

**O/0306/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3716017**

**IN THE NAME OF ORCHESTR8 DIGITAL LTD**

**TO REGISTER THE FOLLOWING TRADE  
MARK:**

**Orchestr8 Digital**

**IN CLASS 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 432247**

**BY ACCESS UK LTD**


## **Background and pleadings**

1. On 30 October 2021, Orchestr8 Digital Ltd ('the applicant') applied to register the trade mark "Orchestr8 Digital". It was accepted and published in the Trade Marks Journal on 28 January 2022 in respect of the following services:

Class 42: Software development services; Computer software design and development; Software development, programming and implementation; Consultancy relating to software design and development; Design and development of software for inventory management; Design and development of computer software for logistics; Product development; Product development consultation; Consultancy relating to the design and development of computer software programs; Website development services; Design and development of software in the field of mobile applications.

2. On 28 March 2022, Access UK Ltd ("the opponent") filed a notice of opposition against the application. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all the applied for services.

3. The opponent relies upon the following trade marks:

Earlier Mark	Registration no.	Registration date	Goods and Services relied upon
	UK 2532381 "The first earlier mark"	26 March 2010	Class 9: Computer software for simulation, planning and scheduling applications; scheduling software for manufacturing, businesses and other organisations.  Class 42: Software configuration, maintenance and support services; consulting services in respect of customised software development.
	UK 2532380	26 March 2010	Class 9: Computer software for simulation,

<b>ORCHESTRATE</b>	“The second earlier mark”		<p>planning and scheduling applications; scheduling software for manufacturing, businesses and other organisations.</p> <p>Class 42: Software configuration, maintenance and support services; consulting services in respect of customised software development.</p>
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4. By virtue of their earlier filing dates, the opponent’s trade marks are earlier marks, in accordance with section 6 of the Act. Both marks had completed their registration processes more than five years before this date and are therefore subject to the proof of use provisions contained in section 6A of the Act.

5. In its notice of opposition, the opponent contends that the competing trade marks are highly similar and that the respective goods are either identical or similar, giving rise to a likelihood of confusion.

6. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use in respect of both of its earlier marks.

7. The opponent is represented by Williams Powell whereas the applicant is represented by Humphreys & Co. Whilst the opponent filed evidence, the applicant did not. Neither party requested a hearing however the applicant did file written submissions in lieu. I now make this decision after careful consideration of the papers before me.

8. 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 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.

## DECISION

### Proof of use

9. The applicant has requested proof of use in these proceedings in respect of the opponent's earlier marks. I will begin by assessing whether and to what extent the evidence supports the opponent's statement that it has made genuine use of the marks in relation to the goods and services relied upon. In accordance with section 6A(1A) of the Act, the relevant period for this purpose is the five years ending on the filing date of the contested application: 31 October 2016 to 30 October 2021.

10. The relevant statutory provisions are set out in Section 6A of the Act, which states:

“(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)- (5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

11. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade marks was made within the relevant territory in the relevant period, and in respect of the goods and services as registered.

### **Relevant case law**

13. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The Court of Justice of the European Union (“CJEU”) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

14. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not genuine use.<sup>1</sup>

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<sup>1</sup> *Nike Innovate CV v Intermar Simanto (Jumpman)* O/222/16 Daniel Alexander QC (as he then was) sitting as the Appointed Person on appeal.



15. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

16. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed

for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

17. In other words, a number of factors must be considered when assessing whether genuine use of the mark has been demonstrated from the evidence filed. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>2</sup>

### **Opponent's evidence**

18. The opponent's evidence consists of a witness statement dated 30 August 2022 from the company's Legal Counsel, Kirsty Wright and is accompanied by 12 exhibits. She states that the opponent has used both their marks in relation to the goods and services for which they are registered in the UK since their registration dates.

19. From the outset I note that the opponent's evidence has its limitations. Ms Wright has not filed evidence relating to turnover figures, advertising expenditure nor details as to whether any of the goods or services have been sold within the UK during the relevant period. Several of the exhibits filed are clearly dated outside of the relevant period including a single invoice dated 14 March 2014<sup>3</sup>. The invoice itself does not include a customer name or address, so it is unclear if the sale was made to a UK based customer. As such, I have not given any of the exhibits dated outside of the relevant period any consideration in reaching my decision and I will focus my assessment on the exhibits dated within the relevant period.

20. The opponent has provided several prints from their Twitter account in Exhibit 2 demonstrating that they have 19 followers. The mark “Orchestrate” is clearly visible and the profile bio states, “Access Orchestrate offer easy-to-use planning software, production scheduling software and simulation software.” Many of the tweets are unclear as they simply include hyperlinks as shown below:

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<sup>2</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, GC Case T-415/09

<sup>3</sup> Exhibit 3



21. The most recent tweet dated 24 May 2019 appears to show a webinar demonstrating an overview of the Orchestra software however the opponent has not provided any further information as to who engaged with this tweet or if it generated any sales within the UK.

22. Exhibit 5 includes printouts taken from the Waybackmachine web archive of the opponent's website as it was on 16 October 2021. The website describes Access Orchestra as advanced planning and scheduling software (APS) and invites potential customers to book a demo or view a brochure. The website also includes a hyperlink to a case study from "TMB Patterns" demonstrating how they used the software. This is outlined as follows:

Find out how TMB Patterns used Access Orchestra software for efficient capacity planning and scheduling.

***"The live plan means different departments can see exactly what is happening. It provides a visual check on jobs to find out how they are progressing and when they are finished. We are also able to carry out accurate 'what-if?' scenario planning, so we can provide a completion date for customers and understand the implications of taking on a project."***

**Read Full Case Study ([/Web/20211016024355/Https://Www.Theaccessgroup.Com/En-Gb/Manufacturing/Case-Studies/Live-Updates-Bolstering-Operations-Tmb-Patterns-Access-Orchestrate/](https://www.theaccessgroup.com/en-gb/manufacturing/case-studies/live-updates-bolstering-operations-tmb-patterns-access-orchestrate/))**

 Adobe Stock 334760694

23. Whilst this exhibit appears to be in relation to the registered goods in class 9, it is unclear from the evidence provided who “TMB Patterns” are, if they are based in the UK and when they used the software. The mere existence of a website and copies of screen shots in isolation, are of little value evidentially without any supporting information such as an indication as to how many customers viewed the website, over what period, how many products were sold via the website, the volume of custom generated as a result or the extent that the relevant consumer had been exposed to the mark by visiting the website. These details have not been provided.

24. Turning to Exhibit 6, an extract from the Software Advice website is provided including reviews of Access Orchestrate software from three users dated 16 September 2021, 7 September 2021 and 27 July 2021 respectively. I note that Ms Wright claims in her witness statement that the reviews show use of the software during the relevant period. Each review states that the user has used the software for 2+ years however, no details are provided as to the dates of use and if this was during the relevant period and none of the reviews refer to any of the registered services. Moreover, I find three reviews for a software product to be minimal when considered in the context of the software industry which is significant.

25. Exhibit 8 is an extract of an article on the opponent’s website which is said by Ms. Wright to provide customers of the Orchestrate software with information and advice regarding the functionality of the software<sup>4</sup>. The article was accessed on 21 July 2022 however the printout clearly shows that the article is two years old and therefore within the relevant period. It is shown in the exhibit that the article has received 971 views however, no further details have been provided as to when the article was viewed and how many of the views would have been from within the UK, or whether those viewers were in fact customers of the opponent and its software sold under the earlier Orchestrate marks. The article itself does not appear to demonstrate any direct evidence of sales of the registered goods and services to any customers.

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<sup>4</sup> See paragraph 10 of the witness statement of Kirsty Wright

26. Exhibits 9 and 10 are also said to be accessed from the opponent's website on 21 July 2022. Exhibit 9 is a manual for orchestrate software which is undated but states that the manual is two years old. Exhibit 10 is dated 22 June 2018. The manual documented in Exhibit 9 shows that it has received 1552 views but again, no further details have been provided as to when the article was viewed and how many of the views would have been from within the UK, or whether it was viewed by customers of the opponent. In response to this, the applicant in their submissions in lieu states, "Again, all references are to a planning and scheduling software product, not services. Contrary to what is suggested by the Opponent, any consequential or ancillary explanations/advice given by a company as to how its software product works, does not equate to standalone e.g., software consulting services being offered and supplied under a mark." I agree with the applicant that these exhibits are not sufficient to demonstrate use of the registered consulting services in relation to software. I find the provision of manuals such as the ones shown in Exhibits 9 and would be expected by consumers when purchasing such software rather than being considered as a consultancy service in respect of customised software development.

### **Use with another element**

27. In their submissions in lieu, the applicant draws attention to the fact that much of the evidence provided has been for the sign "Access Orchestrate" whereas the opponent's second earlier mark is registered for the word "Orchestrate".

28. In their submissions they state, "...it is unequivocal from the evidence submitted by the Opponent that its planning and scheduling software product has, if at all, only been offered under the mark ACCESS ORCHESTRATE within the relevant period. Use of the mark ACCESS ORCHESTRATE is not use of ORCHESTRATE. It is not use of the registered mark a form that does not alter its distinctive character as the addition of the word 'ACCESS' is a distinctive element, particularly when it appears at the beginning of the mark as it does here."

29. Whilst I accept that some of the evidence dated within the relevant period does show the sign "Access Orchestrate", I acknowledge that where a registered mark is

used as part of another mark or with additional matter, this may still constitute use of an acceptable variant of the mark as registered, where this element continues to act independently as an indicator of origin.<sup>5</sup>

30. The website printout shown in Exhibit 5 refers to Access as a “Manufacturing Suite” and then provides a list of software modules that are available from Access (including “Orchestrate” as a planning and scheduling module):

## The Access Manufacturing Suite

Below are just some of the modules that can be chosen as part of the suite:

- Finance
- Material requirements planning (FactoryMaster)
- Planning and scheduling (Orchestrate)
- Warehouse management (Delta)
- Order Management
- Stock Management
- HR
- Payroll
- CRM
- Shop Floor Data Capture
- Analytics

31. In my experience it is not uncommon for software companies to provide various software packages with different names. Having considered the evidence dated in the relevant period, I find this does not alter the distinctive character of the second earlier word mark, ‘Orchestrate’. This is because the evidence shows ‘Access’ to be the house mark or undertaking responsible for a number of software products (in theory, I will come on to the sufficiency of evidence for proving use shortly). The ‘Orchestrate’ part is operating as a secondary mark referring to the planning software product.

## Conclusion

32. I have carefully considered the evidence provided by the opponent and whether this meets the requirements for genuine use as per *Walton*, set out earlier in this decision. I am also mindful of the guidance from the *Dosenbach-Ochsner* and *Awareness* appeal cases emphasising the need to consider what the evidence fails

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<sup>5</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

to “show” and what might reasonably have been conclusively shown. In my analysis above, I have highlighted numerous shortcomings in the evidence.

33. The first earlier mark is only shown once in the evidence in Exhibit 2 and is dated as 2011/2012, years before the relevant period. Consequently, the evidence filed in relation to this mark has failed to establish that it has been put to genuine use in the UK during the relevant period for its registered goods and services.

34. Turning to the second earlier mark, as previously outlined, no turnover, advertising or market share figures have been provided. The only evidence of sales provided was a single invoice which is dated outside of the relevant period. Documentation such as manuals being made available on a website are not proof of sales of software products, nor are they evidence of the provision of the services for which the earlier marks are registered under class 42. Promotion or information provided on Twitter has had very little reach as the opponent had 19 followers at the point the evidence was provided. Similarly, reviews from businesses which cannot be identified as UK customers and for which no purchase date or evidence of purchase has been provided, do not assist the opponent. I consider that the consumer of the goods and services in question are likely to be business users and as previously stated, the size of the software industry is significant. After considering the evidence and relevant caselaw, I am not satisfied that the opponent has demonstrated genuine use of its marks in the UK for any of the goods or services for which it is registered. The consequence of which is that the earlier marks may not be relied upon to support the opponent’s claim and the opposition must inevitably fail.

35. The opposition under section 5(2)(b) has failed in its entirety. Subject to any successful appeal, the contested mark will proceed to registration in the UK for all the specified services.

## **COSTS**

36. The applicant has been successful in this case and is therefore entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1



July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement:	£200
Considering the other side's evidence:	£500
Filing submissions:	£300
<b>Total:</b>	<b>£1000</b>

37. I therefore order Access UK Ltd to pay the sum of £1000 to Orchestr8 Digital Ltd. 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 27<sup>th</sup> day of March 2023**

**Catrin Williams**  
**For the Registrar**