

O/0476/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003717010
BY CARBON RE LTD TO REGISTER THE FOLLOWING TRADE MARKS
(SERIES OF TWO):**

Carbon Re

CarbonRe

IN CLASSES 9 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 431256 BY NEAR INTELLIGENCE HOLDINGS, INC**

Background and Pleadings

1. On 2 November 2021, Carbon Re Ltd ('the Applicant'), filed an application to register the following series of two trade marks:

Carbon Re
CarbonRe

2. The application was published for opposition purposes in the Trade Marks Journal on 26 November 2021. Registration is sought in respect of the following goods and services:

Class 9:	<i>Artificial intelligence software; intelligent gateways for real-time data analysis; artificial intelligence software for analysis; environmental monitoring software; computer software; downloadable software.</i>
Class 42:	<i>Software as a service; platforms for artificial intelligence as software as a service [SaaS]; artificial intelligence consultancy; scientific and technological research and advice; compilation, monitoring and analysis of environmental information; information services relating to environmental issues and provision of such services online from a computer database or from the Internet; assessment of companies' and individuals' greenhouse emissions; determination of such emissions; emissions reduction advisory services; provision of information, advice and consultancy in relation to carbon measurement and reduction; advisory services relating to energy efficiency; technical data analysis; computer services for the analysis of data; technical advisory services relating to renewable energy; energy efficiency, consultancy services in relation to climate change and greenhouse gas mitigation programmes and to emission reduction projects; information in the fields of environmental emissions; providing scientific information in the</i>

	<i>fields of climate change and global warming; collection of information relating to the environment; advisory services relating to environmental pollution; advisory services relating to environmental protection; constructing an internet platform for electronic commerce; advisory and consultancy in relation to all the aforesaid services. All of the aforesaid in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials.</i>
--	--

3. On 22 February 2022, the application was opposed by Near Intelligence Holdings, Inc. ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The Opposition is directed against all of the Applicant's goods and services. The Opponent relies on the following earlier registration:

International Registration WO0000001359498

CARBON

Designation date: 31 May 2017

Date of protection of the international registration in the UK: 25 January 2018

Priority date: 8 December 2016 (Priority country: Singapore)

Registered in respect of the following services:

Class 35:	<i>Compiling and analyzing data to provide location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers to businesses.</i>
Class 42:	<i>Software as a service (SaaS) for the purpose of analyzing data regarding location intelligence, geospatial information, socio-</i>

	<i>cultural information, behavioral information and human factors information about potential customers for businesses.</i>
--	---

The Opponent relies upon all of its services.

4. The Opponent claims that:

- the parties' marks are highly similar;
- the parties' goods and services are identical or highly similar;
and
- that there is a likelihood of confusion between the parties' marks.

5. The Applicant filed a Defence and Counterstatement in which it:

- Denies that the parties' goods and services are similar or claims that that similarity 'is so low that it outweighs any visual similarity' between the marks;¹
- Accepts that the parties' marks 'are visually and aurally similar in that they both contain the word 'Carbon' but argues that the presence of 'RE' in the Applicant's mark 'distinguishes the Applicant's mark from the Opponent's';
and
- Denies that there is a likelihood of confusion between the parties' marks.

6. The Opponent is represented by Forresters IP LLP. The Applicant is represented by Stephens Scown LLP. Neither party has filed evidence. A hearing was neither requested nor thought necessary. Only the Opponent has filed written submissions in lieu of a hearing. I will not summarise the Opponent's written submissions here, but I confirm that I have read them and will refer to them where necessary in my decision. The following decision has been made after careful consideration of the papers before me.

Decision

Section 5(2)(b) of the Act and related case law

¹ Applicant's Counterstatement, paragraph [22]

7. Section 5(2)(b) of the Act states:

“5(2) A trade mark shall not be registered if because –

(a) ...

(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.”

8. In accordance with section 6 of the Act, the Opponent’s mark is an earlier mark by virtue of its priority date which fell before the filing date of the Applicant’s mark (2 November 2021).

9. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged because the Opponent’s mark had been protected in the UK for less than 5 years on the date on which the Applicant filed its Application for the registration of its mark. The Opponent is therefore entitled to rely upon all of the services that it seeks to rely upon.

10. The following principles are derived from the decisions of the Court of Justice of the European Union² (“CJEU”) 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*

² 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.

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 C120/04; Shake 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

11. Section 60A of the Act provides:

(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the 'Nice Classification' means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.

12. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties' goods and services must be taken into account:

"[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 are complementary".

13. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281³, identified the following factors for assessing similarity of the respective goods and services:

- (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.

14. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC, sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

³ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

15. In making an assessment between the competing services, I bear in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05:

“29. ... 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”.

16. In construing the terms used in the parties’ specifications, I will follow the guidance of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49].

Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is

equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

17. The Applicant's goods and services can be found at paragraph [2] and the Opponent's services can be found at paragraph [3].

Class 9

Applicant's goods: *computer software; downloadable software*

18. I compare the Applicant's goods to the Opponent's class 42 service: *Software as a service (SaaS) for the purpose of analyzing data regarding location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers for businesses*. I understand that 'Software as a service (SaaS)' is the provision of centrally-hosted software by way of a 'cloud' which is licensed on a subscription basis. The Opponent's service is specifically for use in the fields enumerated in the wording of the term which are, broadly speaking, concerned with consumer behaviour and market research, the ultimate purpose of which is to generate custom. The Applicant's terms are very broad and will cover software for use in any field. The purposes of the respective goods and service will therefore overlap somewhat because the Applicant's goods will cover software for use in the fields to which the Opponent has restricted its services. However, the overlap will not be total because the Applicant's goods will cover software used for a multitude of purposes. For both parties' offerings, the average consumer will likely be predominantly the professional public. In my view, users will likely overlap only to the extent that the Applicant's goods cover software focused on the fields to which the Opponent's services relate. Trade channel overlap is possible; the same undertaking might provide both software as goods and the Opponent's software as a service in the specified fields. Methods of use will differ; the Applicant's software as goods will typically be loaded on to the user's device or system, whereas the Opponent's services will be accessed by way of a 'cloud'. The parties' offerings will differ in nature; the Applicant's offering being goods (albeit non-physical entities) as opposed to the Opponent's acts of service. In my view, the competing goods and services will be in a competitive relationship

only as far as the Applicant's goods cover software in the fields to which the Opponent's services relate; in which case, a purchaser might deliberate over whether to purchase a subscription to the Opponent's service or whether to purchase the appropriate software as goods. I do not find complementarity; neither good/service is necessary for each other even if the average consumer did presume both to originate from the same undertaking. In the light of the foregoing, I find the parties' goods and services to have a low to medium level of similarity.

Applicant's goods: *Artificial intelligence software*

19. I understand that 'artificial intelligence software' is a computer program which mimics human behaviour by learning various data patterns. I compare these goods to the Opponent's *Software as a service (SaaS) for the purpose of analyzing data regarding location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers for businesses*. The Opponent's services focus on customer behaviour and are ultimately intended to help businesses increase sales. The Applicant's term is, in my view, a broad term because artificial intelligence software can be employed in a multitude of fields, including the fields in which the Opponent's services operate. There will therefore be some overlap between the parties' goods and services in terms of purpose. The overlap will be partial because many of the Applicant's goods will not be used in relation to customer behaviour, market research etc. My observations in respect of the above comparison at [18] on users, trade channels, physical nature of the respective goods/services, and whether they are competitive or complementary, also apply here. I find the parties' goods and services to have a low to medium level of similarity.

Applicant's goods: *artificial intelligence software for analysis*

20. The Applicant's goods are, to my mind, pieces of artificial intelligence software intended to analyse data. I compare these goods to the Opponent's *Software as a service (SaaS) for the purpose of analyzing data regarding location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers for businesses*. As already

noted, the Opponent's services focus on customer behaviour and market research. I consider the Applicant's 'artificial intelligence software for analysis' to be a broad term because the goods could be employed to analyse data in a multitude of areas, including those to which the Opponent's services relate. There will therefore be a partial overlap between the parties' offerings in terms of their purposes. My observations in respect of the above comparison at [18] on users, trade channels, physical nature of the respective goods/services, and whether they are competitive or complementary, also apply here. I find the parties' goods and services to have a low to medium level of similarity.

Applicant's goods: *environmental monitoring software*

21. I compare the Applicant's goods to the Opponent's *Software as a service (SaaS) for the purpose of analyzing data regarding location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers for businesses*. The Applicant's goods will, to my mind, cover software for use in monitoring certain features of the environment, such as levels of pollutants, to give one example. The parties' goods and services will share a purpose only to the very broad extent that both offerings provide a software solution, albeit one is as a service and the other is a good. The specific purposes will be different because the party's offerings are in distinct fields, i.e. customer behaviour/market research versus environmental monitoring. Both parties' goods/services will be typically used by the professional public but the difference in fields makes user overlap unlikely. Trade channel overlap is possible; it is conceivable that the same undertaking might provide both parties' offering despite them relating to different fields. The goods and services will differ in terms of physical nature; one being an act of service and the other being a good (albeit a non-physical entity). I find the goods and services to be neither competitive nor complementary. In the light of the foregoing, I find the respective goods and services to be dissimilar. If I am wrong about that, then the level of similarity will be no more than very low.

Applicant's goods: *intelligent gateways for real-time data analysis*

22. I understand that ‘intelligent gateways’ are either devices or programs that serve as the connection point between the ‘cloud’ and other devices and enable the flow of data in both directions, i.e. both from and to the cloud. I compare these goods to the Opponent’s *Software as a service (SaaS) for the purpose of analyzing data regarding location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers for businesses*. Although both parties’ offerings might be used to analyse data, the primary purpose of the Applicant’s goods is to connect devices to a cloud. The goods and services will therefore be distinct in terms of their primary purposes. In my view, users will overlap somewhat; a user of the Applicant’s ‘gateways’ (which connect devices to the cloud) might also purchase the Opponent’s services (which involve cloud-based software). Trade channels will, to my mind, also likely overlap; an undertaking might sell both parties’ offerings. The goods and services will differ in nature, one being a good (albeit a non-physical entity) and the other being acts of service. The goods and services are not competitive, neither being substitutable for the other. I do, however, find complementarity; the Applicant’s ‘intelligent gateways’ will likely be important for many users of cloud-based software services and the average consumer might presume both to originate from the same undertaking. I find the parties’ goods and services to have a low to medium level of similarity.

Class 42

Applicant’s services: *Software as a service; [...] in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials*.

23. I compare the Applicant’s services to the Opponent’s *Software as a service (SaaS) for the purpose of analyzing data regarding location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers for businesses*. The parties’ services will coincide in purpose to the broad extent that both are ‘software as a service’. However, their specific purposes will differ by virtue of their use in different fields;

the Applicant's services focus on the environment and/or industrial and energy processes, whereas the Opponent's services focus on market research and customer behaviour. In my view, users will likely be distinct by virtue of the different fields to which the respective services relate. Trade channels may overlap; the same undertaking might provide both parties' services. The services will be at least highly similar in nature, both parties' offerings being 'software as a service'. I find the services to be neither competitive nor complementary. Neither service is substitutable for the other, due to the specific and distinct fields to which the services relate. Neither service is necessary or important for the other, even if the average consumer were to presume both to originate from the same undertaking. I find the parties' services to have a low level of similarity.

Applicant's services: platforms for artificial intelligence as software as a service [SaaS]; [...] in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials.

24. The Applicant's service is, as I understand it, 'software as a service' which is specifically the provision of a platform for artificial intelligence. I compare this to the Opponent's *Software as a service (SaaS) for the purpose of analyzing data regarding location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers for businesses*. My comments on the comparison of the parties' services above at [23] also apply here. I find the parties' services to have a low level of similarity.

Applicant's services: artificial intelligence consultancy; emissions reduction advisory services; provision of information, advice and consultancy in relation to carbon measurement and reduction; advisory services relating to energy efficiency; technical advisory services relating to renewable energy; energy efficiency, consultancy services in relation to climate change and greenhouse gas mitigation programmes and to emission reduction projects; advisory services relating to environmental pollution; advisory services relating to environmental

protection; advisory and consultancy in relation to all the aforesaid services⁴; All of the aforesaid in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials.⁵

25. The Applicant's services involve the provision of information, advice or consultancy in relation to the fields underlined above at [24]. None of the Opponent's services entail the provision of information, advice or consultancy. All of the Opponent's services relate to customer behaviour and market research, a field distinct from those to which the Applicant's services relate. Bearing in mind the purposes, users, trade channels and natures of the parties' services, and whether or not they are competitive or complementary, I do not find any similarity between the Applicant's services and those of the Opponent. I find the parties' services to be dissimilar.

Applicant's services: assessment of companies' and individuals' greenhouse emissions; determination of such emissions

26. In my view, 'assessment' of greenhouse emissions and 'determination' of greenhouse emissions mean the same thing, i.e. measurement of the emissions. The two terms noted above are therefore synonymous. The purposes of the Applicant's services are distinct from the purposes of the Opponent's services, which are concerned with compiling and analysing data in the fields of customer behaviour and market research. Bearing in mind the users, trade channels and natures of the parties' services, and whether or not they are competitive or complementary, I do not find any similarity between the Applicant's services and those of the Opponent. I find the parties' services to be dissimilar.

Applicant's services: compilation, monitoring and analysis of environmental information; [...] in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials.

⁴ This term relates to all of the services preceding it as they appear in the Applicant's class 42 specification.

⁵ My underlining.

27. I compare the Applicant's services to the Opponent's class 35 term *Compiling and analyzing data to provide location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers to businesses*. Both parties' services entail compiling and analysing data.⁶ However, the specific purposes of the services will differ to the extent that the data/information compiled and analysed are in different subject areas, i.e. environmental information/data (Applicant) versus data on prospective customers (Opponent). Users will likely be distinct by virtue of the different fields to which the respective services relate. Trade channels may be shared; the same undertaking might provide both parties' services. The services will be similar in nature to the extent that the acts of service will entail compiling and analysing information, albeit the subject areas are distinct. The Opponent's service also, on my reading of the term, goes further than the acts of compiling and analysing; the provision of 'location intelligence, geospatial information, socio-cultural information, behavioural information and human factors information about potential customers to businesses', in my view, likely entails synthesising the data that have been compiled and analysed, perhaps by way of producing some sort of report on a 'customer profile'. I do not find the respective services to be either competitive or complementary. Neither service is substitutable for the other, due to the specific and distinct fields to which the services relate. Neither service is necessary or important for the other, even if the average consumer were to presume both to originate from the same undertaking. I find the parties' services to have a low level of similarity.

Applicant's services: *information services relating to environmental issues and provision of such services online from a computer database or from the Internet; information in the fields of environmental emissions; providing scientific information in the fields of climate change and global warming; collection of information relating to the environment; [...] in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials.*

⁶ The Applicant's term includes the word 'information', but I consider 'information' and 'data' to be synonymous.

28. The Applicant's services entail the provision of information. I compare the Applicant's services to the Opponent's class 35 service *Compiling and analyzing data to provide location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers to businesses*. The Applicant's services entail the provision or collection of information in relation to environment. As already noted, the Opponent's services operate in different fields. Bearing in mind the users, trade channels and natures of the parties' services, and whether or not they are competitive or complementary, I do not find any similarity between the Applicant's services and those of the Opponent. I find the parties' services to be dissimilar.

Applicant's services: *constructing an internet platform for electronic commerce; [...] in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials.*

29. The construction of an internet platform entails the creation of electronic infrastructure. The Opponent's services are concerned either with the provision of software as a service or the compilation and analysis of data. The purposes of the respective services are distinct. As already noted, the parties' services also operate in different fields. Bearing in mind the users, trade channels and natures of the parties' services, and whether or not they are competitive or complementary, I do not find any similarity between the Applicant's services and those of the Opponent. I find the parties' services to be dissimilar.

Applicant's services: *technical data analysis; [...] in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials.*

30. I compare the Applicant's services to the Opponent's class 35 term [...] *analyzing data to provide location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers to businesses*. Both parties' services entail data analysis, albeit the

Applicant's services relate to '*environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials*', whereas the Opponent's services relate to customer profiling and market research. The services will overlap in purpose to the broad extent that both entail data analysis of some sort. However, the specific purposes will differ by virtue of the different fields to which the services relate. Users will therefore likely be distinct. Trade channel overlap is possible; the same undertaking might provide both parties' services. The services will be similar in nature to the extent that the acts of service will entail data analysis, albeit the subject areas are distinct. Due to the services being in separate fields, I do not find them to be competitive or complementary. Neither party's service is substitutable for the other. Although both parties' services might be offered by the same undertaking, neither party's service is necessary or important for the other. I find the parties' services to have a low level of similarity.

Applicant's services: *computer services for the analysis of data; [...] in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials.*

31. I compare the Applicant's services to the Opponent's class 35 services *Compiling and analyzing data to provide location intelligence, geospatial information, socio-cultural information, behavioral information and human factors information about potential customers to businesses*. Both parties' services will entail data analysis of some sort. My comments above at [30] also apply here. I find the parties' services to have a low level of similarity.

Applicant's services: *scientific and technological research and advice; [...] in relation only to environmentalism and sustainability purposes, industrial and energy processes, the design of industrial infrastructure and equipment, and/or the development of materials.*

32. I compare the Applicant's services to the Opponent's class 35 services *Compiling and analyzing data to provide location intelligence, geospatial information, socio-*

cultural information, behavioral information and human factors information about potential customers to businesses. The purposes of the parties' services will be distinct. Although the Opponent's services involve the compilation of data and possibly the provision of information, they do not involve the conducting of research or the giving of advice. Bearing in mind the users, trade channels and natures of the parties' services, and whether or not they are competitive or complementary, I do not find any similarity between the Applicant's services and those of the Opponent. I find the parties' services to be dissimilar.

33. Some similarity between the parties' goods and services is essential in order to find a likelihood of confusion between the parties' marks. In the case of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

'49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity'.

34. The opposition against the services that I have found to be dissimilar therefore fails at this point. The goods and services against which the opposition remains 'live' are as follows:

Class 9:	<i>computer software; downloadable software; Artificial intelligence software; artificial intelligence software for analysis; intelligent gateways for real-time data analysis</i>
Class 42:	<i>Software as a service; platforms for artificial intelligence as software as a service; compilation, monitoring and analysis of</i>

	<i>environmental information; technical data analysis; computer services for the analysis of data</i>
--	---

Average consumer and the purchasing act

35. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word “average” denotes that the person is typical. 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*.

36. In my view, the average consumer of most of the goods and services that come into play is a member of the professional public, the goods and services being in specialist fields. I consider that goods under the Applicant's broad terms ‘computer software’ and ‘downloadable software’ will be purchased by both the general and professional public. In my view, for both the general and professional public, most prospective purchasers would likely first encounter providers of the relevant goods and services online by visiting websites. The purchasing process will therefore be primarily visual in many cases. There will, to my mind, likely be an aural aspect to the purchasing process in many cases e.g. particularly in the case of a professional purchaser where the business discusses its requirements with the provider before concluding a transaction. The professional purchaser will, in my view, likely be prudent when considering their prospective purchase because they will want to ensure that the good or service meets their business needs. The goods/services which relate to specialist fields will also, to my mind, have a relatively high price-point. I find that the average consumer of the specialist goods/services will pay a level of attention in the medium to high range during the purchasing act. For those average consumers of ‘computer software’ and ‘downloadable software’ at large who are the general public, I consider that a measure of care would be taken when considering their purchases. Factors influencing the purchasing decision might include, *inter alia*: whether the software is compatible with their existing software or hardware. I find that the attention level of the average consumer who is a member of the general public will also be in the medium to high range.

Comparison of the marks

Opponent's mark: CARBON	Applicant's marks (series of two): Carbon Re CarbonRe
---------------------------------------	---

37. 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.”

38. 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.

39. The Opponent's mark is a word mark⁷ consisting of the single word element 'CARBON' in a plain typeface. The overall impression resides in the mark in its entirety.
40. The Applicant's marks are also word marks. The first mark in the series comprises the word elements 'Carbon Re' in a plain typeface. In my view, the 'Carbon' element will have greater visual prominence by virtue of its much greater size. I consider 'Carbon' to be more readily articulable than the element 'Re' because 'Re' is not, strictly speaking a word, but will likely be perceived as an abbreviation for the word 'regarding'. The overall impression resides in the mark in its entirety, with the 'Carbon' element playing a greater visual role in the mark.
41. The second mark in the series differs from the first mark only to the extent that 'Carbon' and 'Re' are coalesced to form one unit 'CarbonRe'. The overall impression resides in the mark in its entirety. In my view, the 'Carbon' portion of the mark will play the greater visual role, despite its coalescence with 'Re', because it is the more readily articulable part of the mark.

Visual comparison

42. The Opponent's mark is included in its entirety in, and forms the first part of, both of the Applicant's marks. The only visual difference between the parties' marks is the presence of the element 'Re' in each of the Applicant's marks; separated from 'Carbon' by a space in the first mark, but coalesced with 'Carbon' in the second mark in the series. I find both of the Applicant's marks to have a high level of visual similarity to the Opponent's mark.

⁷ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

Aural comparison

43. The Opponent's mark will be articulated as 'CAR-BUN'. The average consumer will, in my view, articulate the Applicant's marks as 'CAR-BUN REE'. The parties' marks have a high level of aural similarity.

Conceptual comparison

44. The average consumer will, in my view, understand the word 'carbon' in the context of 'carbon emissions' i.e. as a substance that is released into the atmosphere when fuel is burned, and that causes harm to the environment. The Opponent has submitted that the 're' element 'could mean regarding or [...] repeat but it is most likely that the average consumer will not apportion any particular meaning to RE'.⁸ My view is that the average consumer will perceive 're' as an abbreviation for the word 'regarding'. The Opponent's mark will be perceived as a reference to the substance 'carbon', as described. The presence of the 're' element in the Applicant's marks will, in my view, add very little in terms of concept over and above that conveyed by 'carbon' solus. The marks will likely convey the idea of 'something to do with/related to carbon'. I find the parties' marks to be conceptually identical. In case I am wrong about that, the parties' mark will have a very high level of conceptual similarity.

Distinctive character of the earlier mark

45. *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,

⁸ Opponent's written submissions, paragraph [9].

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).”

46. Registered trade marks possess varying degrees of inherent distinctive character: perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.

47. I have found that the Opponent’s mark ‘Carbon’ will be perceived by the average consumer in the context of ‘carbon emissions’. ‘Carbon’ is a dictionary word that is neither descriptive nor allusive of the services in respect of which the mark is registered. I find the earlier mark to have a medium level of inherent distinctive character.

Likelihood of confusion

48. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat Inc*⁹.

⁹ Case BL O/375/10 at [16].

Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹⁰, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their ‘mind’s eye’ (or vice versa).¹¹ Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

49. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [10]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

50. I have found the following of the Applicant’s goods and services to have some level of similarity with the Opponent’s services:

Class 9: computer software; downloadable software; Artificial intelligence software; artificial intelligence software for analysis; intelligent gateways for real-time data analysis

Class 42: Software as a service; platforms for artificial intelligence as software as a service; compilation, monitoring and analysis of environmental information; technical data analysis; computer services for the analysis of data

51. In my view, a significant proportion of average consumers would confuse the marks. The parties’ marks have a high degree of visual and aural similarity, both parties’ marks containing the element ‘Carbon’. I have found the marks to be

¹⁰ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

¹¹ In Decision O489/20, Thomas Mitcheson Q.C. (as he then was) sitting as the Appointed Person clarified that it is irrelevant which of the competing marks is seen first.

conceptually identical. The only visual difference between the marks is the presence of the 'Re' element after the word 'Carbon'. It is my view that when the average consumer encounters the Opponent's mark, they may mistake it for the Applicant's mark (or vice versa) because the mind's eye has failed to register or recall the presence of the 'Re' element in the Applicant's marks, and consumers do not compare marks side by side.¹² I find this to be the case even though the average consumer will pay a medium to high level of attention during the purchasing act. There is a likelihood of direct confusion based on imperfect recollection.

52. There will be no likelihood of confusion in respect of those of the Applicant's goods and services that I have found to be dissimilar to the Opponent's goods:

Class 9: environmental monitoring software

Class 42: artificial intelligence consultancy; emissions reduction advisory services; provision of information, advice and consultancy in relation to carbon measurement and reduction; advisory services relating to energy efficiency; technical advisory services relating to renewable energy; energy efficiency, consultancy services in relation to climate change and greenhouse gas mitigation programmes and to emission reduction projects; advisory services relating to environmental pollution; advisory services relating to environmental protection; advisory and consultancy in relation to all the aforesaid services; assessment of companies' and individuals' greenhouse emissions; determination of such emissions; information services relating to environmental issues and provision of such services online from a computer database or from the Internet; information in the fields of environmental emissions; providing scientific information in the fields of climate change and global warming; collection of information relating to the environment; constructing an internet platform for electronic commerce; scientific and technological research and advice.

¹² In Decision O/489/20, Mr Thomas Mitcheson Q.C., as he then was, sitting as the Appointed Person clarified that it was irrelevant which of the competing marks was seen first.

Conclusion

53. The Opposition has been partially successful. Subject to any successful appeal:

- The application is **refused** in respect of the following:

Class 9: computer software; downloadable software; Artificial intelligence software; artificial intelligence software for analysis; intelligent gateways for real-time data analysis

Class 42: Software as a service; platforms for artificial intelligence as software as a service; compilation, monitoring and analysis of environmental information; technical data analysis; computer services for the analysis of data

- The application **may proceed** in respect of the following:

Class 9: environmental monitoring software

Class 42: artificial intelligence consultancy; emissions reduction advisory services; provision of information, advice and consultancy in relation to carbon measurement and reduction; advisory services relating to energy efficiency; technical advisory services relating to renewable energy; energy efficiency, consultancy services in relation to climate change and greenhouse gas mitigation programmes and to emission reduction projects; advisory services relating to environmental pollution; advisory services relating to environmental protection; advisory and consultancy in relation to all the aforesaid services; assessment of companies' and individuals' greenhouse emissions; determination of such emissions; information services relating to environmental issues and provision of such services online from a computer database or from the Internet; information in the fields of environmental emissions; providing scientific information in the fields of climate change and global warming; collection of information relating to the environment; constructing an internet platform for electronic commerce; scientific and technological research and advice.

COSTS

54. The Applicant has enjoyed the greatest measure of success¹³ and is therefore entitled to a contribution based upon the scale published in Tribunal Practice Notice 2/20216 I award the Applicant the sum of £133 calculated as follows:

Consideration of the Opposition and preparation of Defence and Counterstatement	£200
Sub-total	£200
Less £67 to account for partial success of the Opponent	-£67
Total:	£133

55. I therefore order Near Intelligence Holdings Inc to pay to Carbon Re Ltd the sum of £133 This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of May 2023

For the Registrar

¹³ Roughly two-thirds of its specification may proceed to registration.