrón have provided translations of the parts that they believe to be relevant. I note that as highlighted in paragraph 32 of *Pollini* (BL O/146/02), "where an exhibit is in a foreign language, a party seeking to rely on it in registry proceedings must provide a verified translation into English". Therefore, the translations within this exhibit should have been prepared in a translator's own witness statement (as Ms Conlon has as done for **PANDA03** and **PANDA11**). Consequently, I cannot take these translations into consideration.

14. Mr Otsoa and Ms Barrón state that the opponent was established and founded in 1990 in Spain and began its international expansion in 1996. In 2007, the opponent changed its name to "Panda Security S.L. to reflect better on its focus on computer security". The opponent now has 80 offices throughout the world, including the UK, protecting 30 million users worldwide in 195 countries.

15. **Exhibit PANDA01** contains the details of the countries in which the opponent has an active presence, including 34 European countries, such as the UK, as well as America, Asia, Africa and the Pacific. I note that the website uses the following mark:



16. Mr Otsoa and Ms Barrón also provides the following total sales for the opponent's computer security goods and services in the EU in 2016 to 2018:

2016 - €28,281,000

2017 - €31,821,000

2018- €34,024,000

17. I also note that Mr Otsoa and Ms Barrón state in their witness statement that the "revenues in the years 2019-2021 are of a similar scale".

18. **Exhibit PANDA04** contains extracts from UK Companies House for the opponent's UK subsidiary Panda Security UK Ltd. I note that in their witness statement, Mr Otsoa and Ms Barrón state the following:

"The Company's wholly owned UK subsidiary was incorporated on 27 April 1999 under the name Panda Software (UK) Ltd, changing its name to Panda Security (UK) Ltd on 30 November 2007, then changing to Panda Software (UK) Ltd on 16 April 2008, before its final change of name to Panda Security UK Ltd on 23 September 2009. **The UK company was originally formed by its then UK Partner, but the Company took full ownership of the company as of mid-2009. Throughout its period of trading under the various PANDA company names, the UK company was solely focused on the distribution and sale of the Company's PANDA branded security goods and services.**"

19. I note that in the applicant's submissions in reply, they submit that "exhibit Panda04 incorporates some extracts from Companies House providing information about certain companies, none of which are the opponent. The opponent has not provided any evidence verifying that these companies were using the First Registration with consent from the Opponent".²

20. In the opponent's evidence in reply, they highlight that "it is stated at paragraph 6 of the Otsoa and Barrón witness statement [above] that Panda Security UK Ltd is a

² Paragraph 4.5.

wholly owned subsidiary of the Opponent, and therefore clearly operates under its auspices. As such, Exhibit PANDA04 is relevant supporting evidence”.

21. As highlighted above, the opponent’s evidence sets out that Panda Security UK Ltd is a wholly owned subsidiary of the opponent. I have no reason, nor evidence, to consider that this statement is untrue. Further, I note that the evidence is accompanied by a statement of truth. If the applicant wanted to pursue their argument any further, they should have requested cross-examination. Thus, I am prepared to accept that any use of the mark by Panda Security UK Ltd is use with the consent of the opponent.

22. I note that within **exhibit PANDA04**, the opponent’s “principal activity” is described as the “marketing and distribution of anti-virus software”. It also shows the following UK turnover figures for the years ending 31 December 2016 to 2018:

2016 - £2,024,678

2017 - £2,845,339

2018- £3,840,440

23. **Exhibit PANDA03** contains sample invoices for the opponent’s products to customers in the EU. These documents are in Spanish; however, these have been translated and now exhibited in **VC1**. I note the following from this exhibit:

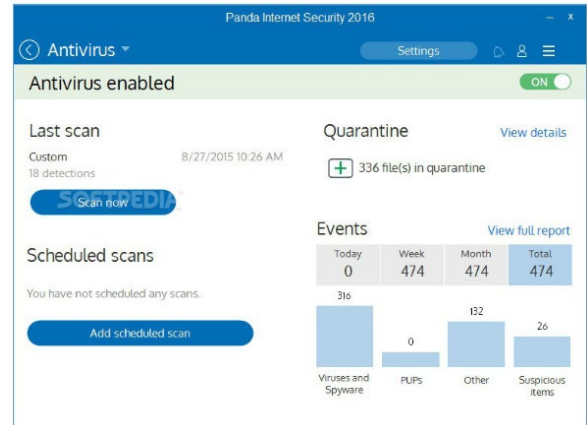
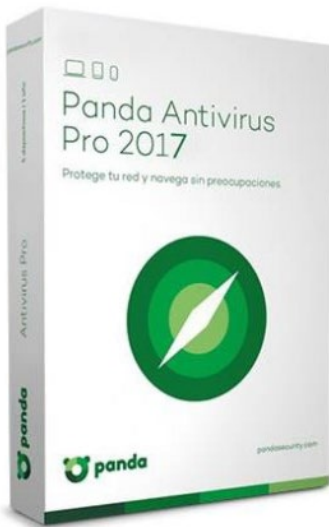
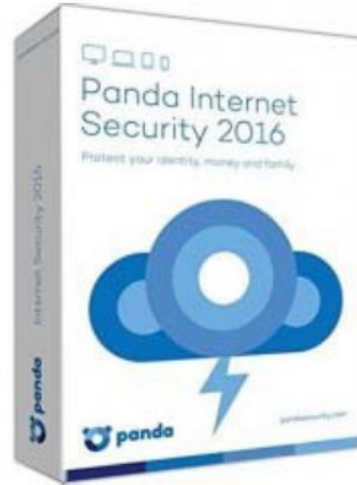
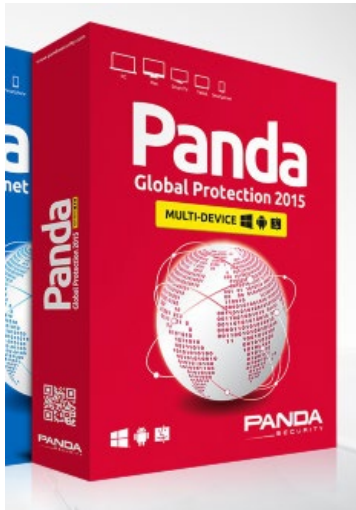
Date	Customer location	Goods	Invoice total
08/08/2016	Madrid- Spain	Panda antivirus pro minibox Panda internet security minibox Panda global protection minibox	€236,083.20
28/09/2016	Gipuzkoa – Spain	Panda internet security renewal	€112.99
04/11/2016	Madrid- Spain	Panda internet security ESD	€247.69
30/12/2016	Madrid- Spain	Panda adaptive Defense SIEMFeeder from adaptive Defense Premium Support +	€347,908.15
08/03/2017	Gipuzkoa – Spain	Panda adaptive Defense 360	€142.18
19/04/2017	Malaga- Spain	Endpoint Protection for Mac Endpoint Protection plus Systems management	€4,223.77
24/05/2017	Madrid- Spain	SIEMFeeder from adaptive Defense	€216,057.81

		Panda adaptive Defense	
24/07/2017	Madrid- Spain	Panda adaptive Defense 360+	€918.39
05/10/2017	Malaga- Spain	Panda adaptive Defense 360	€5,000.69
27/12/2017	Gipuzkoa – Spain	Premium support + Panda adaptive Defense SIEMFeeder from adaptive Defense	€408,648.93
08/01/2018	Zaragoza- Spain	Panda global protection ESD Panda global protection renewal	€43.78
30/01/2018	Madrid- Spain	Panda adaptive Defense	€199,740.75
11/05/2018	Barcelona- Spain	Fusion 1 year	€723.58
30/11/2018	Zaragoza- Spain	Premium technical support Panda adaptive Defense	€211,420.28
28/02/2019	Madrid- Spain	Panda adaptive Defense 360	€390.83
30/06/2019	Madrid- Spain	Endpoint protection	€410.19
20/06/2019	Zaragoza- Spain	Adaptive Defense SiemFeeder Panda data control Installation and training pack Panda patch management Endpoint protection plus Advanced reporting tool Panada adaptive Defense	€257,249.87
18/07/2019	Madrid- Spain	Advanced reporting tool Email protection 2 years Panda fusion 360	€23,717.77
31/10/2019	Valencia- Spain	Z:PACKAGING WASTE HANDLING FEE Z:DISPATCH MANAGEMENT Panda internet security minibox	€1,817.42
31/10/2019	Madrid- Spain	Panda adaptive Defense 360 SIEMFeeder from adaptive Defense service Premium support + dedicated TAM and product experts Panda threat hunting Panda patch management	€2,036,356.36

24. I also note that the following mark is clearly displayed on the left top hand corner of the invoices:



25. **Exhibit PANDA05** contains pictures of the opponent's boxed software products as well as screenshots for the various software as it appears on the screen, showing use of its mark, including the following:



26. Mr Otsoa and Ms Barrón state that the opponent’s security software is available direct for downloading from the opponent’s website or in boxed physical form (as demonstrated above) which would be sold via retail outlets or promoted by strategic partners/alliances.

27. **Exhibit PANDA06** contains screenshots of the opponent’s UK, Spanish and German website using the Wayback Machine, via which its goods are promoted and sold.

28. I note that the following UK screenshot is shown dated 13 April 2018 and 19 August 2019 within **PANDA06**:



29. The small print in the above screenshot says “traditional cybersecurity is struggling to keep up with sneaky new malware. Our Smart technology, based on Big Data and AI, monitors every running application on your systems and classifies absolutely EVERYTHING. Unlike traditional antivirus solutions, which only take action if a process is malicious, our technology detects attacks before they even happen”.

30. I also note that the following UK screenshots dated 2 October 2016 and 9 June 2017 shows that the opponent offers antivirus protection:

Panda Antivirus
FIND THE PERFECT SOLUTION

ANTIVIRUS PRO	INTERNET SECURITY	GLOBAL PROTECTION
<ul style="list-style-type: none"> • Shop and browse online safely • Protect yourself anytime, anywhere 	<ul style="list-style-type: none"> • Shop and browse online safely • Protect yourself anytime, anywhere • Optimize and keep all your devices under control • Keep your family safe from inappropriate Web content 	<ul style="list-style-type: none"> • Shop and browse online safely • Protect yourself anytime, anywhere • Optimize and keep all your devices under control • Keep your family safe from inappropriate Web content • Protect your data, money and identity from cyber-criminals

Choose the antivirus protection for Windows, Mac and Android that best suits your needs!
And stop worrying about computer threats!

BASIC	ADVANCED	COMPLETE
<p>FREE Trial</p> <ul style="list-style-type: none"> • Antivirus for Windows • Wi-Fi protection 	<p>FREE Trial</p> <ul style="list-style-type: none"> • Antivirus for Windows, Android and Mac* • Wi-Fi protection • Parental controls • Data protection and backups 	<p>FREE Trial</p> <ul style="list-style-type: none"> • Antivirus for Windows, Android and Mac* • Wi-Fi protection • Parental controls • Data protection and backups • Password manager

31. Mr Otsoa and Ms Barrón state that **exhibit PANDA07** consists of “UK published articles from 2016 to 2018 referring to the opponent’s security hardware, together with product information relating to the hardware appliances”. This exhibit contains the following:

- A “Panda GateDefender eSeries” brochure page which states that the Panda GateDefender eSeries “provides, in a single product, all the security services you need to protect your company’s network, adapting to your IT environment through its wide range of models and platforms”. The GateDefender also has the following features; secure malware-free internet access, firewall and intrusion prevention system, anti-spam filtering and quarantine, application firewall and bandwidth control, high availability and internet connection backup, flexible and secure connectivity, automatic updates, centralized management

of remote offices, hotspot management and easy integration and consolidation of the security service. I note that this brochure contains the following mark in the right bottom hand corner of the pages:



- A printout from “pugh.co.uk” stating that “Panda Security specialises in the development of IT security solutions. Initially focused on the development of antivirus software, the company has expanded its line of business to advanced cyber-security services with technology for preventing cyber crime”. Under “products” it lists the following:
 - Endpoint protection plus which is antivirus for workstations and exchange servers.
 - Systems management which provides management, monitoring and support for all the devices in your company.
 - Fusion which manages the security and IT infrastructure of your company cloud-based security, management and support and it protects, manages and provides remote support to all the devices in your network.
 - Adaptive Defense 360 which reveals patterns of malicious behaviour and generates defensive strategies to counter known and unknown threats.
 - Gatedefender which is an enterprise perimeter security solution which helps manage a company’s protection against intrusion attempts and external attacks. It filters web browsing, mail traffic and access to content via wi-fi connections.
 - Email protection which provides multi-layer protection for a company’s email against all types of malware and spam.

- An article from “computing” dated 18 October 2016 called “The Computing Security Excellence Awards shortlist revealed”. The opponent is shortlisted for the following:

- Security Innovation of the Year for its Adaptive Defense Advanced Reporting Tool.
- Enterprise Threat Detection Award for its Adaptive Defense 360.
- APT Solution Award for its Adaptive Defense.
- Firewall Solution and Unified Threat Management Award for its Panda Gatedefender.
- SME Solution Award for its Endpoint Protection Plus.
- Enterprise Security Award for its Adaptive Defense 360.
- Security Vendor of the Year.

32. **Exhibit PANDA08** consists of press release articles from the opponent's website regarding the Panda Adaptive Defense 360 remote support service. In a press release dated 21 September 2015 it states that the opponent's service combines its Panda Endpoint Protection Plus which has all the traditional protection features (antivirus, antimalware, personal firewall, web and mailing filtering and device management) and its Panda Adaptive Defense which adds detection and automated response, continuous monitoring and real-time forensic analysis. In a second press release dated 17 September 2018, it states that the Panda Adaptive Defense 360 earned an IT Pro Editor's Choice and 5 stars for its "advanced cybersecurity suite". IT Pro mentioned that they were "bowled over by its tough security measures and rated it as the perfect cloud-based service". IT Pro also wrote its own article called "Panda Adaptive Defense 360 review: Smarter than your average bear", dated 13 September 2018. It states that the service price is £1,231 excluding VAT and that the "pros" of this service is its "heaps of endpoint protection features, low price, easy deployment and discovery".

33. **PANDA08** also includes undated screenshots from its website detailing its Panda Security Premium Support service which offers "unlimited technical assistance" including:

- Virus and spyware removal
- Antivirus installation and setup
- Assistance setting up your home Wi-Fi connection
- Social media privacy setup

- Smartphone and tablet setup
- Tune up/optimization of your PC, Mac, smartphone or tablet
- Troubleshooting of operating system, application and software problems
- Assistance with peripherals such as printers, cameras and scanners
- The screenshot also includes the following pricing system:



34. **PANDA09** contains reviews of the opponent’s goods from IT security testing entities AV-test.org and AV Comparatives. I note that they test IT security and “offers systematic testing that checks whether security software, such as PC/Mac-based antivirus products and mobile security solutions, lives up to its promises”.³ AV Comparatives have given the opponent between 1 and 3 stars for its different products and services (such as malware protection, performance and adware/spyware protection) between the years of 2010 to 2019.⁴

35. AV-test has also rated the opponent’s free antivirus for the years 2010 to 2018, rating its protection at its lowest, 4/6, and at its highest, 6/6.⁵

36. The opponent has also won the following awards, and certifications, which are exhibited at **PANDA10**:

- AV Comparatives’ Real Word Protection 2017 Gold Award and Approved Security Product on 7 February 2018. This was for the opponent’s Free Antivirus solution and its Adaptive Defense 360 advanced cyber security solution for companies. The AV opponent’s article which details this win also states that “initially focused on the creation of antivirus software, the company

³ **PANDA09**, page 138

⁴ **PANDA09**, pages 141 to 145

⁵ **PANDA09**, pages 151 to 154

has expanded its line of business towards advanced cybersecurity services with technologies for the prevention of cybercrime”.⁶

- Silver Anti-malware certification from OPSWAT for its Panda Adaptive Defense 360 on 7 September 2018. This certifies the service as a compatible advanced cybersecurity solution “that incorporates Endpoint Protection and Endpoint Detection and response (EDR), along with 100% Attestation and Threat Hunting & Investigation services”.⁷
- Panda Adaptive Defense achieved the EAL2+ certification in its evaluation for the Common Criteria standard published in the BOE (Official state Bulletin) for May (2018). “This certification further validates the ability of Panda Security and Panda Adaptive Defense to protect any organisation with the guarantee of complying with the maximum security standards defined and verified by the Common Criteria organisation”⁸ with the certification available in the 28 members of the Common Criteria Recognition Arrangement all around the world (including European countries such as the UK).
- NSS Labs’ 2018 Advanced Endpoint Protection (AEP) Group test evaluated 20 market leading security products (AEPs) in security effectiveness and total cost of ownership (TCO) and the Panda Adaptive Defense 360 achieved a recommended rating.⁹
- Panda Adaptive Defense 360 was reviewed by PC Pro and ITPro, two leading business IT websites in the UK, where it received 5 stars and the Editor’s Choice award.¹⁰
- I note that pages 183 to 189 of **exhibit PANDA10** shows all the awards listed on the opponent’s website including the above as well as all those awarded as early as 2008.
- In a printout from “fossbytes.com” it lists the 10 best free antivirus software of 2017. The opponent is listed second. It also lists the major features of Panda Free Antivirus such as real-time protection from malware to knock down threats,

⁶ Page 161

⁷ Page 165

⁸ Page 170

⁹ Page 181

¹⁰ Page 181

the Panda Cloud Cleaner, its URL scanning to safeguard web browsing, and USB protection for killing different kinds of trojans.¹¹

- In the “Free Antivirus Software” article on moneysavingexpert.com, the opponent’s PANDA FREE ANTIVIRUS is listed. It states it has been praised by viewers for its detection rates and it also prevents USB drives running software automatically when inserted into your computers, as well as vaccinates your own USB sticks against infection from other PCs.¹²
- In comparitech’s article, dated 29 March 2018, it rates ‘Panda Dome Antivirus’ 4 out of 5 stars, which provides complete antivirus and software security.
- On Which?, the opponent’s Panda Internet Security 2016 (which is an antivirus software package) was rated as easy-to-use and decent security, scoring 71%. It provides good malware protection, quiet and effective firewall, has a USB vaccinate tool and data shield.

Proof of use

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

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

¹¹ Page 192

¹² Page 198

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]"

38. Section 6A of the Act states:

“(1) This section applies where

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

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his

consent in relation to the goods or services for which it is registered,
or

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

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

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

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

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

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

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

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

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

40. As the First Earlier Mark has completed its registration process more than five years before the relevant date (the filing date of the mark in issue), it is subject to proof of use pursuant to section 6A of the Act.

41. As the Second Earlier mark had not completed its registration process more than five years before the relevant date, the use provisions at section 6A of the Act do not apply. The opponent may rely on all of the goods and services it has identified without demonstrating that it has used its mark.

42. I must assess whether, and to what extent, the above evidence supports the opponent’s statement that it has made genuine use of its First Earlier Mark in relation to the goods and services for which it is registered. The relevant period for this purpose is the five years ending on the filing date of the applicant’s mark, i.e. 14 July 2016 to 13 July 2021.

43. The relevant provisions about proof of use in opposition proceedings are contained in section 6A of the Act, which I have highlighted above. 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.”

44. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Bunderversvereinigung 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].”

Form of the mark/how the marks are used

45. 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 Court of Justice of the European Union (“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)

46. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

47. Where the opponent's First Earlier Mark has been used as registered this will, clearly, be use upon which the opponent can rely.

48. As highlighted above, I note that the mark has been used in the following variants:



49. The distinctive character of the First Earlier Mark lies in the word PANDA. I note that this word is present within all of the above variants.

50. However, variant 1 presents the word 'panda' in a blue, lower-case typeface, with a device on the left hand side. The device is composed of hollow circle, split into 4 quadrants, each in a different shade of blue (from light to dark). I note that the circle has 2 semi-circles on the top 2 quadrants. I consider that the average consumer would recognise the device as a bear's head, especially when next to the word panda (which is a type of bear). The registered mark as a whole, the word PANDA, is used and unaltered beside the panda head device. Therefore, applying *Colloseum* above, I consider that variant 1 is genuine use of the mark, as it will "continue to be perceived as indicative of the origin of the product at issue".

51. Variant 2 is similar to variant 1. However, the word 'panda' is presented in a white lower-case typeface, next to a panda bear head device, which is presented in white and grey. The word 'panda' and the device are all presented against a dark navy blue

background. As highlighted above, the word PANDA is clearly used and unaltered, but used alongside the panda head device. Therefore, applying *Colloseum* above, I consider that variant 1 is genuine use of the mark, as it will “continue to be perceived as indicative of the origin of the product at issue”.

52. Variant 3 is composed of the larger word ‘PANDA’ presented on top of the smaller word ‘SECURITY’, which sits next to a white line, on its left-hand side. Both words are presented in a white capitalised typeface. This is all presented on a dark navy blue background. As highlighted above, the word PANDA is clearly used and unaltered which can therefore “continue to be perceived as indicative of the origin of the product at issue”. Furthermore, and as highlighted above, at paragraph 16 in *Lactalis McLelland Limited*, the addition of descriptive or suggestive words is unlikely to change the distinctive character of the mark. I note that in their witness statement, Mr Otsoa and Ms Barrón states that in 2007, the opponent changed its name to “Panda Security S.L. to reflect better on its focus on computer security”. Consequently, I do not consider that the additional word “SECURITY” alters the distinctive character because it is suggestive of the opponent’s goods and services which offers antivirus and anti-malware protection. Therefore, variant 3 is also acceptable use of the mark.

Conclusions from the evidence on genuine use

53. 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.¹³

54. 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”.

¹³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

55. As the opponent's First Earlier Mark is a comparable mark, the relevant territory for the period before IP Completion Day (31 December 2020) is the EU, and for the remainder of the period is the UK.

56. The opponent's above invoice, website, brochure and publication evidence, as a whole, confirms that the opponent has been operating since at least 2016, providing computer security goods and services in the EU, including the UK. This is also supported by sales figures for its computer security goods and services, from 2016 to 2018, in the EU, amounting to €94,216,000. I note that figures have not been provided for the years 2019 to 2021, however Mr Otsoa and Ms Barrón state that the revenues for these years are "of a similar scale" to the above figures. The opponent has also provided overall UK sales figures, for the years 2016 to 2018, which amount to £8,710,457. I note that although I have not been provided with any market share figures, I consider that the EU sales figures provided seem notable for what is likely to be a significant market within the EU. Albeit I haven't been provided any marketing figures, I have been provided evidence of awards and certifications which have been posted in third party publications. Therefore, taking all of the above into account, I am satisfied that the opponent has demonstrated genuine use of its First Earlier Mark, in the EU and UK, during the relevant period.

Fair Specification

57. I must now consider whether, or the extent to which, the evidence shows use of 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."

58. 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.”

59. The goods and services for which the First Earlier Mark is registered and upon which the opponent relies are computer antivirus goods and services in classes 9, 42 and 45.

60. I note that at the hearing, Ms Watkinson submitted that the opponent has only shown genuine use for its class 9 software goods. I agree. It is clear from the above evidence that the opponent has only shown genuine use for all of its class 9 antivirus computer programme and software goods.

61. I note that only **exhibit PANDA07** shows use of the opponent’s hardware goods (its GateDefender product). However, I do not consider that this exhibit by itself is enough to show genuine use of ‘hardware’ goods in class 9. I also do not consider that the opponent has demonstrated use of its class 42 services because there is no evidence of the opponent providing a service making bespoke software to its customers.

62. I note that in its evidence in reply, the opponent states that all of the opponent’s computer software products “come with at least a year’s user licence”¹⁴ and therefore shows use of its class 45 computer software licence services. However, the opponent has not provided any further supporting evidence of this, and this therefore is not sufficient to establish genuine use of its class 45 services. Consequently, I consider a fair specification for the First Earlier Mark to be:

Class 9 Antivirus computer programmes; antivirus software; antimalware computer programmes; antimalware software; computer security programmes; computer security software; computer threat prevention computer programmes; computer threat prevention software.

¹⁴ Paragraph 2.18

63. 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)(b)

64. 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.”

65. In making this decision, I bear in mind the following principles 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

66. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

67. I note that at least some of the goods and services covered by the parties’ respective specifications are identical. For example, the term “antivirus software” in the First Earlier Marks specification and the term “software and hardware related to antivirus programs” in the Second Earlier Marks specification is self-evidently identical to “computer software used in connection with cyber security, anti-virus, and anti-malware” in the applicant’s specification. For this reason, I will not undertake a full comparison of the goods and services above.

68. 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 marks. 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

69. 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 (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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

70. 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.

71. 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.

72. The goods and services are likely to be purchased from IT 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.

73. 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

74. 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.”

75. 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.

76. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="363 1621 628 1686">PANDA</p> <p data-bbox="301 1731 687 1767">("The First Earlier Mark")</p> <p data-bbox="268 1850 724 1921">Panda Dome</p> <p data-bbox="279 1951 711 1986">("The Second Earlier Mark")</p>	<p data-bbox="828 1671 1370 1727">PANDORA'S BOX</p> <p data-bbox="874 1778 1324 1834">Pandora's Box</p> <p data-bbox="1007 1912 1190 1948">(Series of 2)</p>

Overall Impression

77. The First Earlier Mark consists of the word PANDA. There are no other elements to contribute to the overall impression which lies in the word itself.

78. The Second Earlier Mark consists of the words 'Panda Dome' in a basic typeface. I consider that the overall impression of the mark lies in the combination of these words, with the stylisation playing a lesser role.

79. The applicant's series of 2 trade marks consists of the words PANDORA'S BOX. The first mark is presented in upper-case, and the second mark is presented in lower-case. I consider that the overall impression of the marks lies in the combination of these words.

Visual Comparison

The First Earlier Mark and the applicant's marks

80. Visually, the marks coincide in the letters P, A, N and D at the beginning of the marks. I also bear in mind that the average consumer pays more attention to the beginning of the marks. These act as visual points of similarity. However, the First Earlier Mark ends in the letter A, to make the word 'PANDA'. The letters P, A, N and D in the applicant's marks ends in the letters O, R, A, apostrophe S, to make the word 'PANDORA'S'. The applicant's marks also ends in the word 'BOX'. These all act as visual points of difference. Taking the above into account, I consider that the marks are visually similar to between a low and medium degree.

The Second Earlier Mark and the applicant's marks

81. Visually, the marks coincide in the letters P, A, N and D at the beginning of both first words in the marks. This acts as a point of visual similarity. However, the First Earlier Mark's first word ends in the letter A, to make the word 'Panda', followed by the word 'Dome'. The applicant's first word ends in the letters O, R, A, apostrophe S, to

make the word 'Pandora's' and ends in the word 'Box'. These all act as visual points of difference. Therefore, I consider that the marks are visually similar to a low degree.

Aural Comparison

The First Earlier Mark and the applicant's marks

82. Aurally, the First Earlier Mark will be pronounced as PAND-AH. The applicant's marks will be pronounced as PAND-OR-AH-SS BH-OX. Therefore, as the marks share the first syllable, 'PAND', I consider that the marks are aurally similar to between a low and medium degree.

The Second Earlier Mark and the applicant's marks

83. Aurally, the Second Earlier Mark will be pronounced as PAND-AH DH-OME. The applicant's marks will be pronounced as PAND-OR-AH-SS BH-OX. Therefore, as the marks share the first syllable, 'PAND', I consider that the marks are aurally similar to a low degree.

Conceptual Comparison

The First Earlier Mark and the applicant's marks

84. I note that exhibited at **XCYBER01** are screenshots from Collins Dictionary to demonstrate the meaning of PANDA, Panda Dome and PANDORA'S BOX.

85. The opponent and the applicant submit that conceptually the applicant's marks will be recognised as "an artefact from Greek mythology" which is connected to the myth that Pandora, "the first woman, was forbidden to open [a box], which released from all the ills that beset humankind".¹⁵ I consider that a significant proportion of average consumers would recognise and assign the meaning of a Greek mythological story of Pandora's box to the applicant's marks. However, for those who may not recognise

¹⁵ Exhibit XCYBER01

this meaning, which I consider is a small proportion of the average consumer, they would recognise “Pandora” as a girl’s name, and will give the word “box” its ordinary dictionary meaning, which together would mean a ‘box belonging to Pandora’.

86. I consider that First Earlier Mark will be assigned its ordinary dictionary meaning, and therefore recognised as a species of bear, which most typically have black and white fur, and originate from China.

87. Therefore, taking the above into account, I consider that the marks are conceptually dissimilar.

The Second Earlier Mark and the applicant’s marks

88. The same conceptual meaning for the applicant’s marks, in paragraph 85 above, applies.

89. The applicant submits that a “Dome” is a “reference to a rounded roof on a building or structure”. The opponent submits that the Second Earlier Mark therefore “refers to a panda enclosure, or some other dome associated with pandas”. The opponent further submits that “there is a degree of conceptual similarity between the concepts of a box and a dome, as both are enclosures of some kind”. However, I consider that this conceptual connection between a ‘box’ and ‘dome’ is tenuous and unconvincing. Consequently, I consider that the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

90. 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).”

91. 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.

92. I will begin by assessing the inherent distinctive character of the First and Second Earlier Marks.

93. As highlighted above, the First Earlier Mark is the word PANDA, which the average consumer will recognise as a type of black and white bear. I do not consider that this word is allusive or descriptive of the opponent’s computer security goods. Therefore, I consider that the First Earlier Mark is inherently distinctive to a medium degree.

94. The Second Earlier Mark is composed of the words ‘Panda Dome’, both of which have ordinary English dictionary meanings. Together, they convey the concept of a dome which houses panda’s. The mark is neither descriptive or allusive of the opponent’s goods and services. Consequently, I consider that the Second Earlier Mark is inherently distinctive to a medium degree.

95. Exhibited at **PANDA11**, the opponent provides decisions by the Spanish authorities of 2017, 2018 and 2019, and the EUIPO decision (Opposition No. B2431461) “finding that the PANDA brand has a reputation”. However, I note that this Tribunal is not bound by the decisions of the EUIPO. Furthermore, although the opponent has not specifically pleaded enhanced distinctness, 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 this is the UK market.

96. The opponent has provided UK sales figures, for the years 2016 to 2018, to enable me to assess the extent of use that has been made of the First Earlier Mark. This amounts to £8,710,457. Although I have not been provided with any market share figures, I consider that these sales figures alone are not substantial enough for what is likely to be a significant market within the UK. I note that all of the invoice evidence only pertains to Spain and therefore, the opponent hasn’t demonstrated geographical spread of the mark within the UK. I also haven’t been provided with any UK advertising figures. Therefore, taking all of the above into account, I do not consider that the evidence is sufficient to establish enhanced distinctiveness.

Likelihood of confusion

97. 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 the 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.

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

- I have found the First Earlier Mark and the applicant's mark visually and aurally similar to between a low and medium degree.
- I have found the Second Earlier Mark and the applicant's mark visually and aurally similar to a low degree.
- I have found all of the marks to be conceptually dissimilar.
- I have found the opponent's First and Second Earlier Mark to be inherently distinctive to a medium degree.
- I have identified the average consumer to be members of the general public, and business users, who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods and services, however, I recognise that the level of attention may be above medium where the goods and services are particularly technical in nature.
- I have found the parties' goods and services to be identical.

The First Earlier Mark

99. Taking all of the factors listed in paragraph 98 into account, particularly the visual, aural and conceptual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other.

100. I note that the beginning 4 letters of the marks are identical (P, A, N and D), however, in *CureVac GmbH v OHIM*, T-80/08, it was determined that this was not always a decisive matter in the finding of a likelihood of confusion.

101. The First Earlier Mark, as a whole, is the word PANDA. The applicant's mark, as a whole, is 'PANDORA'S BOX'. At the hearing Mr Bridge-Butler acknowledged that there were conceptual differences between the signs, but submitted "it is not the case that a difference in one area acts as an automatic barrier to likelihood of confusion". However, it is well established that where the meaning of at least one of the two supposedly conflicting marks at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them.¹⁶ In this instance, both marks have clear and specific meanings, which is accepted by both parties. Furthermore, and as highlighted above, the marks are visually and phonetically similar only to between a low and medium degree. Therefore, the marks are different in more than just "one area". I do not consider that the average consumer would overlook the "A" at the end of the First Earlier Mark, nor do I consider that the average consumer would overlook the letter O, R, A, apostrophe S, and the word "BOX" at the end of the applicant's mark. Therefore, I do not consider that sharing the first 4 letters of the marks is sufficient enough to counteract the strong conceptual hooks, that each mark provides, in order to differentiate the two marks. Consequently, I do not consider there to be a likelihood of direct confusion.

102. 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:

"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

¹⁶ *The Picasso Estate v OHIM*, Case C-361/04P, CJEU

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.”

103. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

104. At the hearing, Mr Bridge-Butler highlighted that the three categories listed in *LA Sugar* are, of course, merely illustrative, and not exhaustive. He submitted that the applicant’s mark would be “viewed either as a brand extension or a brand so strikingly close in the context that it must be from the same source which uses the distinctive mark beginning PAND-”. However, I consider that it is implausible that the average consumer would believe that a brand extension would rest simply on the marks beginning with “PAND”. On the basis of this argument, it would follow that any mark which begins with “PAND” would therefore be a potential brand extension. This would allow a mark to cover a monopoly over any words that begin with “PAND” which would be unrealistic, let alone problematic.

105. Therefore, I consider that 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 that the applicant’s trade mark was connected with the opponent or vice versa on the basis that they both contain the first four beginning letters (PAND).

106. With the marks (PANDA and PANDORA’S BOX) having clear and distinct conceptual differences, it is clear that they are not natural variants or brand extensions of each other. Therefore, taking all of the above into account, I do not consider there to be a likelihood of indirect confusion.

The Second Earlier Mark

107. I note that at the hearing, Mr Bridge-Butler submitted that the Second Earlier Mark was the opponent's best case. However, as highlighted above, I consider that these marks are even more visually, aurally and conceptually different (to a low degree) from the applicant's mark than its First Earlier Mark. It therefore follows that I also do not consider that the marks would be mistakenly recalled or misremembered as each other. The same reasoning therefore applies in paragraphs 99 to 101 above. I do not consider there to be a likelihood of direct confusion.

108. I also do not consider there to be a likelihood of indirect confusion. Again, it would be illogical to base a brand extension off of the first four beginning letters of the marks, when both have such clear conceptual differences, which would not be a natural variant of each other. As highlighted above, I consider that the 'conceptual link' of a dome and box being "enclosures of some kind" tenuous and unconvincing. I therefore consider that the same finding applies in paragraphs 104 to 106 above.

CONCLUSION

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

COSTS

110. 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 **£1,400** 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
Preparing and filling evidence	£500
Preparation for and attendance at hearing	£700

Total

£1,400

111. I therefore order Panda Security, S.L. to pay X Cyber Group Ltd, Inc. the sum of £1,400. 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 6th day of February 2023

L FAYTER

For the Registrar

ANNEX

The applicant's mark

Class 9

Computer software, hardware and applications; artificial intelligence software; computer software used in connection with cyber security, anti-virus, and anti-malware; computer software and hardware for detection, blocking, and facilitating removal and remediation of computer malware, cyber-attacks, malicious attacks, and advanced persistent threats; computer software and hardware for providing secure networks; computer software for use in fraud detection, criminality detection, money laundering detection, intelligence gathering, and risk assessment; computer software and hardware for ensuring digital security; computer software for use in data gathering, mining, processing, prediction and analysis; database software; computer software for use in the automation of searching and investigative processes; open source intelligence software; software for creating, authoring, distributing, downloading, transmitting, receiving, playing, editing, extracting, encoding, decoding, displaying, storing, analysing and organizing text, graphics, images, audio, video, and multimedia content; apparatus for recording, transmission or reproduction of text, sound and/or images; magnetic data carriers, image and/or sound recording disks; downloadable electronic publications; downloadable electronic publications connected with computer software, computer hardware, cyber security, fraud detection, anti-money laundering, criminality detection and intelligence gathering; none of the aforesaid in the field of gambling.

Class 35

Business research and investigation services; investigation services for businesses in relation to its' clients and customers; business intelligence services; advisory services in relation to business investigation, compliance, auditing and appraisal; business consultancy and advisory services; business consultancy relating to the administration of information technology; data services for businesses namely processing, management, administration, compilation, and retrieval; business risk assessment management services; computer file management; computerised updating of business data and management of files; management of data, databases and data processing; advice, information and consultancy in relation to the aforesaid.

Class 36

Money laundering investigations; financial investigations; insurance investigations; advice, information and consultancy in relation to the aforesaid.

Class 41

Education and training; education and training connected with information technology, cyber security, anti-money laundering, fraud detection, and criminality detection; publication of printed matter, published materials, pamphlets, prospectuses, books, publications, periodicals, posters, printed forms, directives, guidelines and fact sheets; advice, information and consultancy in relation to the aforesaid; none of the aforesaid in the field of gambling.

Class 42

IT services; cloud computing services; IT security, protection and restoration; testing and quality control relating to computer software and hardware; data encryption and security services; IT penetration testing services; Software as a Service (SAAS); Platform as a Service (PAAS); SAAS and PAAS connected with cyber security, fraud detection, money laundering detection and investigations; SAAS being open source intelligence software; software development, programming, implementation and engineering; software research and development; design and development of data processing, prediction and analysis systems; information, advisory and consultancy services relating to the aforesaid services; none of the aforesaid in the field of gambling.

Class 45

Due diligence services; due diligence services in order to ensure conformity with regulatory requirements; due diligence services in order to ensure compliance with law, in particular, financial crime legislation; regulatory risk assessment services; investigation services; providing information about regulatory requirements; licensing of computer software; information, advisory and consultancy services relating to the aforesaid services.

The First Earlier Mark

Class 9

Antivirus computer programmes; antivirus software and hardware; antimalware computer programmes; antimalware software and hardware; computer security programmes; computer security software and hardware; computer threat prevention computer programmes; computer threat prevention software and hardware.

Class 42

Analysis for the installation of computer systems in connection with computer security, computer threat prevention, antivirus and/or anti-malware; analysis of computer systems in connection with computer security, computer threat prevention, antivirus and/or anti-malware; design of computer systems in connection with computer security, computer threat prevention, antivirus and/or anti-malware; design and development of computer hardware and software in connection with computer security, computer threat prevention, antivirus and/or anti-malware; computer consulting in connection with computer security, computer threat prevention, antivirus and/or anti-malware; rental of computers in connection with computer security, computer threat prevention, antivirus and/or anti-malware; computer programming in connection with computer security, computer threat prevention, antivirus and/or anti-malware; design of computer software in connection with computer security, computer threat prevention, antivirus and/or anti-malware; installation of computer software in connection with computer security computer threat prevention, antivirus and/or anti-malware; rental of computer software in connection with computer security, computer threat prevention, antivirus and/or anti-malware; maintenance of computer software in connection with computer security, computer threat prevention, antivirus and/or anti-malware; updating of computer software in connection with computer security, computer threat prevention, antivirus and/or anti-malware; duplication of computer programmes in connection with computer security, computer threat prevention, antivirus and/or anti-malware; conversion of data or documents from physical to electronic media in connection with computer security, computer threat prevention, antivirus and/or anti-malware; conversion of computer programmes and data in connection with computer security, computer threat prevention, antivirus and/or anti-malware; database reconstruction in connection with computer security, computer threat prevention, antivirus and/or anti-malware; Web site creation and maintenance for others in connection with computer security, computer threat prevention, antivirus

and/or anti-malware; super server hosting (of Web sites) in connection with computer security, computer threat prevention, antivirus and/or anti-malware; technical project studies in connection with computer security, computer threat prevention, antivirus and/or anti-malware; computer data-processing in connection with computer security, computer threat prevention, antivirus and/or anti-malware; operation and maintenance of computer systems (software) in connection with computer security, computer threat prevention, antivirus and/or anti-malware.

Class 45

Granting of computer software licenses in connection with computer security, computer threat prevention, antivirus and/or anti-malware.

The Second Earlier Mark

Class 9

Antivirus computer programs; software and hardware related to antivirus programs; anti-malware computer programs; software and hardware related to anti-malware; computer programs relating to computer security; software and hardware relating to computer security; computer programs for prevention of computer risks; software and hardware relating to computer risk prevention.

Class 42

Analysis for the implementation of computer systems in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; analysis of computer systems in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; design of computer systems in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; design and development of computers and software in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; computer consultancy in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; rental of computers in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; computer programming in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; computer software development in connection with computer security, computer risk prevention, antivirus and/or anti-

malware programs; computer software installation in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; computer software rental in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; computer software maintenance in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; computer software updating in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; computer program duplication in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; conversion of data or documents from a physical medium to another electronic medium in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; conversion of computer programs and data in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; recovery of computer data in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; creation and maintenance of web pages for third parties in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; super server services (web pages) in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; technical project studies in the field of computer security, computer risk prevention, antivirus and/or anti-malware programs; operation and maintenance of computer systems (software) in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs; computer security consultancy; information technology security, protection and restoration; software as a service [SaaS] relating to computer security software.

Class 45

Licensing of computer software in connection with computer security, computer risk prevention, antivirus and/or anti-malware programs.