

O/015/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003251958

BY KPMG LLP

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASSES 9, 16, 35, 36, 41, 42 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 411132 BY

BENETTON HOLDINGS LTD

BACKGROUND AND PLEADINGS

1. On 22 August 2017, KPMG LLP (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 29 September 2017.

2. The application was opposed by Benetton Holdings Ltd (“the opponent”). The opposition is based upon section 5(2)(a) and section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the earlier EU Trade Mark registration no. 10054302 for the mark **PILOT**. The opponent’s mark has an application date of 16 June 2011 and a registration date of 7 March 2017. The opponent relies on the goods and services listed in paragraph 17 below.

3. The applicant filed Form TM21b on 14 April 2018 to reduce the specification for which it sought to register its mark. The applicant now seeks to register its mark for the goods and services listed in Annex 1 to this decision only.

4. On 25 April 2018 the opponent confirmed that, notwithstanding the amendment to the applicant’s specification, it wished to proceed with its opposition. The opposition is directed against the following goods and services in the applicant’s specification (as amended) only:

Class 9 Computer programs; computer software; interactive computer software; software applications; downloadable electronic publications; publications in electronically, magnetically or optically recorded and recordable forms; none of the aforesaid goods including or relating to customs brokerage services.

Class 16 Instructional and teaching material (not including apparatus); none of the aforesaid goods including or relating to customs brokerage services.

Class 35 Business consulting, advice and information relating to electronic commerce services, namely, providing information about products via

telecommunication networks for advertising and sales purposes; outsourcing services [business assistance]; analysis of workforces; analysis of workforce performance; business management planning and development, business risk management; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; legal accountancy services, including fraud establishment and fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; market studies; auditing services; investor auditing services; data analytics relating to commercial affairs, business, electronic commerce and enterprise resource planning; data analysis services relating to commercial affairs, business, electronic commerce and enterprise resource planning; data modelling services relating to commercial affairs, business, electronic commerce and enterprise resource planning; data collection, compilation and systemisation services; compilation of computer data-bases; data management services; the aforesaid services also being provided online via global computer networks and/or the Internet; none of the aforesaid services including or relating to customs brokerage services.

Class 41 Provision of training and courses relating to management of commercial and financial affairs; provision of online publications; publishing of books, reports, magazines and other printed matter; none of the aforesaid services including or relating to customs brokerage services.

Class 42 Software design, development and implementation services; computer software design; computer software design and programming services; development of computer software; development of computer software applications; constructing internet platforms for electronic commerce; cloud computing services; technical consultancy in relation to the aforementioned services; computer software technical support services; hosting of digital content, namely, on-line journals and blogs; consultancy in the field of information technology, computers; technical consultancy in the fields of digital and mobile technologies, electronic

commerce and electronic enterprise resource planning; none of the aforesaid services including or relating to customs brokerage services.

5. The opponent argues that the respective goods are identical or similar and that the marks are identical or similar.

6. The applicant filed a counterstatement denying the claims made.

7. The opponent is represented by Swindell & Pearson Ltd and the applicant is represented by Simkins LLP. No evidence was filed, but the applicant filed written submissions dated 23 August 2018. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUE

8. In its written submissions, the applicant has made reference to various other registrations for the word PILOT. In support of its written submissions it provided examples of these registrations which, because they were not filed in the correct format, were not admitted as evidence in these proceedings and I have disregarded them accordingly.

9. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by

analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

10. The presence of other marks on the register is not relevant to the decision I must make. The submissions made by the applicant in this regard are not, therefore, of assistance to it in these proceedings.

DECISION

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

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

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

(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. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

13. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(a)

14. It is a prerequisite of section 5(2)(a) of the Act that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer”.

15. The opponent’s mark PILOT is a word only mark. The applicant’s mark consists of the word PILOT presented on a blue background with an airplane device creating a circle around it. The presence of the airplane device is an addition which is not likely to go unnoticed by the average consumer. I do not, therefore, consider these marks to be identical. The opposition under section 5(2)(a) must, therefore, fail at the first hurdle.

Section 5(2)(b)

16. 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.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

17. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
<u>Class 9</u> Computer software; computer hardware; computer firmware; personal computers; lap top computers; tablet computers, smart telephones mobile telephones; software downloaded in electronic form for use on computers, telephones, mobile telephones, smart telephones, Personal Digital Assistants, or other electronic apparatus; applications being	<u>Class 9</u> Computer programs; computer software; interactive computer software; software applications; downloadable electronic publications; publications in electronically, magnetically or optically recorded and recordable forms; none of the aforesaid goods including or relating to customs brokerage services.

<p>software for use on mobile telephones, smart telephones, tablet computers, and personal computers; downloadable electronic publications and software; telecommunications apparatus and instruments; downloadable data in digital form, downloadable data in electronic form; downloadable software; data storage components; handheld computers, personal digital assistants, electronic notepads; smart phones; computer hardware and software; database management software; parts and accessories for handheld and mobile digital electronic devices; parts and accessories for mobile telephones; computer software for use in downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organising data including audio and video data; apparatus for the downloading, transmitting, encoding, decoding, editing, playing and storage of data including audio and video recordings; interactive products comprising or for use with any of the aforesaid goods; parts and fittings for all the aforesaid goods; all the aforesaid goods excluding the fields of construction and heavy construction; safety and protective clothing, headwear and footwear; e-books; e-cards; e-messages; electronic</p>	<p><u>Class 16</u> Instructional and teaching material (not including apparatus); none of the aforesaid goods including or relating to customs brokerage services.</p> <p><u>Class 35</u> Business consulting, advice and information relating to electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; outsourcing services [business assistance]; analysis of workforces; analysis of workforce performance; business management planning and development, business risk management; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; legal accountancy services, including fraud establishment and fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; market studies; auditing services; investor auditing services; data analytics relating to commercial affairs, business, electronic commerce and enterprise resource planning; data analysis services relating to commercial affairs,</p>
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greetings cards and electronic greetings messages; digital greetings cards and digital greetings messages; electronic and or digital cards; downloadable publications; downloadable newspapers, newsletters, magazines, pamphlets, booklets, books, brochures; electronic communications apparatus and instruments; electrical communications apparatus and instruments; downloadable music; downloadable films, Television programs, videos, music videos, radio broadcasts; electronic publications; on-line publications; downloadable publications; podcasts; sound recordings; video recordings; downloadable educational material, magazines, downloadable newsletters, downloadable news sheets, downloadable advertising sheets, downloadable printed matter, downloadable books, downloadable pamphlets, downloadable journals; MP3 and other digital format audio and video players; electronic organizers; prerecorded computer programs for personal information management; electronic mail and messaging software; paging software; database synchronization software; computer programs for accessing, browsing and searching online databases; computer hardware and software for providing

business, electronic commerce and enterprise resource planning; data modelling services relating to commercial affairs, business, electronic commerce and enterprise resource planning; data collection, compilation and systemisation services; compilation of computer data-bases; data management services; the aforesaid services also being provided online via global computer networks and/or the Internet; none of the aforesaid services including or relating to customs brokerage services.

Class 41

Provision of training and courses relating to management of commercial and financial affairs; provision of online publications; publishing of books, reports, magazines and other printed matter; none of the aforesaid services including or relating to customs brokerage services.

Class 42

Software design, development and implementation services; computer software design; computer software design and programming services; development of computer software; development of computer software applications; constructing internet

integrated telephone communication with computerized global information networks; mobile telephone covers; multimedia products comprising or for use with the transmission of audio and video data.

Class 16

Printed matter; bookbinding material; typewriters; typewriters; typewriters; plastic materials for packaging not included in other classes; printers' type; printing blocks; printed publications; greetings cards; birthday invitations; wedding invitations; party invitations; birthday cards; Christmas cards; wedding cards; new baby cards, baptismal cards, bar mitzvah cards, bat mitzvah cards, maternity leave cards, paternity leave cards, promotion cards, leaving for another job cards, moving house cards, relocation cards and having a baby cards, Christian confirmation cards, first confession cards, engagement cards, retirement cards, graduation cards, divorce cards, cards upon professional qualification, cards to celebrate exam success, coming of age cards; gift wrapping; gift wrapping foil; gift wrapping materials; gift wrapping paper; magazines; business card holders; bookmarks, calendars, periodicals, journals, newspapers;

platforms for electronic commerce; cloud computing services; technical consultancy in relation to the aforementioned services; computer software technical support services; hosting of digital content, namely, on-line journals and blogs; consultancy in the field of information technology, computers; technical consultancy in the fields of digital and mobile technologies, electronic commerce and electronic enterprise resource planning; none of the aforesaid services including or relating to customs brokerage services.

newsletters; brochures; flyers; advertising material; paper, cardboard and goods made from these materials, not included in other classes; pamphlets, prospectuses, books, forms, maps, magazines, manuals, pictures photographs; photograph albums; calendars; catalogues; publicity material; promotional material; advertising material; books; car stickers; programmes; posters; postcards; prints; greeting cards; cards; tickets; leaflets; carrier bags; paper bags; book covers; diaries; business cards; business card holders; Albums; Almanacs; Calculating tables; Calendars; Cardboard; Cards; Catalogues; Chaplets; Charts; Comic books; Decalcomanias; Handbooks [manuals]; Magazines [periodicals]; Manuals [handbooks]; Maps (Geographical -); Newsletters; Newspapers; Obliterating stamps; Paintings [pictures], framed or unframed; Pamphlets; Paper; Periodicals; Postcards; Posters; Printed matter; Printed publications; Printed timetables; Rosaries; Tables (Arithmetical -); Tables (Calculating -); Terrestrial globes.

Class 35

Administration relating to marketing; Retail services connected with the sale of the following goods, the bringing

together, for the benefit of others, of a variety of the following goods to allow consumers to conveniently view and purchase the following goods, electronic shopping retail services, including such services provided from an internet website, connected with the sale of the following goods and mail order retail services connected with the sale of the following goods, e-books, e-cards, e-messages, electronic greetings cards and electronic greetings messages, digital greetings cards and digital greetings messages, electronic and or digital cards, birthday e-cards, Christmas e-cards, wedding e-cards, new baby e-cards, baptismal e-cards, bar mitzvah e-cards, bat mitzvah e-cards, maternity leave e-cards, paternity leave e-cards, promotion e-cards, leaving for another job e-cards, moving house e-cards, relocation e-cards and having a baby e-cards, Christian confirmation e-cards, first confession e-cards, engagement e-cards, retirement e-cards, graduation e-cards, divorce e-cards, cards upon professional qualification, e-cards to celebrate exam success, coming of age e-cards, downloadable publications, downloadable newspapers, newsletters, magazines, pamphlets, booklets, books, brochures, computer software, computer hardware, computer firmware, personal

computers, lap top computers, tablet computers, smart telephones mobile telephones, software downloaded in electronic form for use on computers, telephones, mobile telephones, smart telephones, Personal Digital Assistants, or other electronic apparatus, applications being software for use on mobile telephones, smart telephones, tablet computers, and personal computers, downloadable electronic publications and software, electronic communications apparatus and instruments, electrical communications apparatus and instruments, telecommunications apparatus and instruments, downloadable data in digital form, downloadable data in electronic form, downloadable software, downloadable music, downloadable films, Television programs, videos, music videos, radio broadcasts, electronic publications, on-line publications, downloadable publications, apparatus for recording, transmission or reproduction of sound or images, data storage components, apparatus for the transmission of messages, downloadable educational material, magazines, downloadable newsletters, downloadable news sheets, downloadable advertising sheets, downloadable printed matter,

downloadable books, downloadable pamphlets, downloadable journals, MP3 and other digital format audio and video players, handheld computers, personal digital assistants, electronic organizers, electronic notepads, magnetic data carriers, telephones, mobile phones, smart phones computer gaming machines, videophones, cameras, computer hardware and software, pre-recorded computer programs for personal information management, database management software, electronic mail and messaging software, paging software, database synchronization software, computer programs for accessing, browsing and searching online databases, computer hardware and software for providing integrated telephone communication with computerized global Information networks, parts and accessories for handheld and mobile digital electronic devices, Computer software for use in downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organising data including audio and video data, sound, video and data recordings, chips, discs and tapes bearing or for recording computer programs and software, multimedia products comprising or for use with the transmission of audio and

video data, apparatus for the downloading, transmitting, encoding, decoding, editing, playing and storage of data Including audio and video recordings, interactive products comprising or for use with any of the aforesaid goods, printed matter, instructional and teaching material (except apparatus), printed publications, greetings cards, birthday invitations, wedding invitations, party invitations, birthday cards, Christmas cards, wedding cards, new baby cards, baptismal cards, bar mitzvah cards, bat mitzvah cards, maternity leave cards, paternity leave cards, promotion cards, leaving for another job cards, moving house cards, relocation cards and having a baby cards, Christian confirmation cards, first confession cards, engagement cards, retirement cards, graduation cards, divorce cards, cards upon professional qualification, cards to celebrate exam success, coming of age cards, gift wrapping, gift wrapping foil, gift wrapping materials, gift wrapping paper, magazines, business card holders, bookmarks, calendars, periodicals, journals, newspapers, newsletters, brochures, flyers, advertising material, stationery, pamphlets, prospectuses, books, forms, maps, magazines, manuals, pictures

photographs, photograph albums, calendars, catalogues, instructional and teaching materials, publicity material, promotional material, advertising material, books, writing Instruments , office requisites (other than furniture), stickers, car stickers, programmes, posters, postcards, prints, notebooks.	
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18. “Retail services connected with the sale of... Writing Instruments” (as highlighted above) is listed as one of the services in class 35 relied upon by the opponent in its Notice of Opposition. However, this does not appear in the opponent’s specification. I will disregard this on the basis that it is a typographical error and, in any event, it has no impact on the outcome of these proceedings.

19. 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 CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

20. Guidance on this issue has also 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:

- (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.

21. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. 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.”

22. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course,

to the normal and necessary principle that the words must be construed by reference to their context.”

23. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

24. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

25. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

26. I have lengthy submissions from both parties on the similarity of the goods and services and, whilst I do not propose to reproduce those here, I have taken them all into consideration in reaching my decision.

Class 9

27. “Computer software” appears in both the applicant’s specification and the opponent’s specification. These goods are self-evidently identical.

28. “Applications being software for use on mobile telephones, smart telephones, tablet computers, and personal computers” in the opponent’s specification falls within the broader category of “software applications” in the applicant’s specification. “Interactive computer software” and “computer programs” in the applicant’s specification fall within the broader category of “computer software” in the opponent’s specification. “Electronic publications” in the opponent’s specification fall within the broader category of “publications in electronically, magnetically or optically recorded and recordable forms” in the applicant’s specification. “Downloadable electronic publications” in the applicant’s specification falls within the broader category of “downloadable publications” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

Class 16

29. A number of goods listed in class 16 of the opponent’s specification could be considered to fall within the broader category of “instructional and teaching material (not including apparatus)...none of the aforesaid goods including or relating to customs brokerage services” in the applicant’s specification. For example, “Tables (Arithmetical -)” and “Tables (Calculating -)” in the opponent’s specification are both

materials used to speed up mathematical calculations which could be used by teachers. "Printed matter" in the opponent's specification could include any number of teaching or instructional books which would fall within the applicant's specification. Similarly, "Handbooks [manuals]" in the opponent's specification plainly fall within the broader category in class 16 of the applicant's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

Class 35

30. The opponent's class 35 services include "Retail services connected with the sale of... computer programs for accessing, browsing and searching online databases". The applicant's specification includes "data collection, compilation and systemisation services" and "compilation of computer data-bases" which both involve the creation of databases. However, the nature of the services are different as the applicant's involves retail services for selling a particular type of software used for accessing databases and the opponent's involve the services of creating a database. The uses and nature of the services are clearly different. The users may overlap on a superficial level as the services may all be used by businesses, but they differ in that the opponent's services will be used by those looking to purchase software to enable it to use a database itself whilst the applicant's services will be used by those looking to create a database. In my view, there is no similarity between these services. If I am wrong, then they will be similar to only a low degree. I have considered the opponent's other goods and services and, in the absence of any submissions to assist me, I see no further point of similarity which will put the opponent in a better position.

31. "Administration relating to marketing" in the opponent's specification represents the opponent's best case in respect of the applicant's "Business consulting, advice and information relating to electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes". The applicant's services involve the provision of information about products for advertising purposes. There is some overlap in use on a general level with marketing. However, the opponent's services are administrative services in relation to marketing rather than marketing services themselves. The specific uses will, therefore, differ. There may be some overlap in users as both services may be used by

businesses. There may be some overlap in trade channels. There is no competitive or complementary relationship between the services. I consider that “administration relating to marketing” in the opponent’s specification and “Business consulting, advice and information relating to electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes” in the applicant’s specification are similar to a low degree. I have considered the opponent’s other goods and services and, in the absence of any substantive submissions to assist me, I see no further point of similarity which will put the opponent in a better position.

32. I have considered the nature, intended purpose, users and trade channels of the applicant’s remaining class 35 services and the opponent’s goods and services and I can see no similarity between them. I do not consider there to be a competitive or complementary relationship between them. Without the benefit of any substantive submissions to assist me, I am not satisfied that there is any similarity between the remaining services in class 35 of the applicant’s specification and the opponent’s goods and services.

33. As some degree of similarity between the goods and services is necessary to engage the test for likelihood of confusion¹, my findings above mean that the opposition must fail in respect of the applicant’s following class 35 services:

Class 35 Outsourcing services [business assistance]; analysis of workforces; analysis of workforce performance; business management planning and development, business risk management; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; legal accountancy services, including fraud establishment and fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; market studies; auditing services; investor auditing services; data analytics relating to commercial affairs, business, electronic commerce and enterprise resource planning; data analysis services

¹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

relating to commercial affairs, business, electronic commerce and enterprise resource planning; data modelling services relating to commercial affairs, business, electronic commerce and enterprise resource planning; data management services; the aforesaid services also being provided online via global computer networks and/or the Internet; none of the aforesaid services including or relating to customs brokerage services.

Class 41

34. In its Notice of Opposition, the opponent states:

“7. In particular we maintain that the opposed Class 41 services are in particular similar to the online and electronic publications in Classes 9 and 16 of the earlier registration as such services extend to publication. It is further argued that as the earlier right covers both online/electronic publications and printed matter as well as instructional and teaching materials it covers such publications whether electronic or printed in relation to “management of commercial and financial affairs;” hence such goods are similar to the services of “Provision of training and courses relating to management of commercial and financial affairs; in class 41 of the opposed application”.

35. I accept the opponent’s argument that “Printed matter” in class 16 of its own specification covers printed matter in all fields including management of commercial and financial affairs. I also accept that there may be circumstances in which printed matter on the subject is handed out during the “provision of training and courses relating to management of commercial and financial affairs” in the applicant’s specification. However, I do not consider that this is sufficient to find complementarity between the goods and services as they are not indispensable to each other. Further, the nature and trade channels will clearly be different. There may be overlap in users on a superficial level but this will not be enough to find similarity on its own. The use may be the same; that is, to provide information about the subject in question. There may be a small degree of competition between them as someone may choose to read about a topic and research it themselves rather than enroll on a formal training course.

Notwithstanding this, in my view, there will only be a low degree of similarity between the goods and services.

36. "Printed matter" and "electronic publications" in class 16 of the opponent's specification share some similarity with "provision of online publications" and "publishing of books, reports, magazines and other printed matter" in the applicant's specification. The nature of the goods and services will clearly be different. However, there will be some overlap in users. Further, it is not uncommon for the same undertakings to be responsible for the sale of printed or electronic publications and their publishing. For example, in the case of magazines, the undertakings which produce, publish and sell the magazines will be the same. There is a complementary nature between the goods and services as the goods would not exist were it not for the provision of services for their publication. They are indispensable. I consider these goods and services to be highly similar.

Class 42

37. In its Notice of Opposition, the opponent states:

"8. In particular we maintain that the goods in Class 9 being computer software and computer software applications and the computer hardware goods in Class 9 are similar to the services of Class 42 in the opposed application to the extent that such opposed services in Class 42 are "the design development implementation of computer software, constructing internet platforms for electronic commerce, cloud computing services as well as technical consultancy in relation to the aforementioned services and also computer software technical support services.

9. We further maintain that the Class 42 services of the opposed application of "hosting digital content, namely, on-line journals and blogs"; is similar to the online and electronic publications in Class 9 and the printed journals in Class 16 of the earlier right. Similar the services of "consultancy in the fields of digital and mobile technologies, and electronic enterprise resource planning" is similar to the Class 9 goods being computer hardware and software. Further the

services of “technical consultancy in the fields electronic commerce” is similar either to the Class 9 goods of the earlier registration including the computer software and hardware goods and the retail services in Class 35.”

38. “Computer software” is the end result of its design and development. The relationship between the software and its design and development is complementary and the average consumer is likely to perceive one undertaking to be the provider of both the goods and services. It is common for software providers to offer updates to develop the software further and to provide continuing technical support for users of the software. I therefore consider “Software design, development and implementation services”, “computer software design”, “computer software design and programming services”, “development of computer software”, “development of computer software applications” and “computer software technical support services” in the applicant’s specification to be highly similar to “computer software” in the opponent’s specification.

39. “Computer software” in the opponent’s specification is clearly different in nature to “cloud computing services” in the applicant’s specification. However, users of computer software will often also use cloud services to store data generated through that software. It is not uncommon for providers of software to also provide cloud services, and in that sense there will be some overlap in trade channels. The goods and services are not in competition. I consider these goods and services to be similar to a medium degree.

40. “Electronic publications” in class 16 of the opponent’s specification is complementary to “hosting of digital content, namely, on-line journals and blogs” in the applicant’s specification. “Electronic publications” in the opponent’s specification is broad enough to cover both on-line journals and blogs. The nature of the goods and services are clearly different. However, there will be overlap in users. In order for an undertaking to provide the services of hosting digital content, it must have content available to host. Similarly, electronic publications cannot be made available without a hosting platform. They are indispensable to each other. I consider these goods and services to be highly similar.

41. The opponent argues that “constructing internet platforms for electronic commerce” in the applicant’s specification is similar to “computer software” and “computer hardware” in its own specification. Whilst I acknowledge that the construction of internet platforms may be achieved using both computer software and computer hardware, I see no reason why the consumer would consider them to be provided by the same undertakings and I do not consider this sufficient for a finding of complementarity. Construction of internet platforms is a particular field of expertise and will have different uses and trade channels to computer software and hardware. There may be some overlap in users on a superficial level but this will not be sufficient alone for a finding of similarity. There will be no competition between them. I do not consider there to be any similarity between the goods and services. If I am wrong then they will be similar to only a low degree. I have considered the other goods and services in the opponent’s specification and, in the absence of any submissions to assist me, I see no further point of similarity with the applicant’s services which improves the opponent’s position.

42. The opponent argues that “technical consultancy in relation to the aforementioned services”, “consultancy in the field of information technology, computers” and “technical consultancy in the fields of digital and mobile technologies, electronic commerce and electronic enterprise resource planning” in the applicant’s specification are similar to “computer software” and “computer hardware” in its own specification. Consultancy in these fields is a particular area of expertise that will have different uses and trade channels to computer software and hardware. I recognise that consultancy in these areas will involve the use of computer hardware and computer software, but I do not consider this sufficient to give rise to a finding of complementarity as envisaged by the case law. The users may overlap on a superficial level but this is not sufficient to give rise to a finding of similarity. The trade channels and uses of the goods and services will differ, as will their method of use. There is no competition between them as you would not choose one as an alternative for the other. I do not consider there to be any similarity between the goods and services, but if I am wrong then they will be similar to only a low degree. I have considered the similarity of the applicant’s services to the other goods and services in the opponent’s specification and, in the absence of

any substantive submissions to assist me, I see no further point of similarity which would improve the opponent's position.

The average consumer and the nature of the purchasing act

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

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

44. In its written submissions, the applicant stated:

“32. The Applicant's Goods and Services are not everyday consumer products and services. Rather, they are specialist goods and services aimed at discerning professionals, to which the purchaser will pay a high degree of attention prior to purchase.

33. The Applicant's Goods and Services are specialist products and services which be provided at considerable financial cost, and will therefore have important financial consequences, to the decision maker/purchaser of such services. Such consumers are, accordingly, likely to be more well-informed, observant and circumspect than the public at large, and will not make snap decisions on a purchase of this nature.

34. The level of attention of the average consumer will thus be higher than average when choosing the goods and services. The heightened level and duration of attention applied by this consumer to the marks and goods/services will be such that confusion as to the origin of the goods and services is unlikely, bearing in mind the dissimilarity of the goods and services and the weak similarity of the marks.”

45. In its written submissions, the opponent stated:

“The Applicant maintains that their goods and services are so highly specialist they argue that this means there cannot be confusion.

However, the opposed goods and services are not defined as highly specialist and are in fact very general and very broad, for example:

Class 9 “computer programs; computer software”

Class 16 “instructional and teaching material (not including apparatus)”

Class 35 “legal accountancy services”

Class 41 “provision of online publications”

Class 42 “computer software design”

Also the goods and services are not that specialist. Every business whether big or small could use accountancy services, for example.

The goods and services set out in the opposed application appeal to all users of such goods and services, and there is a very large amount of variance of sophistication between the biggest and the smallest user, between the simplest and the most complex user, and between the simplest and the most complex factual situation and therefore the average consumer of these goods and services, is just that, “average”, who does not have face the highest levels of difficulty or complexity in their business and monetary affairs and therefore does not need to display the highest levels of attention and as such there is a likelihood that for the identical and similar goods and similar services for the highly similar marks there is a likelihood of confusion.”

46. The average consumer for the goods may be either a member of the general public or a business user. For example, goods such as “computer software” are not limited to business users only. These purchases are likely to be fairly infrequent and can vary significantly in cost. The level of attention paid by both business users and members of the general public is likely to be at least average, as attention will need to be paid to ensure that the goods satisfy the consumer’s particular requirements. The average consumer for the services may also be either a member of the general public or a business user. For example, services such as “provision of online publications” are likely to be used by the general public whereas services such as “technical consultancy in the fields of digital and mobile technologies, electronic commerce and electronic enterprise resource planning” are likely to be used mainly by businesses. The purchases are likely to be fairly infrequent and will vary in cost significantly. The level of attention paid by both business users and members of the general public is likely to be at least average.

47. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that advice may be sought from a sales assistant or representative. The services are likely to be purchased from specialist retail outlets or their online equivalent. The purchasing process for the services is likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises’ frontage on the high street, on websites and in advertisements (such as flyers, posters or online adverts). However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

Comparison of trade marks

48. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and

conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

49. It would be wrong, therefore, to artificially dissect the trade marks, 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.

50. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
PILOT	

51. In its Notice of Opposition, the opponent stated:

“2. The marks PILOT and [the applicant's mark] are phonetically identical being both said PILOT. The marks are conceptually identical having both the concept of PILOT. Further or in the alternative if a view is taken that the logo element adds some extra conceptual material, the marks are thus at least conceptually

very similar. Visually the dominant element of the opposed mark is the word PILOT which is identical to the earlier right PILOT the marks are therefore visually very similar.”

52. In its Counterstatement, the applicant stated:

“The Applicant’s mark is comprised of distinctive and stylised graphic elements which clearly differentiate it, visually and conceptually, from the Opponent’s relied-upon plain word mark.

Furthermore, the only element of the Opponent’s mark, the plain word PILOT, contains little imaginative content and is conceptually weak in relation to the goods and services for which the Opponent’s mark is registered. Since the Opponent’s mark is conceptually weak, on a side by side comparison of the marks, the consumer’s attention will inevitably focus on the more distinctive stylised elements of the Applicant’s mark. Where an earlier mark is not especially well known to the public and consists of a mark with little imaginative content, the mere fact that the two marks may be deemed conceptually similar is not sufficient to give rise to a likelihood of confusion (*Sabel v Puma*, 25).”

53. These arguments were expanded upon by the parties in their respective written submissions and, although I do not propose to reproduce them in full here, I have taken them into account in reaching my decision.

54. The opponent’s mark consists of the 5-letter word PILOT, presented in upper case. There are no other elements to contribute to the overall impression, which is contained in the word itself. The applicant’s mark consists of the 5-letter word PILOT, presented in a white uppercase font on a blue background. The word is surrounded by a white circle which gives the impression of being the vapour trail of the airplane device which appears above the word itself. The word PILOT plays a greater role in the overall impression, with the circle, device and background all playing a lesser role.

55. Visually, the marks applicant’s mark contains the word PILOT and the opponent’s mark consists only of the word PILOT. The use of colour in the applicant’s trade mark

does not create a significant point of visual difference between the marks. The Court of Appeal has stated on two occasions following the CJEU's judgment in *Specsavers*² (see paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc* [2015] EWCA Civ 290 at paragraph 47) that registration of a trade mark in black and white covers use of the mark in colour. Consequently, the opponent's mark should be considered on the basis that it could be used in any colour. The presence of the airplane device with the circular vapour trail creates a point of difference between the marks. Notwithstanding this, I consider the marks to be visually similar to at least a medium degree.

56. Aurally, the word PILOT will be pronounced identically in both marks. As this is the sole element of the opponent's mark and the only element of the applicant's mark which will be pronounced by the consumer, the marks are aurally identical.

57. Conceptually, the word PILOT in both marks will be given its ordinary dictionary meaning of someone who drives an airplane. This conceptual meaning will be further enhanced in the case of the applicant's mark by the presence of the airplane device. In my view, the marks are conceptually identical.

Distinctive character of the earlier trade mark

58. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

² *Specsavers International Healthcare Limited & Others v Asda Stores Limited*, Case C-252/12

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

59. 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.

60. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider.

61. In its written submissions, the applicant stated:

“14. It is submitted that the Opponent’s Mark is at best weakly distinctive in relation to the Opponent’s goods and services. The word PILOT *solus* is quasi-laudatory and contains little imaginative content...”

62. In its written submissions, the opponent stated:

“The Applicant argues that the Opponent’s mark is weakly distinctive but gives no evidence why this should be. However as the mark is registered as a single word in plain text, it is a registered trade mark and must be treated as such. There are not two registers, one for strong marks, and the other for weak marks; parts A and B as it were. There is a single register, therefore [(sic)] there is no class of “weak” single word plain text marks. Even if there were, there is no

evidence to suggest that the mark would be part of that hypothetical class. For this reason the Applicant's criticisms of the Opponent's rights do not bite.

The Applicant, if they truly believe the Opponent's rights to be vulnerable per Section 3 of the Trade Marks Act, 1994 would have sought to invalidate. However they did not and the earlier rights must be considered prima facie valid.

Despite suggesting a lack of imaginative content with the earlier rights, there is no requirement for imaginative content in a trade mark, following the SAT.2 case (SAT. 1 Satelliten Fernsehen GmbH v European Union Intellectual Property Office Case C-329/02 P). The Applicant's criticisms of the Opponent's rights do not therefore bite."

63. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. The word PILOT is an ordinary dictionary word. I do not agree with the applicant, in the absence of any detailed submissions, that it would be considered a quasi-laudatory word. The word PILOT is not descriptive or allusive of the goods and services for which it is registered. In my view, the opponent's mark has a medium degree of inherent distinctive character.

Likelihood of confusion

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

services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

65. I have found the parties' marks to be visually similar to at least a medium degree and aurally and conceptually identical. I have identified the average consumer to be either a member of the general public or a business user, who will select the goods and services primarily by visual means (although I do not discount an aural component). I have concluded that at least an average degree of attention will be paid during the purchasing process. I have found the parties' goods and services to vary from identical to sharing only a low degree of similarity (except for those goods and services which I have found to share no similarity at all). I have found the opponent's mark to have a medium degree of inherent distinctive character.

66. Bearing all of these factors in mind, notwithstanding the fact that the marks are conceptually and aurally identical, I am satisfied that the visual differences are sufficient to prevent the consumer from confusing one mark for the other. I do not, therefore, consider that there is a likelihood of direct confusion.

67. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

68. Taking into account my findings summarised at paragraph 65 above, in respect of those goods and services which are similar to a medium or high degree or are identical, I consider that the consumer will view the marks as different configurations of the same mark which are being used by a single undertaking. There is, therefore, a likelihood of indirect confusion in respect of those goods and services which are similar to either a medium or high degree or are identical. There is no likelihood of indirect confusion in respect of those goods and services which are similar to only a low degree.

CONCLUSION

69. The opposition has succeeded in relation to the following goods and services, for which the application is refused:

- Class 9 Computer programs; computer software; interactive computer software; software applications; downloadable electronic publications; publications in electronically, magnetically or optically recorded and recordable forms; none of the aforesaid goods including or relating to customs brokerage services.
- Class 16 Instructional and teaching material (not including apparatus); none of the aforesaid goods including or relating to customs brokerage services.
- Class 41 Provision of online publications; publishing of books, reports, magazines and other printed matter; none of the aforesaid services including or relating to customs brokerage services.
- Class 42 Software design, development and implementation services; computer software design; computer software design and programming services; development of computer software; development of computer software applications; cloud computing services; computer software technical

support services; hosting of digital content, namely, on-line journals and blogs; none of the aforesaid services including or relating to customs brokerage services.

70. The application will proceed to registration in respect of the following goods and services only:

Class 35 Business consulting, advice and information relating to electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; outsourcing services [business assistance]; analysis of workforces; analysis of workforce performance; business management planning and development, business risk management; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; legal accountancy services, including fraud establishment and fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; market studies; auditing services; investor auditing services; data analytics relating to commercial affairs, business, electronic commerce and enterprise resource planning; data analysis services relating to commercial affairs, business, electronic commerce and enterprise resource planning; data modelling services relating to commercial affairs, business, electronic commerce and enterprise resource planning; data collection, compilation and systemisation services; compilation of computer data-bases; data management services; the aforesaid services also being provided online via global computer networks and/or the Internet; none of the aforesaid services including or relating to customs brokerage services.

Class 36 Pension services; provision of pension information; pension advisory services; pension planning services; money saving advice; financial analysis; financial research and information services; investment analysis; advice on creditor and debtor control investments, grants and financing of loans; tax reporting services (not accounting); corporate

finance services including advising on financial affairs, financial evaluation and financial consultancy; advisory services relating to credit and debt control; financial investigation; business appraisals for financial valuation; financial risk assessments; analysis of financial information; provision of online information relating to financial affairs; investment services; financial investment services; investment management services; investment, grants and financing of loans; investment asset management; arranging investments, in particular capital investments, financing services and insurance; advisory services related all the aforesaid services; the aforesaid services also being provided online via global computer networks and/or the Internet; none of the aforesaid services including or relating to customs brokerage services.

Class 41 Provision of training and courses relating to management of commercial and financial affairs; none of the aforesaid services including or relating to customs brokerage services.

Class 42 Constructing internet platforms for electronic commerce; technical consultancy in relation to the aforementioned services; consultancy in the field of information technology, computers; technical consultancy in the fields of digital and mobile technologies, electronic commerce and electronic enterprise resource planning; none of the aforesaid services including or relating to customs brokerage services.

Class 45 Legal services; expert witness services; services pertaining to legal matters including consultancy, advocacy, litigation and handling of legal formalities; tax law consultancy; corporate governance; regulatory and compliance services; drafting of deeds, legal instruments and legal documents; information and advisory services related to the aforesaid; advisory services relating to legal matters.

COSTS

71. As the parties have both been successful in roughly equal measure I do not consider that it would be appropriate to make an award of costs in either of their favour.

Dated this 11th day of January 2019

S WILSON

For the Registrar

ANNEX 1

Applicant's applied for specification (as amended)

- Class 9 Computer programs; computer software; interactive computer software; software applications; downloadable electronic publications; publications in electronically, magnetically or optically recorded and recordable forms; none of the aforesaid goods including or relating to customs brokerage services.
- Class 16 Instructional and teaching material (not including apparatus); none of the aforesaid goods including or relating to customs brokerage services.
- Class 35 Business consulting, advice and information relating to electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; outsourcing services [business assistance]; analysis of workforces; analysis of workforce performance; business management planning and development, business risk management; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; legal accountancy services, including fraud establishment and fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; market studies; auditing services; investor auditing services; data analytics relating to commercial affairs, business, electronic commerce and enterprise resource planning; data analysis services relating to commercial affairs, business, electronic commerce and enterprise resource planning; data modelling services relating to commercial affairs, business, electronic commerce and enterprise resource planning; data collection, compilation and systemisation services; compilation of computer data-bases; data management services; the aforesaid services also being provided online via global computer networks and/or the Internet; none of the aforesaid services including or relating to customs brokerage services.

- Class 36 Pension services; provision of pension information; pension advisory services; pension planning services; money saving advice; financial analysis; financial research and information services; investment analysis; advice on creditor and debtor control investments, grants and financing of loans; tax reporting services (not accounting); corporate finance services including advising on financial affairs, financial evaluation and financial consultancy; advisory services relating to credit and debt control; financial investigation; business appraisals for financial valuation; financial risk assessments; analysis of financial information; provision of online information relating to financial affairs; investment services; financial investment services; investment management services; investment, grants and financing of loans; investment asset management; arranging investments, in particular capital investments, financing services and insurance; advisory services related all the aforesaid services; the aforesaid services also being provided online via global computer networks and/or the Internet; none of the aforesaid services including or relating to customs brokerage services.
- Class 41 Provision of training and courses relating to management of commercial and financial affairs; organising conferences, seminars, symposia and meetings relating to commercial, financial and management affairs; provision of online publications; publishing of books, reports, magazines and other printed matter; translation of deeds, legal instruments and legal documents; none of the aforesaid services including or relating to customs brokerage services.
- Class 42 Software design, development and implementation services; computer software design; computer software design and programming services; development of computer software; development of computer software applications; constructing internet platforms for electronic commerce; cloud computing services; technical consultancy in relation to the aforementioned services; computer software technical support services; hosting of digital content, namely, on-line journals and blogs; consultancy in the field of information technology, computers; technical

consultancy in the fields of digital and mobile technologies, electronic commerce and electronic enterprise resource planning; none of the aforesaid services including or relating to customs brokerage services.

Class 45 Legal services; expert witness services; services pertaining to legal matters including consultancy, advocacy, litigation and handling of legal formalities; tax law consultancy; corporate governance; regulatory and compliance services; drafting of deeds, legal instruments and legal documents; information and advisory services related to the aforesaid; advisory services relating to legal matters.