

O/0627/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003632511 BY
THEGALLERY.COM LTD. TO REGISTER THE FOLLOWING TRADE MARK:**

CLICKWORK

IN CLASSES 9 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 427112 BY CLICKWORKER GmbH**

Background and Pleadings

1. On 26 April 2021, TheGallery.com Ltd. ('the Applicant') applied to register the trade mark shown on the cover of this Decision, number UK00003632511. The application was published for opposition purposes in the Trade Marks Journal on 25 June 2021. Registration is sought for the following goods and services:

Class 9:

Software; platform software, application software, mobile apps, web application and server software; collaboration software platforms; downloadable computer software; mobile application software; computer software development tools; downloadable electronic publications, recorded content; software for transmission and receipt of data, images, and files, organizing and providing digital platforms.

Class 42:

Software platforms; computer services; development of computer platforms; hosting platforms on the internet; hosting of communication platforms on the internet; hosting electronic facilities and communication networks; Software as a service (SaaS); Platforms as a service (PaaS); Providing online non-downloadable software.

2. On 24 September 2021, clickworker GmbH ('the Opponent') filed an opposition against the application based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition is directed against the Applicant's specification in its entirety.
3. The Opponent relies upon the following earlier trade mark registration:

UK00910629822¹

¹ The earlier mark is a comparable mark pursuant to Article 54 of the 'Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic



Filing date: 9 February 2012

Date of entry in register: 21 August 2012

Registered for the following goods and services, all of which are sought to be relied upon by the Opponent:

Class 35:

Arranging of contractual services with third parties; Business management and consultation; Personnel placement and recruitment; Employment hiring, recruiting, placement, staffing and career networking services; Information, advisory and consultancy services relating to business and management or business administration, including such services provided on line or via the internet; Advertising services, namely promotion of the goods and services of others; Advertising and promotion services and related consulting; Advertising via electronic media and specifically the internet.

Class 41:

Education; Providing of training; Entertainment; Sporting and cultural activities; Translation services.

Class 42:

Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Providing of files, downloadable from global computer networks, namely scientific and technological research results.

Energy Community (2019/C 384 1/01)', also known as the 'Withdrawal Agreement', based on EUTM 010629822, which was registered prior to the withdrawal of the UK from the European Union.

4. The Opponent claims that the parties' marks are very similar and that the respective goods and services are identical or very similar; leading to a likelihood of confusion. The Opponent made a statement of use on the notice of opposition (form TM7) in relation to all of the services relied upon.

5. The Applicant filed a Defence and Counterstatement in which it:
 - denies that the parties' marks are similar;
 - denies that the Applicant's goods/services are identical/very similar to those of the Opponent, despite admitting to 'a degree of overlap in relation to design and development of computer software in class 42';²
 - denies that there is a likelihood of confusion;
and
 - requests that the opponent provide proof of use of the mark in respect of all of the services upon which the opponent seeks to rely.

6. The Opponent is represented by Stevens Hewlett & Perkins. The Applicant is represented by Mathys & Squire LLP.

7. Only the Opponent filed evidence. The Applicant filed written submissions in the evidence round, dated 27 September 2023. A hearing was neither requested nor considered necessary. Both parties filed written submissions in lieu of a hearing. I will refer to the evidence and submissions in my decision to the extent necessary.

8. The Opponent's evidence comes from Mr Christian Rozsenich, Managing Director of the Opponent company. Mr Rozsenich's Witness Statement is dated 30 June 2023 and is accompanied by twelve exhibits, CR1 to CR12, intended to support the Opponent's claim that it has made genuine use of its mark.

² Applicant's Counterstatement, at [8].

RELEVANCE OF EU LAW

9. 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.

10. The following decision has been made after careful consideration of the papers before me.

DECISION

Proof of Use

11. I will begin by assessing whether there has been genuine use of the Opponent's earlier mark. The relevant law is as follows:

“6A(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 8 purposes of this section as if it were registered only in respect of those goods or services.”

12. Section 100 of the Act states that:

“100. 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.”

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.

Section 5(2)(b)

20. 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.”

Earlier mark

15. In accordance with section 6 of the Act, the Opponent’s mark is an earlier mark by virtue of its filing date (9 February 2012), which fell before the filing date of the applied-for mark (26 April 2021).

Relevant dates for proof of use

16. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is engaged; the earlier mark having been registered for more than 5 years on the date on which the Applicant’s mark was filed. The Applicant has requested proof of use of the earlier mark in respect of all of the services upon which the Opponent seeks to rely.

17. The Opponent has made a statement that it has made genuine use of all of the services for which its earlier mark is registered. The relevant time period for this purpose is the five years prior to and ending on the application date of the applied-for mark: 27 April 2016 to 26 April 2021.³

Comparable UK trade marks

18. Paragraph 7 of Part 1, Schedule 2A of the Act states that:

“7. (1) Section 6A applies where an earlier trade mark is a comparable mark (EU), subject to the modifications set out below.

(2) Where the relevant period to in section 6A(3)(a) (the “five-year period”) has expired before completion day—

³ Both parties have stated the relevant 5-year period incorrectly as ‘26th April 2016 to 25th April 2021’; in the Witness Statement of C. Rozsenich at [4]; and in the Applicant’s written submissions of 27 September 2023, at [2].

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before completion day –

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

19. Use of the Opponent’s earlier mark in the EU, but outside the UK, may therefore be taken into account for the period 27 April 2016 to 31 December 2020. For the portion of the relevant period 1 January to 26 April 2021, only UK use may be taken into account.

Evidence of use

20. I note the following from the Opponent’s evidence:

a) Mr Rozsenich has given narrative evidence that the Opponent’s business is the provision of ‘managed crowd-sourcing services via its platform and team of specialists’ to organisations in the ‘eCommerce and high-tech industries’.⁴ Mr Rozsenich further states that the Opponent has been using its ‘Clickworker’ mark since 2010, when it changed its name from ‘Humangrid GmbH to clickworker GmbH’.⁵

⁴ Witness Statement of C. Rozsenich, at [3].

⁵ As above, at [4].

b) Exhibit CR2 comprises screenshots of the 'About us' pages from the Opponent's website 'Clickworker.com'. Each page bears the Opponent's mark in the top left-hand corner of the 'header'. I note that the text is in American English. Outside of the USA, it is not clear to which other countries/continents/states the webpages are aimed. The first 6 screenshots are undated, one of which describes the services offered as follows:⁶

"Your Virtual Workforce – On Demand – Worldwide

With more than 4.5 million freelancers, known as Clickworkers, In Europe, America and Asia, clickworkers is one of the leading providers of paid crowdsourcing.

Clickworker offers scalable solutions in the area of

- Datasets for Machine Learning
- SEO content services
- categorization and tagging
- Surveys
- web research
- customer insights from PoS
- product data maintenance

In 45 languages and in more than 70 target markets.

Clickworker is a full-service provider and offers both standard and customized solutions for the implementation of data-oriented projects. These projects are automatically broken down into micro jobs and processed by qualified Clickworkers from the crowd. The results are then reassembled and transmitted to the customer in a quality-assured manner.

Clickworker also offers a self-service solution via the online marketplace for smaller and standardized tasks in the areas of text creation, surveys,

⁶ Exhibit CR1, page [3].

and sentiment analysis. These practice-proven services offer reliable and high-quality results with high output, outstanding scalability and significant cost savings”.

- c) Screenshots of archived pages from the Opponent’s website, obtained via the Wayback Machine,⁷ (‘Wayback prints’) dated 21 May 2020 and 7 July 2021, respectively, have been provided. I note the following information on the page dated 21 May 2020⁸

“About clickworker and its workflows

We utilize the knowledge of the crowd to engage the know-how and labor of hundreds and thousands of clickworkers who assist us in the fast and efficient processing of projects for your company.

Our Clickworkers are independent contractors to provide these services using their own computing equipment and schedule. They use a standard web browser to complete tasks on a piece rate basis. Most of these tasks are part of a larger, more complex, project.

Task coordination and oversight is conducted utilizing the technology of clickworker, which provides the internet-based workflow system. Project examples include the processing of unstructured data, such as text, photographs, and videos. We can create, categorize, append, capture and translate.”

- d) Wayback print from the Opponent’s website, dated 21 May 2020, have been provided, the following of which is noted:

- the following ‘events’ are set out in a timeline:⁹

⁷ An internet archiving service.

⁸ Exhibit CR1, page [8].

⁹ As above, pages [9].

2017	Crowd grows to 1 million Clickworkers. Development of the Clickworker App for iOS.
2018	Development of the Clickworker App for Android.
2020	Crowd grows to 2 million Clickworkers.

- A graphic which indicates the geographical locations of the Opponent's 'clickworkers' by per centage: 10% - Germany; 37% - other European countries.

e) Wayback prints of the Opponent's website, dated 1 November 2020 and 6 June 2017 have been provided. The Opponent's mark as registered does not appear on the pages provided. There are frequent uses of the word 'clickworker' as references to the individuals registered with the Opponent to perform tasks for the third-party professionals who engage the Opponent for their services. I note the following:

- The text:

"Best input for your AI system

We use the power of our global crowd of Clickworkers to generate, validate, and label data.

The versatility of our team of qualified Clickworkers ensures you receive high quality, reliable AI training data that represents the kind of diversity that makes your AI model powerful and train [sic] your AI system to perfection"¹⁰

- There are (as at the date of the Wayback print, 1 November 2020) 'More than 2.2 million Clickworker [sic] based in 136 countries worldwide'.¹¹ An accompanying map graphic indicates that 30% of 'clickworkers' are based

¹⁰ Exhibit CR2, page [5].

¹¹ As above, page [6].

in Europe. Beneath the graphic is the text 'Clickworkers are a team of internet professionals registered with our organization. They work online, performing micro-tasks on our platform using their own desktop, tablet or smartphone (via Clickworker-App). Clickworkers participate in projects on a freelance basis and according to their own schedule. They are compensated directly through us on a per assignment basis'.¹²

- One of the tasks performed by the Opponent's 'clickworkers' is the creation of audio, video and image datasets which are then transferred to customers anywhere in the world. ¹³
- The following 'solutions' provided by the Opponent are listed as follows (the non-emboldened text presumed to indicate a service encompassed by the emboldened item above it):

AI training Data

Audio Data Sets – Speech Recognition

Photo Data Sets – Image Recognition

Video Data Sets

Image annotation

Texts

SEO Texts¹⁴

Product Description

Category Texts

Advisors & Guides

Glossaries & Dictionaries

Descriptions of Destinations

Categorization & Tagging

Product Categorization & Tagging

¹² As above.

¹³ Exhibit CR2, page [7].

¹⁴ It is my understanding that 'SEO' stands for 'Search Engine Optimisation' and entails devising strategies which enhance a website's visibility such that it occupies a higher position in internet search results.

Image & Video Tagging

Sentiment Analysis

Video Analysis

Search Relevance

Product Data Management

Mobile crowdsourcing

Customer insights from PoS

External Form (iFrame)

Industry Solutions

Online Marketing

E-Commerce

- The accompanying text indicates that, broadly speaking, the tasks undertaken by 'clickworkers' involve: adding text to material by way of labels or descriptions; conducting web searches to help improve a website's position in search results.

f) Mr Rozsenich has given narrative evidence that the Opponent company 'offers different options for its customers to submit tasks, including a managed tailor-made service for the effective implementation of projects; a self service marketplace option and an Application Programming Interface' and refers to Exhibits CR3 and CR4 in support.¹⁵ I note the following:

- Wayback prints, dated 12 May 2019, 23 January 2021 and 27 February 2021, of the Opponent's website, indicate that the Opponent offers a service according to which it crowd-sources individuals to provide/generate data which are then sent to customers for use in machine learning and Artificial intelligence. The data provided by 'clickworkers' include, *inter alia*:

¹⁵ Witness Statement of C. Rozsenich, paragraph [8]; Exhibits CR3 and CR4. Due to a pagination error, it is not possible to discern where Exhibit CR3 ends and CR4 begins. However, all relevant pages appear to be present.

voice/audio recordings; photographs; video recordings; samples of handwritten or typed text; image annotation. Other tasks performed by 'clickworkers' include: testing search engines by inputting search terms; providing feedback on texts, videos and audio files; video tagging (i.e. providing written descriptions for video content); completing surveys; translating texts into other languages; image labelling (i.e. providing texts to accompany images). Another task performed by 'clickworkers' is 'Competitor Research' which appears to entail researching the internet for a particular company's competitors and finding information on their products/services, pricing and delivery conditions.

g) Mr Rozsenich highlights three particular options for the Opponent's customers to 'submit tasks': a 'managed tailor-made service for the effective implementation of projects'; 'a self-service marketplace option' and 'an Application Programming interface'.¹⁶ Exhibit CR5 has been adduced in support, from which I note the following:

- Wayback prints of the Opponent's website, dated 3 November 2020, talk about a 'Managed Service' according to which a customer discusses its brief with the Opponent, which then manages the project to completion, by way of allocating its constituent tasks to 'clickworkers' who are monitored and overseen by the Opponent's project managers.¹⁷
- Wayback prints of the Opponent's website, dated 6 November 2020, feature information on the Opponent's 'Self Services'. From the information provided, it is my understanding that this involves the customer using online templates provided by the Opponent to submit its requirements, which are then actioned by the Opponent, utilising its 'clickworkers'.¹⁸ The customer is kept abreast of progress via email and is also able to check progress online. In short, the service entails completion of a project by remote means.

¹⁶ Witness Statement of C. Rozsenich, paragraph [8];

¹⁷ Exhibit CR5.

¹⁸ As above.

- A Wayback print of the Opponent's website, dated 5 December 2020, headed 'API' describes 'clickworkers application programming interface' as web services which 'allow you to access our crowdsourcing services through an API and integrate them seamlessly into your applications. This can be used for your content management system, blog or any other internet application'.¹⁹ It is my understanding that this service amounts to the provision of some sort of 'platform' or electronic infrastructure which can be incorporated into, or used in concert with, the customer's existing applications. In the absence of any other detail on what, in lay terms, this means in practice, I am unable to interpret the information on the webpage further.

h) Mr Rozsenich states that the Opponent's 'global community of workers grew to 2 million internet-savy [sic] clickworkers by 2020, which has now expanded to 5.0 million in 2023, working on a freelance basis, receiving a fixed fee for each properly completed task'.²⁰ Exhibit CR6 comprises Wayback prints of the Opponent's website dated: 7 July 2017; 27 October 2020; and 27 February 2021. From these, I note that, as of 7 July 2017, the Opponent had over 800,000 'clickworkers' internationally; 25% of which were based in Germany and 25% in other European countries/states, the remaining 50% based outside Europe. As of 27 October 2020, the body of 'clickworkers' had grown to 'more than 2.2 million', 30% of which were based in Europe, the remaining 70% based outside of Europe. The proportion of UK-based 'clickworkers' is not given. According to the Wayback print of 27 February 2021, the body of 'clickworkers' remained at 'more than 2.2. million', the geographical distribution being shown as unchanged from 27 October 2020.

i) A selection of invoices has been provided, for sums paid by the Opponent in respect of advertising and promotional services. It is convenient to summarise the information in the following table:

¹⁹ Exhibit CR5.

²⁰ Witness Statement of C. Rozsenich, paragraph [9].

Invoice date:	Payee and geographical location	Description of service purchased:	Invoice amount:
17 Oct 2017	StudentJob (geographical location not apparent on invoice)	'StudentJob International Contract Renewal -1 Year Nationwide Top Jobs extension in; NL, UK, DE, FR, ES, BE, AT'	€6,600
31 Jan 2018	Grip Media Limited, London UK	12 month listings for each of the following features/sections of online publication 'Save.the.student.org': 'make money guide'; 'top pick deal page'; and 'mystery shopping guide'.	£3,600
16 Feb 2018	E4s employment 4 students, Oxfordshire, UK	'Nationwide annual listing; Annual Company Profile; Content page branding – annual'	£1,499
14 Feb 2019	E4s employment 4 students, Oxfordshire, UK	As above.	£1,499
10 Apr 2019	Grip Media Limited, London UK	12 month listings for each of the following features/sections of online publication 'Save.the.student.org':	£4,200

		'make money guide'; 'top pick deal page'; and 'mystery shopping guide'.	
19 Nov 2019	StudentJob (geographical location not apparent on invoice)	'1 Year Renewal Package'	€7,140
18 Mar 2020	E4s employment 4 students, Oxfordshire, UK	'Nationwide annual listing; Annual Company Profile; Content page branding – annual'	£1,499
30 Nov 2020	StudentJob (geographical location not apparent on invoice)	'1 Year Renewal Package'	£7,140
17 Mar 2021	E4s employment 4 students, Oxfordshire, UK	'Nationwide annual listing; Annual Company Profile; Content page branding – annual'	£1,499
27 Jan 2021	StudentJob (geographical location not apparent on invoice)	'1 Year Renewal Package'	£7,140
11 May 2021	Grip Media Limited, London UK	12 month listings for each of the following	£4,200

		features/sections of online publication 'Save.the.student.org': 'make money guide'; 'top pick deal page'; and 'mystery shopping guide'.	
<u>25 Jul 2022</u> (post-dates the relevant 5-year period)	Grip Media Limited, London UK	As above.	£4,200
Totals:			€13,740 and £36,476

- j) The following table, described by Mr Rozsenich as 'A summary of my Company's annual financial turnover figures, recruitment costs and marketing expenses from 2018 to 2022' has been provided (although the table only includes figures up to 2020):²¹

[I acknowledge that the way in which I have reproduced the table results in the parts of some of the figures running on to different lines, which is not ideal. However, in order to retain the standard font size of 'Arial 12' and keep the table within the margins, I am, unfortunately, unable to present this in any other way].

	<i>Actuals</i>	<i>Actuals</i>	<i>Actuals</i>	<i>Actuals</i>
	2017	2018	2019	2020
Revenue	€1,414,776.	€1,327.375.0	€2,731,841.4	€2,937,154.7
GmbH	41	1	6	9

²¹ Witness Statement of C. Rozsenich, paragraph [11].

thereof with UK customers	€31,198.47	€13,486.94	€31,602.34	€29,694.22
Cost of Sales (=total payouts clickworker)	€649,859.00	€789,496.89	€918,807.69	€1,282,139.07
Payouts to UK-based clickworkes [sic]	€173,743.30	€215,923.00	€426,942.00	€350,305.00
Clickworker recruiting costs GmbH	€13,532.00	€28,972.58	€18,285.21	€12,117.40
Marketing expenses GmbH	€35,902.00	€34,496.63	€43,684.28	€24,984.19
Marketing expenses for UK market	£-	£4,000.00	€3,751.76	€ -
No of clickworkers	25,773	36,405	40,709	46,157

I note that no figures have been provided for the portion of the relevant period from 1 January to 26 April 2021. To my mind, the row labelled 'Cost of Sales (=total payouts clickworker)' refers to fees paid out by the Opponent to its clickworkers for their assignments completed. I consider the figures in the fourth row, labelled 'Payouts to UK-based clickworkes [sic]' to represent the sums paid out to 'clickworkers' based in the UK.

k) Mr Rozsenich has given narrative evidence that the Opponent's customers include the following UK-based companies: Norton Life Lock UK Ltd., Cirrus Logic International Semiconductor Ltd, Pearson PPLC, 1715 Labs Ltd and Codigital Ltd.²² Wayback prints of the Opponent's website, dated 25 September 2019, 21 May, 26 and 28 September and 29 October 2020, highlight the following 'case studies' as particular projects that the Opponent has worked on:²³

- Creation of IT Support Questions in in Text Format to Train a Chatbot
- Creation and analysis of voice recordings as training data for a speech recognition software
- Creation of photos of faces as training data for a face recognition software
- Text classifications to improve online product presentation for the company 'Deutsche Telekom AG' (webpage dated 25 September 2019).
- Text descriptions for kitchens and kitchen equipment for the company 'Kiveda' (webpage dated 29 October 2020).
- Collection and analysis of in-store data with regard to shelf stock and shelf placement of a specific hair care brand.
- Clickworker creates article descriptions in 8 languages for the online shop 'Tennis-Point'. (webpage dated 26 September 2020).
- Creation of content for 'keyword-rich 800-page financial term dictionary' for the German publisher 'IDG Business Media GmbH' (webpage dated 26 September 2020).
- Research on competitors to enable the company 'Axzo' to optimise its customer lists and improve sales. (Webpage dated 25 September 2020).

l) A small selection of invoices to the Opponent's customers has been provided. The Opponent's mark is visible in the top right corner of each invoice. I will consider only those dated within the relevant period (5 invoices). It is convenient to set out the relevant information in the following table:

²² Witness Statement of C. Rozsenich, paragraph [11].

²³ Exhibit CR8.

Invoice date:	Geographical location of customer:	Services purchased:	Invoice amount:
31 Aug 2019	Hertford, UK	'Test your verbal ability'; 'Test your verbal aptitude!' (x 4 items)	€7,245.00
31 Mar 2020	Edinburgh, UK	'Voice records US-English single session'	€1,373.85
30 Apr 2020	Hertford, UK	'DATVA German FF1'; 'DATVA German FF2'; 'DATVA German FF3'; and 'DATVA German FF4'.	€6,048.00
31 July 2020	Oxford, UK	29 items are enumerated, the first of which is 'Pick some blueberries! (2319 jobs)'. The remaining items are in a similar vein, for example: 'Identify Supermarket Milk (4576 jobs)' and the like.	€6,311.31
31 Aug 2020	Oxford, UK	31 items including, <i>inter alia</i> , 'Transcribe some football commentary (510 jobs)'; 'Identify missing bananas at supermarket checkouts (90 jobs)'; 'Help identify investments relationships from text (461 jobs)'. Total:	€2,923.23 €23,901.49

These invoices cover only a one-year portion of the relevant period; 31 August 2019 to 31 August 2020. A selection of invoices to cover the following portions

of the relevant period would have been helpful: 27 April 2016 – 30 August 2019 and 1 September 2020 – 26 April 2021.

- m) A number of documents described as ‘credit notes’ have been provided which enumerate tasks undertaken by ‘clickworkers’ and the payment received by the ‘clickworker’ for each task. Those of the credit notes that fall within the relevant 5-year period are dated: 31 August 2018; 30 June 2019; 6 November 2019; 30 April 2020 and 23 December 2020. The majority of the tasks entail making comparisons of web search results. Other tasks frequently mentioned include: answering various survey questions; providing ‘selfie’ photographs or videos of various activities (e.g. attendance at a sports event).²⁴
- n) Evidence of the Opponent’s attendance at, and participation in, the ‘IoT Tech Expo’, a global conference held in London, UK, on the ‘Internet of Things’,²⁵ has been provided. Wayback prints, dated 31 August 2018, of the website of ‘IoT Tech Expo’, indicating that the Opponent had booked to attend the event. I note that the Opponent is listed as a participant with an allocated trade stand, its mark displayed prominently on the webpage. Invoices dated 11 and 30 April 2018, and 10 April 2019, indicate the Opponent’s attendance at the event in the years 2018 and 2019. No information has been provided on the numbers attending the event. A copy of the Opponent’s presentation delivered at the 2018 event has been provided, titled ‘Keeping Enterprise AL in Shape’.²⁶ The focus of the presentation appears to be on the provision of data for use by companies whose business is the training of machines or systems to use AI.
- o) Results from ‘Google Analytics’ demonstrate that the Opponent’s ‘Clickworker’ website received up to 20,000 visits from UK consumers in 2018, reaching a peak of over 40,000 visits in the middle of 2020. The figures are at around the 20,000 mark at the lowest point. It is not clear what proportion of the visits is referable to businesses/organisations engaging the Opponent’s services, as

²⁴ Exhibit CR9.

²⁵ It is my understanding that the Internet of Things might be described, in simple terms, as a network of devices connected within an electronic ‘realm’.

²⁶ Exhibit CR11.

opposed to the 'clickworkers' who perform the tasks which ultimately 'feed into' the finished project delivered to the customer.

Assessment on genuine use

21. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²⁷

22. The totality of evidence available to me indicates that, in essence, the Opponent operates as an intermediary whereby it receives briefs for projects/tasks from third parties which it then breaks down into smaller constituent tasks which are then allocated to individuals known as 'clickworkers'. An example is the provision of 'banks' of data including audio or image files to organisations which train machines to use AI. Another example is researching information on a company's competitors regarding their pricing and delivery services. It is clear that 'clickworkers' do not have the status of 'employees' but complete tasks on an ad-hoc basis according to their own schedules. It is my understanding that the Opponent manages the process of dividing the project into 'subsets' of tasks, monitoring their progress to completion before collating/'re-assembling' the various parts and presenting the finished 'project' to the customer. The evidence demonstrates that the services are provided remotely by electronic means via an 'internet-based workflow system'.

23. Annual turnover figures have been provided for the years 2017 to 2020, though none have been provided for the initial portion of the relevant period, i.e. 27 April 2016 to 31 December 2016. I consider the figures labelled 'thereof with UK customers' to represent turnover referable to UK-based customers. The figures are modest, generally being around the 30,000 EURO mark, with the exception of 2018, where they dipped to around 13,500 EURO. Although the sales figures are modest, the sums paid out to UK-based 'clickworkers' are not insignificant, being in the hundreds of thousands. This, to my mind, indicates that the Opponent has attracted steady and significant streams of work by way of assignments to be allocated to its 'clickworkers'. No breakdown of the figures has been provided

²⁷ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

according to the services provided by the Opponent. The marketing expenses for the UK are fairly low; nil for the years 2017 and 2020, and approximately £4,000 for each of the years 2018 and 2019. However, I recognise that low marketing figures do not necessarily equate to the marketing efforts having a low impact. Invoices for various student-directed publications indicate an ongoing and consistent advertising campaign targeted at the UK student population, spanning the relevant period. I infer from this that there has been an ongoing commercial need for the Opponent to maintain a workforce of 'clickworkers' to be utilised for the projects from third parties engaging the Opponent. Evidence of advertising campaigns directed at the third parties to whom the Opponent's services are aimed would have strengthened the Opponent's case even further. It is clear from evidence of the Opponent's repeated attendance at the 'IoT Tech Expo' in London, UK, in years 2018 and 2019, that the Opponent is seeking to maintain and/or expand its presence in the UK market as a provider of data to third parties operating in the field of AI.

24. Taking the body of evidence as a whole, I am satisfied that the Opponent has made genuine use of its mark throughout the relevant period for services that might be best described as follows: the provision of data in the form of sound, image or video files; the provision of text by way of copy for, *inter alia*, product listings; the provision of survey results on various topics; market research; translation of text into other languages; provision of a web-based facility for third parties to engage the aforementioned services.

25. I must now consider for which of the goods and services in respect of which the Opponent's mark stands registered, there has been genuine use. The specification as registered is set out above at [3]. I must consider whether the specific services for which there has been genuine use are services which encompass, or are encompassed by, the terms for which the mark is registered. I am not permitted to expand the specification as registered by introducing services which are not covered by existing terms.

Fair specification

26. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs K.C. 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.”

27. 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 (although it equally applies to the issue of a fair specification for proof of use assessments):

“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].

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."

28. In the light of my findings on genuine use, I consider the following to be a fair specification upon which the Opponent may rely:

Class 41: Translation services

29. I will now set out my reasoning for why I have been unable to find that the use that has been made of the mark falls into any of the remaining terms within the registered specification. I will deal with each class of services in turn.

Class 35

30. Broadly speaking, the Opponent's services fall into roughly four 'groups': services to do with business management; advertising services; recruitment and staffing services; and arranging of contractual services with third parties. According to the evidence available to me, the activities that the Opponent appears to carry out cannot be said to constitute a business management or advisory/consultation

service. It is my understanding that business management involves the running of a business. Consultation and advisory services relating to business, to my mind, entail the provision of expertise and advice on matters such as, *inter alia*, strategy, efficiency and people management. The Opponent's apparent role as an intermediary which facilitates the completion of specific projects or tasks for third parties does not, in my view, amount to providing advice or expertise on how to run businesses or matters relating to the running of businesses.

31. I now turn to the advertising services in the specification. While I accept that the Opponent has produced evidence that it advertises *its own* services, both to third parties as prospective customers, as well as the public at large for the purposes of recruiting 'clickworkers', the Opponent cannot be said to be offering advertising services to third parties.

32. In my view, the Opponent cannot be said to be providing recruitment or staffing services to third parties, either. The 'crowdsourcing' of individuals to perform the 'microtasks' as 'clickworkers' is for the Opponent itself to operate, and not a service being held out to third party businesses.

33. I now address the term *arranging of contractual services with third parties*. Although the Opponent itself is clearly entering into contractual relationships with both its customers (the businesses engaging it to fulfil their briefs/manage projects) and its 'clickworkers', it cannot be said to be arranging contractual services for third parties. To put it another way, a customer requesting completion of a task by the Opponent is not, first and foremost, requesting that the Opponent, in turn, engage a third party to undertake the work. Rather, they are simply asking the Opponent to get a particular task done, irrespective of whether that might involve engaging another party.

Class 41

34. The terms within the registered specification, broadly speaking, cover education/training and entertainment, sport and culture. None of the services mentioned in the Opponent's evidence can be said to be covered by these terms.

Class 42

35. The class 42 terms within the registered specification are: *Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Providing of files, downloadable from global computer networks, namely scientific and technological research results.*
36. Based on the evidence available to me, the Opponent provides what might be described as ‘banks’ of data (by way of sound or image files, for example) to third party companies which then use the data in the course of their scientific or technological research. The evidence provided has not given me to understand that the Opponent itself offers scientific or technological services, or research and design relating to those fields. Nor does the evidence demonstrate that the Opponent itself conducts industrial analysis; industrial research; or the design and development of computer hardware and software. With respect to the term *Providing of files, downloadable from global computer networks, namely scientific and technological research results*, although the Opponent clearly does provide electronic files (e.g. sound or image files) which may well be downloaded from ‘global computer networks’, the evidence does not suggest that such files are *the results of* scientific or technological research. Rather, it is a case of files being provided to third parties who will go on to use these files in the course of their scientific or technological research.

Section 5(2)(b) case law

37. The following principles are derived 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 C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P:

(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

38. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the 'Nice Classification' means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.

39. The CJEU in *Canon*, Case C-39/97, stipulated that all relevant factors relating to the parties' goods and services must be taken into account:

"[23] 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”.

40. Jacob J. (as he then was) in the *Treat* case²⁸ identified the following factors for assessing similarity of the respective goods and services:

- (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.

41. In *Kurt Hesse v OHIM*, Case C-50/15 P, 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)*, Case T-325/06, 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

²⁸ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

may think that the responsibility for those goods lies with the same undertaking.”

42. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

43. Case law establishes that “... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise” but “Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”²⁹

44. The goods and services to be compared are as follows:

Opponent’s mark:	Applied-for mark:
Class 41: <i>Translation services</i>	Class 9: <i>Software; platform software, application software, mobile apps, web application and server software; collaboration software platforms; downloadable computer software; mobile application software; computer software development tools;</i>

²⁹ *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch).

	<p><i>downloadable electronic publications, recorded content; software for transmission and receipt of data, images, and files, organizing and providing digital platforms.</i></p> <p>Class 42: <i>Software platforms; computer services; development of computer platforms; hosting platforms on the internet; hosting of communication platforms on the internet; hosting electronic facilities and communication networks; Software as a service (SaaS); Platforms as a service (PaaS); Providing online non-downloadable software.</i></p>
--	--

Class 9

Contested terms: *Software; platform software, application software, mobile apps, web application [...] software; collaboration software platforms; downloadable computer software; mobile application software*

45. The Applicant's terms are all fairly broad 'software' terms. In simple terms, software refers to the set of instructions, often referred to as a 'computer program', according to which computers (or other devices) operate. 'Mobile apps' are forms of software. The purpose of the Opponent's services is the translation of material from one language to another. The parties' offerings will differ in terms of their specific purposes. I nevertheless acknowledge that the Applicant's goods will encompass software used specifically for translation. Users will overlap. Trade channel overlap is, in my view, very unlikely, but not impossible. The same undertaking would not, to my mind, typically perform translation services as well as

selling software for translation. Methods of use will also be distinct; the Opponent's services entail engaging a third party to perform the translation task whereas the Applicant's software goods are purchased for the consumer to use themselves. The goods and services will differ in physical nature: the Opponent's offering entails acts of service (i.e. translating) whereas the Applicant's goods are items, albeit non-physical entities (although they may be recorded on a disc or some such). There may be competition between the parties' offerings in some instances; a purchaser might deliberate over whether to engage a third party to perform translation tasks or whether to purchase a piece of translation software to enable them to produce translations themselves. I do not find the goods and services to be complementary; the average consumer would unlikely presume both parties' offerings to originate from the same undertaking. All things considered, I find a low level of similarity between the parties' goods and services.

Contested term: [...] *server software*

46. It is my understanding that a server is a computer on a network which receives 'requests' from other computers on the network and responds to them. I therefore consider 'server software' to be the software which enables a server to operate. Bearing in mind the purposes, users, trade channels, methods of use, nature of the goods/services, together with the matters of competition and complementarity, I find the parties' offerings to be dissimilar.

Contested term: *computer software development tools*

47. I consider this term to encompass tools used to develop computer software. Bearing in mind the purposes, users, trade channels, methods of use, nature of the goods/services, together with the matters of competition and complementarity, I find the parties' offerings to be dissimilar.

Contested term: *downloadable electronic publications, recorded content*

48. The above term is very broad and will encompass any electronic document capable or being downloaded, and any sort of audio or visual content that has been

recorded. Bearing in mind the purposes, users, trade channels, methods of use, nature of the goods/services, together with the matters of competition and complementarity, I find the parties' offerings to be dissimilar.

Contested term: *software for transmission and receipt of data, images, and files, organizing and providing digital platforms.*

49. The Applicant's goods are pieces of software specifically to facilitate the sending and receiving of data and the provision of digital platforms. Bearing in mind the purposes, users, trade channels, methods of use, nature of the goods/services, together with the matters of competition and complementarity, I find the parties' offerings to be dissimilar.

Class 42

Contested terms: *Software platforms; Software as a service (SaaS); Providing online non-downloadable software.*

50. The Applicant's terms, broadly speaking, entail the provision of software solutions. It is my understanding that 'Software as a service', put simply, entails the provision of software, hosted by the service provider by way of 'cloud', which is purchased by way of a subscription. I consider that both terms could provide the use of software for translation purposes. I find the parties' goods and service to have a low level of similarity for reasons analogous to those given above at [45].

Contested term: *development of computer platforms*

51. The Applicant's service entails the act of developing computer platforms, whereas the Opponent's service entail acts of translating. The parties' services will therefore have distinct purposes. Bearing in mind the users, trade channels, methods of use, nature of the services, together with the matters of competition and complementarity, I find the parties' offerings to be dissimilar.

Contested term: *computer services*

52. The Applicant's term is very broad and will, in my view, encompass services including, *inter alia*, the operation, maintenance and repair of software for computer systems. In short, activities which support the running of computer systems. Bearing in mind the purposes, users, trade channels, methods of use, nature of the services, together with the matters of competition and complementarity, I find the parties' services to be dissimilar.

Contested terms: *hosting platforms on the internet; hosting of communication platforms on the internet; hosting electronic facilities and communication networks*

53. It is my understanding that 'hosting' is a service according to which a 'host', the service provider, provides the necessary infrastructure for the user to communicate, collaborate, web-edit etc (or whatever the user wishes to do electronically) as the case may be. I can see no reason why the Applicant's service could ultimately be used to enable the user to produce translations. I therefore find a low level of similarity between the parties' services for reasons analogous to those above at paragraphs [45] and [50].

Contested term: *Platforms as a service (PaaS)*

54. It is my understanding that 'Platform as a service' is a service which provides the user with access to everything that the user needs to, for example, build, develop and maintain a software application. The service provider hosts the servers, network, software, databases and development tools by way of a cloud access to which the user pays for, typically on a subscription basis. Although it is possible for a consumer to use these services in order to develop their own translation software, my view is that the Applicant's service is not a commercially realistic alternative. Bearing in mind the purposes, users, trade channels, methods of use, nature of the services, together with the matters of competition and complementarity, I find the parties' services to be dissimilar. If I am wrong about that, then the level of similarity will be very low.

55. Some similarity between the parties' goods or services is essential in order to find a likelihood of confusion between the parties' marks.³⁰ For those of the Applicant's goods and services that I have found to be dissimilar to those of the Opponent, the opposition therefore fails at this point. The opposition remains live for the following goods and services:

Class 9:

Software; platform software, application software, mobile apps, web application [...] software; collaboration software platforms; downloadable computer software; mobile application software

Class 42:

Software platforms; hosting platforms on the internet; hosting of communication platforms on the internet; hosting electronic facilities and communication networks; Software as a service (SaaS); Platforms as a service (PaaS); Providing online non-downloadable software.

Average consumer and the purchasing act

56. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word "average" denotes that the person is typical. 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*.

57. I consider that the average consumer of the Applicant's class 9 goods and class 42 services will be both the general and professional public. The average consumer of the Opponent's *translation* services will, to my mind, likely most often be used by professional customers seeking the translation of documents. The class

³⁰ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

9 terms are broad and will encompass a vast range of software; from phone ‘apps’ for children’s games, to sophisticated software in specialist areas of business. In my view, the purchasing act will be primarily visual in nature, the average consumer likely to have encountered the service provider on a website or directory of services. I recognise that there will also be an aural aspect to the purchasing process in many cases; e.g. the purchase of a ‘Software as a Service’ package for a business will likely be carefully considered and may be made only after advice or consultation with the service provider. I find that the attention level of the average consumer will vary according to the service engaged. For example, the purchase of a mobile phone app to set up a social media account might entail a medium level of attention. On the other hand, a business customer might contemplating the purchase of a sophisticated software package might take a high measure of care during the purchasing act. The goods and services will therefore likely be purchased with a level of attention ranging from medium to high.

Comparison of the marks

58. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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 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.”

59. 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 created by the marks.

60. The marks to be compared are as follows:

Opponent's mark:	Applicant's mark:
	<p>CLICKWORK</p>

Overall impression of the marks

61. The Opponent's mark comprises the word element 'clickworker' rendered in a lightly stylised typeface, with a figurative element positioned above the final four characters. The stylisation is such that the characters 'c', 'o' and 'e' appear flattened and almost square-shaped. The figurative element is a device depicting a group of people in silhouette, each person rendered in a different colour (with the exception that two of the figures are the same shade of purple). I consider that both the word and figurative elements will play a role in the overall impression of the mark, with the word element playing a greater visual role due to its size and the fact that words generally 'speak louder' than devices.

62. The Applicant's mark is a word mark³¹ comprising the single element 'clickwork' rendered in a plain typeface. The overall impression, therefore, necessarily resides in the mark in its entirety.

³¹ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-*

Visual comparison

63. The marks share the characters 'C-L-I-C-K-W-O-R-K' in that order. The points of visual difference are:

- the presence of the characters 'er' at the end of the word element of the Opponent's mark, which are absent from the Applicant's mark;
- the presence of the device in the Opponent's mark, which is absent from the Applicant's mark.

The Applicant has conceded that the parties' marks are similar 'to a degree'.³² All things considered, I find the marks to have a high level of visual similarity.

Aural comparison

64. I consider that the marks will be articulated in the usual way: i.e. 'CLIK-WURK-UH' versus 'CLIK-WURK'. The only aural difference resides at the end of the marks; the 'UH' sound is present in the Opponent's mark, and absent from the Applicant's mark. I agree with the Opponent's submission that the marks have a high level of aural similarity.

Conceptual comparison

65. The Opponent has submitted the following on the matter of the conceptual message conveyed by its mark 'In this case, the person or thing (CLICK) conducts the work, i.e. worker (CLICKWORKER)'.³³ Whilst the Opponent's argument could have been expressed more clearly, I presume that the argument was intended to be that 'clickworker' will be perceived as denoting the person or thing that carries out 'clickwork'. Neither party has attempted to explain how the 'click' aspect of the mark will be perceived. To my mind, a significant proportion of average consumers will likely see 'click', in the context of the mark as a whole, and the relevant services, as an allusion to carrying out work online/computer-based tasks, i.e. 'at

Nederlanden Nederland (NN), T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).

³² Applicant's written submissions in lieu of a hearing, paragraph [16].

³³ Opponent's written submissions in lieu of a hearing, paragraph [[6].

the click of a mouse'. I find that the device depicting a group of people will likely be seen simply as a group of workers (or 'clickworkers'), merely reinforcing that the Applicant's mark 'clickwork' will likely be seen as a reference to work carried out online/computer-based tasks; the 'click' element likely being seen as alluding to a computer mouse. In the light of the foregoing, I find the marks to have a high level of conceptual similarity.

Distinctive character of the earlier mark

66. *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).”

67. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

68. I have found that the Opponent's mark will be perceived as referring to a worker who carries out their online or computer-based work 'at the click of a mouse'. It is my view that the mark is somewhat allusive of the relevant services (i.e. *translation services*) to the extent that it suggests that the service is perhaps performed or delivered electronically or using computers. I have found that the device will likely have the effect of reinforcing the idea of a group of workers available to carry out the services. I find the earlier mark to have a medium level of inherent distinctive character.

69. I now consider whether the mark enjoys an enhanced level of distinctiveness. The turnover figures referable to the UK market are modest and the marketing expenses for the UK are fairly low. Few invoices have been provided to evidence UK sales. No information has been provided on the size of the UK market for translation services and the Opponent's position within that market. Based on the totality of evidence available to me, I am unable to make a finding that the earlier mark has a level of distinctiveness beyond the medium level of inherent distinctive character that I have found above.

Likelihood of confusion

70. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*³⁴. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*³⁵, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by

³⁴ Case BL O/375/10 at [16].

³⁵ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

71. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [37]. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

72. I have found those of the Applicant's goods set out above at [55] to have some level of similarity with those of the Opponent: a low level for all goods except *Platforms as a service (PaaS)*, in Class 42, which I found to be similar to a 'very low' degree. I have found the parties' marks to be highly similar on all three planes of comparison. Visually speaking, the applied-for mark is wholly replicated in the Opponent's mark, the only verbal difference residing in the characters 'er' at the end of the word element of the earlier mark. The only aural distinction to be made between the marks is the final syllable 'UH' in the Opponent's mark. There is a close conceptual nexus between the marks, both evoking the idea of work carried out online or using a computer; albeit the Opponent's mark will be seen as denoting the person/thing conducting the work as opposed to the Applicant's mark, which will be perceived as denoting the work carried out. I have found that the multicoloured device will add little in terms of conceptual content to the Opponent's mark, merely serving to reinforce the idea of a group of workers. To my mind, the figurative element of a group of persons standing in silhouette is a fairly banal image, notwithstanding the multiple colours in which it is rendered. The earlier mark enjoys a medium level of distinctive character in the context of the relevant services (i.e. *translation services*, in class 41). Although the mark is somewhat allusive in so far as it is suggestive of work carried out on computers/online or 'at the click of a mouse', it cannot be said to be descriptive of the particular service *translation*

services. Taking into account all of the circumstances of the case, it is my view that a significant proportion of average consumers may encounter either of the parties' marks and, overlooking the difference in spelling (clickwork *versus* clickworker), and the presence of the device in the Opponent's mark, mis-remember one mark as being that of the other party. The fact that the word element of the Opponent's mark is lightly stylised is of no consequence because normal and fair use allows the Applicant to present its mark with such stylisation, should it so choose. I find that there is a likelihood of confusion between the parties' marks. I bear in mind the interdependency principle according to which 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). Whilst I recognise that this is not an absolute rule, I consider that the high levels of visual, aural and conceptual similarity in the instant case are such that there is a likelihood of confusion between the marks even where I have found the goods to have a very low level of similarity. There is a likelihood of direct confusion. I find this to be so, even in instances where the average consumer pays a high level of attention during the purchasing act.

73. I now consider whether there is a likelihood of indirect confusion. I note that in the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), 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.

74. In *L.A. Sugar Limited v Back Beat Inc*³⁶, Mr Iain Purvis Q. C. (as he then was), as the Appointed Person, explained that [my words in parentheses]:

³⁶ Case BL O/375/10

“17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] 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 [or vice versa], 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)”

75. I bear in mind that the above categories are not intended to be exhaustive. My view is that, in the instant case, a significant proportion of average consumers may notice the coloured device in the earlier mark, but overlook the slight difference in spelling due to imperfect recollection. I consider that the marks may be seen merely as variant marks deriving from the same undertaking. I therefore find that there is also a likelihood of indirect confusion.

Conclusion

76. The opposition has been partially successful. Subject to a successful appeal, the application is:

- refused in respect of the following goods and services only:

Class 9:

Software; platform software, application software, mobile apps, web application [...] software; collaboration software platforms; downloadable computer software; mobile application software

Class 42:

Software platforms; hosting platforms on the internet; hosting of communication platforms on the internet; hosting electronic facilities and communication networks; Software as a service (SaaS); Platforms as a service (PaaS); Providing online non-downloadable software.

- may proceed to registration in respect of the following goods and services only:

Class 9:

server software; computer software development tools; downloadable electronic publications, recorded content; software for transmission and receipt of data, images, and files, organizing and providing digital platforms.

Class 42:

computer services; development of computer platforms

COSTS

77. The parties have enjoyed a roughly equal measure of success. I therefore make no order for costs.

Dated this 3rd day of July 2024

**N. R. Morris
For the Registrar,
the Comptroller-General**