

O/0602/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003824840  
BY FORTIFIED IT LTD  
TO REGISTER THE FOLLOWING SERIES OF SIX TRADE MARKS:



IN CLASSES 9, 35, 37, 41 AND 42

AND

AN OPPOSITION THERETO UNDER NUMBER 600003044  
BY DANNY EASTMAN

## BACKGROUND AND PLEADINGS

1. On 30 August 2022, Fortified IT Ltd (“the applicant”) applied to register in the UK the trade mark series shown on the cover page of this decision. The application was accepted and published for opposition purposes on 3 February 2023 and registration is sought for goods in Class 9 and services in Classes 35, 37, 41 and 42.<sup>1</sup>

2. On 2 May 2023, Danny Eastman (“the opponent”)<sup>2</sup> filed a fast track opposition opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>3</sup> The opponent relies upon UK trade mark number UK00003279919,



, which has a filing date of 2 January 2018 and a registration date of 30 March 2018. For the purposes of this opposition, the opponent relies upon its entire Class 42 services.<sup>4</sup>

3. The opponent opposes the application in full on the basis that the respective marks are similar and are to be registered for similar goods and services, resulting in a likelihood of confusion.

4. Given its earlier filing date, the opponent’s mark is an earlier mark in accordance with section 6(1) of the Act. Further, in accordance with section 6A of the Act, the earlier mark is not subject to proof of use and so the opponent may rely upon all the services identified for the purposes of this opposition.

5. The applicant filed a defence and counterstatement denying a likelihood of confusion on the basis that neither the marks nor the goods/services are identical or similar.

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<sup>1</sup> These are listed in Annex A to this decision.

<sup>2</sup> This is addressed as a preliminary issue in this decision.

<sup>3</sup> 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.

<sup>4</sup> These are listed in Annex B to this decision.

6. At the commencement of these proceedings, the opponent was unrepresented. On 18 April 2024, the opponent filed a Form TM33P appointing JaiOm Ltd T/A Magnaius Solicitors as its representatives. The opponent has been represented by Joshi-IP.Law for the duration of these proceedings.

7. The opponent filed a fast track opposition. Rule 6 of the Trade Marks (Fast Track Opposition (Amendment) Rules 2013, S.I. 2013 2235 disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but it provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. Further, Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

9. In this case, the opponent sought to file evidence; following a case management conference (“CMC”) held on 6 June 2024, the request was refused. The applicant did not seek to file evidence. A hearing was neither requested nor was it considered necessary. Both parties did, however, elect to file written submissions, which I will address at the relevant points in this decision. This decision is made following a perusal of all the papers before me.

## **PRELIMINARY ISSUE**

10. I note that the earlier mark relied upon in these proceedings is owned by Danny Eastman of Cyber Fortified Limited. Mr Eastman filed the Form TM7F and, at section 7, included his own name and signature. However, in section 3 (“Full name of opponent”) he wrote “Cyber Fortified Limited”. In my view, Mr Eastman intended to bring the opposition in his own name, relying on the trade mark also in his own name.

However, owing to a misunderstanding, the name of the company for which he is director and sole shareholder was included on the form. Whilst Mr Eastman explained in correspondence dated 6 December 2023 that his belief is that the earlier mark “organically passed” to the company, no assignment has taken place in accordance with section 24(3) of the Act and the earlier mark stands registered in the name of Danny Eastman. I will proceed on the basis that Danny Eastman is the owner of the earlier mark and the opponent in these proceedings.

## **DECISION**

11. Section 5(2)(b) is as follows:

“5. [...]

(2) A trade mark shall not be registered if because –

(a) [...]

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

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

## **Relevant law**

12. 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**

13. Some of the contested services are identical to the services on which the opposition is based (*computer security consultancy*, for example). For reasons of procedural economy, I will not undertake a full comparison of the goods and services. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier mark. If the opposition fails even where the goods/services are identical, it follows that the opposition will also fail where the goods/services are only similar.

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

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

15. The relevant services are *computer security consultancy*, the average consumer of which is an individual or business seeking consultancy services in the field of computer security, either for themselves or for their company. Businesses which conduct their business wholly or mainly online are likely to access these services on a regular basis, whereas individuals may require the services on only an occasional basis. Neither group of average consumers will pay a low degree of attention to the selection of the services. To my mind, individuals seeking the services for personal use will pay a medium to high degree of attention to the selection on the basis that they may be unfamiliar with the services and must consider their suitability. Businesses are likely to pay a medium to high degree of attention on the basis that their choice may have implications on their entire business. Even if this finding does not extend to all of the goods and services applied for, no less than a medium (or average) degree of attention will be paid.

16. The services are likely to be purchased by self-selection from websites or printed advertisements, though they may also be purchased following word-of-mouth recommendations or discussions with professionals. Accordingly, the purchasing process is predominantly visual, with an aural component also being relevant.

### **Comparison of trade marks**





17. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing

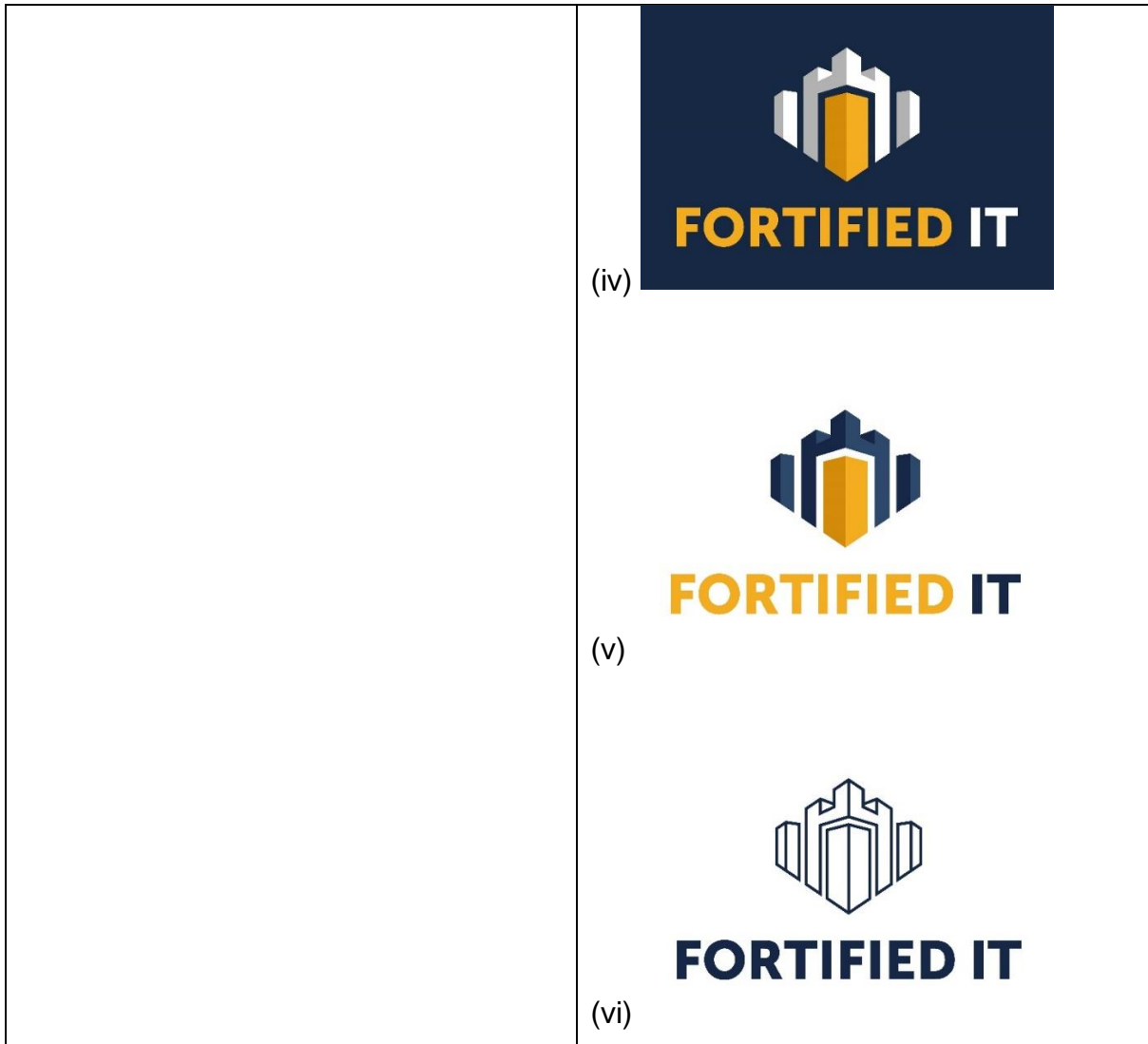
in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

18. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

19. The trade marks to be compared are as follows:

The opponent’s mark	The applicant’s marks
	<p>(i) </p> <p>(ii) </p> <p>(iii) </p>



20. All six of the marks in the applicant’s series comprise the words “FORTIFIED IT” and a device made up of several geometric shapes. The main difference between marks (i)-(iii) and marks (iv)-(vi) is the position of the device relative to the text: to the left of the text in (i)-(iii) and centrally above the text in (iv)-(vi). A further difference is in the colours used across the series, though all six marks use white, orange and/or dark blue. There are no material differences between the marks in the series that would alter their comparison to the opponent’s mark. As such, I will refer to the six marks collectively as “the series” and compare them to the opponent’s mark.

21. The opponent’s mark comprises the words CYBER FORTIFIED in a colour fade ranging from white to mid-blue. The majority of the letters within the mark are stylised in that they contain gaps to the effect that the letters are not fully formed, though in my

view, and in contrast to the applicant's submissions,<sup>5</sup> they can be easily read. The overall impression of the opponent's mark resides in the words CYBER FORTIFIED which are equally dominant and distinctive. As I will come to discuss, CYBER and FORTIFIED are strongly allusive, in equal measure. The stylisation to the mark plays a much lesser role in the overall impression.

22. As described above, the applicant's series comprise a textual component (FORTIFIED IT) and a device. Both components add to the overall impression of the mark, however, the device is more distinctive than the text (given the allusive nature of FORTIFIED IT), whereas the text is slightly more dominant than the device. The dark blue background in (i) and (iv) is purely decorative.

23. Visually, the marks coincide only in the word FORTIFIED, in a standard font in the applicant's series and stylised in the opponent's mark. All other components in the respective marks differ. Overall, I consider the marks to be visually similar to a low degree.

24. The opponent's mark will be pronounced as the ordinary words CYBER and FORTIFIED and articulated as five syllables. The applicant's series will be pronounced either as the four syllables FORTIFIED IT, with 'IT' pronounced as the pronoun 'it', or – more likely given the services at issue – as the five syllables FORTIFIED I-T, with 'IT' pronounced as the two individual letters of the alphabet. The device will not be articulated. The common element is at the end of the opponent's mark but the beginning of the series. Overall, I consider the marks to be aurally similar to a low degree.

25. Turning to the conceptual comparison, I bear in mind that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM*.<sup>6</sup> The assessment must be made from the point of view of the average consumer.

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<sup>5</sup> Paragraph 11 of the applicant's written submissions.

<sup>6</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

26. In the opponent's mark, CYBER relates to the use of computers and FORTIFIED means defensible or strengthened. The words combine to conjure, in the mind of consumers, the idea of a strengthened computer system, although the placement of the words – with the adjective FORTIFIED being subsidiary to the word it is describing – is atypical.

27. FORTIFIED has the same meaning in the applicant's series. It is most likely that consumers will see IT in the series as an abbreviation for 'information technology' which refers to the practice of using computers to store, process and disseminate data/information. The words combined will portray the same message as the opponent's mark: a strengthened computer system, although the placement of the words makes this concept even more immediately obvious in the applicant's series. In this scenario, the marks are conceptually highly similar, given the nuances emanating from the words CYBER and IT.

28. In the event that the consumer sees IT as the pronoun 'it', the concept of the applicant's series is that of fortifying (or strengthening) something, with no link to computer systems. In this case, the marks are conceptually similar to a medium degree.

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

29. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

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

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

30. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

31. The opponent has filed no evidence of use of its earlier mark and so I have only the inherent position to consider. The mark is comprised of two ordinary words – CYBER and FORTIFIED – with stylisation. As discussed above, the combination of the two words, in the context of the services relied upon, are strongly allusive. The stylisation marginally contributes to the mark’s distinctiveness as a whole, which I consider to be low.

### **Likelihood of confusion**

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater

degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

33. I have found the marks to be visually and aurally similar to a low degree and conceptually highly similar (or similar to a medium degree depending on the consumer's perception of IT in the applicant's series). I have found the earlier mark to have a low degree of inherent distinctive character. I have identified two groups of average consumers: individuals or businesses, both of which will pay a medium to high degree of attention to the selection of the relevant services. I have concluded that the purchasing process is predominantly visual, but with an aural component. I have proceeded on the basis of identical services.

34. I will discuss direct confusion first. The common element between the marks is the word FORTIFIED, which is at the beginning of the opponent's mark and the end of the applicant's. This is important since the beginnings of marks tend to have more visual and aural impact than the ends,<sup>7</sup> and the marks begin with entirely different words. Neither the opponent's mark nor the applicant's series contain additional components so negligible that they are likely to go unnoticed. Even bearing in mind the interdependency principle and that the relevant services are identical, given that direct confusion involves no process of reasoning, I find it highly unlikely that the average consumer would mistake one mark for the other. I do not consider there to be a likelihood of direct confusion.

35. I turn now to indirect confusion. Indirect confusion was described in the following terms by Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*<sup>8</sup>

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<sup>7</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

<sup>8</sup> BL O/375/10.

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

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

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

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

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

36. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>9</sup>

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

38. As discussed above, the common element (FORTIFIED) is an ordinary dictionary word which, in the context of the relevant services, is not particularly distinctive. It is certainly not so strikingly distinctive that consumers would assume that only the brand owner would use it in a trade mark.

39. The additional words (CYBER versus IT) both relate somewhat to computers. However, they are not interchangeable and appear in different positions in the marks, making the idea of a brand extension less logical. In the same regard, the different position of the word FORTIFIED makes a difference to the overall impression of the marks and makes the idea of a brand extension far less likely.

40. Whilst the marks are conceptually highly similar, such a concept is strongly allusive of, if not descriptive for, the services. As such, it is far more likely that the presence of the word FORTIFIED in both marks, as well as the shared concept, will be unsurprising for consumers, who will put it down to mere coincidence, rather than assuming a connection between the two undertakings. The fact that the applicant’s series may call the opponent’s mark to mind, or vice versa, is not enough in itself for a finding of a likelihood of indirect confusion.<sup>10</sup> This would be mere association rather than an actual belief that the marks are related.

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<sup>9</sup> See *Deubros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82].

<sup>10</sup> *Deubros Limited* (cited at <sup>9</sup>).

41. In my view, the average consumer, who is deemed to be reasonably circumspect, paying even a medium degree of attention is unlikely to arrive at the conclusion that there is a commercial connection between the opponent's mark and the applicant's series. There is no likelihood of indirect confusion. As per my paragraph 13, this finding extends to all goods and services in the application.

## **CONCLUSION**

42. The opposition under section 5(2)(b) fails and the application may proceed to registration.

## **COSTS**

43. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in fast track proceedings are governed by Tribunal Practice Notice ("TPN") 1/2023,<sup>11</sup> which caps awards at £600, excluding official fees.

44. In its written submissions dated 13 June 2024, the applicant requested an award of costs "above the scale" on the basis that the opponent (i) opted for a fast track opposition but their own actions significantly delayed proceedings, (ii) failed to clarify their case sufficiently and only appointed legal representation one year into the proceedings, and (iii) made a late request to adduce evidence which was "hopeless" and resulted in unnecessary time and cost for the applicant.

45. TPN 1/2023 also provides for off scale costs, the relevant section of which is copied below:

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<sup>11</sup> TPN 1/2023 applies to proceedings commenced on or after 1 February 2023.

## Off-scale costs

5. Notwithstanding the published scale, the Tribunal retains the discretion to award costs “off the scale” to deal proportionately with unreasonable behaviour. It is not possible to set out all the circumstances in which a Hearing Officer might depart from the scale. It is worth clarifying though that just because a party has lost, this in itself is not indicative of unreasonable behaviour. Some examples of what might constitute unreasonable behaviour include a party seeking an (avoidable) amendment to its statement of case which, if granted, would cause the other party to have to amend its statement or would lead to the filing of further evidence. Other examples include behaviour designed to delay, frustrate or unreasonably increase the costs/burden on the other party and/or repeated breaches of procedural rules. Off-scale costs may also be awarded if a losing party unreasonably rejected efforts to settle a dispute before an action was launched or a hearing held, or unreasonably declined the opportunity of an appropriate form of Alternative Dispute Resolution.

6. The level of off-scale costs will, generally speaking, be commensurate with the extra expenditure a party has incurred as a result of the unreasonable behaviour. Any claim for costs approaching full compensation or for “extra costs” will need to be supported by a bill itemizing the actual costs incurred. There may be some circumstances where costs below the minimum indicated by the published scale are awarded. For example, a party who does not follow a suggestion from the Hearing Officer as to the most efficient means of managing the case, may only be entitled to whatever award they would have received if they had followed the Hearing Officer’s suggestion.

46. These proceedings were delayed for several reasons, including:

- Amendments being required to the Form TM7F;
- The opponent appointing representatives and requesting an extension of time in which to consider whether to seek leave to file evidence or to request a hearing; and
- A CMC being appointed to discuss the Registry’s preliminary view to refuse the opponent’s request to file evidence, which was subsequently rescheduled as a result of the opponent’s representatives being unavailable.

47. Whilst the applicant can reasonably expect a fairly swift conclusion to proceedings where the opponent has chosen the fast track procedure, there is no timeframe within which fast track proceedings should be completed. Firstly, amendments to forms are a common request of parties in Registry proceedings, regardless of whether they are

fast track proceedings or whether the parties are unrepresented. Secondly, an extension of time was requested by the opponent and granted by the Registry in line with its wide case management powers afforded to it by the Trade Marks Rules 2008. Thirdly, the opponent was within its rights to request a CMC to challenge a preliminary view that was not made in its favour and further, it was entitled to reject one CMC date and request an alternative. Despite the preliminary view being upheld at the CMC and the evidence being refused, the opponent was entitled to make such a request. In the circumstances, I do not consider such a request to be unreasonable; rather, the evidence was considered to be immaterial to the case before me.

48. Taking account of all the circumstances in these proceedings, I do not consider that the opponent acted unreasonably or that any procedural rules were breached. Neither do I consider the delays in these proceedings to have been designed by the opponent to purposely increase the costs or burden on the applicant. An award of costs off the usual scale is not appropriate.

49. Given that off scale costs are not appropriate, I am guided by the scale adaptations for fast track proceedings and the £600 cap. I do, however, agree that the applicant should be awarded a contribution towards its costs for all tasks (which are recoverable in line with TPN 1/2023) undertaken as part of these proceedings. I therefore award the maximum £600 to the applicant, calculated as follows:

Considering the notice of opposition and filing a counterstatement:	£250
Preparing for and attending a CMC:	£200
Filing written submissions:	£150
<b>Total:</b>	<b>£600</b>

50. I therefore order Danny Eastman to pay Fortified IT Ltd the sum of £600. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 26th day of June 2024**

**MRS E FISHER  
For the Registrar**

## **Annex A – Applicant’s specification**

Class 9: Computer software and hardware in the field of information technology systems and management; business technology software; application software for cloud computing services; security software; artificial intelligence software; artificial intelligence software for analysis; artificial intelligence and machine learning software; computer network hubs; digital solutions provider software; software that provides access to remote workspaces; Internet of Things [IoT] gateways, sensors, detectors enabled devices and/or computer hardware for use in relation thereto; data and file management and database software; computer networking hardware; computer network operating systems; computer software for use in enhancing, optimizing, securing, analyzing, accelerating, monitoring, and managing data, computer network traffic and applications communicating across networks; computer software for enhancing and optimizing the performance, security, speed, availability and accessibility of software applications and network hardware devices on computer networks; Downloadable computer software for computer and network security; computer software for scanning, detecting, and removing viruses, worms, Trojan horses, adware, spyware, and other malware; Computer software for controlling and managing access server applications; Personal computer application software for managing document control systems; Software; Computer software [programmes]; Cloud computing software; Network management computer software; Cloud network monitoring software; Downloadable cloud computing software; Computer software for database management; Computer programs and software for use in providing threat prevention, analysis, detection, and response, including on a real-time basis, for computer systems, servers, computer networks, endpoints, and portable electronic devices; computer programs and software for use in providing visibility, management, and monitoring, including on a real-time basis, of computer systems, servers, computer networks, endpoints, and portable electronic devices; computer programs for preventing viruses and unauthorized access to computer systems, computer networks, endpoints, and portable electronic devices; parts and fittings for all the aforesaid goods.

Class 35: Business consultancy relating to the administration of information technology, cybersecurity and cloud storage; outsourcing services in the field of

business analytics; data processing, systematisation and management; business data analysis; information and data compiling and analysing relating to business management; statistical analysis and reports for business purposes; preparation of reports for business purposes; arranging subscriptions to software and/or IT services; consultancy, advisory and information in relation to all of the aforesaid services.

Class 37: Installation, maintenance and repair services relating to computer network hardware and information technology hardware; maintenance and repair of security systems; information services relating to installation and maintenance of computer networks hardware, computer systems hardware, computer hardware relating to cyber security services; installation, maintenance and repair of computer network and information technology equipment; consultancy, advisory and information in relation to all of the aforesaid services.

Class 41: Training services relating to information technology; conducting workshops in the field of business; training and education in relation to the operation and use of digital platforms, security solutions, IT infrastructure projects, data interpretation, artificial intelligence software and hardware, and cloud based IT solutions; education courses relating to automation; consultancy, advisory and information in relation to all of the aforesaid services.

Class 42: IT services; IT project management; IT security, protection and restoration; IT service management; private cloud hosting provider services; public cloud hosting provider services; consultancy in the field of office and workplace automation; cloud storage services for electronic files; cloud storage services for electronic data; data security consultancy; provision of security risk management programs; data security services [firewalls]; provision of security services for computer networks, computer access and computerised transactions; providing artificial intelligence computer programs on data networks; Software as a Service [SaaS]; Software as a Service [SaaS] featuring computer software platforms for artificial intelligence; Platform as a Service [PaaS]; development of computer software application solutions; programming of software for database; providing online non-downloadable software for database management; design and development of information technology infrastructure and architecture; computer services for the analysis of technical data;

provision of non-downloadable software that provides access to remote workspaces; consultancy, advisory and information in relation to all of the aforesaid services; Computer network and information technology consulting services; technical support services, providing assistance to others in the field of computer software and information technology; providing temporary use of software for use in enhancing, optimizing, securing, analysing, accelerating, monitoring, and managing data, computer network traffic and applications communicating across networks; providing temporary use of software for enhancing and optimizing the performance, security, speed, availability and accessibility of software applications and network hardware devices on computer networks. Providing computer security consultancy, security reviews and security risk assessments and threat detection of computer information systems, working environments and infrastructure, namely, desktops, servers, laptops, routers, network devices, computer databases and applications; Providing computer security services for enterprises, namely, the detection, investigation, response, and prevention of the compromise, loss, or exposure of data, network information and confidential information; Computer consultation; consulting in the field of information technology; computer consultation in the field of computer and network security; computer security consultancy in the field of scanning and penetration testing of computers and networks to assess information security vulnerability; software as a service (SAAS) services featuring software in the field of computer and network security; software as a service (SAAS) services, namely, hosting software for use by others for detecting, blocking, and removing computer viruses and threats; application service provider (ASP) featuring non-downloadable computer software for use in computer and network security; maintenance and updating of computer software relating to computer and network security and prevention of computer risks; Computer services in relation to developing and implementing plans for improving computer and network security and preventing criminal activity for businesses and governmental agencies; cloud computing featuring software for use in computer and network security; cloud computing services in the field of computer and network security; computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for creating databases of information and data related to malware and computer and network security; computer services, namely, online scanning, detecting, quarantining, and eliminating viruses, worms, Trojans, spyware, adware, malware and unauthorized data and

programs on computers, networks, and electronic devices; computer systems analysis; monitoring of computer systems for security purposes; provision of systems for the management of computer and network threats, namely, surveillance and monitoring of vulnerability and security problems in computer hardware, networks, and software; computer network and Internet security services; computer consultation; computer consultation in the field of computer security; computer diagnostic services; technical support services, namely, troubleshooting of computer hardware and software problems; technical support services, namely, providing back-up computer programs and facilities; computer virus protection services; computer software installation services; computer programming; computer software design for others; technical consultation in the field of computer software installation and maintenance; consulting services in the field of design, selection, implementation and use of computer hardware and software systems; development, updating and maintenance of software for networks and standalone computers in the fields of security, database management, and anti-virus protection and monitoring security systems; providing information in the field of network and Internet security; providing technical information in the field of computer software applications; application service provider services; remote or on-site monitoring of computer systems; monitoring the computer systems of others and providing back-up computer programs and facilities; security verification of computer network firewalls, servers and other network devices from unauthorized access; forensic advice relating to attacks on computer systems and networks; provision of information, and advisory and consultancy services, all relating to the aforesaid including such services provided on-line or via the Internet; Hosting computer software applications for others; Provision of security services for computer networks, computer access and computerised transactions; Computer security system monitoring services; Data security services; Computer security consultancy; Software as a service [SAAS] services; Application service provider services; Computer security services, namely, restricting and controlling access privileges of users of computer systems, servers, computer networks, endpoints, mobile phones and portable and handheld electronic devices, and of computing resources for cloud, mobile or network resources based on assigned credentials; computer security consultancy; cloud computing featuring software for use in providing security for computer systems, servers, computer networks, endpoints, mobile phones and portable and handheld electronic devices; maintenance of computer software relating to computer security

and prevention of computer risks; software as a service (SAAS) featuring software for use in providing threat prevention, analysis, detection, and response, including on a real-time basis, for computer systems, servers, computer networks, endpoints, mobile phones and portable and handheld electronic devices; software as a service (SAAS) featuring software for use in providing visibility, management, and monitoring, including on a real-time basis, of computer systems, servers, computer networks, endpoints, mobile phones and portable and handheld electronic devices; platform as a service (PAAS) featuring computer software platforms for creating, managing, and deploying cloud computing infrastructure services; platform as a service (PAAS) featuring computer software platforms for use in providing security for computer systems, servers, computer networks, endpoints, mobile phones and portable and handheld electronic devices; providing online non-downloadable software for use, including on a real-time basis, in operational and security monitoring and alerting, cyber defence and cyber-security of computer systems, internet, networks, applications, and electronic data and communications, endpoints, mobile phones and portable and handheld electronic devices; providing online non-downloadable intrusion detection software; information services relating to installation and maintenance of cloud data systems; Installation, maintenance and repair services relating to computer network software and information technology software; information services relating to installation and maintenance of computer networks software, computer systems software, computer software relating to cyber security services; computer security services, namely, tracking software, data files, and executable files in computer networks, endpoints, mobile phones and portable and handheld electronic devices, including on a real-time basis, identifying unauthorized, new or unknown software, data files, and executable files, including on a real-time basis, and blocking unauthorized software executions and data access, including on a real-time basis, advisory and information in relation to all of the aforesaid services.

Class 45: Licensing of technology, source code, computer software and other intellectual property; licensing of computer software for the protection of computers, computer systems, computer networks and internet websites against attacks from computer viruses, hackers, tampering, unauthorized intrusion and unauthorized manipulation of data; provision of information, and advisory and consultancy services,

all relating to the aforesaid including such services provided on-line or via the Internet, advisory and information in relation to all of the aforesaid services.

## **Annex B – Opponent’s specification**

Class 42: Computer advisory services; Computer analysis; Computer and information technology consultancy services; Computer and software consultancy services; Computer consultancy; Computer consultancy and advisory services; Computer consultancy services; Computer consultation; Computer consultation services; Computer consulting services; Computer disaster recovery planning; Computer hardware and software consultancy; Computer hardware and software consultancy services; Computer hardware (Consultancy in the field of -); Computer security consultancy; Computer security services for protection against illegal network access; Computer security threat analysis for protecting data; Computer services; Computer services for the analysis of data; Computer software advisory services; Computer software consultancy; Computer software consultancy services; Computer software consultation; Computer software consulting; Computer software consulting services; Computing consultancy; Consultancy and advice on computer software and hardware; Consultancy and information services in the field of computer system integration; Consultancy and information services in the field of information technology; Consultancy and information services in the field of information technology architecture and infrastructure; Consultancy and information services relating to computer system integration; Consultancy and information services relating to information technology; Consultancy and information services relating to information technology architecture and infrastructure; Consultancy and information services relating to software maintenance; Consultancy (Computer software -); Consultancy in the field of computer hardware; Consultancy in the field of computer hardware and computer software; Consultancy in the field of computer security; Consultancy in the field of computer software; Consultancy in the field of computer system analysis; Consultancy in the field of computer system integration; Consultancy in the field of computers; Consultancy in the field of security software; Consultancy in the field of technological design; Consultancy in the field of technological research; Consultancy relating to computer software; Consultancy relating to computer systems; Consultancy relating to computers; Consultancy relating to the recovery of computer data;

Consultancy relating to the updating of software; Consultancy services for analysing information systems; Consultancy services relating to computer networks; Consultancy services relating to computer networks using mixed software environments; Consultancy services relating to computer systems; Consultancy services relating to computers; Consultancy services relating to computing; Consultancy services relating to information technology; Consultancy services relating to software used in the field of e-commerce; Consultation services relating to computer hardware; Consultation services relating to computer systems; Consultation services relating to computers; Consultations in the field of computer hardware; Consulting in the field of cloud computing networks and applications; Consulting services in the field of cloud computing; Consulting services in the field of software as a service [SaaS]; Consulting services relating to computer software; Control technology consulting services; Data decryption services; Data encryption and decoding services; Data encryption services; Data migration services; Data recovery services; Data security services; Data security services [firewalls]; Design and development of Internet security programs; Design and development of networks; Design and development of new technology for others; Design and development of wireless computer networks; Design and development of wireless data transmission apparatus; Design of computer systems; Computer programming services for electronic data security; Design and development of electronic data security systems; Information services relating to computers; Information services relating to information technology; Information technology consultancy; Information technology consulting; Information technology [IT] consultancy; Information technology [IT] consulting services; Services for maintenance of computer software; Services for the design of computer systems; Services for the design of electronic data processing software; Software consultancy services; Software consulting services; Data security consultancy.