

O-0612-24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION UK00003805669 BY MOMENTA (SUZHOU)
TECHNOLOGY CO., LTD. TO REGISTER:**

momenta

AS A TRADE MARK IN CLASSES 9, 12 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 438382

BY BLACKBERRY LIMITED

BACKGROUND AND PLEADINGS

1. On 4 July 2022, MOMENTA (SUZHOU) TECHNOLOGY CO., LTD. (“the applicant”) applied to register the trade mark shown on the cover page to this decision in the United Kingdom in respect of the following goods and services:

Class 9: Downloadable maps; Face recognition equipment; Internal communication apparatus; Electronic monitoring apparatus; Vehicle video recorders; Computer operating programs, recorded; Computer software, recorded; Computer programs, downloadable; Computer software applications, downloadable; Interactive touch screen terminals; Downloadable software applications for mobile phones; Computer applications for car audio video navigation; Central processing units for processing information, data, sound or images; Monitors [computer hardware]; Scanners [data processing equipment]; Black boxes [data recorders]; Biometric scanners; Navigational instruments; Image amplifiers; Video cameras adapted for monitoring purposes; Audio recorders; Image recording apparatus; Blind spot cameras for cars ; Rearview cameras for vehicles; Automobile data recorder; Range finders [for cameras]; Speed measuring apparatus [photography]; Measuring apparatus; Speedometers for vehicles; Steering apparatus, automatic, for vehicles; Chips [integrated circuits]; Electronic chips; Parking sensors for vehicles; Remote control apparatus; Laser measuring systems; Laser level measuring apparatus; Simulators for the steering and control of vehicles; Infrared detectors; Distance measuring apparatus; Inductors [electricity]; Electronic controllers; Sensors; Alarms.

Class 12: Automobiles; Electric vehicles; Hybrid vehicles; Self-driving cars; Robotic cars; Self-driving robots for delivery; Reversing alarms for vehicles; Propulsion mechanisms for land vehicles; Motor buses; Trucks.

Class 42: Vehicle performance testing; Cloud computing; Establishment of control programs for electric operation control and drive modules components; Technological research; Design of integrated circuits; Research and

development of new products for others; Artificial intelligence consultancy; Automotive design; Conversion of computer programs and data, other than physical conversion; Computer software design; Platform as a service [PaaS]; Software as a service [SaaS]; Maintenance of computer software; Monitoring of computer systems by remote access; Electronic data storage services; Providing virtual computer systems through cloud computing; Information technology services provided on an outsourcing basis; Maintenance and updating of computer software; Design and development of computer database programs; Computer system integration services; Rental of a database server (to third parties); Installation, maintenance and repair of computer software; Design and development of computer software for others; Monitoring of computer systems for detecting unauthorized access or data breach; Cartography services.

2. On 30 September 2022, a notice of opposition was filed by BlackBerry Limited (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition concerns the application in its entirety and, for the purpose of the opposition, the opponent relies upon the following trade mark and some of the goods and services for which it is registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 2306680

MOMENTICS

Class 9: Computer software; computer software development tools; computer software development software; downloadable electronic books, guides and manuals for use in relation to computer software.

Class 42: Computer software development services; consultancy services relating to computer software; computer programming services.

Filing date: 30 July 2002

Registration date: 17 January 2003

3. The opponent contends that the parties' respective trade marks are highly similar and that the competing goods and services are either identical or similar, giving rise to a likelihood of confusion on the part of the relevant public.

4. Whilst it makes some concession as to the similarity of some of the goods and services, the applicant nonetheless maintains that the parties' trade marks are not similar and would therefore not be confused by the average consumer. In its counterstatement, it also puts the opponent to proof of use in respect of all goods and services relied upon.

5. The applicant is represented by IPEY whilst the opponent is represented by Kilburn & Strode LLP. Both parties filed evidence during the course of the proceedings. Neither party requested a hearing, though the opponent elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

Relevance of EU law

6. 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

7. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

8. Section 5A of the Act reads as follows:

“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.”

9. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years before the application date of the mark in issue, it is consequently subject to proof of use pursuant to section 6A of the Act.

Proof of use

10. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
 - (aa) or (ba) in relation to which the conditions set out in section 5(1), (2)

or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

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

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

11. Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the filing date of the application at issue i.e. 5 July 2017 to 4 July 2022.

13. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal*

Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with

the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

14. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

The opponent's evidence in chief

15. The opponent filed evidence in chief in the form of the witness statement of Ms Cindy L. Petrie dated 16 June 2023. Ms Petrie has held the role of Trade Mark Manager for the opponent since 2008. Her statement is supported by five exhibits (CLP1 – CLP5).

16. I take the following from Ms Petrie's statement:

-The opponent is a leading designer, manufacturer and licensor of a variety of innovative technology solutions and software including connectivity solutions, telecommunications services, operating systems and cloud computing software.

-The opponent's MOMENTICS tool suite included with the opponent's QNX software development platform enables development teams to create, debug, optimize and deploy embedded software projects. Ms Petrie describes the QNX Momentics Tool Suite as a "comprehensive, integrated development environment with innovative profiling tools for maximum insight into system behavior."

-The below table sets out the revenue generated by sales of MOMENTICS products to UK consumers from financial year 2018 to 2022:

Year	Sales (US\$M)
FY18	0.3
FY19	0.2
FY20	0.7
FY21	0.2
FY22	0.3
	1.0
TOTAL	2.7

-Ms Petrie encloses examples of the earlier mark used on documents such as invoices, manuals, data sheets, packaging and articles during the relevant period.

- An article published in May of 2018 headed "connected cars" announces that the opponent is partnering with Jaguar Land Rover (JLR) to design a new software architecture for JLR's next generation vehicles. The article explains that the

opponent's QNX Software Development Platform (which includes its QNX Momentics Tool Suite) "will be used for running car infotainment consoles to support JLR's connected and autonomous react and drive based on rich data".¹

- I enclose a small sample of extracts from the opponent's evidence in chief below:

QNX Momentics Tool Suite

The QNX Momentics Tool Suite offers a comprehensive, Eclipse-based integrated development environment (IDE) and powerful command-line tools that are ideal for developers familiar with Linux and POSIX-compliant environments.

Whether you work on Linux, macOS or Windows, the QNX Momentics tools enable your development teams to quickly create, debug, optimize and deploy embedded software projects, including projects built with the QNX Neutrino RTOS, the QNX OS for Safety, the QNX Hypervisor and the QNX Hypervisor for Safety.

LEARN MORE



BlackBerry QNX Launches its Most Advanced and Secure Embedded Software Platform for Autonomous Drive and Connected Cars

January 04, 2017 03:01 ET | Source: [BlackBerry Limited](#)

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The applicant's evidence

¹ <https://web.archive.org/web/20180719080014/https://www.softwaretestingnews.co.uk/the-tech-behind-jaguar-land-rovers-connected-cars/>

17. The applicant filed a witness statement dated 11 August 2023 from Mr Jiaqi Lin, the opponent's senior legal specialist. Mr Lin has held the position for four years and his statement introduces three exhibits (MT-1 to MT-3). Amongst Mr Lin's exhibits are a Wikipedia entry pertaining to the applicant's company, a screenshot from its website showing the MOMENTA mark and a list of all trade marks owned by the applicant and its associated companies.

18. Alongside the aforementioned witness statement and exhibit, the applicant filed written submissions. I do not intend to reproduce those submissions here but will keep them in mind and refer to them where relevant throughout the decision.

The opponent's evidence in reply

19. This comes in the form of a witness statement from Ms Nora Fowler, trade mark attorney for Kilburn & Strode LLP since September 2021. Ms Fowler's statement is dated 20 October 2023 and is supported by twelve exhibits (NFX1 – NFX12).

20. The exhibits provide additional information relating to the tools and services available under the earlier mark. A product brief explains that the *Momentics* Tool Suite offers "everything developers need to quickly build and optimize applications... From board bring-up to remote diagnostics [it] provides time-saving tools for the entire development cycle". The suite offers integrated IDE, development environment, software updates, development hosts, training and support packages and assistive documentation and manuals. Ms Fowler also addresses the applicant's submission concerning its development of autonomous vehicles, providing a printout from the opponent's website showing its goods and services in the context of *advance driver assistance systems* (which she submits is related to the development of autonomous vehicles).

21. That concludes my summary of the parties' evidence, insofar as I consider it necessary.

22. I consider it worthwhile, however, to note the applicant's observation in which it claims that the oponent's MOMENTICS mark is "...always used alongside the trade mark QNX and so confusion is even less likely to occur." The opponent addresses this observation in its submissions in lieu of a hearing, citing case law from *Colloseum Holdings AG v Levi Strauss & Co.*² and *Hyphen v EUIPO*³. It states:

"11. The use shown in evidence is genuine use of the mark as registered, whether on its own, or in combination with additional elements (such as QNX). The use of the mark by the Opponent in combination with other elements clearly falls within the purpose of allowing use of a variant of a mark. It is very common for marks designating specific goods and services to be presented alongside a house mark or an umbrella mark or another associated mark. The MOMENTICS mark will be clearly recognised by consumers as a standalone mark designating the goods and services for which it is registered. The way the marks are presented in the use shown in evidence also clearly highlights this (e.g. the space between QNX and MOMENTICS and the use of the registered trade mark sign after QNX and separately after MOMENTICS)."

23. I agree with the opponent's approach. *Colloseum* sets out that a registered trade mark may be used alongside other matter providing that it continues to be perceived as indicative of the product's origin, which I find to be the case here.

24. The opponent seeks to rely on the following goods and services:

² Case C-12/12

³ Case T-146/15

Computer software; computer software development tools; computer software development software; downloadable electronic books, guides and manuals for use in relation to computer software (class 9).

Computer software development services; consultancy services relating to computer software; computer programming services (class 42)

25. I must consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. As for devising a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*⁴, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

26. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“*Thomas Pink*”) at [52].

⁴ BL O/345/10

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM (Case T-256/04)* ECR II-449; EU:T:2007:46."

27. The opponent has produced a variety of documentation showing the use made of the earlier mark within the relevant period including via websites, data sheets and invoices and it has presented annual sales figures pertaining to the revenue generated by the earlier mark in the UK which, though absent of an indication of market share, I consider to be substantial. The evidence may have benefitted from some insight into the investment made in the promotion of the earlier mark, for example, but nonetheless I am satisfied that it shows an effort on the opponent's part to create and preserve a

share in the market. As for which goods and services the evidence shows use of, I keep in mind that the opponent is not required to show use of each individual term it relies upon and rather I must consider how the average consumer would interpret or articulate the use it has made. Equally, I do not wish to grant the opponent too broad a level of protection. In its submissions, the applicant accepts that the opponent has demonstrated use in relation to *computer software; computer software development tools* and *computer software development software* so I focus my consideration on the remaining class 9 goods and the class 42 services. The evidence shows that the opponent offered datasheets and user guides in relation to its MOMENTICS suite⁵. It also offers user support and training packages providing “an overview of developing, debugging and analyzing performance using the QNX IDE tool set.” The QNX Momentics IDE (Integrated Development Environment) is a comprehensive integrated development environment with the Momentics tool suite also offering command-line tools. It seems clear that the opponent offers assistive goods and services alongside the software itself, rather than just the goods in isolation. Its collaboration with JLR, for example, demonstrates the opponent’s participation in the development and tailoring of its software platforms within a specific context. The article cited above states that “Blackberry has announced that it will be providing a team of engineers and will supply its infotainment and QNX Software Development Platform to JLR... to help the automaker handle high-powered connected and autonomous technologies”. Taking the evidence as a whole, I find it appropriate for the opponent to retain all goods and services it seeks to rely upon.

Preliminary matter

28. In its witness statement, the applicant states that:

“5. ...At no time has my company or any of the companies with which we deal encountered any evidence of confusion in the marketplace with the opponent’s MOMENTIC trade mark.”

⁵ See, for example, exhibit NFX7, showing a downloadable document headed QNX Momentics – IDE User’s Guide

29. On the issue of reliance on the absence of confusion in the marketplace, Tribunal Practice Notice ("TPN") 4/2009 states:

'6. Parties are also reminded that claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

7. In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

30. In *Rousselon Freres et Cie v Horwood Homewares Limited*⁶, Warren J commented:

"99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says...)"

31. In *The European Limited v The Economist Newspaper Ltd*⁷ Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

In light of the above case law, it is clear that the applicant's submission does not assist it. I must consider the likelihood of confusion notionally i.e. I must consider what the future position would be, should the parties be in direct competition with one another.

Section 5(2)(b) - Case law

32. The following principles are gleaned from the decisions of the courts of the European Union 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v.*

⁶ [2008] EWHC 881 (Ch)

⁷ [1998] FSR 283

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 greater 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 will wrongly 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

33. The goods and services to be compared are set out at paragraphs 1 and 2 to this decision.

34. When approaching my comparison, I am guided by the provision set out in *Gérard Meric v OHIM*⁸, which reads as follows:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

⁸ Case T-133/05

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

35. On the basis of the above principle, I find the applied for *computer software, recorded and computer software applications, downloadable* identical to the opponent's *computer software*.

36. The applicant's *development of computer software for others* is encompassed by the opponent's *computer software development services*. I therefore find these services identical.

37. As for the applicant's remaining goods and services, the relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

38. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,⁹ the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

39. In *Kurt Hesse v OHIM*¹⁰, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,¹¹ the General Court stated that “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.”

40. In *Sky v Skykick* [2020]¹², Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer

⁹ Case C-39/97

¹⁰, Case C-50/15 P

¹¹ Case T-325/06

¹² EWHC 990 (Ch)

software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

41. For the purpose of a comparison it is permissible to group goods or services together, as appropriate.¹³

Computer operating programs, recorded; Computer programs, downloadable; Computer applications for car audio video navigation (class 9)

42. To my knowledge, the aforementioned goods are likely to be caught within the remit of the opponent's *computer* software (and are therefore identical according to *Meric*). If that approach is considered incorrect, in the alternative I find a high degree of similarity between the goods given the similarity, or opportunity for similarity in the respective uses, users and trade channels and the opportunity for competitiveness and complementarity.

¹³ *Separode Trade Mark* BL O-399-10 (AP)

Vehicle video recorders; Black boxes [data recorders]; Audio recorders; Image recording apparatus; Blind spot cameras for cars; Rearview cameras for vehicles; Automobile data recorder; Speedometers for vehicles; Steering apparatus, automatic, for vehicles; Parking sensors for vehicles; Simulators for the steering and control of vehicles (class 9)

43. In the case of the above applied-for goods, when considered against the terms relied upon by the opponent, I find the respective uses are distinct and any correlation in the respective users is likely to be on a fairly artificial level. The physical nature of the goods is not similar and the trade channels are unlikely to be shared. I cannot identify a competitive nor complementary relationship with any of the goods or services relied upon. Whilst I acknowledge that software, for example, may be used in some circumstances in conjunction with some of the above goods, or to manage the information captured by those goods, I do not find sufficient coincidence in the relevant factors to reach a finding of similarity. The above goods are dissimilar to the goods and services relied upon by the opponent.

Monitors [computer hardware]; Scanners [data processing equipment]; Biometric scanners (class 9)

44. The opponent relies upon *computer software* and the above are peripheral hardware goods. The uses may be distinct but it seems reasonable to expect a significant overlap in the respective users. The goods' nature is not similar but they may move via similar trade channels and, though not competitive, there could be an element of complementarity to the extent that the goods may be seen to originate from a single undertaking. I find the similarity to be between a low and medium degree.

Interactive touch screen terminals; Central processing units for processing information, data, sound or images; Downloadable maps; Face recognition equipment; Internal communication apparatus (class 9)

45. To my knowledge, the above goods are likely to rely, at least in part, on software of some description. The respective uses may be distinct, generally speaking, though, there could be an opportunity for a related use. There is likely to be some coincidence in the goods' respective users though the trade channels may not always be the same. The goods are not competitive nor, to my understanding, strictly complementary. Whilst I also bear in mind that one good being used as a component or element of another is not sufficient for a finding of similarity,¹⁴ in respect of the above, I find the goods similar to a low degree.

Navigational instruments; Distance measuring apparatus; Speed measuring apparatus [photography]; Measuring apparatus; Laser measuring systems; Laser level measuring apparatus; Electronic monitoring apparatus; Video cameras adapted for monitoring purposes (class 9)

46. The core use of the above goods is different from that of the opponent's goods, though there may be some broad overlap in the goods' respective users. The trade channels are likely to be distinct and I do not consider there to be a complementary or competitive element to the goods' relationship. Though I acknowledge the opportunity for software to be incorporated into the goods' performance, in some circumstances at least, this is not, to my knowledge, exclusively the case and nonetheless this is not sufficient in and of itself for a finding of similarity. I find the goods dissimilar.

Image amplifiers; Chips [integrated circuits]; Electronic chips; Infrared detectors; Inductors [electricity]; Sensors; Alarms. Remote control apparatus; Electronic controllers; Range finders [for cameras] (class 9)

¹⁴ *Les Éditions Albert René v OHIM*, Case T-336/03

47. When considered against the opponent's goods, I find a distinction in the respective uses and only a broad opportunity for overlap in the respective users. The goods are unlikely to reach the market via the same trade channels and the goods are not competitive nor complementary. Notwithstanding any opportunity for an element of software to be incorporated into the performance or functionality of the above, I do not consider the goods to be similar.

Downloadable software applications for mobile phones (class 9)

48. The opponent relies upon *computer software*. Other than one being used on computers and the other on mobile phones, there is clearly an opportunity for similarity in the goods' use and in the respective users. There is also likely some similarity in the goods' nature, notwithstanding the different contexts in which they are utilised. The trade channels are likely to be shared and, in some circumstances, there may be an element of competitiveness and complementarity. I find the goods highly similar.

Automobiles; Electric vehicles; Hybrid vehicles; Motor buses; Trucks (class 12)

49. Whilst I acknowledge that the opponent's *computer software* can be used in the context of vehicles and the automotive industry generally, I will approach the comparison according to the factors laid out above. I find the uses of the respective goods fairly distinct and, although the users may be shared, to an extent, the applicant's goods will likely target motorists specifically. The goods' physical nature is not similar and the trade channels are unlikely to be shared. The goods are not competitive and I do not find them strictly complementary in the sense that they are indispensable for one another. That being said, to my knowledge, many modern vehicles offer a technological console which will likely use or rely on a particular kind of software to support its various functions. This consideration is supported by the opponent's evidence which shows, for example, a partnership between the opponent

and Jaguar Land Rover with the opponent providing the necessary technology to facilitate the vehicle's 'infotainment system'. Still, I do not take the view that the average consumer would generally expect the respective goods to originate from a shared undertaking and I do not wish to award too wide a protection to the opponent's *computer software*. Applying due weight to the relevant factors, I do not find the goods similar.

Self-driving cars; Robotic cars; Self-driving robots for delivery (class 12)

50. I apply much of the reasoning in my previous paragraph to my consideration of the above goods, though I accept that self-driving or robotic cars may rely more heavily on a software-based system than a traditional vehicle which operates predominantly on a mechanical basis. Though there may, consequently, be more of an indispensable relationship between the goods, I am not persuaded that the consumer would necessarily anticipate a shared origin. On balance, I find the goods are dissimilar.

Reversing alarms for vehicles; Propulsion mechanisms for land vehicles (class 12)

51. The above goods have specific functions to perform within a vehicular context and do not necessarily interact with any of the goods and services relied upon by the opponent. Goods such as the applicant's will be used by consumers within the automotive industry whereas the opponent's are used by the general public or those working in Information Technology, for example. The physical nature of the respective goods is not similar and it seems reasonable to expect that the trade channels are distinct. The goods are not competitive and I cannot identify a complementary relationship. To my knowledge, the respective goods aren't typically offered by a single undertaking. I find the goods are dissimilar.

Computer software design; Maintenance of computer software; Maintenance and updating of computer software; Design of computer software for others; Installation, maintenance and repair of computer software (class 42)

52. The opponent relies upon both *computer software* and *computer software development services*. The respective uses may, on the face of it, be distinct, though there is a relationship between them. The users are likely to be shared; a consumer of software, for example, would also likely be interested in services such as maintaining or repairing such software. It seems likely, given the relationship, that the respective goods and/or services will share trade channels. There may not be a competitive dynamic but I do consider there to be a complementary element. Weighing all factors, I find a fairly high degree of similarity between the above applied-for terms and the goods and services retained by the opponent.

Technological research; Research and development of new products for others; Cartography services; Vehicle performance testing; Automotive design; Establishment of control programs for electric operation control and drive modules components; Design of integrated circuits (class 42)

53. When it comes to the aforementioned services, I find there is a distinction in use when considered against the terms relied upon by the opponent. There may be some broad overlap in the respective users but the trade channels are unlikely to be shared. I cannot identify any tangible opportunity for the goods and/or services to occupy competitive roles and, whilst software of some description, for example, may be beneficial to some of the services identified, I do not find any complementarity. Applying due weight to the relevant factors, I find no similarity.

Artificial intelligence consultancy (class 42)

54. I find there is a distinction in the use(s) of the above services and those relied upon by the opponent. Any coincidence in the respective users is likely to be fairly artificial and I see little likelihood of similarity in the nature of the services nor the respective trade channels. As the services will be accessed for different purposes there is unlikely to be a competitive element and I do not consider there to be any complementarity. These services are dissimilar to those of the opponent and I find the position the same when considering the similarity against the opponent's class 9 goods.

Electronic data storage services; Rental of a database server (to third parties) (class 42)

55. In *Fenix Software Inc v Bernhard Frohwitter*¹⁵, Ms Amanda Michaels, as the Appointed Person, considered whether it is self-evident that certain 'data storage services' are similar or identical to certain services proper to class 42. In that case, Ms Michaels made the following finding:

"24. ...“Research, design and development of computer software” and “installation... of computer software” differ in nature to the Data Storage Services, but I accept that the providers of the respective services may coincide, as they are all computer related services. In addition, the Opponent's design and development services could include the design and development of the more specific storage services, so that consumers may assume that the same company that designs and develops these software products would also provide the service providing the software. The services are also likely to overlap in terms of users and channels of trade... Therefore, in my judgment, they are similar at least to a low degree to the Opponent's services in Class 42.”

56. Whilst I acknowledge the difference in the merits of each case, I find it appropriate to take the same approach. It would not seem unreasonable for the average consumer

¹⁵ BL O/0059/24

to expect the respective services to be offered by a single undertaking or related undertakings and there could be significant crossover in the services' users and trade channels. Weighed against the services' differences, I find a low degree of similarity between the services.

Information technology services provided on an outsourcing basis (class 42)

57. I find the above "information technology services" to be a fairly broad term which could realistically incorporate similar services to those which are offered by the opponent. Whilst the uses may not be the same, exclusively, there could be an element of similarity depending on the context of the services captured within the applicant's term. The users may be shared, to a degree at least, and whilst the services are not necessarily competitive nor complementary (to the extent that they are indispensable), the consumer may feasibly expect that an entity offering the opponent's class 42 services would also offer general, or additional, information technology services on an outsourcing basis. I find the services similar to between a low and medium degree.

Design and development of computer database programs (class 42)

58. The opponent relies upon *computer software development services*. Where such services concern databases specifically, the above development services may be deemed identical to those relied upon. Alternatively, and also acknowledging the design services above, whilst there may be a distinction in the nature of the services, there could be an element of similarity in the respective use and the users are likely to be shared. There could be some coincidence in the services' trade channels and, in certain circumstances, the services may occupy competitive roles. I do not consider the services strictly complementary though it would seem reasonable for a single entity, or related entities, to offer both sets of services simultaneously. I find at least a medium degree of similarity.

Cloud computing; Monitoring of computer systems by remote access; Providing virtual computer systems through cloud computing; Computer system integration services; Monitoring of computer systems for detecting unauthorized access or data breach; Conversion of computer programs and data, other than physical conversion; platform as a service [PaaS] (class 42)

59. To my knowledge, the above services have a different use to the services relied upon by the opponent, though the users, for the most part, are likely to be shared. The nature of the services is unlikely to be similar but the services may occupy the same channels of trade and, though not necessarily competitive nor indispensable, the services may originate from a shared entity. I find at least a low degree of similarity.

Software as a service [SaaS] (class 42)

60. If the above term is not encompassing of (and therefore identical to) the opponent's class 42 services, I nonetheless find a fairly high degree of similarity. When considered against the terms relied upon by the opponent, there is a similarity in the respective use and there is likely to be a significant overlap in the goods and services' users, though there will be a clear difference in nature. There may, however, be some element of similarity in trade channels. The goods and services are not competitive though I do consider them complementary.

61. As some degree of similarity between the goods and/or services is essential to a finding of confusion¹⁶, the opposition fails at this point in relation to all goods and services where I have failed to establish any similarity.

The average consumer and the nature of the purchasing act

¹⁶ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

62. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

63. To my mind, the average consumer of the goods and services at issue will comprise both members of the general public and professional users. The goods and services are generally selected via visual means such as websites or the pages of brochures or catalogues, for example, placing a greater emphasis on the marks' visual impression. That being said, I do not discount the relevance of the marks' aural impact as advice may be sought from sales representatives or colleagues, for example. In most cases, the purchase of the goods and services will not be engaged with on a very frequent basis and the costs are not of a high degree, though for the professional consumer the cost could be more significant. Although the significance of the goods and services will vary amongst consumers, I find it likely that a member of the general public will typically apply a medium degree of attention to its purchase and, for a professional consumer, a fairly high degree of attention will be applied.

Comparison of trade marks

64. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

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

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

66. The trade marks to be compared are displayed in the table below:

Opponent's mark	Applicant's mark
MOMENTICS	momenta

67. The opponent's mark comprises a single word of nine letters. The mark's overall impression therefore resides solely within the word itself.

68. The applicant's mark is figurative but comprises a representation of a single word, of seven letters in length. The adopted font is black and fairly bold but is not particularly remarkable. The letters all appear in lower case with the exception of the sixth letter (T), though all are the same size. I find the mark's overall impression to reside in the word it comprises, with the presentation playing the lesser role.

69. Visually, the parties' marks coincide in their first six letters (M-O-M-E-N-T). In the earlier mark these letters precede three additional letters (I-C-S) and, in the later mark, all that follows is a single letter (A). Whilst I keep in mind the presentation adopted in the applicant's mark, particularly given that the beginnings of marks tend to have more of an impact on the consumer than their endings¹⁷, I find the marks' visual similarity to be of a fairly high degree.

70. I find both marks are likely to be articulated in three syllables, respectively MO-MEN-TICS and MO-MEN-TAH. Given that the first two syllables are identical, and given the percussive similarity at the beginning of the third syllables, I find a high degree of aural similarity between the marks.

71. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer¹⁸. To my knowledge, the word MOMENTICS (or MOMENTIC if it is viewed as a plural form) has no retrievable concept and will instead be seen as an invented word, perhaps reminding consumers of ordinary dictionary word MOMENT, though still they will be unable to attribute any specific meaning to the term. I make much the same finding in regard to the applicant's mark; it will convey no specific concept to the average consumer though the consumer may identify the word MOMENT within the mark based on the replicated sequence M-O-M-E-N-T. On that basis, I find the conceptual position is neutral.

¹⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

¹⁸ See, for example, *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

Distinctive character of the earlier trade mark

72. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases 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).”

73. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive

character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

74. I begin with the mark's inherent position. I have already found that the earlier mark will be seen as an invented word and will convey no tangible concept to the average consumer. Consequently, it does not have any descriptive or allusive qualities in regard to the goods and services relied upon. On that basis, the earlier mark enjoys a fairly high degree of inherent distinctiveness. As for whether the distinctiveness of the mark has been enhanced through use, it is the UK market which is key to that assessment. The mark has been used since at least as early as 2017 and I find the revenue generated by the sales of goods and services sold under the earlier mark to be significant, though admittedly I have no insight into its market share. I also have no insight as to the amount the opponent has invested into the promotion of its earlier mark, though it features in a number of press articles admitted with the opponent's evidence. Still, I find the evidence is collectively insufficient to show that the earlier mark's distinctiveness has been enhanced to any material extent. Even if I am wrong in that finding, given that I have already attributed a fairly high degree of inherent distinctiveness to the earlier mark, it would not alter the opponent's position to any meaningful degree.

Likelihood of confusion

75. In determining whether there is a likelihood of confusion, 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

also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

76. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

77. In *Kurt Geiger v A-List Corporate Limited*¹⁹, Mr Iain Purvis Q.C., as the Appointed Person, pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

¹⁹ BL O-075-13

78. Confusion can be direct or indirect. Direct confusion is simply a matter of mistaking one mark for another, whereas indirect confusion arises where the consumer recognises that one mark is different from the other but nonetheless attributes what the marks have in common to a shared or related origin²⁰.

79. I have found the parties' marks visually similar to a fairly high degree and aurally similar to a high degree. I have found the conceptual position to be neutral and that the earlier mark enjoys a fairly high degree of inherent distinctiveness. The degree of attention applied to the average consumer's selection of the relevant goods or services is likely to be between a medium and fairly high degree. The marks' visual impression is likely to play the greatest role in the selection process and the goods and services' similarity ranges from a low degree to a high degree and I have found some identical. The first six letters of each of the parties' marks are identical (M-O-M-E-N-T) and the beginnings of marks, generally speaking, have the greatest impact on the consumer. Whilst the marks' final letters are different (I-C-S in the earlier mark and an A in the later mark), those letters do not introduce any conceptual clarification; the consumer will not retrieve a meaning from either of the marks, other than an acknowledgement that the mark incorporates the common dictionary word MOMENT and it seems likely that this will be acknowledged consistently; i.e. the consumer will notice the word's presence in both marks or neither. As a consequence, even where a consumer is applying a fairly high degree of attention to its selection of the relevant goods or services, I find it likely, given the degree of visual and aural similarity between the marks and the absence of any clear conceptual indication, the average consumer would imperfectly recollect the marks' endings and simply mistake one mark for the other. I find this to apply to all goods and services where similarity has been identified; where this is at a low degree, the interdependency principle would come into effect and the low similarity between the goods or services would essentially be offset by a greater degree of similarity between the marks themselves. I find a likelihood of direct confusion.

²⁰ *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10

80. Having found a likelihood of direct confusion, I need not consider a likelihood of indirect confusion.

Conclusion

81. The opposition has succeeded in respect of the following goods and services. Subject to any successful appeal, the application will be refused for:

Computer software, recorded; computer software applications, downloadable; development of computer software for others; Computer operating programs, recorded; Computer programs, downloadable; Computer applications for car audio video navigation; Monitors [computer hardware]; Scanners [data processing equipment]; Biometric scanners; Interactive touch screen terminals; Central processing units for processing information, data, sound or images; Downloadable maps; Face recognition equipment; Internal communication apparatus; Downloadable software applications for mobile phones (class 9)

Computer software design; Maintenance of computer software; Maintenance and updating of computer software; Design and development of computer software for others; Installation, maintenance and repair of computer software; Electronic data storage services; Rental of a database server (to third parties); Information technology services provided on an outsourcing basis; Design and development of computer database programs; Cloud computing; Monitoring of computer systems by remote access; Providing virtual computer systems through cloud computing; Computer system integration services; Monitoring of computer systems for detecting unauthorized access or data breach; Conversion of computer programs and data, other than physical conversion; platform as a service [PaaS]; Software as a service [SaaS] (class 42)

82. The opposition has failed in respect of the following goods and services. Subject to any successful appeal, the application will proceed to registration for:

Vehicle video recorders; Black boxes [data recorders]; Audio recorders; Image recording apparatus; Blind spot cameras for cars; Rearview cameras for vehicles; Automobile data recorder; Speedometers for vehicles; Steering apparatus, automatic, for vehicles; Parking sensors for vehicles; Simulators for the steering and control of vehicles; Navigational instruments; Distance measuring apparatus; Speed measuring apparatus [photography]; Measuring apparatus; Laser measuring systems; Laser level measuring apparatus; Electronic monitoring apparatus; Video cameras adapted for monitoring purposes; Image amplifiers; Chips [integrated circuits]; Electronic chips; Infrared detectors; Inductors [electricity]; Sensors; Alarms. Remote control apparatus; Electronic controllers; Range finders [for cameras] (class 9)

Automobiles; Electric vehicles; Hybrid vehicles; Motor buses; Trucks; Self-driving cars; Robotic cars; Self-driving robots for delivery; Reversing alarms for vehicles; Propulsion mechanisms for land vehicles (class 12)

Technological research; Research and development of new products for others; Cartography services; Vehicle performance testing; Automotive design; Establishment of control programs for electric operation control and drive modules components; Design of integrated circuits; Artificial intelligence consultancy (class 42)

Costs

83. Both parties have achieved a measure of success, which I consider to be roughly equal. In these circumstances, I direct that each party should bear its own costs.

Dated this 27th day of June 2024

Laura Stephens

For the Registrar