

O/1021/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003635056
IN THE NAME OF LOOMIASSIST LTD
FOR THE TRADE MARK**

Loomi

IN CLASSES 9 AND 42

AND

**THE OPPOSITION THERETO UNDER NO. 427320
BY BOOMI, INC.**

Background and pleadings

1. On 30 April 2021, LOOMIASSIST LTD (“the applicant”) applied to register the trade mark ‘Loomi’ in the UK.
2. The application was accepted and published in the Trade Marks Journal on 02 July 2021 in respect of goods and services in classes 9 and 42. The contested goods and services will be set out later in this decision.
3. On 04 October 2021, Boomi, Inc. (“the opponent”) opposed the application under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application.
4. Under Sections 5(2)(b) and 5(3), the opponent relies on the goods and services covered by the three trade marks set out below:

UK00916876311

BOOMI

Filing date: 16 June 2017; Date of entry in the register: 12 October 2017

Class 9: *computer software, namely, computer software for use in data and application integration within and/or among enterprises.*

Class 42: *online software services, namely, providing temporary use via global and/or local communications networks of non-downloadable computer software for use in data and application integration within and/or among enterprises; computer programming services, namely, development of computer software for use in data and application integration within and/or among enterprises; consulting in the field of data and application integration within and/or among enterprises.*

UK00801539363

BOOMI

Filing date: 05 February 2020; Date of entry in the register: 26 November 2020

Priority date: 24 September 2019; Priority country: United States of America; TM from which priority claimed: 88629292

Class 9: *Downloadable computer software for use in data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications, managing compliance with laws and regulations, and collecting and analyzing data generated by business applications.*

Class 37: *Installation of computer hardware.*

Class 38: *Electronic data interchange services.*

Class 41: *Educational services, namely, conducting conferences and training in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation; providing non-downloadable blogs, non-downloadable videos and podcasts, via a website in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation; arranging and conducting business conferences in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation.*

Class 42: *Platform as a service (PAAS) and software as a service (SAAS) featuring software for use in data, application, database and computer system integration*

within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications, managing compliance with laws and regulations, and collecting and analyzing data generated by business applications; design of computer network data hub systems and implementation of computer network data hub systems software; data integration services in the nature of integration of computer systems and networks, applications, data and databases; computer system analysis and programming services; software programming and design; configuration of computer hardware for others using software; installation and configuration of computer software for others; consulting services in the fields of computer software, data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications; computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, engage in social networking, collaborate, ask technical questions, obtain training and technical support, all in the fields of information technology, technology support, software as a service (SAAS), cloud computing, application development, computer network management and data and application integration within and/or among enterprises.

UK00801538521

boomi

Mark Description/Limitation: The mark consists of Stylized presentation of the word "BOOMI" in lower case letters.

Filing date: 31 January 2020; Date of entry in the register: 25 November 2020.

Priority date: 27 September 2019; Priority country: United States of America; TM from which priority claimed: 88633406

Class 9: *Downloadable computer software for use in data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications, managing compliance with laws and regulations, and collecting and analyzing data generated by business applications.*

Class 37: *Installation of computer hardware for others.*

Class 38: *Electronic data interchange services.*

Class 41: *Arranging and conducting business conferences in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation; educational services, namely, conducting conferences and training in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation; providing non-downloadable blogs and non-downloadable videos and podcasts, via a website in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation.*

Class 42: *Platform as a service (PAAS) and software as a service (SAAS) featuring software for use in data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications, managing compliance with laws and regulations, and collecting and analyzing data generated by business applications; data management consulting, namely, design of computer network data hub systems and implementation of computer network data hub systems software; data integration services in the nature of integration of computer systems and networks, applications, data and databases; computer system analysis and programming services; software programming and design; configuration of computer hardware for others and installation and configuration of computer software for others; consulting services in the fields of computer software, data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications; computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, engage in social networking, collaborate, ask technical questions, obtain training and technical support, all in the fields of information technology, technology support, software as a service (SAAS), cloud computing, application development, computer network management and data and application integration within and/or among enterprises.*

5. The opponent's trade marks have filing dates that are earlier than the filing date of the application and, therefore, they are earlier marks, in accordance with Section 6 of the Act. The opponent's marks had not completed their registration process more than five years before the filing date of the application at issue. The conditions of use do

not, therefore, apply and the opponent can rely on all the goods and services for which its marks are registered.

6. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the applicant's mark is similar to its own marks, and the respective goods and services are identical or similar.

7. Under Section 5(3), the opponent states that the earlier marks have acquired a reputation in relation to the goods and services relied upon and that use of the applicant's marks would, without due cause, take unfair advantage or be detrimental to the distinctive character or repute of the earlier marks.

8. Lastly, under Section 5(4)(a), the opponent relies on the sign 'BOOM!' and claims to have used it throughout the UK since 2007 for the following goods and services:

Computer software; software as a service (SAAS); downloadable computer software for use in data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications, managing compliance with laws and regulations, and collecting and analyzing data generated by business applications; installation of computer hardware for others; electronic data interchange services; arranging and conducting business conferences in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation; educational services, namely, conducting conferences and training in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation; providing non-downloadable blogs and non-downloadable videos and podcasts, via a website in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation; platform as a service (PAAS) and software as a service (SAAS) featuring software for use in data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications, managing compliance with laws and regulations, and collecting and analyzing data generated by business applications; data management consulting, namely, design of computer network data hub systems and implementation of computer network data hub systems software; data integration services in the nature of integration of computer systems and networks, applications, data and databases; computer system analysis and programming services; software programming and design; configuration of computer hardware for others and installation and configuration of computer software for others; consulting services in the fields of computer software, data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications; computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, engage in social networking, collaborate, ask technical questions, obtain training and technical support, all in the fields of information technology, technology support, software as a service (SAAS), cloud computing, application development, computer network management and data and application integration within and/or among enterprises; online software services, namely, providing temporary use via global and/or local communications networks of non-downloadable computer software for use in data and application integration within and/or among enterprises; computer programming services, namely, development of computer software for use in data and application integration within and/or among enterprises; consulting in the field of data and application integration within and/or among enterprises.

9. The opponent claims that its goodwill entitles it to prevent the use of the applicant's mark under the law of passing off.

10. The applicant filed a defence and counterstatement, denying the claims.

11. Both parties filed evidence during the evidence rounds. The applicant also filed written submissions dated 16 May 2022. I shall refer to the evidence and submissions to the extent that I consider necessary.

12. The applicant is represented by LawBriefs Ltd and the opponent by Fieldfisher LLP. Neither party asked to be heard but the opponent filed submissions in lieu.

EU Law

13. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

The evidence

14. The opponent's evidence is provided by Edward McCarthy, the Legal Counsel of the opponent's company. Mr McCarthy's witness statement is dated 13 March 2022 and is accompanied by 22 exhibits (EM1 - EM22).

15. The applicant's evidence is provided by Almir Ramich, the Chief Executive Officer of the applicant's company. Mr Ramich's witness statement is dated 16 May 2022 and is accompanied by 2 exhibits (AR1 - AR2).

DECISION

Section 5(2)(b)

16. Section 5(2)(b) of the Act is as follows:

“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”.

17. Section 5A of the Act is as follows:

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

18. 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;

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

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

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

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

Comparison of goods and services

19. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

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

20. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- (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. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 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.”

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

The applicant’s goods and services	The opponent’s goods and services
<p>Class 9: <i>Software platform for information flow; personal assistant software program; organisational</i></p>	<p>UK00916876311</p> <p>Class 9: <i>computer software, namely, computer software for use in data and</i></p>

software and media; voice recognition software; time management software.

Class 42: *Provision of information flow software/platform as a service; provision of personal assistance software/platform as a service; provision of organisational software/platform and media as a service; provision of voice recognition software/platform as a service; provision of time management software as a service.*

application integration within and/or among enterprises.

Class 42: *online software services, namely, providing temporary use via global and/or local communications networks of non-downloadable computer software for use in data and application integration within and/or among enterprises; computer programming services, namely, development of computer software for use in data and application integration within and/or among enterprises; consulting in the field of data and application integration within and/or among enterprises.*

UK00801539363 and UK00801538521¹

Class 9: *Downloadable computer software for use in data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing*

¹ The specifications are nearly identical, any difference is not material.

and operating electronic data interchange systems, designing and deploying cloud-based applications, managing compliance with laws and regulations, and collecting and analyzing data generated by business applications.

Class 37: *Installation of computer hardware.*

Class 38: *Electronic data interchange services.*

Class 41: *Educational services, namely, conducting conferences and training in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation; providing non-downloadable blogs, non-downloadable videos and podcasts, via a website in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation; arranging and*

conducting business conferences in the fields of data, application, database and computer system integration within and/or among enterprises, cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), and workflow automation.

Class 42: *Platform as a service (PAAS) and software as a service (SAAS) featuring software for use in data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications, managing compliance with laws and regulations, and collecting and analyzing data generated by business applications; design of computer network data hub systems and implementation of computer network data hub systems*

	<p><i>software; data integration services in the nature of integration of computer systems and networks, applications, data and databases; computer system analysis and programming services; software programming and design; configuration of computer hardware for others using software; installation and configuration of computer software for others; consulting services in the fields of computer software, data, application, database and computer system integration within and/or among enterprises, for cloud computing, cloud automation, cloud data integration, creation and integration of and connectivity to application programming interfaces (APIs), workflow automation, data migration, synchronization of data, managing, ensuring integrity of, and controlling access to data shared across cloud-computing networks, establishing and operating electronic data interchange systems, designing and deploying cloud-based applications; computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, engage in social networking, collaborate, ask technical questions, obtain training and technical support, all in the fields of information</i></p>
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	<p><i>technology, technology support, software as a service (SAAS), cloud computing, application development, computer network management and data and application integration within and/or among enterprises.</i></p>
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24. In its written submissions the applicant criticises the opponent for not having provided evidence to support its assertions of a high degree of similarity between the goods/services of the respective marks. Further, the applicant submits that there is no overlap between the goods and services in question and points out that the specifications of the earlier marks include the limitation “*within and/or among enterprises*” which has no counterpart in the applicant’s specification.

25. In its submissions in lieu the opponent states that the applied for goods are wholly encompassed by the opponent’s broad goods “*computer software, namely, computer software for use in data and application integration within and/or among enterprises*”, given that the opponent’s software encompasses all the functionality described by the applicant’s goods. The opponent further states that:

- The applied-for “*software platform for information flow*” is wholly incorporated within the opponent’s “*downloadable computer software for use in data, application, database and computer system integration*”;
- The applied-for “*personal assistant software program*” is wholly incorporated within the opponent’s “*downloadable computer software ...for... workflow automation*”;
- The applied-for “*organisational software and media*” is wholly incorporated within the opponent’s “*downloadable computer software for use in data, application, database and computer system integration*”;
- The applied-for goods in class 9 are highly similar to the opponent’s class 42 services “*platform as a service (PAAS) and software as a service (SAAS) featuring ...*”;

- The opponent's services are not limited by the word "*featuring*" as "*this is a non-exclusive word meaning the following text is by way of example only. In addition, software as a service and software per se have the same uses and users, same suppliers, and are well established as being highly similar, substitutable, and related to one another*";
- The applied-for services in class 42 "*Provision of information flow software/platform as a service; provision of personal assistance software/platform as a service; provision of organisational software/platform and media as a service; provision of voice recognition software/platform as a service; provision of time management software as a service*" are identical to the opponent's services in the same class and are also similar to the opponent's goods in class 9;
- In the alternative that it is not accepted that the goods and services are identical, they are highly similar in that they are both software (per se or as a service) used by businesses in controlling and manipulating data and in automated workflows. If there are minor differences in functionality, this is not sufficient to render the goods and services different overall. The opponent's goods and services, as is standard in this industry, are provided as a suite of related products, which can be added to over time, and any minor differences in functionality are likely to be as additions to the opponent's software suite, rather than products from a separate supplier.

Class 9

26. The limitation "*within and/or among enterprises*" in the opponent's specification, means that the opponent's *computer software, namely, computer software for use in data and application integration* are used to satisfy the needs of organizations rather than individual users.

27. The applied-for *Software platform for information flow; personal assistant software program; organisational software and media; voice recognition software; time management software* are limited only by the specific functionality listed in the

specification; as such, they encompass software which incorporate the listed functionality and which are for use within and/or among enterprises.

28. The goods are similar in nature (i.e. they are both types of software), although the specific purpose of the software may be different. They may target the same users, (i.e. enterprises), and may share trade channels. These goods are not obviously competitive although they can be complementary as the opponent's *computer software for use in data and application integration* may be used to assist the integration of other applications, including the applicant's *Software platform for information flow; personal assistant software program; organisational software and media; voice recognition software; time management software* and the average consumer is likely to assume they come from the same undertaking. In my view, the competing goods are similar to a medium to high degree.

Class 42

29. The closest clash I can see is between *Provision of information flow software/platform as a service; provision of personal assistance software/platform as a service; provision of organisational software/platform and media as a service; provision of voice recognition software/platform as a service; provision of time management software as a service* in the applicant's specification and *Platform as a service (PAAS) and software as a service (SAAS) featuring software for use in data, application, database and computer system integration within and/or among enterprises* in the opponent's specification. Although I disagree with the opponent's argument in that I think that the word "featuring" limits the services to the description that follows, which means that the opponent's *Platform as a service (PAAS) and software as a service (SAAS)* relate only to *software for use in data, application, database and computer system integration*, this does not necessarily make the goods dissimilar. Likewise, as I have said, the limitation "*within and/or among enterprises*" does not make the services dissimilar because the applied-for services can also be designed for use within and/or among enterprises. The services have the same nature, (i.e. software as a services), may target the same users (i.e. enterprises), and share trade channels. They are also complementary, insofar as the opponent's *Platform as a service (PAAS) and software as a service (SAAS) featuring software for use in*

computer system integration may be used to integrate the applicant's platforms. Alternatively, the opponent's specification covers *software programming and design* which can be used to design types of software which are identical to the software/platforms offered by the applicant through its services; in that case, users would have the choice between using the applicant's service or using the opponent's services to design similar software/platforms, and there would therefore be some scope for the services to be provided through the same trade channels and to the same users. As a result, an average consumer of *Provision of information flow software/platform as a service; provision of personal assistance software/platform as a service; provision of organisational software/platform and media as a service; provision of voice recognition software/platform as a service; provision of time management software as a service* might think that the responsibility for the design of the specialist software lies with the same undertaking as that providing the applicant's services. In my view, the competing services are similar to a medium to high degree.

Average consumer

30. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

31. 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.”

32. The average consumer of the opponent's goods and services is a business user, whilst the applicant's goods and services may target both business users and members of the general public.

33. The goods and services will be available either in physical stores or via specialist providers and they will also be offered online. The selection process is likely to be dominated by the visual aspect, but I do not discount that aural considerations may play a part by way of word-of-mouth recommendations. I also regard it as unlikely that such goods and services would be chosen without some discussion, either by telephone or face to face with the retailer/provider.

34. The opponent's goods include software for the integration of data and applications and the applicant's goods include software with various functionality such as software platform for information flow, personal assistant software program, organisational software and media, voice recognition software and time management software. In both cases, the goods are unlikely to be purchased frequently and the average consumer is likely to pay particular attention to the features offered and to the software's compatibility with other applications. The degree of attention will therefore be medium to high. Similar considerations apply to the services which cover the provision of the same types of software but in the form of a service.

Comparison of marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

36. 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. The respective marks are shown below:

The applicant’s mark	The opponent’s marks
LOOMI	BOOMI boomi

Overall impression

37. The applicant’s mark ‘LOOMI’ and the opponent’s mark ‘BOOMI’ are both word-only-marks with no additional elements or stylisation and therefore the overall impression of each mark resides in the totality of the word itself.

38. The opponent also relies on a slightly stylised version of the word ‘BOOMI’ presented in black low-case letters with the tittle of the letter ‘i’ presented in grey. The dominant and distinctive element of this mark is the word itself, whilst the stylisation is so minimal that it contributes very little to the overall impression.

Visual similarity

39. In its written submissions, the applicant criticises the opponent for not having provided evidence of the claim that the marks ‘BOOMI’ and ‘LOOMI’ are highly similar. It also states that the beginnings of marks tend to make more of an impact than the

ends and that the “*highly different first letter*” of the respective marks results in a clear difference between them.

40. The opponent’s states:

The Opponent's Marks and the Sign coincide in the letters OOMI and differ only in the initial letters B and L respectively. This means that 80% of the letters are identical. Where the Opponent's Marks and the sign do differ, the difference is small given that it concerns only one letter and also given that there is a physical resemblance in the letters B and L. The two lines forming the upper case L replicate the lines forming the left and bottom edges of the upper case B. In the case of the Opponent's stylised mark, the letter B is in lower case, and there is also a strong resemblance between the "b" and the L in the Sign, with the L resembling a "b" missing the top and right hand sections of the curved part of the letter. In support of the above we refer to the decision in EUIPO Opposition No. B1989154 in which it was held that the marks BOLLI and LOLLI were confusingly similar due to having the identical last four letters and differing in their first letters being the letters B and L, *i.e.* a directly analogous situation to the current one.

In light of the above, the Sign is highly similar, visually, to each of the Opponent's Marks.

41. Though I do not agree with the opponent that the letters ‘B’ and ‘L’ are visually similar, four out of the five letters in the word elements of the marks are identical. Furthermore, they are placed in the same order. The applicant is correct in saying that, according to settled case-law, consumers generally pay greater attention to the beginning of a mark than to the end, however, that finding cannot apply in all cases and cannot call into question the principle that the assessment as to whether the marks are similar must take account the overall impression created by those marks. Furthermore, although the consumer’s attention is often caught by the first part of words, his or her visual attention may focus just as much on the last letters of the signs.² Here, the fact that the only two letters which differ are placed in the beginning of the words does not offset the visual similarities created by the presence, in both marks, of four identical letters in the same position. The marks are visually similar to a medium to high degree.

42. Aurally, the signs coincide in the pronunciation of the sequences of letters which they have in common, namely ‘OOMI’ and differ in the pronunciation of their first letters, namely ‘B’ and ‘L’. The marks are aurally similar to a medium to high degree.

² CReMESPRESSO, T-189/16, paragraph 49 and the case-law cited

43. Conceptually, neither of the marks at issue has any meaning taken as a whole and, consequently, a conceptual comparison is not possible.

Distinctive character of earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

45. Registered trade marks possess various 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. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

46. I will begin by assessing the inherent distinctive character of the earlier marks. The mark 'BOOMI' has no meaning and will be perceived as invented. As such, it is inherently distinctive to a high degree.

47. The opponent has filed evidence of use of the mark 'BOOMI' and claims that the mark benefits from enhanced distinctiveness. In its submissions in lieu the applicant says that it "does not dispute the existence of Boomi or that they have a reputation under the BOOMI mark in numerous countries, including in the United Kingdom". However, it then goes on to criticise the opponent's evidence pointing out that (a) Mr McCarthy refers to Boomi having 18,000 customers, 800 partners, 43,000 certifications and 100,000 community members across the globe – a fact which is not dispute by the applicant – however, these figures do not correspond exclusively to Boomi's activities within the UK; (b) Mr McCarthy's evidence does no more than demonstrate that 'Boomi' has a handful of key customers in the UK, including Sky, University of Sussex and Eddie Stobart. There seem to be a few more listed in the case studies section of Boomi's website but Boomi's actual activities in the UK appear to be somewhat exaggerated; (c) Mr McCarthy's witness statement refers to Boomi's international reputation. It seems that the vast majority of Boomi's marketing spend and turnover relates to its activities in the United States. The applicant assumes that the lack of effort in providing figures for the UK is due to such figures failing to support its alleged reputation in the UK.

48. There is some tension between the applicant's statement that it *"does not dispute the existence of Boomi or that they have a reputation under the BOOMI mark in numerous countries, including in the United Kingdom"*, and the applicant's criticisms to the opponent's evidence. In light of this, I have reviewed the applicant's pleadings. In its counterstatement:

- the applicant denies the opponent's claim to reputation under Section 5(3) but only to the extent that the opponent had provided no evidence to support such a claim. It states: *"The Opponent has provided no proof or evidence that it has an established reputation in the UK and in the earlier marks. Furthermore, the Opponent has provided no proof or evidence that it has a significant reputation*

in the UK and in the earlier marks". However, the opponent did not have to provide evidence of reputation at the pleading stage;

- denies the claim to passing off under Section 5(4)(a) only to the extent that given the difference between the respective marks and the goods/services provided under them, the applicant's use of its sign would not constitute a misrepresentation. As regards the opponent's claim to goodwill, the opponent neither denied nor admitted it.

49. Based on the applicant's clear statement that it does not dispute that the opponent has a reputation in the mark 'BOOMI' in numerous countries, including in the UK, I consider that a concession has been made. The concession was that the opponent had a reputation in the mark 'BOOMI' in the UK, whilst I read the applicant's criticisms to the evidence filed as being concerned with the extent of that reputation.

50. The evidence shows that the opponent is a US company established in 2000. It started trading in the UK in 2007 and Mr McCarthy says that it is the market leader in the field of cloud-based integration software. The opponent's evidence includes global turnover and marketing figures but no specific figures for the UK have been provided. The turnover ranges from USD46million in 2016, to over USD300million in 2022. The marketing figures increased from USD14million in 2019 to UDS36 million in 2022. Mr McCarthy says that *"no specific figures are provided for the UK, but the UK marketing spend and the UK turnover is proportionate"*. The evidence also indicates that 'BOOMI' has collaborated with key UK customers, including SKY. To the extent that the applicant accepted that the opponent had a reputation in the UK, any other finding is not one open to the me because the applicant had admitted the opponent's reputation. However, in the absence of clear turnover and marketing figures, I am unable to find that the opponent's reputation is more than small. Given the inherently high distinctive character of the word 'BOOMI', such reputation would not be sufficient to increase the distinctiveness of the opponent's marks to any material extent.

Likelihood of confusion

51. 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

52. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

53. In its written submission the applicant relies on the absence of confusion and refers to the following paragraph from Mr Ramich’s witness statement:

“The Loomiassist platform known as Loomi.ai has been in development since September 2017. The Loomi.ai website went live on or before 16 November 2017 as evidenced by the Way Back Machine screenshot shown at Exhibit AR2. Thus, the Loomi.ai website has been live for over 4 years. During that period of time, Loomiassist has not encountered any actual confusion with Boomi. It is therefore very unlikely that the average consumer would confuse Loomiassist’s LOOMI mark with Boomi’s BOOMI mark, as alleged by Boomi”.

54. The applicant argues that the lack of actual of actual confusion between the marks ‘BOOMI’ and ‘LOOMI’ over the past 4 years, supports the conclusion that there is no likelihood of confusion between them. Although the applicant is a UK company, there is no evidence that it has been trading in the UK after 2017. The only evidence Mr Ramich has provided is a copy of the following landing page:



55. There is no reference to any product or to any future product to be sold and supplied under the mark whether of the type specified in the application or any other. Further the page says “*Loomi is coming*” but there is no evidence that there was at any time a fully functional website. Finally, the website www.loomi.ai, does not have a UK internet code, and there is no evidence that, even if the website was working, it would have targeted the UK consumers. I therefore disregard this evidence and the argument based upon it, namely that there has been absence of confusion despite side-by-side use.

56. I now turn to the likelihood of confusion. Earlier in this decision I have found the marks to be visually and aurally similar to a medium to high degree. I have found the marks to be conceptually neutral. I have found the opponent’s marks to be inherently distinctive to a high degree. I have found the goods and services to be similar to a medium to high degree. I have identified the average consumer to be a business user or a member of the general public who will select the goods and services primarily by visual means although I do not discount an aural component. I have concluded that a medium to high degree of attention will be paid during the purchasing process for the goods and services.

57. In its submission in lieu, the opponent refers to a number of decisions from both the UKIPO and the EUIPO where marks differing in the initial letter were found to be confusingly similar. These includes, *inter alia*, the following comparisons: FRUGI vs BRUGI (O-202/12); CVIEW vs IVIEW (O-300/13); KREAM vs CREAM (O-267-17); NURA vs TURA (O/034/03); EPDQ vs VPDQ (O/082/05); GOCO vs COGO (O/413/17); ZERO vs XERO (O/787/19). The other decisions to which the opponent refers replicate the same pattern.

58. Whilst I bear in mind that (a) I am not bound by those decisions, and that (b) the facts in those decisions are different to the facts of the present case, those decisions nevertheless stress that it is not always the case that beginnings of marks are generally more focused upon, and that this must therefore be only a rule of thumb.

59. In this case, the marks share four out of five letters in the same position, the earlier mark is highly distinctive and there is no conceptual hook that can assist the recollection of the marks in the mind of the average consumers. Having taken into account all of the above factors, it is my conclusion that the similarities between the marks are such that they outweigh the differences, notwithstanding the average consumer paying a medium to high degree of attention. Compared side by side the marks could be distinguished but bearing in mind the similarities, the nature of the goods and services and taking account the effects of imperfect recollection, I conclude that there is a risk of one mark getting tangled up with the other one in the minds of the consumers. There is a likelihood of direct confusion.

60. The opposition based upon Section 5(2)(b) is successful.

Section 5(3)

61. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United

Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

62. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

63. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

64. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

65. The relevant date for assessing whether the opponent has a reputation is the filing date of the contested application, namely 30 April 2021.

66. As it will be recalled, the applicant has conceded that the opponent has a reputation in the UK, although I found that the evidence does not enable me to find more than a small reputation. The evidence suggests that if the opponent has any reputation in the UK (which is admitted) it relates to integration software as a service.

67. In its notice of opposition, the applicant pleaded its case on unfair advantage as follows:

The Opponent has an established reputation in the UK and in the Earlier Mark in respect of the goods/services applied for, and the public associate the Earlier Mark with the Opponent. The Applicant's Sign is similar to the Opponent's Earlier Mark and the public will be confused into thinking that there is a commercial connection between the Applicant and the Opponent. Furthermore, given the significant reputation in the Earlier Mark in the UK, by using its Sign, the Applicant would be able to ride on the coat tails of the Opponent and gain the benefits associated with the reputed Mark without the associated costs of developing or maintaining such a reputation.

68. It also claimed detriment to the earlier marks' reputation (because of the potentially poor-quality of the goods and services) and distinctiveness (through dilution or blurring).

69. In its written submissions, the opponent also referred to the similarity of the goods and services stating that it would cause the public to assume that the goods and services are somehow connected to the opponent's business:

The Opponent submits that it has established under the paragraphs 25-28 above under the heading "*Comparison of the relevant goods and services*" that the goods and services applied for in class 9 and 42 are either identical or similar to the Opponent's goods and services. Therefore, this identity or similarity between the goods and services in question increases the likelihood that the relevant public will make a link between use of the Sign and the Opponent's Marks. Since the Opponent has demonstrated that its earlier marks enjoy an enhanced distinctive character, acquired through use, and since it has also shown that it has longstanding reputation and renown in its earlier marks, then it is reasonable to assume that use of the Sign LOOMI in the business software industry, by the Applicant, is likely to make the relevant public think that the goods and services under offer are in some way connected to the Opponent's business.

70. I regard this pleading as alleging that the applied-for mark will gain an unfair commercial advantage as a consequence of the similarity between 'LOOMI' and 'BOOMI' leading consumers to believe there is a trade connection between their users. Claiming that use of the contested marks in relation to identical or similar goods would cause consumers to believe that there is a trade connection between the user of those marks is effectively an argument that there is a likelihood of confusion. The opponent's pleaded unfair advantage case therefore appears to be predicated on a likelihood of confusion. I have already considered and accepted that case in the course of examining the Section 5(2) ground. Having found that there is a likelihood of direct confusion, for the same reason, I also find that there is a link and an unfair advantage.

71. The opposition based upon Section 5(3) is also successful.

Section 5(4)(a)

72. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

(c)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

73. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

74. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

Goodwill

75. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

76. Although the applicant has filed evidence, I have found that the evidence does not establish use of the applied-for mark in the UK. As such, the relevant date for the purpose of Section 5(4)(a) is the filing date of the application, namely 30 April 2021.

77. The applicant has conceded (a) the opponent's reputation and (b) that the opponent has a handful of key customers in the UK. Although the opponent has neither denied nor admitted the existence of any goodwill, the concession made as regards to the existence of a reputation and customers in the UK means that the claim to goodwill is also admitted. In *CX02 BL O/393/19* at [33], Philip Johnson as Appointed Person stated as follows:

"Once such an admission is made it is deemed to be conclusively proved (a formal admission is sometimes called a "waiver of proof": Phipson on Evidence (19th Ed), paragraph 4-03). This means neither party can lead evidence contrary to the admitted fact and, accordingly, a Hearing Officer cannot find a

fact contrary to the admission (as doing so is the same as finding facts contrary to the evidence).”

78. Accordingly, I find that at the relevant date the opponent had a small but sufficient goodwill to sustain a passing off action. The opponent’s goodwill attached to a business providing integration software as a service, which is in the same field of commerce in which the applicant wishes to operate (based on the specification that is applied-for).

79. The opponent’s case is based upon the claim that the applicant’s mark ‘LOOMI’ and the opponent’s sign ‘BOOMI’ are highly similar and that a misrepresentation arises as a result of this. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “*a substantial number of members of the public are deceived*” rather than whether the “*average consumer are confused*”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here and I find that, because of the similarities discussed in respect of the Section 5(2)(b) grounds between the opponent’s sign and the applicant’s mark, members of the public are likely to be misled into purchasing the applicant’s goods and services in the belief that they are the opponent’s goods and services.

80. The opposition based upon Section 5(4)(a) is also successful.

OVERALL OUTCOME

81. The opposition is successful, and the application is refused.

COSTS

82. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of **£1,800** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing and filing a TM7 and considering the counterstatement:	£400
Filing evidence:	£800
Submissions in lieu:	£400
Official fees:	£200
Total	£1,800

83. I therefore order LOOMIASSIST LTD to pay Boomi, Inc. the sum of **£1,800**. 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 21st day of November 2022

Teresa Perks
For the Registrar