

BL O/0370/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3781066 IN THE NAME OF QUEST GLOBAL SERVICES PTE. LIMITED

AND IN THE MATTER OF OPPOSITION NO. OP00437025 THERETO BY QUEST SOFTWARE INC.

DECISION

Introduction

1. This is an appeal by QuEST Global Services Pte. Ltd (“*the applicant*”) against a decision of Ms S Wilson, on behalf of the Registrar of Trade Marks, dated 3 May 2024 (O-0397-24)(“*the Decision*”), in which she upheld the opposition brought by Quest Software Inc (“*the opponent*”) pursuant to section 5(2)(b) of the Trade Marks Act 1994 (“*the 1994 Act*”).
2. On 25 April 2022 the applicant applied to register the trade mark:



3. The application was sought for the following goods and services:

Class 9: Recorded computer software; Downloadable computer software.

Class 42: Research and development of new products for others.

4. On 21 October 2022 the opponent opposed the application on the basis of section 5(2)(b), section 5(3) and section 5(4)(a) of the 1994 Act. For that purpose, the opponent relied upon two trade marks (together “*the earlier marks*”):

QUEST

UKTM No. 9037605011 Filing date 13 April 2004; registration date 9 August 2007 (“*the First Earlier Mark*”)

Quest

UKTM No. 801392791 Filing date 7 December 2017; registration date 10 August 2018 Priority date: 8 June 2017 (“*the Second Earlier Mark*”)

5. For the purposes of section 5(2)(b) and section 5(3) the opponent relied upon all the goods and services for which the earlier marks were registered as set out in Annex 1 to the Decision. For the purposes of section 5(4)(a) the opponent relied upon the goods and services as set out in Annex 2 to the Decision.
6. The applicant filed a counterstatement. The key points from the counterstatement were identified in paragraph [6] of the Decision as follows:
 - a. The opponent is put to proof of use of the First Earlier Mark.
 - b. It is admitted that the parties’ respective goods in class 9 are identical.
 - c. It is admitted that “research and development of new products for others of [the] application would include such services in relation to computers and computer software such as to make them similar services in class 42 [to the class 42 services of the First Earlier Mark]”.
 - d. It is denied that there is a likelihood of confusion.
 - e. It is claimed that the applicant has been using the mark QUEST in the form applied-for (as well as other forms) in the UK since as early as June 2011. Consequently, the applicant claims that the parties have co-existed in the market and that there is no evidence of confusion.
 - f. The section 5(3) and 5(4)(a) grounds of opposition are denied.
7. Both parties filed evidence and written submissions.
8. A hearing took place before the Hearing Officer. The applicant was represented at the hearing by Mr Aaron Wood of Brandsmiths SL Limited. The opponent, represented by K&L Gates LLP, elected not to attend the hearing but filed written submissions in lieu of attendance.

Decision of the Hearing Officer

9. For the purposes of this appeal the applicant relies upon the incorrect assessment of similarity between the applicant’s class 42 services and the opponent’s class 9 goods. I therefore, at this stage, only set out the sections of the Decision that deal with that assessment.

10. The Hearing Officer first identified the comparison that she considered that she as required to make at paragraph [18] of the Decision as follows:

18. As noted above, the applicant accepts that the parties' goods in class 9 are identical. I do not, therefore, need to consider these goods any further and will proceed on that basis. In relation to the applicant's class 42 services, there was an admission regarding the similarity with the class 42 services of the First Earlier Mark. However, no such admission appears to have been made in relation to the specification of the Second Earlier Mark. I will, therefore, assess the similarity of the applicant's class 42 services with the class 9 goods covered by the specification of the Second Earlier Mark. For the avoidance of doubt, I have set out only what I consider to be the most relevant of the opponent's terms in the table below (the full list can be found in Annex 1). With that in mind, the competing goods and services are as follows:

Opponent's goods	Applicant's services
<u>Class 9</u> Computer software for managing, securing, tuning and optimizing, replicating, storing, backing up, recovering and reporting on computer files and databases.	<u>Class 42</u> Research and development of new products for others.

11. Having identified the legal principles that should be applied for the purposes of making the comparison at paragraphs [19] and [20] the Hearing Officer concluded at paragraph [21] as follows (footnote excluded):

21. I accept the applicant's pleading that its own services could include research and development of new software products (which would, plainly, include software such as that offered by the opponent). Even without the applicant's admission, this is the view that I would have taken. I consider that the same businesses are likely to sell both ready-made software goods and services for the development and creation of bespoke software goods. Consequently, there is an overlap in trade channels and user. There will also be complementarity. Consequently, the goods and services are similar to a medium degree. Even if I am wrong regarding the trade channels and complementarity, there will be clear competition as a user may choose to either purchase an off-the-shelf software product or engage the services in class 42 to create a bespoke product. Consequently, I would still have found these goods and services to be similar to a medium degree.

12. The Hearing Officer went on to find with respect to the Second Earlier Mark that there as a likelihood of confusion under section 5(2)(b) on the basis of *inter alia* her findings set out in paragraph [37] of her Decision that:
 - a. The goods and services are identical or similar to a medium degree.
 - b. The average consumer will be either a member of the general public or a business user, who will pay at least a medium degree of attention during the purchasing process (although it is likely to be higher in some cases).
 - c. The purchasing process will be predominantly visual, although I do not discount an aural component.
 - d. The applicant's mark and the Second Earlier Mark are visually similar to between a medium and high degree and aurally similar to a high degree. The QUEST elements of the marks are conceptually identical and, whilst the word GLOBAL in the applicant's mark is a point of conceptual difference, it is not a distinctive one.
 - e. The Second Earlier Mark is inherently distinctive to a medium degree.
13. With respect to the other grounds of opposition under section 5(3) and section 5(4)(a) the Hearing Officer only dealt with then shortly on the basis that they would *inter alia* stand or fall with the ground of opposition under section 5(2)(b).
14. In circumstances where the opponent had been successful in its opposition on the Second Earlier Mark the Hearing Officer did not consider further the opposition based on the First Earlier Mark (see paragraph [42] of the Decision).
15. Accordingly, the opposition was upheld, and the opponent was ordered to pay the applicant a contribution of £1,900 with respect to the applicant's costs.

The appeal

16. A Form TM55P was filed on behalf of the opponent dated 31 May 2024. It was accompanied by Grounds of Appeal.
17. The Grounds of Appeal contained six separate grounds. However, for the purposes of the appeal hearing before me, the opponent's representatives in my view quite rightly only advanced three. These were conveniently categorised in the skeleton of argument as:

Ground 1: Mistake of law as to the nature of services.

Grounds 2 and 3: Conclusions lacking support and error of law as to the finding that the goods and services were complementary.

18. In substance all 3 grounds were directed to the findings made in paragraph [21] of the Decision.
19. It was further maintained that as a result of such errors there was a ‘knock on effect’ on the finding of a likelihood of confusion such that the Hearing Officer could and should have allowed the application to proceed to registration in class 42.
20. There was no challenge to the findings set out in paragraph [37 b], [37c], [37d] or [37e] of the Decision as set out in paragraph 12 above. Nor was there any challenge to the legal principles that the Hearing Officer had identified as applicable to any of the assessments that she was required to make.
21. No Respondent’s Notice was filed.
22. At the hearing of the appeal Ms Priya Gandham of Brandsmiths SL Limited appeared on behalf of the applicant. A skeleton of argument signed by Ms Gandham and Mr Stephen Lowry of Brandsmiths SL Limited was filed in advance of the hearing. The opponent was not represented at the hearing and took no part in the appeal.

The Standard of Review

23. The Court of Appeal addressed the question of the standard of review on appeals in Lidl Great Britain Ltd v. Tesco Stores Ltd [2024] EWCA Civ 262 at [110] where Arnold LJ stated the position to be as follows:

The test on appeal

110. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: *Volpi v Volpi* [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2] (v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle: compare *Magmatic Ltd v PMS International Group plc* [2016] UKSC 12, [2016] Bus LR 371 at [24] (Lord Neuberger of Abbotsbury) and *Actavis Group PTC EHF v ICOS Corp* [2019] UKSC 15, [2019] Bus LR 1318 at [78]- [81] (Lord Hodge) , and see *Re Sprintroom Ltd* [2019] EWCA Civ 932, [2019] BCC 1031 at [72]-[78] (McCombe, Leggatt and Rose LJJ) , which was cited with approval by the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at [49] (Lord Briggs and Lord Kitchin) .

24. See further the in the Supreme Court in Lifestyle Equities CV. Amazon UK Services Ltd [2024] UKSC 8 at [46] to [50].

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

Decision

26. As noted above this is an appeal with respect to findings that were made by the Hearing Officer in making the assessment under section 5(2)(b) of the 1994 Act.

27. In this connection it is to be observed that the Court of Appeal has explicitly confirmed in TVIS Ltd v. Howserv Services Ltd [2024] EWCA Ci 1103 at [31] that:

Since the judge's conclusion that there was no likelihood of confusion involved a multi-factorial evaluation, this Court can only intervene if he erred in law or in principle: compare *Actavis Group PTC EHF v ICOS Corp* [2019] UKSC 15 , [2019] Bus LR 1318 at [78]-[81] (Lord Hodge) and see *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 , [2024] Bus LR 532 at [46]-[50] (Lord Briggs and Lord Kitchen).

28. I can see from paragraphs [14]-[17], [19]-[20], [22], [25] and [32] of the Decision that the Hearing Officer directed herself correctly as to the applicable legal principles. As noted above it was not suggested by the applicant on this appeal that those paragraphs contain any errors.

29. It is also to be kept in mind that as recorded in Decision the applicant admitted that (1) the parties' respective goods in class 9 are identical (paragraph [6b] of the Decision); and (2) "*research and development of new products for others* of [the] application would include such services in relation to computers and computer software such as to make them similar services in class 42 [to the class 42 services of the First Earlier Mark]" (emphasis as in the original) (paragraph [6c] of the Decision).

30. In paragraph [18] of the Decision the Hearing Officer explained that in the light of those admissions the assessment of similarity that she was required to make was between the similarity of the applicant's class services with the class 9 goods covered by the specification of the Second Earlier Mark. For that purpose, the Hearing Officer identified those terms in the Second Earlier Mark's specification which she considered most relevant and recorded them in the table as quoted above. At the same time the Hearing Officer appreciated that this was not the totality of the specification which was set out at Annex 1 to the Decision.

31. The points of criticism of the Hearing Officer's findings of similarity in paragraph [21] maintained at the hearing before me can be summarised as being:

- (1) That the Hearing Officer took a "broad brush" assessment to the similarity without analysing the intended purpose of the terms in particular the generalised term "off the shelf software".

- (2) That the Hearing Officer considered the actual use made when construing the terms of the specification.
 - (3) That the Hearing Officer erred in that the opponent's goods as identified in the Decision for the purposes of the comparison could not be interpreted as "off the shelf software" being software of a type that is complex.
 - (4) That the trade channels and end users would be different *if* the comparison was between "off the shelf software" and "bespoke software".
 - (5) That the Hearing Officer had failed to provide any analysis in support of the finding that the goods and services in issue were complementary and/or that there would be competition between the products and services in issue.
 - (6) That there was no evidence to support any of the findings made by the Hearing Officer.
32. The first point to note is that findings made in paragraph [21] of the Decision were predicated on the basis that the Hearing Officer agreed with the admission that the applicant's services would include research and development of new computers and computer software for others.
33. In that connection it is also of note that so far as the First Earlier Mark was concerned it was admitted that there was similarity between the Class 9 goods and the Class 42 services – the class 42 services being '*Computer and computer software consulting, design, programming, implementation, technical support services*'.
34. The second point to note is that the applicant has not identified what the Hearing Officer should have found with regard to the similarity of goods and services in issue for the purposes of the opposition based on the Second Earlier Mark. It would not seem to be suggested that it was open to the Hearing Officer to find that the goods and services in issue were dissimilar.
35. If all that the applicant is seeking to do by way of appeal it to replace a finding of medium similarity between the goods and services in issue with a finding of a low degree of similarity this argument cannot be accepted. See by way of analogy the reasoning set out in paragraph [35] of TVIS Ltd v. Howserv Services Ltd (above):

35. The second and more fundamental reason is that, while it is conventional for first instance tribunals in trade mark cases to articulate their assessment of the degree of visual and aural similarity between signs and trade marks using words such as "high", "medium" or "low", there is no legal requirement for tribunals to do so. All that is required is for the tribunal to assess the nature and extent of any similarities. This is because what matters is not the verbal label that is applied to the

assessment, but whether the similarities in conjunction with the other factors which must be taken into account lead to a likelihood of confusion. It is possible for there to be no likelihood of confusion despite a relatively high degree of visual and aural similarity. Equally it is possible for there to be a likelihood of confusion despite a relatively low degree of visual and aural similarity. It depends on the other factors that are in play.

36. Further and in any event, in my view the Hearing Officer did what she was required to do. In order to maintain the required distance between the role of decision taker at first instance and decision taker on appeal, it is necessary for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the applicant relies are by force of what they reveal sufficient to establish that the Decision is vitiated by error. See the decision of Geoffrey Hobbs KC in LADY LOUISA WATERFORD TM (O-0646-24) at paragraphs [10] and [19]:

10. Her Decision is not liable to be set aside by this Tribunal on appeal unless it can be regarded as rationally insupportable, whether by reason of an identifiable flaw in the treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account a material factor, which undermines the cogency of the conclusion, or for being contrary to principle or plainly wrong: *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at paras [46] to [50] per Lord Briggs and Lord Kitchin SCJJ (with whom Lord Hodge, Lord Hamblen and Lord Burrows SCJJ agreed); *Volpi v Volpi* [2022] EWCA Civ. 464 at paras [2], [3] per Lewison LJ (with whom Males and Snowden L.JJ agreed)

...

19. The Hearing Officer did what she was required to do. In order to maintain the required distance between the role of decision taker at first instance and decision taker on appeal, it is necessary for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Opponent relies are by force of what they reveal sufficient to establish — to the standard indicated in para. [10] above — that the Decision is vitiated by error. Having regard, in particular, to the Opponent’s approach to this Appeal as summarised in paras [11] to [15] above, I must add that for the Hearing Officer’s position to be characterised as “wrong” it is “*not enough to show, without more, that the appellate court might have arrived at a different evaluation*”: *Lifestyle Equities* (above) at para. [50].

37. I have reviewed paragraph [21] of the Decision in the light of the applicant's criticisms of it and the conclusions on both direct and indirect confusion at paragraphs [40] and [41] of the Decision. In doing so I have had regard to the fact that:

- (1) The conclusions in paragraph [21] of the Decision were expressed shortly.
- (2) It seems to me that it was open to the Hearing Officer to take the view that the specification of the opponent's goods included off the shelf software. There was nothing to suggest otherwise in the specification. In any event it seems to me that to proceed on the basis that the Hearing Officer did was on one view to the applicant's advantage.
- (3) No evidence appears to have been filed by either party directed to the issue of the similarity of the goods and services; however, none was referred to by the Hearing Officer. In that connection there does not seem to have been any evidence to support the contention by the applicant on appeal that there would be no overlap of users or trade channels for off the shelf and bespoke software (none was brought to my attention).
- (4) There was no specific analysis of the finding of complementarity in the Decision. However, whether or not such a finding should have been made, there were other findings to support the conclusion on similarity reached by the Hearing Officer.
- (5) The admission by the applicant recorded and accepted by the Hearing Officer in the first sentence of paragraph [21] of the Decision. The reference in that sentence to software offered by the opponent does not seem to me to be a clear reference to the software actually offered by the opponent; but even if it was this does not seem to me to be a material error as it seems to me that the opponent's goods in the specification would on the basis of the admission fall within applicant's services.

Having completed that review and in the light of the comments made above I am satisfied that the matters relied upon do not reveal any substantive mistakes and that they cannot be taken, individually or together to establish that the Decision under section 5(2)(b) of the Act is liable to be set aside.

Conclusion

38. For the reasons set out above it does not seem to me that the applicant has identified any error or principle or material error in the Hearing Officer's Decision. Moreover, it is not in my view appropriate to interfere with the evaluations that the Hearing Officer made in reaching the conclusions that she did. In the result the appeal fails and is dismissed.

39. As the appeal has been dismissed the opponent is entitled to a contribution towards the costs of the appeal. However, the opponent has not participated in any way in this appeal. It therefore seems to me that the appropriate costs order on appeal is to make no order as to costs.
40. With respect to the cost order made by the Hearing Officer below in accordance with paragraph [52] of the Decision QuEST Global Services Pte. Ltd should pay to Quest Software Inc. the sum of £1,900 within 21 days of the date of this decision being the date of the conclusion of the appeal proceedings.

EMMA HIMSWORTH KC

22 April 2025