

O/0533/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF
APPLICATION NOS. UK00003763732 AND UK00003769271
BY VIZST TECHNOLOGY LTD TO REGISTER THE TRADE MARKS:

VIZST

AND



(SERIES OF TWO)

IN CLASSES 9, 37, 38 AND 42

AND

IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 434561 AND 434897
BY VIZRT AG

BACKGROUND AND PLEADINGS

1. On 9 March 2022, Vizst Technology Ltd (“the applicant”) applied to register the trade mark shown below:

Trade mark no. UK00003763732
 (“the contested word-only mark”)
 Vizst

2. On 23 March 2022, the applicant applied to register the series of two trade marks shown below:

Trade mark no. UK00003769271 (series of two)
 (“the contested logo marks”)



3. The applications were accepted and published for opposition purposes on 25 March 2022 and 08 April 2022, respectively. In both cases, the applicant seeks registration for the same goods and services, being those listed below:

Class 9: *Software for computers; Computer antivirus software; Cloud computing software; Computer operating software; Computer telephony software; Network management computer software; Programs (Computer -) [downloadable software]; Computer software for accessing computer networks; Computer software applications, downloadable; Computer operating system software; Computer software for advertising; Downloadable cloud computing software; Computer programs [downloadable software]; Communications*

processing computer software; Downloadable computer software applications; Computer software for encryption; Operating computer software for main frame computers; Computer software for accessing databases; Computer software for database management; Computer software for document management; Computer software for business purposes; Computer software for use in computer access control; Audio-visual apparatus; Visual display screens; Visual display units; Audio visual teaching apparatus; Computing visual display units; Electronic visual display units; Audio-visual teaching apparatus; Audio/visual and photographic devices; Information technology and audio-visual, multimedia and photographic devices; Computer software to enhance the audio-visual capabilities of multimedia applications; Computer application software for streaming audio-visual media content via the internet; Computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures; Cloud servers; Cloud server software; Cloud network monitoring software; Application software for cloud computing services; Computer networks; Network hubs; Network servers; Network routers; Networking devices; Networking software; Network cables; Network cabling; Communications networks; Communication, networking and social networking software; Network management software; Computer network bridges; Network communication devices; Computer network adapters; Computer network routers; Computer networking hardware; Network junction points for telephone exchange networks; Wide area networks; Network controlling apparatus; Network management apparatus; Local area networks; Computer network switches; Network communication equipment; Computer network hubs; Computer network server; Computer network hardware; Network-attached storage [NAS]; NAS (Network attached Storage); Network operating system programs; Network operating systems programs; Network access server hardware; LAN [local operating network] hardware; Wide area network (WAN) routers; Wireless local area network devices; LAN [local area network] access points for connecting network computer users; Computer programs for network management; Adapters for wireless network access; Video local area network controllers; USB Dongles [Wireless network adapters]; VPN [virtual private network] hardware; WAN [wide area network] hardware; Computer software for

wireless network communications; Computer networking and data communications equipment; Computer network-attached storage (NAS) hardware; Computer network-attached storage [NAS] hardware; Network monitoring cameras namely for surveillance.

Class 37: Maintenance of computer hardware; Repair of computer hardware; Installation of computer hardware; Upgrading of computer hardware; Installation of hardware for computer systems; Installation and repair of computer hardware; Maintenance and repair of computer hardware; Maintenance and repair of computers [hardware]; Maintenance services relating to computer hardware; Computer hardware (Installation, maintenance and repair of -); Installation, maintenance and repair of computer hardware; Updating of computer networking and telecommunications hardware; Repair and maintenance of computer and telecommunications hardware; Computer hardware and telecommunication apparatus installation, maintenance and repair; Consultancy relating to the installation, maintenance and repair of computer hardware; Installation and maintenance of hardware for computer networks and Internet access; Maintenance and repair of hardware; Installation and repair of telecommunications hardware; Installation of hardware for Internet access; Installation of computer networks; Installation of communications networks; Installation of communications network instruments; Installation of data network apparatus; Maintenance of data communication networks; Maintenance and repair of computer networks.

Class 38: Telecommunication network services; Network conferencing services; Communication network consultancy; Computer network communication services; Digital network telecommunications services; Providing access to global computer networks and other computer networks; Providing access to telecommunication networks; Communications via multinational telecommunication networks; Message sending via computer networks; Communication via fibre optical networks; Communications by fibre optic networks; Communications by fibre-optic networks; Local area networks (Operation of -); Communication services over computer networks; Providing access to computer networks; Value added network [communication] services;

Data transmission via telematic networks; Operation of a telecommunications network; Communication via optical fibre networks; Communication by fibre optic networks; Telecommunications services between computer networks; Local area networks (Leasing of -); Communications by fiber optic networks; Video transmission via digital networks; Communication via virtual private networks; Worldwide computer network access services; Communication via fibre-optic networks; Communications via fiber-optic networks; Communications via fibre-optic networks; Providing computer access to communication networks; Providing access to global computer networks; Transmission of information via computer networks; Communications by fiber [fibre] optic networks.

Class 42: *Computer software integration; Consultancy (Computer software -);Computer software maintenance; Computer software consultancy; Computer software development; Computer software consultation; Computer software consulting; Computer software installation; Software (Updating of computer -);Computer software (Maintenance of -);Updating of computer software; Computer software (Updating of -);Computer software (Installation of -);Writing of computer software; Configuration of computer software; Update of computer software; Computer software maintenance services; Repair of computer software; Computer software advisory services; Computer software consulting services; Upgrading of computer software; Maintenance of computer software; Installation of computer software; Computer and software consultancy services; Consultancy relating to computer software; Customized design of computer software; Programming of computer game software; Configuring computer hardware using software; Computer software installation and maintenance; Preparation of design parameters for visual images; Cloud hosting provider services; Cloud computing services; Cloud storage services for electronic data; Private cloud hosting provider service; Public cloud hosting provider service; Cloud-based data protection services; Providing virtual computer systems through cloud computing; Providing virtual computer environments through cloud computing; Cloud storage services for electronic files; Consulting services in the field of cloud computing; Consulting in the field of cloud computing networks and applications; Design and development of operating*

software for cloud computing networks; Rental of operating software for accessing and using a cloud computing network; Programming of operating software for accessing and using a cloud computing network; Design and development of operating software for accessing and using a cloud computing network; Providing temporary use of online non-downloadable software for accessing and using a cloud computing network; Providing temporary use of on-line non-downloadable operating software for accessing and using a cloud computing network; Computer network services; Telecommunication network security consultancy; telecommunication network security consultancy; Computer network configuration services; Monitoring of network systems; Computer network design for others; Design and development of networks; Development of computer based networks; Consultancy services relating to computer networks.

4. On 27 June 2022 and 08 July 2022, VIZRT AG (“the opponent”) opposed the applications in full, based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

5. Under both Sections, the opponent relies on the following trade mark registrations and all of the goods and services covered by the same, as shown below:¹

UK00902264679

(“the earlier word-only mark”)

VIZRT

Filing date: 19 June 2001

Registration date: 18 December 2002

Priority date: 25 May 2001

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM or International Registration designating the EU (“IR (EU)”). The earlier marks were originally protected in the UK as EUTMs or IRs(EU) and are now comparable marks which are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing and priority dates.

Class 9: *Computer software; virtual reality systems; computerized broadcasting equipment; photographic systems including computer software designed to operate the photographic systems, broadcasting and computer equipment.*

UK00801069561

("the earlier logo mark")



Filing date: 3 February 2011

Registration date: 2 February 2012

Priority date: 25 October 2010

Class 9: *Computer software, computer software for use with graphics systems for broadcasting purposes, for digital media asset management (digital resource management) and for publishing over the Internet and on websites; computerized apparatus especially adapted for optimal performance of computer software in the aforementioned contexts.*

Class 37: *Installation, maintenance, repair and servicing of computer hardware.*

Class 41: *Planning and conducting of training courses, seminars, and workshops; organization and provision of educational services for training in the field of computer hardware and software; provision of education and training over the Internet; digital image processing, namely processing of images and image sequences for use in live or recorded television programs, in video programs and in multimedia programs; provision online over the Internet of support information (education, training) for users in connection with computer software, computer hardware, applications relating to processing of images and databases.*

Class 42: *Design, installation, maintenance, updating, repair and servicing of computer software; technical support services online, via a telephone answering service (hotline), and in situ for computer hardware and software; computer*

programming; consulting and advisory services in connection with computer hardware and software for use with graphics systems for broadcasting purposes, for digital media asset management (digital resource management) and for publishing over the Internet and on websites; digital processing of documents, images and information for storage in media asset management databases (digital resource management).

6. The above marks are considered earlier marks in accordance with Section 6(1)(a) of the Act given that they have filing dates (or priority dates) which are earlier than the dates of application for the contested marks. As both earlier marks had been registered for five years or more at the filing date of the contested marks, in accordance with Section 6A of the Act, they are both subject to proof of use.

7. Under Section 5(2)(b), the opponent claims that because of the similarity between the marks and the identity and/or similarity of the goods and services at issue, there exists a likelihood of confusion.

8. Under Section 5(3), the opponent claims to have established a significant reputation in the earlier marks as a provider of visual storytelling tools for media content creators in the broadcast, digital and sport industries, and that due to the similarity of the marks and the closeness of the goods and services, use of the contested marks would take unfair advantage of the reputation of the earlier marks, or result in detriment to the distinctive character or repute of the earlier marks.

9. The applicant filed counterstatements denying the claims made, with the exception of the similarity of the goods and services, which is accepted.² However, the applicant argues that the actual goods and services supplied by the parties are entirely different because the opponent is a provider of visual storytelling tools for media content creators in the broadcast and sport industry, whereas the applicant supplies products to the IT security sector.

² See paragraph 6 of the counterstatement.

10. The opponent is represented by Stobbs and the applicant by Burgate Litigation Services Solicitors. Both parties filed evidence during the evidence rounds. A hearing took place before me on 24 April 2024, by video conference. The opponent was represented by Julius Stobbs and the applicant by Jennifer Dixon of counsel, instructed by Burgate Litigation Services.

RELEVANCE OF EU LAW

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

12. The opponent filed evidence-in-chief in the form of the witness statement from Andre Torsvik dated 23 February 2023, which was accompanied by 19 exhibits, being those labelled AT1-AT19. Mr Torsvik is the Vice President of Product Marketing at Vizrt Norway AS, a company with registered offices in Norway which acts as the global headquarters of the opponent.

13. The applicant filed evidence-in-chief in the form of a witness statement from Richards Betts dated 11 July 2023, which was accompanied by 1 exhibit (RB1). Ms Betts is a director and the CEO of the applicant.

14. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will refer to them to the extent that I deem necessary below.

PRELIMINARY REMARKS

15. At the hearing Mr Stobbs pointed out that the applicant's pleaded case was that there was no similarity between the marks at issue. He referred, in this connection, to the following passage from the applicant's counterstatement:

"Contrary to that what the opponent alleges, there is no similarity between the applicant's trade mark VIZST and the opponent's mark VIZRT and VIZRT logo neither visually, phonetically nor conceptually".

"...In these circumstances it is the applicant's case that there is no similarity whatsoever between Vizst and the opponent's earlier marks..."

16. Mr Stobbs went on to argue that since the applicant's case is that there is no similarity at all between the marks at issue, that is the case the opponent must answer. He then requested me to limit my assessment to the similarity of the marks and said that bearing in mind that the pleaded case is "no similarity at all", if I were to find any similarity between the marks, that would be sufficient to dismiss the applicant's case that there is no similarity. He put it in this way:

"...the pleaded case is this and I do find that there is similarity and therefore the opposition succeeds on this basis".

17. Ms Dixon stated that in terms of visual similarity there is, at best, a low degree of similarity and argued that there is no pleading point that prevents the applicant from making the alternative submission that there is some degree of visual similarity between the competing marks, having previously pleaded that they are dissimilar.

18. Whilst I disagree with Ms Dixon to the extent that the applicant must "stick" to its pleaded case unless it seeks an amendment of its pleadings, I do not think that the opponent should be successful simply because I disagree with the applicant's statement that the marks are dissimilar.

19. The opponent's pleaded case is that the competing marks are highly similar and that, due to the similarity of the marks and the closeness of the goods and services, there is likelihood of confusion under Section 5(2)(b), and unfair advantage and detriment to the distinctive character or repute of the earlier trade marks under Section 5(3). The applicant's pleaded defence that the marks are dissimilar does not exonerate the opponent from establishing its pleaded case in full, insofar as the correct question to be decided is whether the requirements of Sections 5(2)(b) and 5(3) are met. In this connection, Mr Stobbs's submission that the case the opponent needs to answer is that the marks "are not dissimilar" is misconceived because the applicant's defence that the marks are dissimilar does not change (a) neither the opponent's pleadings that there is likelihood of confusion and unfair advantage and detriment to the distinctive character or repute of the earlier trade marks (b) nor the relevant legislation, insofar as a trade mark can be refused registration only if the requirements set out in the pleaded sections of the Act are met. If this Tribunal were to apply the logic behind Mr Stobbs' argument to the resolution of opposition and invalidity proceedings, there would be artificial winners in all cases (which are not rare) whereby a hearing officer disagrees with statements set out in the pleaded defence, because those winners would win their case without effectively establishing the substance of their claims. That cannot be right. In order for these oppositions to be successful the opponent is required to prove the entirety of the case set out in the notices of opposition, not to disprove individual denials set out in the counterstatements.

20. Finally, the purpose of a counterstatement is to set out the applicant's response to the opponent's claims, i.e. to admit (agree) or deny (disagree) or request proof of any of the grounds set out by the other party in their statement of grounds, in order to make clear the real issues between the parties. In this case the applicant's statement that the marks are dissimilar is one of the pleaded reasons for the denial of the opponent's claims that there is likelihood of confusion or unfair advantage and detriment to the distinctive character or repute of the earlier trade marks, and does not eliminate the onus on the opponent of proving the existence of the conditions for applying Sections 5(2)(b) and 5(3). I therefore dismiss Mr Stobbs' argument.

PROOF OF USE

21. As the applicant has put the opponent to proof of use, the first task would be to assess whether the evidence supports the opponent's statement that it has made genuine use of the earlier marks in relation to the goods and services it has identified. However, during the course of the hearing both parties made a number of concessions about the extent to which the evidence establishes genuine use. Mr Stobbs produced the following table, submitting that, at the very least, based on the evidence filed, a reasonable specification would include the goods and services highlighted in bold below:

Trade Mark Registration No. UK00902264679	
Class 9	Computer software; virtual reality systems; computerized broadcasting equipment; photographic systems including computer software designed to operate the photographic systems, broadcasting and computer equipment.
Trade Mark Registration No UK00801069561	
Class 9	Computer software, computer software for use with graphics systems for broadcasting purposes, for digital media asset management (digital resource management) and for publishing over the Internet and on websites; computerized apparatus especially adapted for optimal performance of computer software in the aforementioned contexts.
Class 37	Installation, maintenance, repair and servicing of computer hardware *
Class 41	Planning and conducting of training courses, seminars, and workshops; organization and provision of educational services for training in the field of computer hardware and software; provision of education and training over the Internet; digital image processing, namely processing of images and image sequences for use in live or recorded television programs, in video programs and in multimedia programs; provision online over the Internet of support information (education, training) for users in

	connection with computer software, computer hardware, applications relating to processing of images and databases.
Class 42	Design, installation, maintenance, updating, repair and servicing of computer software; technical support services online, via a telephone answering service (hotline), and in situ for computer hardware and software; computer programming**; consulting and advisory services in connection with computer hardware and software for use with graphics systems for broadcasting purposes, for digital media asset management (digital resource management) and for publishing over the Internet and on websites; digital processing of documents, images and information for storage in media asset management databases (digital resource management)

*** in relation to hardware to facilitate broadcasting**

****in relation to graphic systems, cloud storage and databases for broadcasting**

22. After some discussion about the extent of the applicant's concessions, and having taken instructions, Ms Dixon confirmed that the applicant accepted genuine use for the goods and services in bold, subject to the restrictions indicated in the asterisks, with the caveat that those restrictions are carried into some of the broader terms, for example, in class 41 where the asterisks are not included.

23. Indeed, the bold terms in class 9 are sufficiently specific not to require further limitation. The same goes for the terms in class 37 which are limited by the restriction "*in relation to hardware to facilitate broadcasting*" indicated in the asterisk. I will therefore proceed on the basis that genuine use is accepted for these goods and services.

24. Moving to the services in class 41, Ms Dixon submitted that the terms *organization and provision of educational services for training in the field of computer hardware and software* and *provision of education and training over the Internet* are too broad. She further argued that since, at the hearing, Mr Stobbs conceded that the opponent only

provides training and educational services in respect of its own products,³ a fair specification should limit these services in the same way as the goods in class 9. I agree. Taking into account that the opponent's educational and training services relate to its own products which are computer hardware and software for use with graphics systems for broadcasting, I consider that a fair specification would be *organization and provision of educational services for training in the field of computer hardware and software; provision of education and training over the Internet, all relating to computer hardware and software for use with graphics systems for broadcasting*. The remaining bold terms in class 41, i.e. *digital image processing, namely processing of images and image sequences for use in live or recorded television programs, in video programs and in multimedia programs*, are sufficiently specific not to require further limitation.

25. Finally, at the hearing Mr Stobbs conceded that the evidence of use about technical support, design, installation, updating, and repair services relate to the opponent's own products. Consequently, I consider that the limitation "*all relating to computer hardware and software for use with graphics systems for broadcasting*" should also apply to the broad terms *design, installation, maintenance, updating, repair and servicing of computer software; technical support services online, via a telephone answering service (hotline), and in situ for computer hardware and software* in class 42. The remaining bold terms in class 42, i.e. *computer programming in relation to graphic systems, cloud storage and databases for broadcasting; consulting and advisory services in connection with computer hardware and software for use with graphics systems for broadcasting purposes, for digital media asset management (digital resource management) and for publishing over the Internet and on websites; digital processing of documents, images and information for storage in media asset management databases (digital resource management)*, are sufficiently specific not to require further limitation. I will proceed on that basis.

DECISION

Section 5(2)(b)

³ Transcript (page 8)

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

“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.”

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

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

28. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods and services

29. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

30. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

31. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

32. In her skeleton argument, Ms Dixon stated that the applicant accepts that *“there is similarity, and in some cases identity, between the goods and services for which registration is sought and those covered by the registration of the earlier marks”*. That acceptance seems to refer to the specification of the earlier marks as registered, not to the specification surviving the proof of use. Nevertheless, having conceded, at the hearing, that the opponent made genuine use of the earlier marks to the extent outlined above, Ms Dixon subsequently reiterated that the applicant accepts that there is similarity between the goods or services in question. She stated:

“We accept that there is not dissimilarity but to the extent that we are certain of these products, they are all in IT so computing, telecommunications, software and hardware. At that very high level we accept that there is similarity between each of the goods or services in question. However, that degree of similarity is lower in relation to some of the more specialist hardware products for which the applicant claims for protection”.

33. I therefore consider that the applicant’s admission that the parties’ goods and services are similar stands even when the contested goods and services are compared with the specification surviving proof of use.

34. Ms Dixon then referred to specific examples of goods and services. First, she mentioned the contested *USB Dongles [Wireless network adapters]* and *VPN [virtual private network] hardware*, and stated that these goods, which are effectively networking hardware solutions and virtual private networks for masking one's IP address, are similar to a low degree to the opponent's software products because whilst one could run the opponent's software on the applicant's hardware, the goods are ordinarily provided by different businesses and would be quite unusual for a company to provide both specialist software and networking cabling and VPN solutions.

35. As regard the contested services in class 37, Ms Dixon accepted that there is some similarity and identity to the extent that maintenance of computer hardware is covered by both the contested marks and the earlier logo mark. As regards the earlier word-only mark, she also accepted that there is a low degree of similarity between the contested services in class 37 and the software goods covered by that registration, on the basis that one might use the applicant's services to maintain the hardware on which the opponent's specialised software is run.

36. Finally, in relation to the contested services in class 38, Ms Dixon submitted that there is a low degree of similarity between these services and the opponent's computer software in class 9 because the providers that are concerned with telecommunications networks and services thereof are normally completely separate to the providers that are involved in commercial software even though they are similar to a very high level of generality in that software can run on a phone.

37. Bearing in mind the applicant's concessions, there is (at least) a low degree of similarity between each of the goods and services covered by the contested applications and the opponent's earlier goods and services.

38. I will now proceed to identify the goods and services in relation to which I think there is a higher degree of similarity.

39. I find that the following goods and services in the contested specification are either identical or highly similar to the opponent's goods and services:

Class 9: *Software for computers; Computer operating software; Programs (Computer) [downloadable software]; Computer software applications, downloadable; Computer operating system software; Computer programs [downloadable software]; Downloadable computer software applications; Computer software to enhance the audio-visual capabilities of multimedia applications; Computer application software for streaming audio-visual media content via the internet; Computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures.*

40. The above goods in class 9 are either identical to the opponent's specialist software goods because they are sufficiently broad to encompass them (*Meric*), or are highly similar, because both set of goods are, essentially, software relating to multimedia applications.

Class 9: *Audio-visual apparatus; Visual display screens; Visual display units; Audio visual teaching apparatus; Computing visual display units; Electronic visual display units; Audio-visual teaching apparatus; Audio/visual and photographic devices; Information technology and audio-visual, multimedia and photographic devices.*

41. The above goods in class 9 are all audio-visual apparatus and are identical to the opponent's *virtual reality systems* (as covered by the word-only mark) insofar as they are both apparatus and systems that reproduce images and sounds. Alternatively, they are highly similar, even when considering the goods that are meant to be used in an educational setting, since the opponent's *virtual reality systems* can also be used to simulate reality in education.

Class 37: *Maintenance of computer hardware; Repair of computer hardware; Installation of computer hardware; Upgrading of computer hardware; Installation of hardware for computer systems; Installation and repair of computer hardware; Maintenance and repair of computer hardware; Maintenance and repair of computers [hardware]; Maintenance services relating to computer hardware; Computer hardware (Installation, maintenance and repair of -); Installation, maintenance and repair of computer hardware; Updating of computer networking and telecommunications hardware; Repair and maintenance of computer and telecommunications hardware;*

Computer hardware and telecommunication apparatus installation, maintenance and repair; Consultancy relating to the installation, maintenance and repair of computer hardware; Installation and maintenance of hardware for computer networks and Internet access; Maintenance and repair of hardware; Installation and repair of telecommunications hardware; Installation of hardware for Internet access; Installation of computer networks; Installation of communications networks; Installation of communications network instruments; Installation of data network apparatus; Maintenance of data communication networks; Maintenance and repair of computer networks.

42. The above services in class 37 are identical to the opponent's *installation, maintenance, repair and servicing of computer hardware in relation to hardware to facilitate broadcasting*. Although some of the terms in the contested specification relate to hardware for networking and telecommunications (rather than hardware for broadcasting), they include hardware for networking and telecommunications which is used to facilitate broadcasting.

Class 42: Computer software integration; Consultancy (Computer software); Computer software maintenance; Computer software consultancy; Computer software development; Computer software consultation; Computer software consulting; Computer software installation; Software (Updating of computer); Computer software (Maintenance of -); Updating of computer software; Computer software (Updating of -); Computer software (Installation of -); Writing of computer software; Configuration of computer software; Update of computer software; Computer software maintenance services; Repair of computer software; Computer software advisory services; Computer software consulting services; Upgrading of computer software; Maintenance of computer software; Installation of computer software; Computer and software consultancy services; Consultancy relating to computer software; Customized design of computer software; Programming of computer game software; Configuring computer hardware using software; Computer software installation and maintenance.

43. The above services in class 42 cover maintenance, upgrading and installation of computer software at large. As such, they encompass the opponent's more

specialised *design, installation, maintenance, updating, repair and servicing of computer software all relating to computer hardware and software for use with graphics systems for broadcasting* in class 42 (as covered by the earlier logo mark) and are identical on the principle outlined in *Meric*.

44. Admittedly the earlier marks do not cover consultancy services, whereas the contested marks include various consultancy services relating to computer software (but otherwise unlimited). However, the contested consultancy services in relation to computer software are closely associated with the opponent's *design, installation, maintenance, updating, repair and servicing of computer software all relating to computer hardware and software for use with graphics systems for broadcasting*, because IT consultancy services support the delivery of IT solutions, enabling clients to make the right decisions before the design, installation, maintenance, updating, repair and servicing of software are implemented. Hence, the nature and purpose of the services is highly similar, the services target the same users, are complementary and are likely to be offered by the same providers, sharing trade channels. I consider these services to be highly similar.

Average consumer

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

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

47. Mr Stobbs submitted that the average consumer of the opponent’s goods and services relating to professional graphics used in connection with media content and broadcasting is likely to be a professional individual or an organization with specific professional knowledge and expertise, for example the BBC. Mr Stobbs further submitted that the contested goods and services are broad enough to encompass both consumer products and professional products though, he noted, the applicant made clear that its specific area of interest is aimed at professionals in business.

48. Ms Dixon submitted that both the opponent and the applicant target professional consumers, referring to the segments of the market in which the parties trade; in particular, Ms Dixon said that the opponent specialises in IT software and hardware for broadcasters, especially software that assists in creating visual sets and augmented reality features for broadcasters, whereas the applicant’s business focuses on offering specialist software and hardware products for the education, healthcare and aerospace sectors.

49. As Mr Stobb correctly pointed out during the hearing, the correct approach is to look at the specifications before me, not the goods and services effectively provided by the parties. In this connection, it must be noted that whilst the segment of the market in which the opponent has so far chosen to trade, namely that of graphic systems for broadcasting purposes, is reflected in the specification of the earlier marks which has survived proof of use, the contested specification includes terms that are unlimited, e.g. *Software for computers*, *Computer antivirus software*, and, as such, cover goods and services that might be purchased by members of the general public.

50. However, the applicant has accepted the existence of, at least, a low degree of similarity between the competing goods and services; while a coincidence in the relevant public is not necessarily an indication of similarity, largely diverging publics weigh heavily against similarity. In my view, an admission of similarity between the goods and services carries and admission that the relevant public is the same or at least overlaps. This is because the purpose of assessing the similarity of the goods

and services is to determine, together with the other relevant factors, if there is a likelihood of confusion; but, if the goods and services are intended for different public, they should be deemed dissimilar, because a consumer who is not going to encounter both marks cannot be confused.

51. Taking these points in mind, and looking at the competing specifications, I am of the view that even when the degree of similarity is low, there must be an overlap in terms of consumers.

53. In this case, the overlap exists because the average consumer of the opponent's goods and services, who is a professional acting in the broadcasting sector, might also seek to purchase the goods and services of the contested specification, insofar as a business operating in the broadcasting sector will also need to access the applicant's IT-related goods and services - which Ms Dixon says, at a very high level, relate to computer software and hardware, including cloud computing, networking and telecommunications software and hardware - in the running of their business.

54. The average consumer of the goods and services in question is therefore a business operating in the broadcasting sector. The goods and services are likely to be selected primarily by eye from brochures, presentations, internet sites etc, but word of mouth recommendations and enquiries are also likely to play a part in the selection process.

55. As for the level of attention paid during the selection process, Ms Dixon submitted that the relevant public will pay a high degree of attention because the opponent's goods and services are highly specialised, and many of the applicant's goods fall outside the scope of software purchased for personal use, instead constituting specialised products for technically minded professional customers.

56. Given that the parties' goods and services will be selected by a business user and bearing in mind the specialised nature of the IT- related goods and services involved, I agree with Ms Dixon that the degree of attention being paid during the selection process will be high for the majority of the goods and services at issue, whilst for some goods, e.g. computer network adapters, it will be at least medium.

Comparison of marks

57. 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.”

58. 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.

59. The respective marks are shown below:

The applicant's marks	The opponent's marks
<p>Vizst</p>  <p>vizst TECHNOLOGY</p>  <p>vizst TECHNOLOGY</p>	<p>VIZRT</p>  <p>vizrt</p>

Overall impression

The applicant's marks

60. The applicant's word-only mark consists of the word 'Vizst' presented in title case. There are no other elements to contribute to the overall impression, which lies in the word itself.

61. The applicant's series includes two marks, both consisting of the word 'vizst' presented in large low-case letters, written in a slightly stylised bold font, and in black. Underneath the word 'vizst' is the word 'TECHNOLOGY', presented in a much smaller font. In addition, both marks contain a figurative element consisting of a black dot and a geometrical shape resembling a short bar with two rounded ends, which is placed above the words (in the first logo mark) and on the left-hand side of the words (in the second logo mark).

62. Mr Stobbs argued that the term 'TECHNOLOGY' in the applicant's logo marks is clearly descriptive of the goods and services and will be seen as such by the consumers. Further, consumers are unlikely to attribute much significance to the figurative element due to its simple nature. I agree. The word 'TECHNOLOGY' is descriptive in relation to the goods and services for which the applicant seeks registration, all of which relate to computers and information technology (IT) and has little weight in the overall impression. Likewise, the stylisation of the letters is minimal, and the figurative element will be seen as made up of two banal shapes; neither of those elements will detract from the word 'Vizst', which is the dominant and most distinctive element of the marks.

The opponent's marks

63. The opponent's word-only mark consists of the word 'VIZRT' presented in capital letters. There are no other elements to contribute to the overall impression, which lies in the word itself.

64. Turning to the earlier logo mark, Mr Stobbs argued that the lines depicted in the mark will also not be visually dominant. Ms Dixon submitted the mark displays a relatively unusual gold colour, that the two half arcs emphasise an overall circular aspect to the mark and that the overall impression is that of symmetry. I prefer Mr Stobbs' submissions. The arcs and the colour are relatively indistinct in themselves when compared to the word 'VIZrt', and even when considered collectively they do not overcome the basic principle that words speak louder than devices. The word 'VIZrt' clearly indicates the origin of the goods and services and is the dominant and most distinctive element of the mark.

Visual similarity

65. Comparing the parties' word-only marks, they are both made up of five letters, and coincide in the first three letters 'V', 'I', 'Z' and in the last letter 'T'. The only difference between the marks resides in the fourth letter which, in the opponent's mark is a 'R' and in the applicant's mark is a 'S'. As notional and fair use of word-only marks covers use in any font, case and typeface, the difference created by the use of title case (in the applicant's mark) and upper-case (in the opponent's mark) must be disregarded.

66. At the hearing Ms Dixon argued that each letter of the word 'VIZRT' is separate and distinct in the earlier figurative mark, such that each letter can be clearly seen, and the average consumer would therefore immediately notice that the earlier figurative mark includes a letter 'R', not a letter 'S'. The fact that the letters in the marks are separate does not reduce the high degree of similarity created by the fact that of the five letters which form the marks at issue, four are identical and placed in the same position. Furthermore, consumers normally attach more importance to the first part of words and the distinguishing letters in this case are placed in the middle-end part of the marks. In my view, the word-only marks are visually similar to a very high degree.

67. Comparing the opponent's word-only mark with the applicant's logo marks, the degree of similarity between the words 'VIZST' and 'VIZRT' is still very high even considering the slight stylisation of the letters in the applicant's marks. Although the other distinguishing elements in the applicant's marks (i.e. the word 'TECHNOLOGY'

and the logos) are not very distinctive, they have a visual impact, reducing the overall visual similarity between the marks to a degree between medium and high.

68. Comparing the applicant's word-only mark with the opponent's logo mark, notional use of the applicant's mark means that I must consider the applicant's mark being presented in the same colour and typeface as those used in the opponent's mark, reducing the visual differences between the marks to those created by the presence of arcs in the opponent's mark and the use of the letters 'S' and 'R' in the words 'VIZST' and 'VIZRT'. In my view, the marks are similar to a high degree.

69. Comparing the parties' logo marks, it must be noted that although the letters are stylised, the stylisation is minimal. Hence, the degree of similarity between the word elements 'VIZST' and 'VIZRT' is still high even considering the slight stylisation of the letters in both marks. In addition, the differences created by the other elements of the marks (i.e. the arcs and colour in the opponent's mark and the word 'TECHNOLOGY' and the logos in the applicant's marks) reduce the overall similarity between the marks to a medium degree.

Aural similarity

70. As regards the phonetic comparison, both parties agreed that the marks are not easily pronounceable.

71. Ms Dixon argued that the applicant's marks would be pronounced as 'visht' whereas the earlier marks would be pronounced as 'vizert' effectively putting an 'E' between the 'Z' and the 'R'.

72. Mr Stobbs argued that the earlier marks will be pronounced as 'VIZ – R – T' and the applicant's marks as either 'VIZ – S – T' or 'VIS – ST'.

73. I prefer Mr Stobb's submission. I cannot see why the element 'ZS' in the applicant's marks should be pronounced as the sound 'SH'. Likewise, there is no reason why the average consumer would add a letter 'E' between the letter 'Z' and the letter 'R' in the opponent's marks. In my view the two letters 'ZS' and 'ZR' are both awkward to

pronounce and the marks will be articulated in a very similar or identical manner, namely with the sound of the letters 'ZS' and 'ZR' being absorbed by the clearer sound created by the first three letters 'VIZ' and the last letter 'T'. In my view, the marks are aurally either identical or highly similar. The word 'TECHNOLOGY' in the applicant's logo marks is unlikely to be pronounced due to its descriptive connotation; however, if articulated, it will reduce the level of aural similarity to medium.

Conceptual similarity

74. Mr Stobbs and Ms Dixon agreed that both marks will be perceived as invented words with no meaning. Consequently, a conceptual comparison based on the word elements 'VIZST' and 'VIZRT' is not possible. The word 'TECHNLOGY' is non-distinctive and so any concept it might introduce is also non-distinctive and does not create a distinctive conceptual difference.

Distinctive character of earlier mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

76. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

77. The opponent’s word-only mark consists of the word ‘VIZRT’. As it will be recalled, I have found that the word ‘VIZRT’ will be perceived as invented; as such it has a high degree of distinctiveness. In the opponent’s logo mark the word ‘VIZRT’ is presented in a gold colour within two arcs, however, as those elements are not common to the applicant’s marks, any increased distinctiveness they might add to the mark does not assist the opponent because it is the distinctiveness of the shared elements that matters.

78. The opponent has filed evidence of use and reputation, but it has not pleaded enhanced distinctiveness. Although the fact that the opponent did not plead enhanced distinctiveness would not prevent me from considering whether the distinctiveness of the earlier marks has been enhanced through use, in this case the earlier marks are inherently distinctive to a high degree, which means that any use made of them is unlikely to have increased the distinctiveness of the marks to any material extent.

Likelihood of confusion

79. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it

is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

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

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

81. Earlier in this decision I found that:

- i. The applicant has accepted that the opposed goods and services in the applicant’s marks are all similar to a low degree to the goods and services in the opponent’s marks. I have identified the goods and services which I consider to be either identical or similar to a high degree;
- ii. The average consumer of the goods and services at issue is a professional or a business operating in the broadcasting sector. The goods and services are likely to be selected primarily visually, but aural considerations are also likely to play a part in the selection process. The degree of attention being paid during the selection process will be high for the majority of the goods and services with the less-expensive goods attracting a medium degree of attention (at least);
- iii. The parties’ word-only marks are visually similar to a very high degree, and aurally identical or similar to a high degree. Conceptually, both marks will be perceived as invented words, so a conceptual comparison is not possible.
- iv. The opponent’s word-only mark and the applicant’s logo marks are visually similar to a degree between medium and high. Aurally, the marks are either identical or similar to a high degree (if the word ‘TECHNLOGY’ is not articulated) or similar to a medium degree (if the word ‘TECHNLOGY’ is articulated). Conceptually, the distinctive and dominant elements of the marks will be perceived as invented words, so a conceptual comparison is not possible. The word ‘TECHNLOGY’ is non-distinctive and so any concept it

might introduce is also non-distinctive and does not create a distinctive conceptual difference.

- v. The parties' logo marks are visually similar to a medium degree. Aurally and conceptually, the considerations made at point (iv) apply here;
- vi. The earlier marks are inherently distinctive to a high degree.

82. Before I turn to the likelihood of confusion, I will briefly address the applicant's evidence. The applicant filed evidence aimed at showing that the applicant's business has no connection with the types of products produced by the opponent or the broadcasting sector to which the opponent markets and sells its products. In this connection, Mr Betts' evidence is that the majority of the applicant's customers are in the field of Higher and Further Education, Local Government, Healthcare, Aerospace and Defence, and Finance.

83. None of the facts relied upon by the applicant, including the goods and services effectively offered by the parties, their activities, and customers, have any bearing on the assessment I am required to make, and in particular in determining whether the respective goods and services are similar and whether there is a likelihood of confusion. This is because when considering the likelihood of confusion under Section 5(2), the assessment must be based on the concept of 'notional and fair use' and, as I have said above, the comparison of the goods and services must be carried out based on the specifications before me, not the services effectively provided by the parties.⁴

84. First, I will consider the likelihood of confusion with the earlier word-only mark.

85. Admittedly, the earlier word-only mark has a more limited specification than the earlier logo mark, however, I did not understand Ms Dixon to draw a distinction

⁴ The applicant's main defence is that the marks are dissimilar, and the applicant did not plead honest concurrent use, so I am not considering the evidence for that purpose. Further, the applicant's evidence is aimed at establishing that the parties operate in different markets, which implies that any use made by the applicant is not concurrent in the sense that the marks do not coexist in the same market.

between the earlier word-only mark and the earlier logo mark when making the admission about the similarity of the goods and services. In my view, even proceeding on the basis that all the goods and services are similar to a low degree, the very high degree of visual and aural similarity between the marks 'VIZST' and 'VIZRT' and the high degree of inherent distinctive character of the earlier mark, will result in the marks being directly confused by the target public. Admittedly, the public selecting the goods and services will pay a high degree of attention to the selection, however, such high degree of attention is not apt to nullify the effect of imperfect recollection due to the high degree of visual and aural similarity between the marks and the absence of any conceptual differences between the marks or conceptual hooks upon which the memory of the earlier mark could hang. Hence, the high degree of attention is not sufficient to rule out the existence of a likelihood of direct confusion, even in relation to goods and services which are similar to a low degree. Indeed, the opponent's position is even stronger in relation to the goods and services which I found to be identical or highly similar.

86. Moving to the parties' logo marks, whilst the visual differences created by the figurative elements of the marks are unlikely to go unnoticed, the average consumer will rely on the words 'VIZST' and 'VIZRT' as being the signs indicating the commercial origin of the goods and services. In my view, once it is concluded (as I do) that the average consumer is likely to mistake 'VIZST' for 'VIZRT' (or vice versa), the distinguishing elements of the marks are not sufficient to avoid a likelihood of indirect confusion because they are either ornamental or descriptive, with the result that the applicant's marks will be perceived as variants belonging to a series of marks based on a common core element. There is a likelihood of indirect confusion.

87. The oppositions succeed in their entirety under Section 5(2)(b).

Section 5(3)

88. Section 5(3) of the Act states:

"5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

89. Section 5(3A) of the Act states:

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

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

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

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

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

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

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

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

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

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

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

identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

91. The relevant dates for the assessment under Section 5(3) are the filing dates of the applications at issue, being 9 March 2022 and 23 March 2022.

Reputation

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

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

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

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

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

93. The opponent's most relevant evidence is as follows:

94. Vizrt is part of the Vizrt Group, a global organisation with over 750 employees with offices in 16 countries worldwide, and with customers in over 100 countries. Vizrt is a

world-leader in the field of real-time 3D graphics and a leading provider of visual storytelling tools for media content creators in the broadcast, enterprise and new media fields. It offers software-based solutions for real-time 3D graphics, video playout, studio automation, sports analysis, media asset management, and journalist story telling tools.

95. Vizrt technology is used by many major broadcasters such as the BBC, Fox and Sky. Fox Sports has used Vizrt technology for its graphics production since 2010. Vizrt technology has also been utilized by the BBC for its coverage of the 2018 FIFA World Cup, for example in introducing virtual team line-ups in its pre-match and post-match content. Vizrt technology has also assisted BBC Sport to realise its virtual set vision at the 2022 Winter Games in Beijing. In addition, Vizrt technology has also powered coverage of content such as the US mid-term elections.

96. The opponent's products include an entire range of computer software products and systems, and broadcasting and computer equipment. In addition, the opponent's services include the installation, maintenance, repair, updating and servicing of computer hardware and computer software; the offering of seminars, workshops, and training courses; and technical support services. These goods and services have been offered under the earlier mark in the UK.

97. Annual UK sales figures are provided for goods and services sold under the earlier marks between 2016 and 2022. They range from over £4 million (in 2016) to over £8 million (in 2017 and 2019) for a total of just over £47 million. In addition, Mr Torsvik provides UK annual figures which represent the spend on advertising and promotion of the earlier marks between 2018-2022. They range from £50,000 USD (in 2018) to 380,000 UDS (in 2021) for a total of 925,000 USD.

98. Examples of use of Vizrt's products and services includes the following:

- The 2016 UK local government election results as reported by the BBC was delivered by the BBC using Vizrt's virtual studio system;

- Vizrt's augmented reality graphics assisted BBC Match of the Day's coverage of the 2018 FIFA World Cup in Moscow;
- In 2021, Vizrt provided the BBC with an advanced virtual set graphics ecosystem that helped convert a simple studio into their "Pres 2" set and a home studio for BBC Sport in Salford, UK;
- Vizrt delivered cutting-edge graphics to the BBC in its coverage of the 2022 Winter Olympic Games in Beijing (this is after the relevant date);
- Buckinghamshire New University in England teaches media students with Vizrt technology.

99. Mr Torsvik provides a list of awards and accolades won by the opponent's brand Vizrt for innovation and excellence in the field of media and entertainment technology. Most of these awards appear to have been awarded outside the UK (alternatively, it is not clear that they were awarded in the UK), however, the following relate to the UK:

- Vizrt was shortlisted for the Broadcast Tech Innovation Awards 2022. The event celebrates the teams behind the most outstanding broadcast productions of the past year. Vizrt appeared in the category "Excellence in virtual studios" in relation to BBC Sport Beijing 2022 Virtual Studio;
- Vizrt was shortlisted for the VideoTech Innovation Awards 2022 which took place in London.

100. As the relevant dates are post-Brexit, the opponent must show that it had a reputation in the UK at the relevant dates.

101. Although the marketing spend is not insignificant, the UK annual turnover figures do not appear to be indicative of large use. The market in which the opponent operates is that of software and hardware in the field of graphics for broadcasting purposes, which appears to be a niche, highly specialised market. However, there is no indication

of market share and no way of contextualising the turnover figures in order to gauge some indication of the opponent's position in the relevant market. The only clear evidence of the opponent having sold its goods and services to UK consumers is that relating to the BBC and one University. However, there are no invoices which would shed any light on whether the opponent has other UK consumers or indicate the geographical spread of the sales; further, as the turnover figures are not particularise or broken down in any way, it is impossible to say whether the turnover was generated by the provision of goods, services or a mixture of both.

102. Having said that, the applicant appeared to be very experienced working in its niche market which appear to be very limited; this means that the opponent can only establish a reputation among a few broadcasting operators in the UK. Furthermore, Ms Dixon did not strongly press for me to find that there is no reputation; rather she seemed to agree that the opponent has a limited reputation.⁵ Hence, I find that at the relevant dates the opponent had a small but qualifying reputation for graphics and augmented reality software for facilitating broadcasting.

Link

103. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

I adopt the same finding made at paragraphs 65-74 above.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

⁵ Transcript, page 30

I adopt the same finding made at paragraphs 29-44 above. The competing goods and services are at least similar to a low degree. The relevant public for the respective goods and services is the same and it is a business user operating in the broadcasting sector.

The strength of the earlier mark's reputation.

The earlier marks are likely to have had a small reputation in relation to graphics and augmented reality software for facilitating broadcasting.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

The earlier marks are distinctive to a high degree. Although I found that the earlier marks had a small reputation, that would not be sufficient to elevate the degree of distinctiveness of any material extent.

Whether there is a likelihood of confusion.

There is a likelihood of both direct and indirect confusion.

104. Weighing all the above factors, I find that when faced with the contested marks on all the contested goods and services, a significant proportion of the relevant public is likely to bring to mind the opponent's earlier marks. The necessary link is, therefore, established.

Damage

Unfair advantage

105. If I am correct that there is a likelihood of confusion, it is obvious that the applicant's contested marks used on the contested goods and services will take unfair advantage of the distinctive character and repute of the earlier marks because the public will assume that the applicant's goods and services are offered by the opponent,

stimulating sales in a way that would not have occurred had the applicant's marks not created that impression.

106. The oppositions under Section 5(3) are also successful.

OUTCOME

107. The oppositions have succeeded in their entirety under Section 5(2)(b) and 5(3) and the applications nos. UK00003763732 and UK00003769271 will be refused registration.

COSTS

108. The opponent has been successful and is entitled to an award of costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement: £500

Official fee (Form TM7s): £400

Preparing, and filing, evidence: £600

Preparing for, and attending, the hearing: £500

Total: £2,000

109. I therefore order Vizst Technology Ltd to pay VIZRT AG the sum of £2,000. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of June 2024

TERESA PERKS

For the Registrar