BL O/0579/24

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL REGISTRATION NO. WO0000001542892

DESIGNATING THE UNITED KINGDOM

BY BEAR ROBOTICS, INC.

IN RESPECT OF THE TRADE MARK:

Servi

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 423183

BY CURSUS TECHNOLOGIES, INC.

BACKGROUND AND PLEADINGS

1. Bear Robotics, Inc. ("the holder"), is the holder of international trade mark registration number 1542892 ("the IR"), shown on the cover page of this decision. The IR is registered with effect from 28 April 2020, but claims a priority date of 31 January 2020.[1] The request to protect the IR in the UK was made on 28 April 2020. It was accepted and published for opposition purposes on 13 November 2020, in respect of goods and services in Classes 7, 9, 20, 37, 39, and 43.

2. On 12 February 2021, Cursus Technologies, Inc. ("the opponent") opposed the protection of the IR in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition was directed at some of the goods and services in Classes 9, 39 and 43. For the purposes of its opposition, the opponent relies upon its UK trade mark number 3456132, "SERVY" ("the earlier mark"). The earlier mark was filed on 7 January 2020. The mark became registered on 27 March 2020. The opponent relies on all its goods and services in Classes 9 and 41.[2]

3. Following the filing of the opposition, on 21 September 2022, the holder filed a form MM6 at the World Intellectual Property Office (WIPO) requesting the partial limitation of some of its goods and services in Classes 9 and 39.[3]

4. On 30 September 2022, the Registry issued a preliminary indication that the opposition be rejected in respect of Classes 39 and 43. In view of this, the opponent was invited to file a notice of intention to proceed with the opposition as filed via a Form TM53, by 31 October 2022. The opponent was informed that if they did not file a Form TM53 by the deadline, it will be deemed to have withdrawn its opposition in relation to these services.

5. Notwithstanding the limitation filed by the holder, the opponent indicated in its correspondence dated 25 November 2022 that it intended to continue with the opposition. However, as it had not filed the requested Form TM53 by the requisite

[1] Priority claimed from the Republic of Korea.
[2] These will be listed in the goods and services comparison.
[3] See holder's Form TM8 and counterstatement.

deadline, the Registry confirmed in its official letter dated 1 December 2022 that "as no Form TM53 has been filed by the opponent, […] Classes 39 and 43 have been deemed withdrawn from the opposition."

6. On 1 February 2023, the opponent filed an amended Form TM7 directed solely at the holder's Class 9 goods, but this time in respect of the entirety of the holder's Class 9 goods (as amended by the holder on 21 September 2022).[4]

7. On 10 February 2023 the holder filed a form MM22 at WIPO requesting the division of their IR (WO0000001542892), thereby separating the opposed Class 9 goods, from the unopposed classes. On 18 April 2023, the Registry confirmed that the IR had been divided and was assigned the following numbers: WO0000001542892 in respect of Class 9, and WO0000001542892A in respect of the unopposed classes. The opposition therefore proceeds against international trade mark number WO0000001542892 ("the contested IR"). The opposed Class 9 goods are set out in their entirety in the goods and services comparison section of this decision.

8. In its notice of opposition, the opponent claims that the respective marks are highly similar and that the respective goods and services are sufficiently similar, resulting in a likelihood of confusion and association. The holder filed its defence and counterstatement admitting that the marks are similar but denied any similarity between the goods and services.

9. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods and services for which the earlier mark is registered without having to establish genuine use.

10. Neither party filed evidence. The opponent is represented by J A Kemp LLP; the holder is represented by Dehns. Neither party requested a hearing and only the holder

[4] See the Preliminary Issues section of this decision.

chose to file written submissions in lieu of a hearing. This decision is taken following careful consideration of the papers.

Preliminary issue

11. It is noted that in the opponent's initial Form TM7, served on the holder on 23 March 2021, the opposition was directed against, *inter alia*, only some of the holder's Class 9 goods. However, when it subsequently filed its amended Form TM7 on 1 February 2023, it directed the opposition against all of the holder's Class 9 goods (as amended).

12. This had the resultant effect of broadening the scope of the opposition against the holder's Class 9 goods. This is an issue which was first raised by the holder in their submissions in lieu of a hearing.

13. However, for reasons that will become apparent, even if the opposition were directed against all of the holder's Class 9 goods, it will not put the opponent in a more favourable position. I will therefore proceed with this decision on the basis that all of the holder's Class 9 goods have been opposed, as set out in the opponent's amended Form TM7 dated 1 February 2023.

Relevance of EU law

14. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Section 5(2)(b)

15. Sections 5(2)(b) of the Act states that:

> "5(2) A trade mark shall not be registered if because-
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
>
> […]
>
> 5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Relevant law

16. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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:

The principles

(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

17. Section 60A of the Act provides:

"(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

18. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account.

Those factors include, *inter alia*:[5]

[5] See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd*., [1996] R.P.C. 281 – the *"Treat*" case

- the physical nature of the goods or acts of service;
- their intended purpose;
- their method of use / uses;
- who the users of the goods and services are;
- the trade channels through which the goods or services reach the market;
- in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors)

  or

- whether they are complementary to each other. Complementary means *"there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".*[6] I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[7]

19. When interpreting the terms in a specification I bear in mind:

(i) that it is *"necessary to focus on the core of what is described.."* and that "… *trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise",* although *"where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question"*.[8]

20. The competing goods and services are as follows:

[6] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82
[7] *Kurt Hesse v OHIM*, Case C-50/15
[8] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

Opponent's goods and services	Holder's goods
Class 9 Downloadable software in the nature of a mobile application that provides travelers in airports with directions and routing within the airport, information and locations of retail stores, retail kiosks, and services, including spa and beauty services, shoe shine services, and lounges, and the ability to pre-order and pay retail stores and restaurants for purchases for express pick-up; downloadable software in the nature of a mobile application that provides consumers the ability to pre-order, purchase, and pay for food and beverages; interactive computer kiosk systems comprised primarily of computers, computer hardware, computer peripherals, and computer touchscreens for use in ordering, purchasing, and paying for food and beverages. Class 41 Web-based service that enables users to order, purchase, and pay for food and beverages; software as a service (SaaS) enabling users to order, purchase, and pay for goods, including food and beverages.	Class 9 Teaching robots; electronic control systems for machines, namely for autonomous and semiautonomous humanoid robots with artificial intelligence; computer software, recorded, for the operation, control, maintenance, and Management of autonomous and semi-autonomous robots; computer software, recorded, for robotic navigation, pathing, communications, and for collecting, tracking, analyzing, and reporting data and information, all in connection with autonomous and semi-autonomous robots; computer programs, recorded for operating, controlling and uploading data from autonomous and semi-autonomous robots; downloadable software for the operation, control, maintenance, and management of autonomous and semi-autonomous robots; downloadable software for robotic navigation, pathing, communications, and for collecting, tracking, analyzing, and reporting data and information, all in connection with autonomous and semi-autonomous robots; computer software applications, downloadable, using artificial intelligence for the control, maintenance, and management of autonomous and semi-autonomous robots; downloadable interactive computer software for operating, controlling and uploading data from autonomous and semi-autonomous robots; security surveillance robots; downloadable application software for smart phone for operating, controlling and uploading data from autonomous and semiautonomous robots; laboratory robots; humanoid autonomous and semi-autonomous robots with artificial intelligence; computers for operating and controlling autonomous and semi-

	autonomous robots; downloadable and recorded computer software using artificial intelligence for developing machine learning, statistical learning, and predictive analysis in connection with autonomous and semi-autonomous robots; computer controllers for operating and controlling autonomous and semi-autonomous robots; computer hardware for operating and controlling autonomous and semi-autonomous robots; downloadable computer software platforms for operating, controlling and uploading data from autonomous and semiautonomous robots; touch pads for computers for operating and controlling autonomous and semiautonomous robots; telepresence autonomous and semi-autonomous robots; portable computers for operating and controlling autonomous and semi-autonomous robots; robotic electrical control apparatus; mechanical remote control apparatus for robots; telepresence robots for promoting products.

21. With regard to the opponent's services claimed in Class 41, it is noted that these services do not belong in Class 41, but rather are proper to Class 42. Therefore, I keep in mind that these services have been incorrectly classified when applying the applicable principles of interpretation.

22. With regard to the similarity of the goods and services, in its statement of grounds the opponent states the following:

> "The respective goods and services are similar. The software related goods covered by the Opposed application are broad and could overlap with the Opponent's more specific types of software. The other computer and computer hardware related goods covered by the Opposed application either include the Opponent's goods or they overlap. The remaining contested goods, '*electronic*

control systems for machines, humanoid robots with artificial intelligence, telepresence robots, robots for promoting products' do not have a stated purpose and could also overlap with the Opponent's goods.[9]

23. With regard to the similarity of the goods and services, in its submissions in lieu, the holder submits the following:

"It is submitted on behalf of the Applicant that the goods and services in question, insofar as they are not common-or-garden items, are not self-evidently similar. With this in mind, we would refer to the view of Mr Hobbs KC, sitting as an Appointed Person in the case of *Raleigh International Trade Mark* ([2001] RPC 11).

[…]

In short, where the goods/services are not everyday items and are not self-evidently similar, evidence is required. We thus submit that, in the absence of evidence to prove that the respective goods and services have the same use, users, trade channels, and so on, the Opponent is relying on assertion alone and this is insufficient to prove their case.

Moreover, the Opponent's lack of evidence is significant because, not only are the goods/services not self-evidently similar, but the Opponent had been put on notice in the Counterstatement that the Applicant denied [sic] and requested proof of similarity.

It is submitted that the Class 9 goods covered by the Application are dissimilar to the goods/services of the Earlier Trade Mark.

[…]

[9] This statement was made prior to the holder restricting the purpose of the Class 9 goods at issue.

Turning first to the uses of the goods and services, the Opponent's goods/services would be used to order, purchase, and pay for food and beverages, and/or to navigate and locate retail outlets within airports. In contrast, the Applicant's goods include robots, the purpose of which is to automate certain actions in order to increase efficiency and accuracy (for example, in manufacturing or in clinical settings). The Applicant's other goods are all types of computer hardware/software and control systems for use with robots, which are used to programme and control such robotic devices. As such, the respective uses of the goods/services in question are dissimilar.

Regarding the respective users of the goods and services, these are also dissimilar. Insofar as the Opponent's goods are used to order, purchase, and pay for food and beverages, and/or to navigate and locate retail outlets within airports, the target users are the general public at large. In contrast, the Applicant's goods are sophisticated, technical products that target a professional public. AI and robotic technology are relatively new areas within the field of computer hardware and software, and so cannot yet be considered mainstream. The Applicant's goods are therefore aimed at business users and/or IT professionals, who will take a greater degree of care and consideration during the purchasing process.

[…]

It follows from the dissimilar target users of the respective goods and services that they also have dissimilar trade channels. The specialist nature of the Applicant's goods means, firstly, that the producers of robots/robotic control software are not likely to also produce e-commerce mobile applications and, secondly, that the Applicant's goods are likely to be sold via very specific, business-to-business distribution channels that are distinct from the channels (such as mobile app stores) through which the Opponent's software applications are offered.

Insofar as the respective goods and services have different uses and users, they are not competitive. One could not use the Opponent's goods/services in place of the Applicant's, or vice versa.

For completeness, we submit that just because robots and robotic control apparatus consist of both hardware and software, this does not automatically give rise to a level of similarity between these goods. To support this point, we refer to the decision of the Hearing Officer in the matter of *Version Tech* ([2022] O-213-22) in which 'humanoid robots with artificial intelligence' were deemed to be dissimilar to 'computer hardware and software for telecommunications, television, computer networking and information technology'.

Similarly, in *4Paradigm Sage* ([2023] O-0065/23), the Hearing Officer held that there was no similarity between robots with artificial intelligence and 'computer software that includes artificial intelligence for business data processing', despite the AI overlap. This was due to the "significant differences in the uses" and the fact that "any overlap in users is likely to be at a high level of generality and it is doubtful that the channels of trade will intersect [, nor] is it obvious that there is either a competitive or complementary relationship"."

<u>Teaching robots; security surveillance robots; laboratory robots; humanoid autonomous and semi-autonomous robots with artificial intelligence; telepresence autonomous and semi-autonomous robots; telepresence robots for promoting products</u>

24. The above contested goods share no obvious overlap with the opponent's goods. Whilst it is noted that the opponent's goods contain downloadable software, this software specifically relates to providing travellers in airports with direction, routing and location information regarding retail stores, kiosks, and restaurants, etc,. located in the airport, as well as providing consumers with the ability to pre-order, purchase, and pay for food and beverages. In addition, the opponent's goods include interactive computer kiosk systems comprised primarily of computers, computer hardware, computer peripherals, and computer touchscreens – these kiosk systems have a specific purpose, namely that of ordering, purchasing, and paying for food and beverages

which I do not consider overlaps with the purpose of the above goods. Accordingly, although *robots* will generally consist of both computer hardware and software, this in my view does not give automatic rise to a level of similarity between the goods at issue. I do not consider that there would be an overlap in producer or trade channel between these competing goods and there is no evidence before me to suggest otherwise. With regard to distribution channels, I consider the contested are likely to be sold via very specific channels that differ from the opponent's distribution channels and I have no evidence before me to suggest otherwise, even if there were, this alone is not sufficient to establish that the goods are similar. Accordingly, I do not consider that there is any level of similarity between the goods at issue. They are, therefore, dissimilar. Furthermore, with regard to the services relied upon by the opponent, even if they had been correctly classified, the same conclusion applies, on the basis that the services share no direct similarities with the above contested goods.

Electronic control systems for machines, namely for autonomous and semiautonomous humanoid robots with artificial intelligence; robotic electrical control apparatus; mechanical remote control apparatus for robots; computer controllers for operating and controlling autonomous and semi-autonomous robots; computer hardware for operating and controlling autonomous and semi-autonomous robots; touch pads for computers for operating and controlling autonomous and semiautonomous robots; computers for operating and controlling autonomous and semi-autonomous robots; portable computers for operating and controlling autonomous and semi-autonomous robots

25. The above contested goods are all forms of control systems and apparatus specifically for use with robots. I find that these goods share no obvious overlap with the opponent's goods. Whilst it is noted that the opponent's goods include interactive computer kiosk systems comprised primarily of computers, computer hardware, computer peripherals, and computer touchscreens, these kiosk systems have a specific purpose, namely that of ordering, purchasing, and paying for food and beverages, and therefore the purpose of these goods is different to the holder's goods. Accordingly, although the holder's goods include computers, computer controllers and touch pads for computers, these are specifically for use with *robots,* whereas the opponent's computers, computer hardware and computer peripherals, are contained

within interactive computer kiosk systems, specifically used for ordering, purchasing, and paying for food and beverages. This in my view does not give an automatic rise to a level of similarity between the goods at issue. Further, I have no evidence before me to suggest that there would be any instances where there would be an overlap in producer or trade channels of these goods. Whilst there may be some overlap in user, any overlap will be superficial. As mentioned previously, I consider it likely that the producer of the holder's goods would be very specialist in nature and one that is unlikely to also produce and sell the opponent's specific goods, and again I do not have any evidence that would suggest otherwise. In addition, the goods at issue are likely to be sold via different distribution channels. Accordingly, I do not consider that there is any level of similarity between the goods at issue. They are, therefore, dissimilar to the opponent's Class 9 goods. Furthermore, in regard to the opponent's services, even if they had been correctly classified, the same conclusion applies, on the basis that the services share no direct similarities with the above contested goods.

Computer software, recorded, for the operation, control, maintenance, and Management of autonomous and semi-autonomous robots; computer software, recorded, for robotic navigation, pathing, communications, and for collecting, tracking, analyzing, and reporting data and information, all in connection with autonomous and semi-autonomous robots; computer programs, recorded for operating, controlling and uploading data from autonomous and semi-autonomous robots; downloadable software for the operation, control, maintenance, and management of autonomous and semi-autonomous robots; downloadable software for robotic navigation, pathing, communications, and for collecting, tracking, analyzing, and reporting data and information, all in connection with autonomous and semi-autonomous robots; computer software applications, downloadable, using artificial intelligence for the control, maintenance, and management of autonomous and semi-autonomous robots; downloadable interactive computer software for operating, controlling and uploading data from autonomous and semi-autonomous robots; downloadable application software for smart phone for operating, controlling and uploading data from autonomous and semiautonomous robots; downloadable and recorded computer software using artificial intelligence for developing machine learning, statistical learning, and predictive analysis in connection with autonomous and semi-

autonomous robots; downloadable computer software platforms for operating, controlling and uploading data from autonomous and semiautonomous robots

26. The above goods relate to various forms of software/programs specifically restricted for use with autonomous and semi-autonomous robots. Whilst it is noted that the opponent's goods include downloadable software, these goods have been specifically restricted to use with mobile applications that provide travellers in airports with directions and routing within the airport, information and locations of retail stores, retail kiosks, and services, including spa and beauty services, shoe shine services, and lounges, and the ability to pre-order and pay retail stores and restaurants for purchases for express pick-up; and to enable consumers to pre-order, purchase, and pay for food and beverages. Accordingly, it can be said that the competing terms at issue have very different core purposes, meaning that there is no overlap in purpose between the goods. Whilst I acknowledge that the nature and methods of use for these goods may overlap to some degree on the basis that the goods at issue are all items of software, I do not consider that it necessarily follows that users and trade channels will overlap. I say this as I have no evidence to suggest that those looking to operate, control, maintain and manage autonomous and semi-autonomous robots, for example, will also use the specific software of the opponent, nor is there anything to suggest that the competing software goods at issue are provided by the same undertakings. Furthermore, the goods at issue are not complementary or competitive in nature. Notwithstanding the respective goods are items of software (and therefore share a limited overlap in nature) a finding of similarity on this basis alone would mean that it could be argued that all types of software are similar despite having different purposes, user bases and trade channels. In my view, this offers a scope of protection that is far too broad and not within the parameters of the limited specification for which the earlier mark is registered. As such, I consider that the contested goods are dissimilar to the opponent's Class 9 goods. In regard to the opponent's services, even if they had been correctly classified, the same conclusion applies, on the basis that the services share no direct similarities with the above contested goods.

27. In conclusion, I do not find any similarity at all between the opponent's goods and services and the Class 9 goods for which protection is sought. Since some degree of similarity between the goods and services is necessary in order to consider the

likelihood of confusion under section 5(2)(b) of the Act, a finding of no similarity between them means that there is no likelihood of confusion to be considered.[10] Therefore the opposition must fail. I note that no degree of similarity between the competing marks will have any consequence on this outcome since the competing goods and services are not similar.

28. The opposition based upon section 5(2)(b) of the Act is dismissed in its entirety.

OUTCOME

29. The opposition is unsuccessful and subject to any appeal, international registration number WO0000001542892 may be granted protection in respect of all of the holder's Class 9 goods (as amended).

COSTS

30. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale set out in Tribunal Practice Notice 2/2016. In the circumstances, I award the holder the sum of £650, calculated as follows:

Preparing a counterstatement and considering the notice of opposition	£400
Preparing written submissions in lieu of a hearing	£250
Total	£650

31. I therefore order Cursus Technologies, Inc. to pay Bear Robotics, Inc. the sum of £650. 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.

[10] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

Dated this 20th day of June 2024

Sam Congreve

For the Registrar