

BL O/0059/24

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3702935
FOR FENIX CLOUD-SERVICES
BY BERNHARD FROHWITTER**

AND

OPPOSITION NO. 431341 THERETO BY FENICS SOFTWARE INC.

**AND IN THE MATTER OF TRADE MARK APPLICATION NO. 3702794
FOR FENICS
BY BERNHARD FROHWITTER**

AND

OPPOSITION NO. 431344 THERETO BY FENICS SOFTWARE INC.

**AND IN THE MATTER OF AN APPEAL FROM THE DECISION
OF MS SUZANNE HITCHINGS DATED 1 JUNE 2023**

DECISION

1. This is an appeal from the decision of Suzanne Hitchings (the “Hearing Officer”), BL O/0510/23, dated 1 June 2023, relating to two consolidated trade mark applications and oppositions. She rejected in its entirety the opposition by Fenics Software Inc (“the Opponent”) to an application by Mr Frohwitter to register the mark FENIX CLOUD SERVICES. The opposition to his application to register the mark FENICS was broadly upheld, but rejected in respect of a relatively small number of services.

Background

2. Both trade mark applications were filed on 28 September 2021, for identical specifications of goods and services in Classes 9, 37, 42 and 45. See Annex A.

3. The oppositions were filed on 25 February 2022 based upon sub-sections 5(2)(a) and (b) of the 1994 Act and upon the following earlier UK registered marks:
 - a. No. 908671133 FENICS, registered for goods and services in Classes 9 and 42;
 - b. No. 801503423, **Fenics** registered for goods and services in Classes 9, 36, 38 and 42; and
 - c. No. 801523623, FENICS GO registered for goods and services in Classes 9, 35, 36, 38 and 42.

I will not set out these specifications in full, but those for the latter two marks may be found in a lengthy and helpful comparison table contained in paragraph 30 of the Hearing Officer's Decision. The Opponent was put to proof of use of the '133 mark, FENICS, for all of the goods and services in Classes 9 and 42.

4. The Opponent filed evidence of use of its '133 mark. Neither side requested a hearing. Both sides filed written submissions. In its lengthy submissions the Opponent submitted that the evidence showed that it is an award winning computer software business specialising in foreign exchange software and claimed that it had used the '133 mark in relation to all of the goods and services for which it is registered in classes 9 and 42. It also submitted that the stylised use of the '423 mark did not significantly alter the distinctive character of the plain word mark FENICS, so that use of the stylised version proved genuine use of the earlier word mark FENICS.
5. The Hearing Officer indicated at paragraphs 23-24 of the Decision that she would first consider the oppositions based upon the '423 and '623 marks, and only address the issue of proof of use of the '133 mark if she found no likelihood of confusion based upon the two later registered marks.
6. She carried out a lengthy analysis of the similarity of the parties' respective goods and services, finding some similarity, to varying degrees, some identity and some dissimilarity, in particular she found no similarity for "Electronic data storage, Online data storage and Computer services concerning electronic data storage" in Class 42 ("the Data Storage Services"). She carried out a comparison of the marks applied for with the '423 and '623 marks, finding higher visual than aural similarity, and no conceptual similarity.

7. She found no likelihood of either direct or indirect confusion between the ‘423 and ‘623 marks and FENIX CLOUD-SERVICES. At paragraph 103 she decided that even if use had been proved of the ‘133 mark, the outcome would be the same.
8. However, she found a likelihood of direct confusion between the ‘423 and ‘623 marks and FENICS, for all the goods and services for which she had found there to be similarity or identity. That application was permitted to proceed to registration only in respect of the Data Storage Services and the services in Class 45.
9. The Opponent appeals to the Appointed Person seeking to maintain the unsuccessful parts of its oppositions against both marks, for all of the Applicant’s goods and services, save for the services in Class 45.
10. The Grounds of Appeal were lengthy. In outline they were:
 - Ground 1:* the Hearing Officer was wrong to hold that the ‘133 had a narrower specification than the other earlier marks;
 - Ground 2:* the Hearing Officer wrongly assessed the likelihood of confusion based on the ‘133 mark;
 - Ground 3:* the Hearing Officer should have found a likelihood of confusion in relation to FENIX CLOUD-SERVICES;
 - Ground 4:* the Hearing Officer was wrong to find the Data Storage Services were dissimilar to all of the Opponent’s specifications and especially its own Class 42 services.
11. The Applicant did not attend the hearing of the appeal, but filed written submissions in lieu. I am grateful for those submissions, and for the written and oral submissions of Ms Blythe on behalf of the Opponent.

Standard of appeal

12. It was common ground that this appeal is by way of review, it is not a rehearing. The relevant principles were not in dispute. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer’s conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for the appellate tribunal to

be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See *Reef Trade Mark* [2003] RPC 5; and *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 at [78] to [81].

13. The principles have been summarised in numerous cases. For instance, the Respondent referred me to the Court of Appeal's decision in *Volpi v Volpi* [2022] EWCA Civ 464 at [2]. The principles have also been stated in a number of recent trade mark appeals, such as by Sir Anthony Mann in *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch) at paragraphs [6] to [8]:

“6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in *Instagram LLC v Meta 404 Ltd* [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in *Volpi v Volpi* [2022] EWCA Civ 464.

“i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.

ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.

iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract.”

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion". (*Re Sprintroom Ltd* [2019] EWCA Civ 932)

8. And last, as Richards J observed in *Instagram*, proper respect should be paid to the decision of an expert tribunal in the field in question:

"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49 at paragraph 30, the court should approach the appeal on the basis that it is probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right."

14. I have kept these principles in mind when considering the present appeal.

Merits of the appeal

Ground 4 – Data Storage Services

15. The Opponent dealt first with the issue about the Hearing Officer’s findings in relation to the Data Storage Services. Her reasoning on the point was as follows:

“Electronic data storage; Online data storage; Computer services concerning electronic data storage.

54. The opponent submits that the contested services in Class 42 are similar to the earlier goods in Class 9 as they are often provided by the same businesses and

through the same distribution channels, have a similar purpose and are complementary, and coincide in end users and providers. However, it has provided no supporting evidence to demonstrate this in regard to the contested services listed above. I see nothing within the opposing specifications which immediately strikes me as being self-evidently similar, therefore I find the competing goods and services to be dissimilar.”

16. On the appeal, the Opponent made two complaints about this finding. First, it submitted that the Hearing Officer’s approach to the comparison of the Data Storage Services to its Class 9 goods was cursory, especially in contrast to the more detailed comparison made in relation to some other goods/services. It said that the Hearing Officer’s comment that “nothing ... immediately strikes me as being self-evidently similar” showed that she had not carried out a proper comparison or properly considered the Opponent’s submissions as to the basis of similarity of those goods/services.

17. Secondly, the Opponent complained of an alleged material omission in the Decision, in the Hearing Officer’s failure to compare the Data Storage Services to its own Class 42 services. It drew my attention to its submissions below, in which it had said:

“61 ... the Contested Services in class 42 are all considered to be identical and/ or highly similar to the Earlier Services in class 42. For example there is clear identity with the Contested Services for “*Services for the design of interactive computer software; Services for the design of scalable computer software*” and the services “*design and development of computer software*”. These are all computer software design services and their method of delivery is identical. Furthermore, ... the Contested Services covers the term “*cloud computing*” and will be considered identical to the Earlier Services for “*cloud computing services, namely, cloud hosting in the nature of a scalable computer software for providing access to an electronic financial exchange*” covered by the Third Earlier Mark.”

18. The Opponent complained under Ground 4 that the Hearing Officer had failed to deal with those submissions, and in particular had not carried out any comparison of the Data Storage Services to any of its own Class 42 services, but only to the Class 9 goods. Indeed, it complained that the Hearing Officer had not considered the similarity of the Data Storage Services to any other parts of its earlier specifications, some of which it

identified in the Grounds of Appeal, although I was not addressed on any goods/services at the hearing of the appeal apart from the Opponent's own Class 9 goods and 42 services.

19. The Statement of Grounds in the TM7 did not identify any particular goods or services which the Opponent contended were identical or similar to the Data Storage Services. It simply claimed identity/similarity across the board. Moreover, the Opponent's written submissions did not identify any of its own Class 42 services as identical or similar to the Data Storage Services, but commented specifically only upon the Applicant's software design and cloud computing services. Neither of those documents therefore gave any help to the Hearing Officer in comparing the Data Storage Services (and other parts of the Applicant's Class 42 specification) to the Opponent's Class 42 specifications.
20. Nevertheless, the Hearing Officer did analyse the similarity of certain elements of the Applicant's Class 42 specification to the Opponent's Class 42 services, for example in paragraphs 44 - 53 of the Decision. By contrast, in paragraph 54, she failed to make any comparison of the Data Storage Services with the Opponent's specifications for Class 42 services. Given the failure of the Opponent to identify the parts of its specification relied on in relation to the Data Storage Services, and the overall complexity of the comparison of goods/services in the oppositions, the Hearing Officer's failure to address this point is perhaps not surprising. However, it is in my view an omission in the Decision of a point which the Hearing Officer should have considered, and which requires to be decided.
21. In the Grounds of Appeal, the Opponent submitted that a degree of similarity should have been found between the Data Storage Services and its Class 42 "Research, design and development of computer software" and "installation ... of computer software" in the '423 mark, and its "Scientific and technological research, design and development of computer hardware and software" in the '623 mark. Then, in its skeleton argument for the appeal, the Opponent also sought to rely upon "providing temporary use of on-line non-downloadable computer software for managing financial data and creating financial reports" also in Class 42 in the '423 mark and upon certain services which it said specifically concern data-related or database-related software such as "platform as

a service (PAAS) featuring computer software platforms for accessing, hosting, managing, developing, analyzing and maintaining scalable computer hardware, computer software, computer applications, websites, and databases for others accessible via private and global computer networks.” The Opponent submitted that the parties’ respective services overlap in provider, trade channels, user and nature and are complementary in the sense that customers may think that the responsibility for those services lies with the same undertaking. For example, the design of computer software could be in relation to software for data storage, or the computer software being installed could be to give the user more data storage, etc. The Opponent therefore invited me to find at least some level of similarity between its ‘423 and ‘632 Marks’ specifications in Class 42 and the Data Storage Services, referring me to another Registry decision (O/558/21) in which some level of similarity had been found in relation to the same terms.

22. I have considered carefully whether I should decide this point, or whether I should remit it to the Registry as it was not considered by the Hearing Officer. It seems to me that the parties have both had an opportunity to deal with the point on the appeal, at least in so far as the Opponent’s submissions were based upon the services identified in the Grounds of Appeal. In those circumstances, and given that for the reasons given below I do not propose to remit other elements of case to the Registry, it seems preferable to me to deal with the point myself.
23. I bear in mind the need to provide evidence of similarity where it is not self-evident. This was explained in the decision of Mr Hobbs KC in *Raleigh International Trade Mark* [2001] RPC 11 at paragraph 20, where he said *inter alia*: “If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their "similarity"” There was no evidence as to similarity here.
24. I have considered whether it is self-evident that the Data Storage Services (or some of them) are similar or identical to the services in Class 42 of the ‘423 or ‘623 Marks which were identified in the Grounds of Appeal. The three phrases which have been referred to as the Data Storage Services all relate to data storage in some form, which I take to

mean the digital recording of files and documents that are saved in a storage system for future use, and services relating to such storage. “Research, design and development of computer software” and “installation ... of computer software” differ in nature to the Data Storage Services, but I accept that the providers of the respective services may coincide, as they are all computer related services. In addition, the Opponent’s design and development services could include the design and development of the more specific storage services, so that consumers may assume that the same company that designs and develops these software products would also provide the service providing the software. The services are also likely to overlap in terms of users and channels of trade, as the Hearing Officer found for the other Class 42 services in the Applicant’s specification. Therefore, in my judgment, they are similar at least to a low degree to the Opponent’s services in Class 42.

25. The Hearing Officer upheld the opposition to the FENICS mark in respect of all of the goods/services which she found to be similar or identical to goods/services in the Opponent’s specifications, even where such similarity was only at a low level. Applying her reasoning, therefore, I conclude that the opposition should be upheld for the Data Storage Services in the FENICS Mark.
26. In the circumstances, it is not necessary for me to consider whether the Hearing Officer also erred in rejecting any similarity between the Data Storage Services and the Opponent’s Class 9 goods.

Ground 3 – Fenix Cloud Services

27. The Opponent appealed against the Hearing Officer’s finding that there was not a likelihood of direct or indirect confusion in relation to any of the goods/services covered by the Fenix Cloud Services mark (“the FCS mark”). It did not identify an error of principle or approach by the Hearing Officer, but argued that, on the basis of her own findings, her conclusion on likelihood of confusion was plainly wrong, and was a conclusion which no reasonable Hearing Officer could have reached.

28. The Opponent pointed to a number of findings of the Hearing Officer. First, that she had found some of the goods/services to be identical. Then, when comparing the marks, she said at paragraph 72 of her Decision:

“The applicant’s “935” mark consists of the words “Fenix Cloud-Services”, presented side by side in title case in a standard typeface. In my view, the average consumer will view the hyphenated words “Cloud-Services” in the contested mark as being either allusive or descriptive of the type of goods and services being provided. I therefore consider that it is the word “Fenix” which will make the greatest contribution to the overall impression, although the words “Cloud-Services” will not be entirely overlooked.”

Continuing her comparison of the marks, she held that the FCS mark was visually similar to both the ‘423 and ‘623 marks to a medium degree, but on aural similarity she said:

“ 75. In my view, given the allusive/descriptive qualities of the additional words “Cloud-Services” in the contested mark, there will be a proportion of consumers who will only articulate the “Fenix” element, rendering it aurally identical to the earlier “423” mark, and similar to a medium degree to the earlier “623” mark. There will be other consumers who will voice the contested mark in its entirety, as six syllables, FENICKS-CLOUD-COM-PUTE-ING and in these circumstances, I consider the contested mark to be aurally similar to the earlier marks to a low-medium degree.”

She also held that the purchasing process would combine aural and visual factors, particularly in the case of tele-sales, and that the earlier marks were inherently distinctive to a high degree, as “FENICS” is an invented word.

29. In addition to those findings, the Hearing Officer held that the average consumer of the goods and services would be a professional, who would pay a high degree of attention to the selection of the goods/services.

30. At paragraph 93, as part of her reasoning on the likelihood of confusion, the Hearing Officer said:

“In respect of the contested “935” mark, being “Fenix Cloud-Services”, I considered the word “Fenix” to be the distinctive component, making the greatest

contribution to the overall impression, although the words “Cloud-Services” would not be entirely overlooked. I found it to be visually similar to a medium degree to both the earlier marks, and aurally, when pronounced as FEN-ICKS, it is identical to the “423” mark where the “Cloud-Services” element is not pronounced, and similar to a medium degree to the “623” mark. Where the contested mark is voiced in its entirety, I found it to be similar to a low-medium degree to both the earlier marks, however when the “Fenix” element is pronounced as FEE-NICKS, it is aurally a further step removed from the earlier marks. I found that the “Fenics” element of the earlier marks would be seen as an invented word containing no semantic content, creating a conceptual disparity where the contested mark is perceived as alluding to, or as a misspelling of the word “Phoenix”, while to those consumers who attach no meaning to either of the marks, the position is neutral with regard to conceptual similarity.”

She went on at paragraph 98:

“98. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. I acknowledge the degree of visual and aural similarity between the marks, however, given the high degree of attention paid during the selection of the goods and services, which I have balanced against the identity and similarity between the goods and services at issue, it is my view that even for the services considered to be identical, the average consumer, being reasonably well informed and reasonably circumspect, will notice and recall the differences between the marks. To my mind, realistically, any likelihood of direct confusion between the marks is negligible.

99. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was) in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

100. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

101. I acknowledge that the categories listed by Mr Iain Purvis Q.C. ... are not exhaustive, however, having made a multi-factorial assessment of the various considerations in play, while for some consumers sight of one mark may bring to mind the other mark, I do not see anything which would lead the average consumer into believing that one mark is a variant brand of the other, or assume that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.”

31. The Opponent relied in particular upon the Hearing Officer’s finding that there would be a body of consumers who would not pronounce the “Cloud-Services” part of the mark. As a result, it said, allowing for those who might purchase the relevant goods/services purely aurally (for example through tele-sales), there would inevitably be direct confusion between “a company articulated as “FEN-ICKS” and a company articulated as “FEN-ICKS” selling identical services” especially given that Fenics is a highly distinctive, invented name.
32. It seems to me that the Hearing Officer cannot be said to have misdirected herself in paragraph 98 as to the likelihood of direct confusion. She expressly took into account the degree of visual and aural similarity between the marks, and concluded that those kinds of similarity were outweighed by the high degree of attention paid by the average consumer during the selection of the goods and services. Whilst she considered that in terms of making an aural comparison some consumers might ignore “Cloud-Services,” she rightly carried out the assessment of the likelihood of confusion by reference to the FCS mark in its entirety, and in accordance with her own finding that the words “Cloud-Services” would not be entirely overlooked. In those circumstances, I do not consider that there is an error which would justify setting aside her finding that there is no likelihood of direct confusion with the FCS mark.
33. Turning to the question of the likelihood of indirect confusion, the Opponent did not criticise the Hearing Officer’s summary of the law on indirect confusion, although she referred only to the decision of Iain Purvis QC in *L A Sugar* and of James Mellor QC (as he then was) in *Duebros*. She did not set out the more recent guidance of Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA

Civ 1207, [2022] RPC 5, who (at paragraph 12) approved of the formulation in *L A Sugar*, but added:

"13 As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

34. The Opponent submitted that as “Cloud-Services” are wholly descriptive words, they are a prime example of words that could be added to a distinctive brand to designate a sub-brand or brand extension, so falling squarely within the categories identified by Mr Purvis KC in *L A Sugar*. In the circumstances, given the Hearing Officer’s finding that the words are descriptive or allusive, and her findings as to the high level of inherent distinctiveness of the FENICS element, it said that she had misdirected herself in rejecting a likelihood of indirect confusion.
35. However, the Hearing Officer did not find the words “Cloud-Services” to be descriptive of all of the Applicant’s goods and services, which are not restricted to cloud computing services (see Annex). She said that the words were descriptive or allusive. Plainly, in the circumstances, she *might* have found that the FCS Mark added a non-distinctive element to the earlier mark, leading to a risk of indirect confusion at least for those services for which she thought “Cloud-Services” are properly descriptive words. However, that is not to say that she *ought* to have done so because this amounted to a proper basis for concluding that there was a likelihood of indirect confusion.
36. As Dr Brian Whitehead, sitting as the Appointed Person, said in *Wazdan Holding* BL O/1188/23 at paragraph 30:

“The fact that service providers invest heavily in branding, that competitors' brands are exposed to consumers in the same places, and that brand extensions and sub-brands are common and often follow a logical pattern does not of itself establish "a proper basis for concluding that there is a likelihood of indirect confusion". ...”

37. The reasoning in paragraph 101 of the Decision is short, but the Hearing Officer refers to her multi-factorial assessment of the various considerations in play, which she had discussed at some length at paragraphs 89-94. Her conclusion was that the average consumer would not be led to think the FCS Mark was a variant brand or brand extension. This appears to me to fit with her findings at paragraph 63 as to the rather sophisticated average consumer for the goods and services in question, a factor which she had just relied upon in paragraph 98 in relation to the likelihood of direct confusion. In all the circumstances, whilst plainly another tribunal might have reached the opposite conclusion, it seems to me that the Hearing Officer did not misdirect herself. In my judgment, it was open to the Hearing Officer to find that there was no likelihood of indirect confusion, despite her views on the weakness of the “Cloud-Services” element of the FCS Mark and the distinctiveness of FENICS. Those two points cannot be said to lead inexorably to a likelihood of indirect confusion or necessarily to amount to “a proper basis” for concluding that there is a likelihood of indirect confusion. That would be to ignore other findings which she made, which have not been appealed, and take the Hearing Officer’s findings out of the overall context of her global assessment of the likelihood of confusion.
38. Lastly, the Opponent pointed to the decision of another Hearing Officer in case no BL O/0500/23, in which an application for the mark FENIX for the same specification of goods and services as in this case was found to give rise to a likelihood of confusion in relation to identical or similar goods/services. I do not see that the decision in that case affects the merits of this appeal. That case is broadly comparable to the FENICS application here, and led to much the same result. I cannot see how it helps the Opponent in relation to the FCS Mark.
39. For these reasons, I find that the conclusion which the Hearing Officer reached on the likelihood of indirect confusion for the FCS Mark based upon the ‘423 and ‘623 Marks was one which was open to her on the basis of her other findings, and it is not appropriate to set it aside on appeal.
40. Of course, as discussed above, the Hearing Officer had failed to take into account any possible similarity between the Data Storage Services and the Opponent’s Class 42

services, but it seems to me clear that she would have dismissed any likelihood of confusion in relation to such services in the FCS Mark's specification on the same basis as the Applicant's other goods and services. In the circumstances, the failure to carry out that comparison appears to me to be an immaterial error, and it does not seem to me that it is necessary or appropriate to remit the opposition in relation to the Data Storage Services in the FCS Mark to the Registry for reconsideration.

Grounds 1 & 2 - failure to consider the '133 Mark

41. The Opponent complained that the Hearing Officer had erred in her approach to the '133 mark, which is for the plain word FENICS, and failed to consider whether the '133 mark would have improved the Opponent's position in respect of the Applicant's FENICS mark. She took the position at the outset (paragraphs 23-4) that she would not need to consider the evidence of use of the '133 mark, if the opposition succeeded on the basis of the '423 and '623 marks, and said that she would reconsider the position as to the '133 mark only if no likelihood of confusion was found.
42. The Opponent complained in Ground 1 of the Grounds of Appeal that part of her reasoning for taking that approach was wrong. At paragraph 23 the Hearing Officer said that the '133 mark "has a narrower scope of protection for its goods and services than the other marks on which the opponent relies." This, the Opponent says, was a mistake. In addition, in Ground 2, it complained of her reasoning when she went on at paragraph 103 of the Decision to consider whether the '133 Mark advanced the Opponent's position to the extent that no likelihood of confusion had been found based upon the other earlier marks. The Grounds also stated that she should have considered the claim to enhanced distinctiveness of the '133 Mark, and wrongly undertook the assessment of the likelihood of confusion for the FCS Mark as if the '133 Mark was identical to the other earlier marks.
43. The Opponent therefore invited me to remit the opposition to the Registry, in order for the evidence of use of the '133 Mark to be considered, and the likelihood of confusion to be assessed against the surviving terms in its specification.
44. However, the point about the '133 Mark seems to me not to arise now in relation to the application to register FENICS. The Hearing Officer rejected the opposition against that

application only in respect of the Data Storage Services and the Class 45 services. I have overturned her decision on the former, and the Opponent does not pursue the latter. There is no need to remit the opposition to that application to the Registry.

45. That leaves the question of whether the ‘133 Mark might have an impact upon the opposition to the FCS Mark. At paragraph 103 of the Decision, the Hearing Officer considered the question of reliance on the ‘133 Mark in relation to the FCS Mark. She said:

“103. Earlier in my decision under paragraph 24, I explained that should no likelihood of confusion be found, I would reconsider the need to compare the contested mark against the “133” mark, taking into account the evidence provided in relation to genuine use of the mark. In view of the above findings, even accepting that genuine use of the “133” mark is proven for the goods and services relied upon in Classes 9 and 42, given that the “133” mark is identical to the “Fenics” element of the earlier “623” mark, and is aurally identical and visually similar to a high degree to its stylised “423” mark, I consider that the outcome in relation to likelihood of confusion against the mark “Fenix Cloud-Services” would be the same as for its other marks on which this decision is based.”

46. The Opponent said that the Hearing Officer went wrong in this paragraph, in carrying out a comparison of the ‘133 Mark with the ‘423 and ‘623 Marks, rather than with the Applicant’s FCS Mark. That is certainly how she expressed herself at paragraph 103 of the Decision, but seems to me that her position was that there was insufficient difference between the three earlier Marks for any distinction to be drawn between them in terms of a likelihood of confusion with the FCS Mark. I bear in mind that the Opponent itself had submitted that the slightly stylised use of the ‘423 mark did not significantly alter the distinctive character of the plain word mark FENICS, so that use of the stylised version proved genuine use of the earlier word mark FENICS. The Hearing Officer may not have expressed this well, but it seems to me that her view was that regardless of the specification of the ‘133 Mark, she thought the FCS Mark was sufficiently different to it not to lead to a likelihood of confusion, just as she had found for the other earlier marks.

47. The Opponent complained of the Hearing Officer's failure to consider whether its proof of use of the '133 Mark might show it had an enhanced level of distinctiveness, which would have had an impact on the assessment of the likelihood of confusion. However, the Hearing Officer found that the FENICS element of the '423 and '623 Marks was so distinctive that it could not be elevated by evidence of use and her findings as to the high level of inherent distinctiveness of the later marks must equally apply to the '133 mark. There would therefore be no real benefit in analysing the evidence of use to see whether the '133 mark also had enhanced distinctiveness, as a finding of enhanced distinctiveness would be unlikely to have any real impact on the assessment of the likelihood of confusion.
48. The Opponent also said that the Hearing Officer had also been wrong to say that the '133 specification was narrower than that of the other marks in respect of the Class 42 services, pointing to some parts of the '133 specification in Classes 9 and 42. Whether or not that is correct, it seems to me that the answer to the question of whether the Opponent could rely on those parts of the '133 specification – depending upon the impact of its evidence of use – will not help the Opponent's case. If genuine use were proved for any wider terms, this would mean, at best, that there are more terms in the FCS Mark's specification which are identical or similar to terms in the '133 Mark's specification. But as the Hearing Officer found no likelihood of confusion even for goods/services which she had found to be identical to the Opponent's goods/services, I cannot see how this would advance the Opponent's case. For all these reasons, I do not consider it necessary or appropriate to remit to the Registry the questions relating to the '133 Mark.

Conclusion

49. The appeal therefore succeeds only in relation to the Data Storage Services in the FENICS mark, and is otherwise dismissed.
50. Both sides have had a measure of success on the appeal. In the circumstances, I will make no order as to the costs of the appeal. The Hearing Officer considered that the Applicant had the greater measure of success before her, and in the circumstances I see

no reason to disturb her costs order, so that the £700 which she ordered the Opponent to pay the Applicant shall be paid within 21 days of today.

Amanda Michaels
The Appointed Person
26 January 2024

MS. CHARLOTTE BLYTHE (instructed by Bristows LLP) appeared for the Appellant.

The Respondent did not attend and was not represented.

Annex A

The Applicant's specification of goods and services:

Class 9: Virtual server software; Cluster computer system hardware; Computer software for the setup, configuration and management of cluster computer systems, supercomputer systems, operating system software and multiple computers in a networked environment; Cluster computer system software; Supercomputer systems; Computer networks consisting of a number of computers; Computer software in the field of operating and enhancing high performance and high availability computer hardware and computer networks.

Class 37: Installation and maintenance of hardware for cluster networks and grid architectures.

Class 42: Services for the design of interactive computer software; Services relating to interactive computer networks; Technological services relating to interactive computers; Services for the design of scalable computer software; Services relating to scalable computer networks; Technological services relating to scalable computers; Providing of virtual computer systems by means of cloud computing; Electronic data storage; Online data storage; Computer services concerning electronic data storage; Cloud computing; Consultancy relating to the use of high performance computers; Design of high performance and high availability computer systems, cluster computer systems, supercomputer systems, multiple computer systems and computer networks; Research relating to data processing; Research in the field of information technology; Research in the field of data processing technology.

Class 45: Generation, acquisition, disposal and evaluation of industrial property rights, in particular patents; Licensing of industrial property rights, Industrial property licensing consultancy; Technology licensing.