

**O/1198/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00004077211  
IN THE NAME OF  
OMNICOM INTERNATIONAL HOLDINGS INC.  
TO REGISTER THE FOLLOWING TRADE MARK:**

**weave**  
H E A L T H

**IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. OP600003478  
BY WEAVE COMMUNICATIONS, INC.**

## **Background and pleadings**

1. On 18 July 2024, Omnicom International Holdings Inc. (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 02 August 2024 in respect of the services set out in paragraph 13 of this decision.
2. On 01 November 2024, Weave Communications, Inc. (“the Opponent”) opposed the application under the fast track opposition procedure, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent relies upon the following mark:

## **WEAVE**

International Registration no. WO0000001692976

Date of designation: 14 September 2022

Protection conferred date: 04 April 2023

Relying upon the following services:

Class 42: Providing temporary use of online non-downloadable software for use in customer attraction, customer retention, customer communication, customer relationship management and customer engagement for small businesses; providing temporary use of online non-downloadable software for use in customer service, utilization and analysis of customer information, and compiling customer data and customer interactions for use in customizing and personalizing communications with customers for small businesses; providing temporary use of online non-downloadable software for use in providing voice over internet protocol (VOIP) services, namely, for providing instant messaging, cloud phone utilization, unlimited calling, auto attendant voice response functionality, picture identification and telecommunication management for customer communication; providing temporary use of online non-downloadable software for use in integrating and enabling third party customer relationship management solutions.

3. By virtue of its earlier designation date of 14 September 2022, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to the use provisions contained in section 6A of the Act. The Opponent can, therefore, rely upon all of the services it has identified without having to demonstrate use.
4. The Opponent submits that the marks are highly similar and the applied for services in class 35 are similar to those covered by the earlier mark.<sup>1</sup>
5. The Applicant filed a counterstatement in which it denies the similarity of the marks and denies the similarity of the services at issue.
6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that: "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit." The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions.
7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
8. A hearing was neither requested nor considered necessary; however, both parties filed written submissions in lieu. This decision is taken following a careful consideration of the papers.
9. The Applicant is represented by Abion UK Limited; the Opponent is represented by Bristows LLP.

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<sup>1</sup> The Application was originally applied for in classes 35 and 42, however following the filing of a form TM21B, the Application now only contains the class 35 services listed at paragraph 13.

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

## **DECISION**

### **Section 5(2)(b)**

11. Section 5(2)(b) of the Act is 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”.

12. The following principles 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; Page 8 of 20

(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 services

13. The services for comparison are as follows:

Opponent's services	Applicant's services
<p><u>Class 42:</u>            Providing temporary use of online non-downloadable software for use in customer attraction, customer retention, customer communication, customer relationship management and customer engagement for small businesses; providing temporary use of online non-downloadable software for use in customer service, utilization and analysis of customer information, and compiling customer data and customer interactions for use in customizing and personalizing communications with customers for small businesses; providing temporary use of online non-downloadable software for use in providing voice over internet protocol (VOIP) services, namely, for providing instant messaging, cloud phone utilization, unlimited calling, auto attendant voice response functionality, picture identification and telecommunication management for customer communication; providing temporary use of online non-</p>	<p><u>Class 35:</u>            Business marketing and promotional services in the field of healthcare; business consulting and marketing services in the field of healthcare; providing demand creation and lead generation activities and services in the field of healthcare; marketing consultation, namely, customer targeting consultancy services in the field of healthcare; advertising services, namely, promoting and marketing the goods and services of others in the healthcare field through all public communication means; advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels in the field of healthcare; advertising and marketing services, namely, promoting the goods and services of others in the field of</p>

<p>downloadable software for use in integrating and enabling third party customer relationship management solutions.</p>	<p>healthcare; analysis of market research data and statistics in the field of healthcare; business management consulting with relation to strategy, marketing, sales, operation, product design particularly specializing in the use of analytic and statistic models for the understanding and predicting of consumers, businesses, and market trends and actions in the field of healthcare; marketing services for others in the nature of using analytics to understanding and predict consumers, businesses, and market trends and actions; direct marketing services in the field of healthcare; collection of market research information in the field of healthcare; computerized market research services in the field of healthcare; direct marketing consulting services in the field of healthcare; market analysis and research services in the field of health care; market intelligence services in the field of healthcare; marketing analysis services in the field of healthcare; marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means, particularly specializing in the use of mobile, social, and print media to drive consumer interest, engagement and action in the</p>
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	<p>field of healthcare; providing demand creation and lead generation activities and services in the field of healthcare; providing advertising, marketing and promotional services for the healthcare, pharmaceutical and medical industries; Media planning and buying services for others, namely, purchasing time and space for the delivery of advertising messages of others through broadcast time, print space, indoor space, outdoor space, and television and internet media; media planning and advertising strategy, namely, preparation and realization of media and advertising planning for others; marketing and advertising media analysis services, marketing and advertising media management services namely, preparation and realization of media and advertising for others; marketing and advertising consulting services in the media industry, namely, consulting services regarding strategies for advertising, marketing and media communications content; buying of advertising space, namely, purchasing time and space for the delivery of advertising messages of others through broadcast time, print space, indoor space, outdoor space, and television and internet media; advertising the goods and services of others, development of marketing strategies and concepts for</p>
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	<p>others; marketing services and marketing consulting services in the field of arranging for the advertising and distribution of the products of others and promotional services for third parties, namely promoting the services of various industries through the distribution of digital, printed, video and audio promotional materials; market research services; qualitative market research; business advisory services namely, advice in the field of business advertising and marketing; provision of marketing advice for others; market surveys, analysis and research; market analysis; consumer analysis; semiotic research and analysis for marketing purposes; ethnographic research and analysis for marketing purposes; marketing research for others, marketing methods for others, market analysis for others, market testing for others, business services relating to the provision of sponsorships, namely, consultation and advice on how to search for sponsors to affiliate goods and services of others; business information services, namely, advice in the field of business advertising and marketing; marketing consultation services, namely, analyzing search engine placements and keyword placements.</p>
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14. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.<sup>2</sup>

15. The Opponent submits that goods and services are not regarded as similar or dissimilar on the basis of whether they appear in the same or different classes<sup>3</sup>. I agree; section 60A(1)(a) of the Act provides that 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.

16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

17. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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<sup>2</sup> Paragraph 29

<sup>3</sup> Opponent’s submissions in lieu paragraph 28.

- “(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.”

18. 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 and services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82. ...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”.

19. For the purposes of considering the issue of similarity of the services, it is permissible to consider groups of terms collectively where appropriate: *Separode* Trade Mark, BL O-399-10.

20. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"12. ... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... 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."

21. 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: *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, at [365].

22. The Opponent submits in general terms that its class 42 services are similar to the services of the Applicant. However, throughout their submissions the Opponent does not identify which of their services are the closest comparator, or which of their terms should be compared to the specific terms within the Applicant's services. On this point, I refer to the case of *SmartX* (BL O/0911/24) wherein Mr Iain Purvis K.C., sitting as the Appointed Person, addressed the issue of an Opponent's failure to identify similarity in respect of long specifications. Mr Purvis K.C. said:

"28. [...] it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach [...] would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent."

23. Further on in this decision, Mr Purvis K.C. stated:

“31(v). In fact (as I have pointed out) the Hearing Officer went beyond the written submissions in making findings of similarity in respect of a number of groups of goods on the basis of arguments which had not been raised by the Opponent. If the Applicant had complained about this by way of an Appeal, there would probably have been a good argument that he had been the victim of procedural unfairness. But this has of course not happened and to this extent the Opponent has benefited from the Hearing Officer’s generosity. However, it would obviously be perverse to say that the Hearing Officer ought therefore to have taken every other unpleaded and unargued point in the Opponent’s favour.”

24. I bear in mind the above when considering the Opponent’s submissions regarding the similarity of their class 42 services as a whole, or in general terms. I will therefore proceed on the basis of the Opponent’s submissions, and I will only consider similarities where it is obvious to do so; otherwise, the services will be found to be dissimilar.

***“Business marketing and promotional services in the field of healthcare; advertising services, namely, promoting and marketing the goods and services of others in the healthcare field through all public communication means; advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels in the field of healthcare; advertising and marketing services, namely, promoting the goods and services of others in the field of healthcare; providing advertising, marketing and promotional services for the healthcare, pharmaceutical and medical industries; advertising the goods and services of others, development of marketing strategies and concepts for others; direct marketing services in the field of healthcare; [...] marketing services in the field of healthcare; direct marketing consulting services in the field of healthcare.”***

25. I consider that the closest comparator to the Applicant's above services is the Opponent's "*providing temporary use of online non-downloadable software for use in customer attraction [...] and customer engagement for small businesses*", as they are both broadly related to the attraction of customers. However, the specific nature, method of use and core purposes of the services at issue differ. I note that some of the Applicant's above services are provided specifically within the healthcare sector, whilst the Opponent's services are provided to small businesses in general, which I consider could encompass small businesses within the healthcare sector (such as independent medical practitioners, chiropractors or opticians). I understand business marketing and promotion to be services focused on developing and implementing strategies to support businesses in attracting customers and generating sales, whereby users would interact with marketing businesses to receive tailored marketing and promotional services provided by professionals. This differs in nature and core purpose to the Opponent's services which are the provision of online non-downloadable software for the purpose of allowing small businesses to engage and interact with customers themselves through the use of this online software. As such, the nature of the service provided by the Opponent is not marketing, nor promotional services.

26. The Opponent submits that a business utilising services for marketing would likely also use software for managing customer interactions and analysing customer data. However, the Opponent has not explained why it believes that is the case and, in my view, any potential overlap in users is too broad to engage similarity. Although both services are targeted at business customers, they are not important nor indispensable to one another in such a way that the consumer will believe that the responsibility for them lies with the same undertaking. Consumers would not expect the same provider to be responsible for the respective services; companies that provide business marketing and promotional services are unlikely to also provide temporary use of any software for small businesses to engage and interact with consumers themselves, rather it is more likely that another company that employs software developers would be responsible for the provision of that software. The Opponent's submissions do not persuade me that the overlap in the relevant average consumer results in complementarity in the way set out in

caselaw. Nor do I consider that the services are in competition. Overall, I consider the services to be dissimilar.

***“Marketing services and marketing consulting services in the field of arranging for the advertising and distribution of the products of others and promotional services for third parties, namely promoting the services of various industries through the distribution of digital, printed, video and audio promotional materials; marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means, particularly specializing in the use of mobile, social, and print media to drive consumer interest, engagement and action in the field of healthcare.”***

27. Case law states that the use of ‘namely’ within a specification restricts the scope of the registration solely to the goods/services specifically listed after that expression.<sup>4</sup> I note that the Tribunal Manual also states that specifications which include the wording ‘namely’ should be interpreted as covering only the proceeding named services. Therefore, the Applicant’s above marketing and marketing consultancy services are both limited to the provision of promotional services to various industries through the distribution of digital, printed, video and audio promotional materials. In my view, the closest comparator is the Opponent’s *“providing temporary use of online non-downloadable software for use in customer attraction [...] and customer engagement for small businesses”*, however the specific core purpose of the Opponent’s service is the provision of online non-downloadable software, which differs to the core purpose of the Applicant’s promotional services. Although software may be used in the distribution of promotional materials, especially those distributed digitally, there is a difference in the nature and purpose of the services at issue.

28. Consumers would not expect a company providing marketing or marketing consultancy services to also be responsible for providing online non-downloadable software in these fields. Although the respective services are both

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<sup>4</sup> T-549/14, *Castello / Castellò (fig.) et al.*, EU:T:2016:594, § 71

targeted at business customers, I do not consider them to be in competition. The services are not important nor indispensable to one another in such a way that the consumer will believe that the responsibility for them lies with the same undertaking, I therefore consider that there is no complementarity. Further, the fact that the services both target business consumers is not sufficient for a finding of similarity. Overall, I consider the services to be dissimilar.

***“Marketing and advertising media analysis services, marketing and advertising media management services namely, preparation and realization of media and advertising for others; Media planning and buying services for others, namely, purchasing time and space for the delivery of advertising messages of others through broadcast time, print space, indoor space, outdoor space, and television and internet media; buying of advertising space, namely, purchasing time and space for the delivery of advertising messages of others through broadcast time, print space, indoor space, outdoor space, and television and internet media; media planning and advertising strategy, namely, preparation and realization of media and advertising planning for others.”***

29. I consider that the Applicant's above services are all marketing and advertising services which focus on the planning and delivery of advertising campaigns in a range of settings. In my view, the closest comparator is the Opponent's *“providing temporary use of online non-downloadable software for use in customer attraction [...] and customer engagement for small businesses”*. However, the specific purpose and nature of the services at issue differ, as the Opponent provides software for small businesses to engage and interact with its customers, while the Applicant provides services to plan and deliver marketing strategies primarily through services involved with purchasing advertisement space or time for others. The services are not important nor indispensable to one another in such a way that the consumer will believe that the responsibility for them lies with the same undertaking. A consumer is unlikely to expect a company providing marketing and promotional services to also be responsible for the provision of software, even where that software was used in customer engagement as such the services will not be complementary. Due to the differing natures, intended purposes and

methods of use of the services, I do not consider they would be in competition. Overall, I consider the services to be dissimilar.

***“Business consulting [...] in the field of healthcare.”***

30. The Opponent submits that the Applicant’s above business consultation services overlap in user with their class 42 services as they seek to enhance customer relationships, optimise marketing strategies and improve engagement. While I acknowledge that the user of the Applicant’s above services, and the Opponent’s *“providing temporary use of online non-downloadable software for use in integrating and enabling third party customer relationship management solutions”* will both be business users, this alone is insufficient to result in a finding of similarity.

31. The services at issue differ in nature and purpose as the Applicant provides consultation services to businesses, while the Opponent’s service is the provision of online non-downloadable software for small businesses to engage with its customers. The method of use also differ, users would have to approach a specialised business consulting company in the field of healthcare and discuss with a professional how these services would help their business or organisation, whereas in contrast, users would interact with the Opponent’s software services online. Although customer relationship software may be used by a business consultant, this does not necessarily mean that it is important or essential to these services in such a way that consumers would expect the same provider to be responsible for the respective services; a company that provides business consultancy services is unlikely to also be responsible for the provision of software. Although the services may be used alongside one another, I do not consider that they are complementary, nor are they in competition. Overall, I consider the services to be dissimilar.

***“Business advisory services namely, advice in the field of business advertising and marketing; business information services, namely, advice in the field of business advertising and marketing; provision of marketing advice for others; marketing and advertising consulting services in the media industry, namely,***

***consulting services regarding strategies for advertising, marketing and media communications content; Business management consulting with relation to strategy, marketing, sales, operation, product design particularly specializing in the use of analytic and statistic models for the understanding and predicting of consumers, businesses, and market trends and actions in the field of healthcare.”***

32. The Applicant's above services are advisory and information services in the field of marketing and advertising. In my view, the closest comparator is the Opponent's *“providing temporary use of online non-downloadable software for use in integrating and enabling third party customer relationship management solutions”*. However, for the same reasons set out in paragraph 30-31, the services differ in nature and purpose. The services at issue are not complementary, nor are they in competition. Overall, I consider the services to be dissimilar.

***“Marketing consultation, namely, customer targeting consultancy services in the field of healthcare.”***

33. For the reasons set out in paragraph 27, the use of 'namely' limits the Applicant's above services to *“customer targeting consultancy services in the field of healthcare”*. I consider this to be a specific subset of marketing consultancy that involves advising healthcare businesses on marketing strategies which target a specific group of people. Comparing this against the Opponent's *“providing temporary use of online non-downloadable software for use in customer attraction [...] and customer engagement for small businesses”*, I remind myself that as set out in paragraph 25, while some of the Applicant's above services are provided specifically within the healthcare sector, I consider that the Opponent's services could encompass small businesses within that sector. However, the specific core purpose and nature of the services differ. While the Applicant provides consultancy services, the Opponent's core service is the provision of online non-downloadable software. The purpose of the above applied for service is to provide advice to healthcare businesses on identifying and reaching the right customer audience. This will involve professional marketing consultants providing information on the research and analysis of target demographics and guidance on the best channels

and messaging to reach those customers. In contrast, the purpose of the Opponent's online software is to allow small businesses to engage with customers themselves to attract customers. The Opponent submits that businesses using marketing consultancy services would rely on software to execute, track and optimize their campaigns and communicate with customers, however, there is no evidence to support such an assertion and the fact that the same customer may use both services does not necessarily lead to a finding of similarity. Although both services are targeted at business customers, they are not important or indispensable from one another in such a way that the consumer will believe that the responsibility for them lies with the same undertaking. Consumers would not expect a provider of marketing consultancy services to also provide temporary use of software connected to customer attraction or engagement. The Opponent's submissions do not persuade me that the overlap in the relevant average consumer results in complementarity in the way set out in caselaw. Nor do I consider that the services are in competition. Overall, I consider the services to be dissimilar.

***“Providing demand creation and lead generation activities and services in the field of healthcare.”***

34. I understand 'demand creation and lead generation' to be services for stimulating interest or awareness of a product/service, with the aim of identifying and capturing potential customers. In the Applicant's above term, this service is provided in the field of healthcare. The Opponent submits that the Applicant's above services are similar to their customer relationship management services, which I take as a reference to the Opponent's *“providing temporary use of online non-downloadable software for use in integrating and enabling third party customer relationship management solutions”*. However, I consider that the respective services differ in their core purpose. I say this because the Applicant's provides demand creation and lead generation activities are akin to marketing, whereas the Opponent's core service is the provision of software. Although the software could be utilised to support or further customer relationships, the nature and core purpose of these services clearly differs. The Opponent submits that the services at issue target the same users and are complementary, in that a company seeking lead generation

may also need customer relationship software. While I acknowledge that there may be an overlap in user this is too generalised to engage similarity. The fact that the same customer may use both services is not sufficient to find complementarity in the way set out by caselaw as they are not important or indispensable to one another. Further, there is nothing before me to suggest that consumers are likely to expect these services to be provided by the same undertaking, as such, I consider that there is no complementarity. In view of the differing nature and purpose of the services, I do not consider that they would be in competition. Overall, I consider the services to be dissimilar.

***“Analysis of market research data and statistics in the field of healthcare; market analysis; marketing analysis services in the field of healthcare.”***

35. The Applicant's above services, and the Opponent's *“providing temporary use of online non-downloadable software for use in customer service, utilization and analysis of customer information, and compiling customer data and customer interactions for use in customizing and personalizing communications with customers for small businesses”* are both targeted at business users. As set out in paragraph 25, while some of the Applicant's above services are provided specifically within the healthcare sector, I consider that the Opponent's services could encompass small businesses within the healthcare sector. The Opponent submits that businesses who conduct market research will also need data management and analysis software, leading to the services being complementary and having a shared nature. I disagree. The Opponent's services are the provision of online non-downloadable software for small businesses for use in customer service, to analyse customer information and compile customer data to personalise customer communication. Given its specific nature, i.e. it helps small businesses with customer services by compiling and analysing customer information to personalised communication with customers, I do not consider that this type of online software would be used by marketing companies providing marketing analysis information to third party businesses in the field of healthcare. Even, if the software could be used by marketing companies in the course of its trade to gather information and data, the fact that a marketing business providing market analysis information may use software to analyse and compile data, does not necessarily

mean that they are important or indispensable from one another in such a way that the consumer will believe that the responsibility for them lies with the same undertaking. Consumers would likely expect a company specialising in software development to be responsible for online non-downloadable software, while analysis of market research would be sought from a company specialising in marketing or business consultation. Further, the nature of the applied for services is the direct provision of that market analysis to third party business customers. The exact purposes differ as the Applicant's services aim to provide strategic insights into market trends and consumer behaviour, while I understand the purpose of the Opponent's services are to help small businesses manage and personalise customer interactions operationally. Further one is delivered by a professional, whilst the other is delivered through software as a service, as such the methods of use also differ. In view of the above, I do not consider the services to be in competition as they have different specific purposes. Overall, I consider the services to be dissimilar.

***“Marketing services for others in the nature of using analytics to understanding and predict consumers, businesses, and market trends and actions; consumer analysis; collection of market research information in the field of healthcare; computerized market research services in the field of healthcare; market analysis and research services in the field of health care; market intelligence services in the field of healthcare; market research services; qualitative market research; market surveys, analysis and research; marketing research for others, marketing methods for others, market analysis for others, market testing for others [...].”***

36. The Applicant's above services are all in the field of market research, testing and analysis, which will be provided by marketing agencies to business users. The Opponent submits that these terms overlap in target consumer and are complementary to their services, however they do not identify a specific term within their specification for comparison. I consider the Opponent's *“providing temporary use of online non-downloadable software for use in customer service, utilization and analysis of customer information, and compiling customer data and customer interactions for use in customizing and personalizing communications with*

*customers for small businesses*” is most similar to the Applicant’s above services as they all involve data analysis of some kind. As set out in paragraph 25, while some of the Applicant’s above services are provided specifically within the healthcare sector, I consider that the Opponent’s services could encompass small businesses within the healthcare sector.

37. The nature of the services differs, as the Opponent’s service is the provision of access to software, while the Applicant’s services are marketing services for the provision of market research and analysis of marketing trends offered by marketing professionals. The exact purposes differ as the Applicant’s services aim to provide strategic insights into market trends and consumer behaviour, while I understand the purpose of the Opponent’s services are to help small businesses manage and personalise customer interactions operationally. Further the Applicant’s services are accessed via a professional, whilst the Opponent’s services are delivered through software as a service, as such the methods of use also differ. I do not consider that the average consumer would expect a company providing market research and analysis (such as a marketing agency), to also be responsible for the provision of online non-downloadable software, even where that software covers customer analysis. It is more likely that the consumer would expect the Opponent’s services to be provided through an IT service provider or software developer, as such they are unlikely to be complementary. In view of the difference in nature and purpose, I do not consider the respective services to be in competition. Overall, I consider the services to be dissimilar.

***“Semiotic research and analysis for marketing purposes; ethnographic research and analysis for marketing purposes.”***

38. I understand “semiotic research and analysis” to be the study and interpretation of signs and symbols. I understand “ethnographic research and analysis” to be the study of people and cultures to understand behaviours, values and lifestyles. In relation to marketing, both these types of research and analysis seek to better understand how consumers perceive brands, products, and messages. In my view, the closest comparator to the Applicant’s above services is the Opponent’s *“providing temporary use of online non-downloadable software for use in [...]”*

*utilization and analysis of customer information, and compiling customer data [...] for use in customizing and personalizing communications with customers for small businesses*". However, the purpose of the applied for services are to provide insights into consumer behaviour, market trends, and marketing strategies, whereas the specific purpose of the earlier services are to enable small businesses to analyse customer information for personalisation and engagement. Further, for the same reasoning set out in paragraph 37, I consider the services differ in their specific nature and method of use. I do not consider the services to be complementary, nor in competition. Overall, I consider the services to be dissimilar.

***"Marketing consultation services, namely, analyzing search engine placements and keyword placements."***

39. The Opponent submits that the Applicant's above services overlap with their specification in purpose and target consumers, as well as being complementary. They submit that search engine optimisation brings traffic to a business website, while customer relationship management retains and converts that traffic into customers. I take the Opponent's submissions as a reference to their class 42 term *"providing temporary use of online non-downloadable software for use in integrating and enabling third party customer relationship management solutions"*. However, the fundamental nature of the services at issue differs in that one is online software services whilst the other are marketing consultation or advice services. Further, the core purpose of the Opponent's services is the provision of software to manage customer relationships, which differs to the Applicant's marketing consultation services which are focused on providing advice following the analysis of companies search engine placement or review of keyword strategies used in paid search campaigns. I do not consider that the average consumer would expect a company providing marketing consultancy, to also be responsible for the provision of online non-downloadable software such as the Opponent's it is more likely that the consumer would expect the Opponent's services to be provided through an IT service provider or software developer. As such, the services are not complementary, nor do they have the same trade channels. Neither do I consider the services to be in competition as their methods

of use and exact purposes differ meaning they are not a suitable substitute for one another. Overall, I find the services to be dissimilar.

***“[...] business services relating to the provision of sponsorships, namely, consultation and advice on how to search for sponsors to affiliate goods and services of others.”***

40. The Opponent submits that the Applicant's above services are complementary to their Customer Relationship Management (CRM) software, as the information from CRM software can be used to support sponsorship pitches. I take the Opponent's submissions as referring to the term *“providing temporary use of online non-downloadable software for use in integrating and enabling third party customer relationship management solutions”* within the Opponent's specification. While I acknowledge that information gained through use of this software could be used by businesses in sponsorship pitches this does not, of itself, lead to a finding of complementarity as 'use with' does not mean that they are important, nor indispensable to one another. The Opponent submits that a marketing agency could provide both sponsorship consulting and customer analytic tools, however, without evidence to the contrary, I do not consider that the average consumer would expect a marketing company to also be responsible for the provision of online non-downloadable software, even where that software covers customer analysis, it is far more likely that consumers would believe the software to derive from an IT company/provider. The nature and purpose of the services differ, as the Opponent's core service is the provision of access to software, while the Applicant's services are for advice in relation to sponsorship. In view of the above, I do not consider the services to be in competition as the services cannot perform function of the other. Overall, I consider the services to be dissimilar.

41. It is a prerequisite of section 5(2)(b) that the services be similar. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those

services I have found to be dissimilar will fail.<sup>5</sup> As I have found all of the services to be dissimilar, the opposition fails in its entirety.

## **Conclusion**

42. The opposition under section 5(2)(b) of the Act has failed. Subject to any successful appeal against my decision, the application will proceed to registration.

## **COSTS**

43. The Applicant has been successful and is entitled to a contribution towards its costs. Therefore, considering the guidance in Tribunal Practice Notice 1/2023, I award the Applicant costs on the following basis:

Considering the notice of opposition and preparing a counterstatement	£250
Written submissions in lieu of a hearing	£350
<b>Total:</b>	<b>£600</b>

44. I therefore order Weave Communications, Inc. to pay Omnicom International Holdings Inc. the sum of £600. The above 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 22<sup>nd</sup> day of December 2025

**Emma Rees**  
**For the Registrar**

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<sup>5</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden