

BL O/0701/24

TRADE MARKS ACT 1994
CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

TRADE MARK APPLICATION NOS: 3620330 AND 3620233

BY LENDLEASE DIGITAL AUSTRALIA PTY LIMITED

TO REGISTER THE TRADE MARKS:



AND

PODIUM

IN CLASSES 9, 35 AND 42

-AND-


THE OPPOSITIONS THERETO UNDER NOS.

427736 AND 427737

BY PODIUM INVESTMENT

Background and pleadings

1. These consolidated proceedings concern two UK trade mark applications by Lendlease Digital Australia Pty Limited (“**the Applicant**”). The applications were filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU,¹ therefore they retain their original EU filing dates. Details of the applications are set out below:

The ‘330’ application	
Representation of the mark:	
Trade mark application No.:	3620330
Type of mark:	Figurative
UK Filing date:	1 April 2021
Retained EU filing date pursuant to Article 59 of the Withdrawal Agreement:	20 July 2020
Date of publication in the Trade Marks Journal:	23 July 2021

The ‘233’ application	
Representation of the mark:	PODIUM
Trade mark application No.:	3620233
Type of mark:	Word mark
UK Filing date:	1 April 2021
Retained EU filing date pursuant to Article 59 of the Withdrawal Agreement:	8 October 2020
Date of publication in the Trade Marks Journal:	23 July 2021

¹ ‘Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01)’, also known as the ‘Withdrawal Agreement’.

2. When filed, the applications both sought protection for goods and services in Classes 6, 9, 19, 35, 36, 37 and 42. The Applicant subsequently filed a Form TM21B for both applications,² making a request to remove goods and services from its specifications. The resultant amended specifications are identical to each other; registration of both marks is sought for goods and services in Classes 9, 35 and 42, which are laid out in their entirety at paragraph 20 of this decision.

3. On 25 October 2021, PODIUM INVESTMENT (“**the Opponent**”) opposed the ‘330’ and ‘233’ applications (opposition numbers 427736 and 427737 respectively) under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The oppositions are directed at all the applied-for goods and services (as amended).

4. The Opponent relies on its comparable UK trade mark (EU),³ for the word mark ‘PODIUM INVESTMENT’, trade mark registration number 916422354, which was filed on 2 March 2017 and has a registration date of 8 January 2018. The Opponent’s mark is registered in respect of services in Classes 35, 36, 37 and 42, which are laid out at paragraph 20 of this decision. For the purposes of the oppositions, the Opponent relies on all the services for which its mark is registered.

5. By virtue of its earlier filing date, the trade mark upon which the Opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As it had not been registered for more than five years at the filing date of the contested applications, it is not subject to the use conditions set out in section 6A of the Act. As such, the Opponent may rely on all the services for which its trade mark is registered, without having to show any use at all.

6. The Opponent argues that the marks are similar and that, notwithstanding the amendments made to the applied-for specification, the goods and services are identical or similar, giving rise to a likelihood of confusion.

² Dated 20 January 2024.

³ Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

7. The Applicant filed defences and counterstatements denying that its marks are similar to the Opponent's. Regarding the comparison of the goods and services it admitted some similarity as follows:

“The Proprietor admits that the services applied for in Classes 36, 37 and 42 are similar to those protected by the Opponent's Registration. However, it denies the Opponent's assertion that the goods applied for in Classes 6, 9 and 19 and services applied for in Class 35, are similar or identical.”

8. Given that the Applicant subsequently deleted Classes 36 and 37 from its application, the admission of similarity remains solely in relation to Class 42 – which I note was reduced to a single term following the filing of its defence and counterstatements. However, the Applicant denies that there is any likelihood of confusion, submitting (in relation to both oppositions) that:

“The relevant public is comprised of real estate and construction professionals, who will pay a high level of attention when purchasing those goods or procuring those services. On account of this high level of attention paid by the relevant public, which is perfectly capable of distinguishing the goods and services of one undertaking from those of another, the Applicant submits that no likelihood of confusion exists.”

9. Neither party elected to file evidence during the evidence rounds of these proceedings and neither party elected to file written submissions.

10. A hearing took place before me on 26 February 2024, at which the Opponent was represented by Ms Ruth Bond of Haseltine Lake Kempner LLP. The Opponent filed a skeleton argument in advance of the hearing. The Applicant has been represented by Lewis Silkin LLP throughout these proceedings, but elected not to attend the hearing, and did not file any submissions in lieu of attendance.

11. I make my decision following a careful consideration of the papers before me and the oral submissions made by the Opponent at the hearing.

Assimilated law

12. 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

Legislation and Case Law

13. Section 5(2)(b) and 5A the Act are as follows:

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

[...]

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v.*

Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:

- (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 good and services

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁴ (“**Meric**”), the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa (this principle equally applies to services).

16. Section 60A(1)(a) of the Act provides that for the purposes of the Act goods and services 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, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification.

17. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:⁵

- (1) the physical nature of the goods or acts of service;
- (2) their intended purpose;
- (3) their method of use / uses;
- (4) who the users of the goods and services are;
- (5) the trade channels through which the goods and services reach the market;

⁴ Case T- 133/05

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

- (6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);
or
- (8) whether they are complementary to each other.

18. Complementary means *“there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”*.⁶ Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.⁷

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

- (1) that it is *“necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”*, although *“where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods [and services] in question”*,⁸
- (2) where *“the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services”*,⁹
- (3) the following applicable principles of interpretation:

⁶ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

⁷ *Kurt Hesse v OHIM*, Case C-50/15 P

⁸ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

⁹ *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

“(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.”¹⁰

20. The goods and services to be compared are shown in the table below. I note that the Applicant’s Class 9 specification is subject to two limitations which I have emphasised for ease of reference.

Opponent’s specification	Applicant’s specification
	<p><u>Class 9</u></p> <p>Software in relation to a technology platform solution for real estate and infrastructure developments; computer hardware; downloadable software applications (apps) in relation to a technology platform solution for real estate and infrastructure developments; computer software platforms, recorded or downloadable; data processing equipment; apparatus for recording, transmission or reproduction of sound or images; communications equipment; measuring, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; databases; calculating devices;</p> <p><i>parts and accessories for all the aforesaid;</i></p> <p>electronic publications (downloadable);</p> <p><u>all of the aforesaid with respect to a technology platform solution for the lifecycle of real estate and</u></p>

¹⁰ See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

	<p><u>infrastructure developments namely scheme envisionment, development, design, creation, financing and asset management, construction, building operations, maintenance and tenancy management;</u></p> <p><u>all of the aforesaid excluding with respect to mortgage broking customer relationship management systems.</u></p>
<p><u>Class 35</u></p> <p>Advertising in the field of real estate and building; Auctioneering of property; Organisation and management of investment undertakings for construction and/or preparation of residential and non-residential buildings for sale, rental and leasing; Assistance in the management of real estate undertakings for development, sale, leasing and lending purposes; Organisation of trade fairs, exhibitions and promotions in the field of real estate affairs; Organisation of tenders on markets for trading in land, real estate, usable floor space and residential premises, rental of advertising space.</p>	<p><u>Class 35</u></p> <p>Business management; business administration; business project management services; supply chain management services; procurement services for others (purchasing goods and services for others).</p>
<p><u>Class 36</u></p> <p>Brokerage relating to purchasing, sale and rental of real estate; Real estate management; Organisation and management of funding for investment undertakings consisting in the construction and/or preparation of residential and non-residential buildings for sale; Rental, lending, real estate management, brokerage relating to the purchase, sale and leasing of buildings, premises and usable floor space, real estate appraisal, rental and/or leasing of real estate, residential premises and usable floor space; Administration of real estate, premises and usable floor space, consultancy relating to the management and administration of</p>	

<p>residential buildings and housing estates; Real estate agencies, real estate insurance, leasing of real estate, real estate investment; Information in the field of real estate; Advice on real estate management.</p>	
<p><u>Class 37</u></p> <p>Construction services; Repair, upkeep and maintenance of buildings; Plumbing and gas and water installation; Maintenance of plumbing; Maintenance and repair of utilities in buildings; Assembling [installation] of building framework; Electrical installation services; Maintenance and repair of gas and electricity installations; Installation of building automation equipment; Installation of door openers; Installation of security and safety equipment; Installation of apparatus for ventilating; Installation of security systems; Installation of lighting systems; Installation of sanitary apparatus; Installation of apparatus for air-conditioning; Installation of washroom apparatus; Retrofitting of ventilating installations in buildings; Retrofitting of air conditioning installations in buildings; Retrofitting of heating installations in buildings; Fire alarm installation and repair; Maintenance of fire alarm installations; Maintenance and repair services relating to automatic door equipment; Installation of fixtures and fittings for buildings; Wiring of buildings for telecommunication transmission; Installation of building scaffolds, working and building platforms; Beneath ground construction work relating to plumbing; Advisory services relating to the installation of building automation equipment; Advisory services relating to the installation of security and safety equipment; Installation of insulating materials in buildings, roofs and structures; Installation of computer, telecommunications and ICT systems, apparatus and equipment for use in</p>	

<p>building construction and architecture; Construction and maintenance of roadways; Laying of paving; Laying of asphalt; Ground levelling and soil compaction; Excavation services; Demolition of buildings, Completion of building works, Rental of construction and building equipment, Construction supervision services, Building of fair stalls and shops; Construction information; Building consultancy; Building construction information; Plant maintenance.</p>	
<p><u>Class 42</u></p> <p>Design in the field of building construction, city planning and technology; Building construction advisory services, architecture and interior design, architectural consultation; inspection of buildings; Technical supervision and inspection; Construction supervision of industrial installations; Drawing up energy performance certificates and energy auditing in the field of building construction; Design and development of information technology for buildings; Monitoring of events which influence the environment within buildings; Monitoring of activities which influence the environment within buildings; Design of controlled environmental buildings; Measuring the environment within buildings; Recording data relating to energy consumption in buildings; Professional consultancy relating to energy efficiency in buildings; Scientific and technical research; Design and development of computer, telecommunications and ICT hardware, apparatus, systems and software for use in building construction and architecture; Installation of computer software for use in building construction and architecture.</p>	<p><u>Class 42</u></p> <p>Research and development of new products for others.</p>

21. At the hearing Ms Bond began her submissions by providing a brief background of the Opponent, submitting that: *“Podium Investment are a Polish property developer. Their portfolio includes offices, residential and industrial facilities.”* When moving onto the goods and services comparison, Ms Bond submitted that the Applicant is *“also interested in property development and real estate, and that is actually backed up by the limitation that is applied to [its] Class 9 specification”*.

Class 9

22. Whilst I agree with Ms Bond that in making the comparison, attention must be drawn to the limitation, my comparison is not one which is based on taking the Opponent’s services and comparing them with the wording of the Applicant’s Class 9 limitation only. Thus, in making my comparison, I do not lose sight of the core meaning of the terms being compared.

23. Regarding the first limitation applied to the Applicant’s Class 9 goods, it is a positive limitation (therefore it does not exclude any goods or sub-categories of goods) and it states that those goods are all in respect to a specific *“technology platform solution”* for the *“lifecycle of real estate and infrastructure developments”*, which are boiled down to the following specific functionalities (the inclusion of the word ‘namely’ has the effect of restricting the *“platform”* to those specific functionalities): *“scheme envisionment, development, design, creation, financing and asset management, construction, building operations, maintenance and tenancy management”*.

24. With no evidence nor submissions from the parties to assist me in interpreting this limitation, I rely on the *“ordinary and natural meaning”* of the words used and in doing so, it is open to me to consult dictionaries as part of my decision making process.¹¹ In this regard, I note that the terms listed below are defined by the Oxford English Dictionary (‘OED’) and the Collins English Dictionary (‘CED’) as follows:

¹¹ See the Appointed Person’s decision in *SmartContract Chainlink Limited v Stripe, Inc*, BL O/0294/24 at paragraph [31], wherein the Appointed Person makes reference to a judgement of the General Court in Case T-222/09 *Ineos Healthcare v. OHIM* at paragraph [29] and the case law cited therein.

- “technology”

OED:

- The branch of knowledge dealing with the mechanical arts and applied sciences; the study of this.
- The application of such knowledge for practical purposes, esp. in industry, manufacturing, etc.; the sphere of activity concerned with this; the mechanical arts and applied sciences collectively. (Frequently with a modifying word such as: alternative technology, information technology).
- The product of such application; technological knowledge or know-how; a technological process, method, or technique. Also: machinery, equipment, etc., developed from the practical application of scientific and technical knowledge; an example of this. Also in extended use.

CED:

- Technology refers to methods, systems, and devices which are the result of scientific knowledge being used for practical purposes.

- “platform”

OED:

- *Computing.* A standard system architecture; a (type of) machine and/or operating system, regarded as the base on which software applications are run.
- An online system through which a service is provided or digital products are sold; a website or application that provides access to digital content; esp. one that hosts user-generated content that can be shared and engaged with by other users. Frequently with modifying word.

CED:

- A platform is a particular type of computer hardware or computer operating system.

- “Life cycle” / “lifecycle”

OED:

- In extended use: a course or evolution from a beginning, through development and productivity, to decay or ending. (Frequently in economic or business contexts.)

CED:

- The life cycle of something such as an idea, product, or organization is the series of developments that take place in it from its beginning until the end of its usefulness.

25. I therefore interpret the limitation as referring to a central operating system (or hub) upon which various computer hardware, software, software applications, various technologies, equipment etc. can be integrated and run; this platform being the basis for running real estate and infrastructure developments throughout their entire lifecycle, i.e. from inception and design, to the financing of the developments, to the building of them, right through to the maintenance of the buildings and the management of tenants once those developments are built – the platform being the central hub to access all the relevant technology / software for each stage in that lifecycle.

26. In addition, by operation of the second limitation, none of the Applicant's Class 9 goods relate to mortgage broking customer relationship management systems (which I interpret to mean a form of software system).

27. With the foregoing in mind, I turn to the comparison of the respective goods and services and note that in general terms, goods and services are different in their nature, purpose and method of use. The same can be said of the Applicant's Class 9 goods when compared with the Opponent's services, therefore I proceed with my comparison with these factors pre-determined.

28. Ms Bond took me through the Applicant's specification submitting which of the Opponent's terms are considered to be identical or similar to each applied-for term. I have taken her submissions into consideration and refer to them below where necessary. In essence, her submissions are, for the most part, that the applied-for goods and services are either identical or similar to the Opponent's services.

29. The tables below follow the comparisons drawn by Ms Bond at the hearing, therefore I will address them in that order, however, in reaching my conclusions I have kept in mind the entirety of the Opponent's specification and where relevant/ appropriate, I have referred to other terms in the Opponent's specification which

Ms Bond did not direct me to at the hearing. For ease of reference, I have not inserted in the tables the limitations which apply to the Applicant's Class 9 goods, however, for the avoidance of doubt, I have kept them in mind.

Applicant's term(s)
<p><u>Class 9</u></p> <ul style="list-style-type: none"> • <i>software in relation to a technology platform solution for real estate and infrastructure developments;</i> • <i>downloadable software applications (apps) in relation to a technology platform solution for real estate and infrastructure developments;</i> • <i>computer software platforms, recorded or downloadable;</i> • <i>computer hardware.</i>
Opponent' term(s)
<p><u>Class 42</u></p> <ul style="list-style-type: none"> • <i>design and development of information technology for buildings;</i> • <i>design and development of computer, telecommunications and ICT hardware, apparatus, systems and software for use in building, construction and architecture.</i>
Ms Bond's Submissions
<p>"The channels of trade, the interests of both [the Applicant] and [the Opponent] are identical. [...] I just draw your attention [...] to their Class 9, [...] where it says "<i>all of the aforesaid with respect to a technology platform solution for the lifecycle of real estate and infrastructure developments, namely scheme envisionment, development, design, creation, financing and asset management, construction, building operations, maintenance and tenancy management</i>". As you can see, it is all very real estate heavy and very similar if not identical trade channels to those of [the Opponent]."</p> <p>"They must, in my submission, be considered to be similar to both of the [Opponent's] terms that I have pointed out in class 42."</p>

30. Software and hardware are the end results of their design and development. The relationship between the software and hardware on the one hand, and the design and development services to create them on the other is therefore complementary, with

the average consumer believing one undertaking is responsible for providing both the goods and the services.

31. I also find that the trade channels will overlap, as undertakings that design and develop software and hardware may also provide the Applicant’s software and hardware in Class 9, particularly when taking into consideration that the comparison is between services for the design and development of information technology for buildings, and the design and development of software and hardware for use in buildings and construction on the one hand; and on the other hand, software and hardware goods “with respect to a technology platform solution for the lifecycle of real estate [...] developments” including the development and design of the real estate itself (which could encompass architectural planning and design), its construction and the operation of the building thereafter. The users will also be the same.

32. As a result, overall, I consider the goods and services to be similar to a **medium degree**.

Applicant’s term(s)
<u>Class 9</u> <ul style="list-style-type: none"> • <i>data processing equipment.</i>
Opponent’ term(s)
<u>Class 42</u> <ul style="list-style-type: none"> • <i>Recording data relating to energy consumption in buildings.</i>
Ms Bond’s Submissions
<p>“[The Applicant’s] data processing equipment [...] does not actually specifically talk about the type of data that it might be relating to but we have to assume -- obviously it has got a limitation here -- that it is to do with buildings. [...] We have to assume therefore that the data processing equipment that they will be using will be the same equipment or at least complementary to the equipment that [the Opponent] use[s] to record [its] data in relation to the energy consumption in buildings, so there is a definite complementarity here as well.”</p>

33. To that comparison, I add these Class 42 terms contained in the Opponent's specification:

- *Monitoring of events which influence the environment within buildings;*
- *Monitoring of activities which influence the environment within buildings;*
- *Measuring the environment within buildings.*

34. Firstly, I have to point out for the sake of clarity, that when making the comparison, I am not taking into account what the parties are "using". Ms Bond is conflating the parties with the average consumer by using terminology such as, what "they will be using" and what the Opponent uses. I am only concerned with the goods and services that will be offered to the average consumer based upon how they are worded in the parties' specifications and I am not concerned with anything the parties are 'using' internally to run their own businesses.

35. That said, I agree with the premise of Ms Bond's submissions i.e. that some similarity exists between the respective goods and services.

36. The Applicant's "*data processing equipment*" is in relation to a technology platform solution which, inter alia, relates to the lifecycle of a real estate development including *building operations and maintenance*, which could encompass data processing equipment which captures data about how a building performs e.g. from an energy efficiency standpoint etc.

37. Therefore, it could capture data about the *environment within a building* and its *energy consumption*. In a large real estate development (such as commercial buildings, hospitals etc.), this could conceivably encompass data processing equipment that is installed in a building, (such as in a plant room) to monitor and record the relevant data, which is then uploaded to a central operating system i.e. a technology platform.

38. The relationship between the Applicant's *data processing equipment* and the services for *recording data in relation to energy consumption of a building*, and the *monitoring and measuring of events which influence the environment within buildings* is therefore complementary, with the average consumer likely to believe one undertaking is responsible for providing both the goods and the services. For example,

the owner of a building equipped with specialist data processing equipment may require the services of a specialist surveyor (perhaps even the undertaking who installed it) to use the equipment in a plant room to record the necessary data and report on it.

39. I also find that the trade channels will overlap, as undertakings that provide the recording, monitoring and measuring services may also provide the Class 9 goods. The users will also be the same.

40. The respective goods and services are therefore similar to a **low to medium degree**.

Applicant's term(s)
<p><u>Class 9</u></p> <ul style="list-style-type: none"> • <i>apparatus for recording, transmission or reproduction of sound or images;</i> • <i>communications equipment.</i>
Opponent' term(s)
<p><u>Class 42</u></p> <ul style="list-style-type: none"> • <i>Recording data relating to energy consumption in buildings.</i>
Ms Bond's Submissions
<p>"That apparatus for recording must be a similar apparatus that is used by my client for recording its data. So again, even though it might be -- where obviously it is the service that we provide and they are providing the actual product to record that data, there is a definite similarity. There is a crossover there between the two arguably ancillary products if not the same products.</p> <p>[...]</p> <p>'Communications equipment' to me could be a whole range of things. It could simply be the communication of reporting all of these certificates and data that is recorded by [the Opponent] during the services that they provide. [...] It might be just an ancillary service that is not necessarily listed here because [the Opponent] is not a communications company.</p>

41. Ms Bond's submissions appear to be misguided and I disagree with them. I cannot see a similarity between the Applicant's services above and the Opponent's "recording

data relating to energy consumption in buildings”, for example, notwithstanding data can be communicated using certain apparatus, the service of recording the data is not similar to the means by which it is communicated nor are they complementary to each other. That said, this is not sufficient reason for me to overlook other services in the Opponent’s specification where a comparison can be drawn. In this regard I note that the Opponent’s Class 42 includes the following services (which I consider to be an appropriate comparator to the Applicant’s services identified in the table above):

- *Design and development of computer, telecommunications and ICT hardware, apparatus, systems and software for use in building construction and architecture.*

I interpret the Opponent’s term as being the design and development of:

- computer hardware, apparatus, systems and software for use in building construction and architecture;
- telecommunications hardware, apparatus, systems and software for use in building construction and architecture; and
- ICT hardware, apparatus, systems and software for use in building construction and architecture.

42. Although Ms Bond has submitted that the Opponent is not a communications company, its mark is nonetheless registered in respect of services for the design and development of telecommunications and ICT for use in building construction, furthermore, I am required to consider a notional and fair use of the earlier mark in relation to all of the services in respect of which it is registered.

43. It is my understanding that the term ‘ICT’ is an abbreviation for ‘Information and Communications Technology’ and that ICT hardware, apparatus, and systems enable the transmission of information. They include “*equipment such as radio, telephone and fax*”¹² i.e. apparatus for the transmission or reproduction of sound (in the case of phone or radio) and images (in the case of faxes). The Opponent’s term is limited to ‘use in building construction and architecture’.

¹² See the definition of ‘ICT’ contained in the Oxford English Dictionary.

44. With regard to the Opponent’s design and development of ‘telecommunication’ hardware, apparatus and systems, I consider this would relate to the design and development of apparatus for the recording, transmission and reproduction of sound or images (which is how I interpret ‘telecommunications’ equipment), for use, inter alia, ‘in building construction’.

45. The Applicant’s “*apparatus for recording, transmission or reproduction of sound or images; communications equipment*” can encompass a wide range of goods, not least ICT and telecommunications hardware, apparatus, and systems – all for use in relation to a platform for real estate development which includes the construction of such real estate.

46. The Applicant’s goods are the end results of their design and development. The relationship between the respective goods and services is therefore complementary, with the average consumer likely to believe one undertaking is responsible for providing both the goods and the services.

47. I also find that the trade channels will overlap, as undertakings that design and develop such apparatus may also provide the apparatus in Class 9. The users will also be the same. The respective goods and services are therefore similar to a **low to medium degree**.

Applicant’s term(s)
<p><u>Class 9</u></p> <ul style="list-style-type: none"> • <i>measuring, detecting, testing, inspecting, life-saving and teaching apparatus and instruments.</i>
Opponent’ term(s)
<p><u>Class 42</u></p> <ul style="list-style-type: none"> • <i>Measuring the environment within buildings;</i> • <i>Monitoring of activities which influence the environment within buildings.</i>

48. To that comparison, I also add the Opponent's Class 42 services of "*inspection of buildings*" and its Class 37 "*installation of [...] safety equipment; fire alarm installation [...]*".

Measuring, detecting, testing, inspecting, [...] apparatus and instruments

49. Firstly, within the context of the Opponent's services, I interpret 'the environment within buildings' to relate to the ambient environment and 'inspection of buildings' to relate to both pre and post construction i.e. buildings can be inspected during the construction process to ensure compliance with rules and regulations, and they can also be inspected post construction for reasons of general building operations and maintenance.

50. Secondly, addressing the Applicant's "*measuring, detecting, testing and inspecting apparatus and instruments*", this is a broad range of goods, however, considering them within the context of the limitation which applies to them, "*a technology platform solution [...] namely building operations [and] maintenance*", I think they could encompass the following examples:

- apparatus and equipment for measuring ambient temperature, (such as thermostats) which would be needed in a heating system in a building;
- apparatus to detect smoke within a building as part of a fire alarm system;
- equipment to test for any carbon monoxide in a building; or
- apparatus to inspect a building for any mold growth.

51. I have borne in mind that just because an undertaking provides a certain service, does not necessarily mean that it also provides the goods necessary in order for it to carry out that services, so for example, if a builder is providing construction services to a client, they would not also sell their client the tools they need to carry out that construction, but they could sell them fixtures and fittings as part of the provision of that construction work. Therefore, an undertaking providing the services of "*measuring the environment within buildings*" and "*inspection of buildings*" could, for example, be carrying out inspection of fire alarm systems which they have installed, and those fire

alarms may have been made and supplied by them i.e. the inspection services would be carried out by the manufacturer.

52. Consequently, I find that a **low degree** of similarity exists between the respective goods and services on the basis that they would be complementary, with the average consumer likely to believe one undertaking is responsible for providing both the goods and the services.

“[...] *life-saving [...] apparatus and instruments*”

53. A degree of similarity exists between the Applicant’s “*life-saving apparatus and instruments; [etc.]*”, and the Opponent’s Class 37 “*installation of [...] safety equipment; fire alarm installation [...]*”, since I regard ‘life-saving apparatus and instruments’ to encompass ‘safety equipment’ and ‘fire alarms’. Albeit the Applicant’s goods are subject to a limitation, this does not alter the nature of the goods themselves. The goods, for example, could form part of an installation found in commercial/public buildings (smoke detectors, sprinkler systems etc. all wired to the alarm). I therefore consider the services are likely to be complementary to the goods since one is important for the other, therefore the average consumer may presume they originate from the same undertaking. I also bear in mind that the provider and installer of ‘safety equipment’ and ‘fire alarm systems for buildings’ may also be the manufacturer of those goods and therefore the respective goods and services may share the same trade channels and may also share the same user. The respective goods and services are therefore similar to a **low degree**.

“[...] *teaching apparatus and instruments*”

54. Applying all the applicable principles of interpretation, I do not consider there to be any similarity between the Applicant’s “*teaching apparatus and instruments*” and any of the Opponent’s services, since the limitation cannot alter the nature of the Applicant’s goods, i.e. they are for teaching, neither do I find them to be complementary. These goods are therefore **dissimilar**.

Applicant's term(s)
<u>Class 9</u> <ul style="list-style-type: none"> • <i>Databases.</i>
Opponent' term(s)
<u>Class 42</u> <ul style="list-style-type: none"> • <i>Recording data relating to energy consumption in buildings;</i> • <i>Design and development of computer, telecommunications and ICT hardware, apparatus, systems and software for use in building construction and architecture.</i>

55. The term 'databases' refers to: *"a body of data which forms the basis for a piece of research, a report; a structured set of data held in computer storage and typically accessed or manipulated by means of specialized software (a database in its simplest form typically consists of a single file containing multiple records)."*¹³

56. The Applicant's 'databases' are a body of data in *"respect to a technology platform solution for the lifecycle of real estate and infrastructure developments namely scheme envisionment, development, design, creation, financing and asset management, construction, building operations, maintenance and tenancy management"*.

57. The Applicant's services for the recordal of data relating to the energy consumption of buildings would result in the creation of a body of data. It is conceivable that an undertaking gathering such data is doing so in order to advise its clients in relation to making adjustments to a building, for example, in relation to its windows, insulation etc. in order to make those buildings more energy efficient, and the data collected would likely be provided to the client in the form of a report (i.e. a structured set of data); the databases of information could also be uploaded onto a platform that their client has access to, so that the client could monitor and/or print off reports for themselves. Taking this into account, there appears to be a complementarity between the Applicant's goods and the Opponent's services of *"recording data relating to energy consumption in buildings"*, such that a consumer will assume that they come

¹³ Definition obtained from the Oxford English Dictionary.

from the same undertaking. These goods and services are therefore similar to a **low degree**.

Applicant's term(s)
<u>Class 9</u> <ul style="list-style-type: none"> • <i>Calculating devices.</i>
Opponent' term(s)
<u>Class 42</u> <ul style="list-style-type: none"> • <i>Measuring the environment within buildings.</i>
Ms Bond's Submissions
<p>"measuring the environment within buildings, the recording of the data must also be computed by a device and that could be a calculating device. Again, it is not entirely clear from the application what that calculating device would actually calculate but if it is related to, as it should be, the real estate and the infrastructure then it is certainly a product that would be complementary or ancillary to the services of [the Opponent's] specification."</p>

58. Whilst I acknowledge Ms Bond's comparison, her submissions appear misguided and I disagree with them. I cannot see a similarity between the Applicant's services above and the Opponent's services for "*measuring the environment within buildings*". Whilst I appreciate that some form of calculating device may be necessary to measure the environment within buildings, this is not in and of itself sufficient; if complementarity exists, the degree of complementarity would not be sufficiently pronounced for a finding of similarity.¹⁴

59. Instead, I consider the following services contained in the Opponent's Class 42 specification, to be an appropriate comparator to the Applicant's '*calculating devices*':

- *Design and development of information technology for buildings;*

¹⁴ I note that there is no rule that 'complementarity' always and necessarily equals 'similarity'. See *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, paragraph 22, in which the Appointed Person quoted: *Assembled Investments (Proprietary) Ltd v. OHIM*, T105/05, paragraphs 30 to 35 (which was upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*, C-398/07P, paragraphs 34, 35).

- *Design and development of computer, telecommunications and ICT hardware, apparatus, systems and software for use in building construction and architecture;*

60. The term “*calculating devices*” is broad and covers any device that can perform numerical calculations, therefore it can encompass simple calculators as well as more sophisticated devices such as computers which are forms of hardware / information technology.

61. I have already found that hardware is the end result of its design and development, therefore the relationship between the hardware on the one hand, and the design and development services to create it on the other is complementary.

62. In this instance, since the Applicant’s ‘calculating devices’ are in relation to a ‘*technology platform solution for the lifecycle of real estate*’, namely the construction thereof, I find that the trade channels of the respective goods and services will also overlap, as undertakings that design and develop ‘information technology for buildings’ and ‘computer hardware and apparatus for use in building construction’ may also provide the Applicant’s ‘calculating devices’. The users will also be the same.

63. As a result, overall, I consider the goods and services to be similar to a **medium degree**.

Applicant’s term(s)
<u>Class 9</u> <ul style="list-style-type: none"> • “<i>parts and accessories for all the aforesaid</i>”

64. The “*parts and accessories*” for all aforementioned Class 9 goods are also included in the application. Where the parts and accessories relate to goods that I have found to be similar, then there is also similarity between the parts and accessories for those goods. It therefore follows that where the goods are found to be dissimilar, so too will the parts and accessories for those goods be dissimilar.

Applicant's term(s)
<u>Class 9</u> <ul style="list-style-type: none"> • <i>electronic publications (downloadable).</i>
Ms Bond's Submissions
[The Opponent] does not have that covered so I cannot say anything more on that.

65. I agree with Ms Bond's concession, these goods are **dissimilar** to the Opponent's services.

Class 35

Applicant's term(s)
<u>Class 35</u> <ul style="list-style-type: none"> • <i>Business management;</i> • <i>business administration;</i> • <i>business project management services.</i>
Opponent' term(s)
<u>Class 35</u> <ul style="list-style-type: none"> • <i>Organisation and management of investment undertakings or construction and/or preparation of residential and non-residential buildings for sale, rental and leasing;</i> • <i>Assistance in the management of real estate undertakings for development, sale, leasing and lending purposes.</i>
Ms Bond's Submissions
<p>"It is my submission that the organisation and management of investment undertakings for construction must relate to the general business management of a company, in this case a construction company. "Business management" is covered by the applications, as is "business administration". It is also highly likely that in terms of a real estate undertaking, that there are numerous projects within the building and design and construction of a development that there must be implied</p>

project management services as well, so I also submit that the term “business project management services” is similar if not identical and encompassed within my client’s term also.”

66. The Applicant’s terms are broad terms which would encompass the Opponent’s terms. I therefore consider they would be identical on the principle outlined in *Meric*.

Applicant’s term(s)
<u>Class 35</u> <ul style="list-style-type: none"> • <i>supply chain management services</i>
Opponent’ term(s)
<u>Class 35</u> <ul style="list-style-type: none"> • <i>Organisation and management of investment undertakings or construction and/or preparation of residential and non-residential buildings for sale, rental and leasing.</i>
Ms Bond’s Submissions
<p>“Organisation and management of investment undertakings of construction, as covered by [the Opponent], must also surely contain “supply chain management services” [...]. Supply chain management services is obviously the buying of the goods that are required for that project, that building, that development, so I think it must be covered also by my [the Opponent’s] Class 35 specification.”</p>

67. The term ‘supply chain’ (in relation to business) refers to the processes involved in the production and distribution of a commodity or the supply of a service. In relation to real estate, it could encompass the processes involved at every stage from the construction of a building (including the sourcing and supply of materials for construction) to putting the building on the market with an agent to ultimately making a property available to the real estate customer i.e. the buyer or tenant. I therefore consider the Applicant’s broad term to encompass the Opponent’s services and the respective services are therefore **identical** on the principle outlined in *Meric*.

Applicant's term(s)
<u>Class 35</u> <ul style="list-style-type: none"> • <i>procurement services for others (purchasing goods and services for others)</i>
Opponent' term(s)
<u>Class 35</u> <ul style="list-style-type: none"> • <i>Organisation of tenders on markets for trading in land, real estate, usable floor space and residential premises, rental of advertising space.</i>
Ms Bond's Submissions
<p>"Procurement is defined by the Cambridge Dictionary as <i>"the process by which an organisation buys the products or services its needs from other organisations"</i>. It is quite common in commerce for organisations to put their goods and services that they require out to tender in order to get the best service and the best deal.</p> <p>[The Opponent's] specification covers "organisation of tenders or markets for trading in land, real estate, usable floor space and residential premises, rental and advertising space". So I do think that procurement services and the organisation of tenders on markets for trading are also identical and if not identical they are highly similar. Again, thinking about the trade channels, who the service is actually aimed at, the crossover between the services provided by [the Opponent] and those provided by [the Applicant] is clear. They are identical services in Class 35. If not identical they are highly similar."</p>

68. I agree with Ms Bond's submissions. I consider the Applicant's service is broad and would encompass the Opponent's services. These services are therefore **identical** on the principle outlined in *Meric*.

Class 42

Applicant's term(s)
<u>Class 42</u> <ul style="list-style-type: none"> • <i>research and development of new products for others</i>

Opponent' term(s)

Class 42

- *Scientific and technical research; Design and development of computer, telecommunications and ICT hardware, apparatus, systems and software for use in building construction and architecture.*

Ms Bond's Submissions

"The application covers "research and development of new products for others". This is non-specific in that they have not actually defined what those new products could be but obviously in the context of Class 42 they must be considered to be similar to [the Opponent's] "design and development of computer, telecommunications and ICT hardware, apparatus, systems and software for use in building construction and architecture".

[The Opponent] also has [...] "scientific and technical research", which is a very broad term and therefore it must include the research and development of new products for others as covered by the application. That obviously is supported by the 'Gerard Meric' case, where goods that are designated by the trade mark application are included into a more general category which is designated by the earlier mark. So I think our general category of "scientific and technical research" is very broad and would naturally cover the "research and development of new products for others. [...] So I would say that was identical [...], if it is not identical then it is certainly similar."

69. I agree with Ms Bond's submissions. I consider the Applicant's service to be broad and would encompass the Opponent's services. These services are therefore **identical** on the principle outlined in *Meric*. In the alternative they are similar to at least a high degree, and on the point of similarity, I bear in mind that the Applicant admitted that similarity exists between the respective Class 42 specifications.

Conclusion on the comparison of the goods and services

70. I have found that save for two terms, the applied-for goods and services are either identical or similar to the Opponent's services. Since some similarity between the

goods and services is required for the purposes of a section 5(2)(b) claim, the opposition must fail in respect of the following dissimilar goods:¹⁵

“Teaching apparatus and instruments; parts and accessories for all the aforesaid; electronic publications (downloadable); all of the aforesaid with respect to a technology platform solution for the lifecycle of real estate and infrastructure developments namely scheme envisionment, development, design, creation, financing and asset management, construction, building operations, maintenance and tenancy management; all of the aforesaid excluding with respect to mortgage broking customer relationship management systems.”

71. I therefore proceed to consider a likelihood of confusion only in relation to the goods and services that I have found to be identical and/or similar.

The average consumer and the nature of the purchasing act

72. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word ‘average’ merely denotes that the person is typical,¹⁶ which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.¹⁷ It is therefore necessary to determine who the average consumer of the goods and services is, and how the consumer is likely to select them.

73. The average consumer of the respective goods and services in play are likely to be professionals.

¹⁵ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (case of the CJEU); and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

¹⁶ *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), paragraph 60

¹⁷ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

74. In selecting the goods and services, the average consumer will take various factors into account such as cost, whether the goods and services meet their specific needs and/or perform specific functions. Consequently, the level of attention paid during the selection process will be medium to high.

75. The goods are likely to be selected visually, through catalogues, websites etc., although I do not discount that oral recommendations may play some part in the selection process by way of consultation/discussion with the provider. Therefore, the way the respective marks look is of primary importance, but the way they sound must also be taken into account.

Comparison of marks


76. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union stated in *Bimbo SA v OHIM*,¹⁸ 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.”

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

¹⁸ Case C-591/12P, at paragraph 34.

78. The respective trade marks are shown below:

Earlier mark	Contested marks
<p style="text-align: center;">PODIUM INVESTMENT</p>	<p><u>The '330' application:</u></p> <div style="text-align: center;">  </div> <p><u>The '233' application:</u></p> <p style="text-align: center;">PODIUM</p>

Overall impression

79. The overall impression of the earlier mark lies solely in the two words 'PODIUM INVESTMENT'. Ms Bond submitted words to the effect that the Opponent's Class 36 specification includes services relating to investment activities and as such concluded that *"INVESTMENT really is descriptive of [the Opponent's] services and therefore the dominant element is the word PODIUM."*

80. The term 'investment' is commonly understood to mean the action or process of investing money into something/ buying something, with the aim of being able to profit from it in the future. Whilst I appreciate that the word may be seen to describe some of the Opponent's Class 36 services, I have not found similarity between the Opponent's Class 36 services and the applied-for goods and services.

81. However, the Opponent's Class 35 services include for example, *"Organisation and management of investment undertakings for construction and/or preparation of residential and non-residential buildings for sale, rental and leasing; Assistance in the management of real estate undertakings for development, sale, leasing and lending purposes"* and therefore the word 'investment' would be perceived as having an allusive quality in relation to those services. Consequently the word 'investment' may, in certain circumstances be accorded less weight.

82. That said, due to its positioning as the first word in the mark, 'PODIUM' will have the greatest impact on how consumers will perceive the mark since, as a general rule of thumb, the first part of a mark normally carries a greater significance and it is where consumers tend to focus their attention.¹⁹

83. The overall impression of the '330' application lies in the word Podium which has a stylised circular device to the left of it. The device is rather banal and I consider it has limited weight relative to the word 'Podium', such that it is the word 'Podium' that dominates the overall impression of the mark. In this regard I note that *"according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements"*.²⁰

84. The overall impression of the '233' application lies solely in the word PODIUM, being its only element.

Visual comparison

85. A word mark protects the word itself and the comparison must be made on the basis of the word, not any particular presentation of the word. The protection of a word mark is not limited by any features such as capitalisation or the typeface which appears on the Register,²¹ as such those features do not provide a point of distinction when comparing a word-only mark with a figurative mark, where the figurative mark comprises of words in a stylised font.²²

86. The word 'PODIUM' is wholly reproduced in the contested marks and therefore this element is identical to the earlier mark. The identity lies in the first word of the earlier mark, therefore, given my earlier comments about the average consumer

¹⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81

²⁰ *Migros-Genossenschafts-Bund v EUIPO – Luigi Lavazza (CReMESPRESSO)*, Case T-189/16, paragraph 52

²¹ See the comments of Iain Purvis KC, sitting as the Appointed Person in the following two cases: *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14, paragraph 21; and *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraph 37.

²² *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22.

tending to focus their attention at the beginning of a mark, this identity has a significant impact when comparing the marks as a whole.

87. The word 'INVESTMENT' presents a point of dissimilarity. Notwithstanding it alludes to certain services for which the earlier mark is registered, that does not in any event render it negligible,²³ and it cannot be overlooked in a visual comparison.

88. The circular device in the '330' mark also presents a point of dissimilarity, however, given my earlier comments regarding the limited relative weight of this device it does not represent a significant point of distinction.

89. Overall, I assess the degree of visual similarity between the competing marks as medium.

Aural comparison

90. The word 'PODIUM' will be pronounced identically in the respective marks and that identity lies in the first word of the earlier mark. The circular device in the '330' mark will not be articulated.

91. The word 'INVESTMENT' represents a point of difference between the competing marks. Although it is allusive of certain services, that does not render it aurally invisible,²⁴ therefore overall, I assess the degree of aural similarity between the competing marks as medium.

Conceptual comparison

92. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.²⁵ Ms Bond submitted that the word 'PODIUM' refers to a raised platform, stating *"I imagine the Olympics, when the winners of the race for example will stand on the podium to collect their medal, or it could be a stage where somebody is speaking to a large group of people."* I agree with Ms Bond's definition. The word PODIUM is an ordinary, well-known English word for a raised platform.

²³ *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22.

²⁴ *Ibid.*

²⁵ This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

93. Since the competing marks all share this word, they share the same identical concept in relation to that word, and that identity lies at the beginning of the earlier mark.

94. The circular device in the '330' mark is banal and does not alter nor add anything to the concept of the word 'Podium' in the mark.

95. I have already commented on the meaning of the word 'INVESTMENT'. This obviously represents a point of difference between the competing marks. The earlier mark is a composite mark, however, when the word 'INVESTMENT' is considered together with the word 'PODIUM', the average consumer would not perceive the composite mark as a unit, having a different meaning to the meanings of the separate components which make up the composite mark.²⁶ As such, the earlier mark will be viewed as a combination of two known words with no real meaning (when combined) outside of the meanings associated with those individual words.

96. That said, in comparing the respective marks I do not ignore the presence of the word 'INVESTMENT' and therefore overall, the degree of conceptual similarity between the competing marks is medium.

Distinctive character of the earlier trade mark

97. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be.²⁷ Although it is the distinctive character of a component that is similar /identical between the competing marks that is particularly relevant – *“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.”*²⁸

²⁶ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*, [2015] EWHC 1271 (Ch).

²⁷ *Sabel v Puma*.

²⁸ *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, paragraphs 38 and 39.

98. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,²⁹ 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 [...].”

99. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

100. The Opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, and has filed no evidence of use, therefore I only have the inherent distinctiveness of the mark to consider.

101. I do not consider the word PODIUM to have any allusive qualities with regard to the services for which it is registered. It is an ordinary word which enjoys a medium degree of inherent distinctive character. The word ‘INVESTMENT’ is however allusive of certain services for which it is registered but it is not allusive of others. That said, it is the type of word one would expect to see as a non-distinctive addition to a primary indicator of trade origin, such that it is likely to be accorded less weight in the minds of the average consumer when viewing the mark overall. In my opinion, the mark has a

²⁹ Case C-342/97.

medium degree of inherent distinctive character overall, owing to the presence of the word 'PODIUM'.

Conclusions on Likelihood of Confusion

102. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.³⁰ I must also consider the average consumer of the goods and services, the nature of the purchasing/selection process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa.³¹

103. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.³² The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.³³

104. It is well established that confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark.³⁴

³⁰ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

³¹ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

³² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

³³ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

³⁴ See *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion.

105. I have found as follows:

- (1) the competing goods and services still in play are either identical or similar to varying degrees, although for the most part, where similarity is found, the degree is low;
- (2) the average consumer is likely to be a professional user, who will pay a medium to high degree of attention when selecting the goods and services;
- (3) the selection process is predominantly visual, although I do not discount an aural component;
- (4) the overall impression of the contested marks lies in the word 'PODIUM'. The competing marks share visual, aural and conceptual identity with regard to the word 'PODIUM' which I have found is a component which has greater impact in the overall impression of the earlier mark;
- (5) owing to the presence of the word 'INVESTMENT' in the earlier mark, the competing marks are visually, aurally and conceptually similar to a medium degree overall;
- (6) the average consumer would not perceive the earlier mark as a unit, having a different meaning to the meanings of the separate components; and
- (7) the earlier mark is distinctive overall to a medium degree, although that distinctiveness is owing to the presence of the word 'PODIUM', with the word 'INVESTMENT' unlikely to be accorded much weight in the overall assessment of the distinctive character of the mark.

106. The shared identity of the word 'PODIUM' is a factor in favour of the Opponent. Notwithstanding the earlier mark is a composite mark made up of two components, it is the word 'PODIUM' that has particular impact due to its placement as the first word of the mark, where consumers tend to focus their attention. Furthermore, unlike the word 'INVESTMENT', the word 'PODIUM' does not allude to any of the Opponent's services and is the most distinctive element of the two, with its meaning remaining unaltered notwithstanding it forms part of a composite mark (a consumer will perceive the word 'PODIUM' in the same way in the earlier mark as it would in the contested marks). Thus, distinctiveness is provided by an aspect of the earlier mark which has an identical counterpart in the contested marks.

107. Whilst I take into account that the applied-for goods and services are, for the most part, only similar to a low degree, I bear in mind that any degree of similarity, even a low degree, is sufficient in order to consider a likelihood of confusion, I also bear in mind the principle of interdependency.

108. Taking all the above factors into consideration, and allowing for imperfect recollection, I find that the average consumer (or at least a significant proportion thereof) who is paying between a medium and high degree of attention, will nonetheless be confused as to the origin of the goods and services. This is because they will either mistake one mark for the other due to the shared identity of the word PODIUM and will therefore be directly confused; or they will be indirectly confused. Indirect confusion would arise where they note that the earlier mark contains the word 'INVESTMENT', but they attribute that difference as one which they would expect to find in a sub-brand or brand extension, particularly when bearing in mind the potential allusive nature of that word.

OUTCOME

109. The opposition under section 5(2)(b) of the Act is partially successful. Subject to any appeal, the contested trade mark applications, numbers 3620330 and 3620233, shall be **accepted** for registration only in respect of the following goods:

Class 9

Teaching apparatus and instruments; parts and accessories for all the aforesaid; electronic publications (downloadable); all of the aforesaid with respect to a technology platform solution for the lifecycle of real estate and infrastructure developments namely scheme envisionment, development, design, creation, financing and asset management, construction, building operations, maintenance and tenancy management; all of the aforesaid excluding with respect to mortgage broking customer relationship management systems.

110. The trade mark applications shall therefore be **refused** registration in relation to all the remaining goods and services applied for, namely:

Class 9

Software in relation to a technology platform solution for real estate and infrastructure developments; computer hardware; downloadable software applications (apps) in relation to a technology platform solution for real estate and infrastructure developments; computer software platforms, recorded or downloadable; data processing equipment; apparatus for recording, transmission or reproduction of sound or images; communications equipment; measuring, detecting, testing, inspecting and life-saving apparatus and instruments; databases; calculating devices; parts and accessories for all the aforesaid; all of the aforesaid with respect to a technology platform solution for the lifecycle of real estate and infrastructure developments namely scheme envisionment, development, design, creation, financing and asset management, construction, building operations, maintenance and tenancy management; all of the aforesaid excluding with respect to mortgage broking customer relationship management systems.

Class 35

Business management; business administration; business project management services; supply chain management services; procurement services for others (purchasing goods and services for others).

Class 42

Research and development of new products for others.

COSTS

111. The Opponent has been largely successful and is therefore entitled to an award of costs. In the circumstances I award the Opponent the sum of £2,200 based on the

contributory scale set out in Tribunal Practice Notice 2/2016. The sum is calculated as follows:

Official fee for filing Form TM7 x 2	£200
Preparing the Statement of Grounds and considering the Counterstatement x 2	£400
Preparing for and attending a hearing	£1,600
TOTAL	£2,200

112. I therefore order Lendlease Digital Australia Pty Limited to pay PODIUM INVESTMENT the sum of **£2,200**. The sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 24th day of July 2024

Daniela Ferrari
For the Registrar