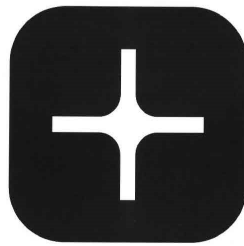


BL O/0131/23

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF
TRADE MARK APPLICATION 3627830



AND TRADE MARK APPLICATION 3627829

JetBrains
 **TECHLAB**

The JetBrains logo, which is a black rounded square with a white stylized cross, is positioned to the left of the word "TECHLAB". The word "TECHLAB" is in a bold, black, sans-serif font. Above the logo and text, the word "JetBrains" is written in a smaller, black, sans-serif font.

BY

JETBRAINS S.R.O.

WITH OPPOSITIONS NO. 427595 & 427599 THERETO

BY

GROUPE CANAL+ SA

Background

1. On 28 December 2022, I issued a provisional decision (“the earlier decision”) in relation to the consolidated proceedings involving the two contested applications UKTM 3627830 and UKTM 3627829. In the earlier decision I rejected the opposition against 3627829 under Section 5(2)(b), whilst I partially upheld the opposition against 3627830 under Section 5(2)(b) in relation to the following goods only:

Class 9 *Software; digital publications; downloadable electronic books.*

Class 16 *Printed matter, printed publications.*

Class 41 *Entertainment; providing online electronic publications (not downloadable).*

2. Within its submissions, the Applicant had provided a fall back specification on a preliminary basis in relation to classes 9, 35 and 42. The fall back specification included the addition of the following limitation:

“...relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education.”

3. As the opposition failed in relation to Classes 35 and 42 the addition of the limitation is considered redundant, and will not be added.

4. Upon issuing the earlier decision, I allowed a period of 14 days in order for the Applicant to file a finalised limitation, at which point the Opponent would be invited to provide submissions.

5. I am now in receipt of the Applicant’s finalised limitation, and the submissions of each side. Each party’s submissions have been thoroughly considered, and have led to the following conclusions:

I will allow the addition of the proposed limitation to classes 16 and 41 (as well as 9).

6. The original fall back specification was requested in relation to Classes 9, 35 and 42 only. It did not specify either classes 16 or 41. However, it is clear from the

Applicant's wording that the request was on a preliminary basis, with the "option of offering an alternative fall back specification in due course".

7. In my provisional decision, I provided the Applicant with a period of 14 days in order to submit a revised limitation for class 9, as the opposition had not been successful in relation to Classes 35 and 42. Whilst I indicated in paragraph 126 (as referred to by the Opponent) that the limitation would have no effect on the goods and services in class 16 and 41, this was on the basis that the original fall back specification request had not cited those classes. It was not for any other reason, such as it would not be applicable or permitted in relation to those classes, for example. Considering that my comments in paragraph 126 were part of an interim conclusion only, and also considering the nature of the Applicant's preliminary request to add the fall back specification, I have decided to allow the limitation to be added to Class 16 and 41 as well as Class 9. Therefore, in accordance with Rule 62 of the Trade Mark Rules 2008, the Tribunal is prepared to allow the addition of the limitation as requested by the applicant.

8. The contested specifications in classes 9, 16 and 41 now read:

Class 9 *Software; digital publications; downloadable electronic books; **all the aforesaid relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education.***

Class 16 *Printed matter, printed publications; **all the aforesaid relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education;** art prints, stickers, posters.*

Class 41 Entertainment; providing online electronic publications (not downloadable); **all the aforesaid relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education.**

The limitation overcomes the opposition in relation to the contested Class 9 software.

9. My original finding was that the contested *software* was a general category that could include within it a type of software that enabled the devices, apparatus and instruments (used in relation to providing, viewing, storing and selecting television channels) in Class 9 of the earlier mark to function. As a result, the contested *software* was found to be complementary to the goods in Class 9 of the earlier mark.

10. The Applicant's limitation identifies that the contested *software* now relates specifically to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education. The newly identified fields of interest to which the contested *software* relate are not, in my view, in any way similar to software that enables the provision, viewing, storing or selection of television channels. Therefore, the limitation is considered to overcome the opposition in relation to the contested *software* in Class 9.

The limitation does not overcome the opposition in relation to the contested Class 9 digital publications, downloadable electronic books.

11. My original finding was that the contested *digital publications* and *downloadable electronic books* could be in the form of a digital user manual for the items in Class 9 of the earlier mark, i.e., a user manual for items used in relation to providing, viewing, storing and selecting television channels. As a result, the goods at issue were considered to be complementary. The Applicant's limitation identifies that the contested *digital publications* and *electronic books* all now relate specifically to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education. The newly identified fields of interest to which the contested *digital publications* and *electronic books* relate are not, in my view, in any way similar to items that enable the provision, viewing, storing or selection of television channels.

12. However, it must be remembered that my original finding also considered the contested *digital publications* and *downloadable electronic books* to be similar to a

medium degree to the *users guides* in class 16 of the earlier mark. The *user guides* for which the earlier mark is registered is a broad general category that could include user guides (that are included in the general category of *digital publications* and *downloadable electronic books*) which are specific to *engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education*. Therefore, the limitation does not overcome the similarity between the goods at issue.

The limitation does not overcome the opposition in relation to the contested Class 16 Printed matter, printed publications.

13. Although the *printed matter* and *printed publications* are now limited to relate specifically to *engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education*, the newly identified fields of interest nevertheless remain included within the broad general category of the *user guides* in Class 16 of the earlier mark. The Applicant's limitation does not, therefore, overcome the identity between the goods at issue.

The limitation does not overcome the opposition in relation to the contested Class 41 Entertainment

14. My original finding was that the contested *entertainment* is a general category that includes the *television entertainment* of the earlier mark. As a result, the services were considered to be identical. The Applicant's limitation identifies that the contested *entertainment* now relates specifically to *engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education*. However, as submitted by the Opponent, such themes of *entertainment* could still feature in *television entertainment*. The limitation does not, therefore overcome the identity between the services at issue.

The limitation does not overcome the opposition in relation to the contested Class 41 Providing online electronic publications (not downloadable);

15. My original finding was that the contested *Providing online electronic publications (not downloadable)* was similar to a medium degree with the *user guides* in Class 16 of the earlier mark. The *user guides* for which the earlier mark is registered is a broad

general category that could include user guides (that are included in the general category of *Providing online electronic publications (not downloadable)*) specific to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education. The Applicant's limitation does not, therefore, overcome the similarity between the goods and services at issue.

Conclusion for application 3627830

16. The opposition is partially successful under Section 5(2)(b).

Subject to an appeal, the contested application will be refused for the following:

Class 9 *Digital publications; downloadable electronic books; all the aforesaid relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education.*

Class 16 *Printed matter, printed publications; all the aforesaid relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education.*

Class 41 *Entertainment; providing online electronic publications (not downloadable); all the aforesaid relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education.*

Subject to an appeal, the contested application shall be published for the following:

Class 6 *Art objects of metal, metals in foil or powder form for 3D printing.*

Class 9 *Software; all the aforesaid relating to engineering, robotics, artificial intelligence, 3D printing, augmented reality, virtual reality and education*

- Class 14 *Key chains, Watch straps of synthetic materials, non-metal key rings, non-metal key chains, articles of jewelry made of precious metals or precious metal alloys, pins.*
- Class 16 *Art prints, stickers, posters.*
- Class 17 *Rubber, artificial resins (semi-finished products), decoration articles made of rubber, plastic filaments for 3D printing.*
- Class 19 *Works of art of stone, artificial stone, clay.*
- Class 20 *Works of art of wood, wax, plaster or plastic, model figures of synthetic resin, models of synthetic resin.*
- Class 21 *Cups, glasses, works of art of glass, porcelain or ceramic.*
- Class 25 *Clothing, t-shirts, footwear, headgear.*
- Class 28 *Toys, playthings.*
- Class 30 *Coffee, tea, artificial coffee, cocoa-based beverages, coffee-based beverages, tea-based beverages.*
- Class 35 *Retail Services related to art objects of metal, metals in foil or powder form for 3D printing, software, digital publications, downloadable electronic books, key chains, Watch straps of synthetic materials, nonmetal key rings, non-metal key chains, articles of jewelry made of precious metals or precious metal alloys, printed matter, art prints, printed publications, rubber, artificial resins (semi-finished products), decoration articles made of rubber, plastic filaments for 3D printing, works of art of stone, artificial stone, works of art of wood, wax, plaster or plastic, model figures of synthetic resin, models of synthetic resin, cups, glasses, works of art of glass, porcelain or ceramic, clothing, tshirts, footwear, headgear, toys, playthings, coffee, tea, artificial coffee, cocoa-based beverages, coffee-based beverages, tea-based beverages; marketing.*
- Class 40 *Printing, 3D printing, metal printing.*

Class 41 *Education, art gallery services, arranging and conducting of seminars and conferences, arranging and conducting of exhibitions for cultural and educational purposes.*

Class 42 *Science and technological services, computer software design, maintenance of computer software.*

Class 43 *Restaurant services, cafes, bar services, snack-bars.*

Conclusion for application 3627829

17. The opposition fails under Section 5(2)(b). Subject to an appeal, the contested application shall proceed to registration.

Costs

18. The proceedings are consolidated, and the costs award will reflect the consolidation accordingly.

19. As the opposition failed in relation to application 3627829, the Applicant was successful and is therefore entitled to a contribution towards its costs. As opposition was only partially successful in the minority in relation to application 3627830, with the majority of goods and services proceedings to registration, the Applicant is considered to again be successful and is therefore entitled to a contribution towards its costs.

20. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the Applicant the sum of £1,800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and

filing a counterstatement (x2) ¹	£600
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¹ The proceedings were not consolidated until after the counterstatements had been received.

Preparing evidence and considering and commenting on the other side's evidence	£1,200
Total	£1,800

21. I therefore order Group Canal+ SA to pay Jetbrains s.r.o. 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 6th day of February 2023

Dafydd Collins

For the Registrar