

**o/0400/25**

**TRADE MARKS ACT 1994**

**IN THE CONSOLIDATED MATTERS OF**

**TRADE MARK APPLICATIONS IN THE NAME OF WAYVE TECHNOLOGIES LTD.**

**NO. 3758801 FOR SERVICES IN CLASS 42**

**AND**

**NO. 3770700 FOR GOODS AND SERVICES IN CLASSES 9 AND 39**

**FOR THE WORD MARK “WAYVE”**

**-AND-**

**OPPOSITIONS NO. 434732 AND NO. 435308 THERETO BY IVO MEDIA LTD**

## INTRODUCTION

1. This written decision follows an oral hearing held before me by Teams videocall on 13 November 2024. The hearing was attended by Iona Berkeley of counsel, instructed by Mischon De Reya on behalf of Wayve Technologies Ltd (**"the Applicant"**), and by Aaron Wood, instructed by Basck Limited for IVO Media Ltd (**"the Opponent"** or **"IVO Media"**).
2. At the end of the hearing, having listened to the parties' submissions and been taken through the opponent's evidence, I gave my oral decision that the oppositions were bound to fail on all grounds. I outlined the various weaknesses in the Opponent's case, any one of which would suffice to defeat the claims. Both parties welcomed my offering an oral decision at the hearing, but it was understood that, unless the parties requested otherwise, a written decision would follow.

### Preliminary point on parallel proceedings

3. Since the hearing of the present consolidated oppositions, the tribunal casework team has brought to my attention two other proceedings initiated between the same two parties - Opposition No. 450183 and Cancellation No. 508138 (outlined at **Annex 1** to this decision).
4. Those parallel proceedings have been forestalled, allowing the parties to agree a mutually acceptable position between themselves, avoiding the cost, time and resource of pursuing those proceedings, should they wish to do so.<sup>1</sup> In view of the existence of these additional related proceedings, and the fact that I gave an oral decision at the hearing itself, this written decision has been expedited. I acknowledge with appreciation the thorough and clear content of the skeleton arguments filed, from which parts of this written decision extensively draw.

## BACKGROUND AND PLEADINGS

5. The hearing dealt with consolidated oppositions against the following two trade mark applications by Wayve Technologies Ltd for the word mark 'Wayve' (**"the Contested Applications"**):

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1 In this regard it is noted that Exhibit JB05 shows a signed undertaking from April 2018 in which the Applicant agreed not to encroach on certain rights at that time acknowledged in respect of the earlier Wayve mark.

Trade Mark Application No. **3758801** with a filing date of 24 February 2022 for certain services in Class 42 (broadly relating to self-driving vehicles), and

Trade Mark Application No. **3770700**, with a filing date of 28 March 2022 for certain goods in Class 9 (broadly autonomous vehicle software) and certain services in Class 39 (broadly transportation services).

6. The details of the specifications of the Contested Applications are set out at **Annex 2** at the end of this decision.
7. In July 2022, IVO Media Ltd filed oppositions based on grounds under sections 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”).
8. For its sections 5(2)(a) and 5(3) objections the Opponent relies on trade mark No. 3032848 (**‘the Earlier Trade Mark’**), which was applied for on 29 November 2013, becoming registered on 9 May 2014. The Earlier Trade Mark is also the word mark ‘Wayve’ and is registered for the goods in Class 9 and services in Classes 35, 41 and 42. The Opponent’s goods and services are listed in full at paragraph 20 of this decision.
9. The claim under section 5(2)(a) is that the respective marks are identical and that the parties’ goods and services are highly similar or identical, and that because of these factors there is a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
10. Under section 5(3) the Opponent claims that the Earlier Mark benefits from a reputation in respect of all of its goods and services, and that use of the Applicant’s trade marks would take unfair advantage of and/or be detrimental to the distinctive character or repute of the Earlier Trade Mark.
11. The claim under section 5(4)(a) is that the Opponent has used the sign “Wayve” throughout the UK since 28 February 2014 in respect of “computer software”, giving rise to goodwill, and that use of the Contested Applications would be a misrepresentation and would cause damage, so should be refused based on the law

of passing off. In his skeleton argument, Mr Wood acknowledged that the case under section 5(4)(a) of the Act is no broader than that under section 5(2)(b).

### **Proof of use**

12. The Earlier Trade Mark, having been registered for more than 5 years when the Applicant filed its contested trade mark applications, is subject to the use requirements as set out in section 6A of the Act. The Opponent stated in its Form TM8 that it had used its trade mark during that period in respect of all of its registered goods and services. The Applicant requested proof of the claimed use of the registered goods and services.

### **The Applicant's defence**

13. The Applicant denies each of the grounds claimed in both oppositions. Its position is that the oppositions should be dismissed in their entirety for the following different reasons:

#### *Failure to prove use of the Earlier Trade Mark*

- i. IVO Media has failed to prove genuine use in respect of **any** of the registered goods or services for the **relevant five-year periods** ending on the filing dates of the Contested Applications (2017 – 2022).<sup>2</sup> Consequently, the Opponent's claims under section 5(2)(a) and 5(3) must fail;
- ii. Alternatively, if the evidence filed by IVO Media is sufficient to show any use at all, it can only be in relation to a very limited specification of the Earlier Trade Mark and it is **only this very limited specification** that can be relied upon with regards the section 5(2)(a) and 5(3) objections.
- iii. Further and in any event, IVO Media has also failed to demonstrate that any use of the Earlier Trade Mark (if any can be proved which is denied) was made **by the proprietor of the Earlier Trade Mark or with his consent** as required by section 6A of the Act.

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<sup>2</sup> 29 March 2017 to 28 March 2022 and 25 February 2017 to 24 February 2022.

*Failure to establish a valid section 5(2)(a) objection*

- iv. Even if the tribunal were to find genuine use of the Earlier Trade Mark in respect of a very limited specification, there is **no similarity between any of the applied-for goods and services** and the specification on which the Opponent could rely. Consequently, the section 5(2)(a) objections must fail for lack of similarity.
- v. Alternatively, if it is found that there is any similarity of services, it is of such a low level that on a properly formulated global appreciation assessment there exists **no likelihood of confusion** and again the section 5(2)(a) objection must fail.

*Failure to establish a valid section 5(3) objection*

- vi. IVO Media has failed to demonstrate that, as at the relevant dates (in February and March 2022), the Earlier Trade Mark had the **required reputation** associated with it in relation to any of the goods and services for which it is registered, and therefore its section 5(3) objection must be dismissed.
- vii. Alternatively, in so far as IVO Media can prove that it has the required reputation associated with any of the goods and services of the Earlier Trade Mark, IVO Media has failed to prove there is any **link** between or **unfair advantage** taken of or detriment to the distinctive character or repute of the Earlier Trade Mark as required under section 5(3) and therefore this objection must be dismissed.

*Failure to establish a valid section 5(4)(a) objection*

- viii. IVO Media has failed to prove that as at the relevant date of 24 February 2022 there is **any goodwill** associated with the sign “Wayve” and the pleaded “Computer Software”.
- ix. Further, even if the evidence could be considered to establish some goodwill, IVO Media has **failed to establish any necessary misrepresentation** such that the use of the Contested Applications is liable to be prevented by virtue of the law of passing off. The section 5(4)(a) objection must again therefore fail.

*Failure to comply with Article 2 of the Trade Mark (Relative Grounds) Order 2007*

- x. IVO Media has failed to establish that it is the **proprietor** of the Earlier Trade Mark and therefore IVO Media is not entitled to raise section 5(2)(a) and 5(3) objections against UK TM Application No. 3758801 (see Article 2 of the Trade Marks (Relative Grounds) Order 2007) and these grounds of Opposition must be dismissed on this basis.
- xi. IVO Media has likewise failed to establish that it is the **proprietor of any earlier right** (in this case goodwill) associated with the sign “Wayve” and the pleaded ‘computer software’, and is therefore not entitled to raise the section 5(4)(a) objections.

**PROOF OF USE**

- 14. Section 6A of the Act provides (emphasis added):

...

- (3) the use conditions are met if—

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom **by the proprietor or with his consent** in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

...

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

- 15. As stated at Section 100 of the Act, “If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

## Relevant case law on genuine use

16. The applicable legal principles on genuine use of a trade mark are very well established and Ms Berkeley referred to the authoritative summary given in the Court of Appeal in *Easygroup*.<sup>3</sup> Points from that summary are set out below (with citations omitted and underlining added for emphasis):

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark.

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark.

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin.

(4) *Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns. Internal use by the proprietor does not suffice. ...*

(5) *The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark.*

(6) *All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including:*

- (a) *whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question;*
- (b) *the nature of the goods or services;*
- (c) *the characteristics of the market concerned;*

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3 *Easygroup Ltd v Nuclei Ltd* [2024] FSR 9 (main judgement given by Arnold LJ)

- (d) the scale and frequency of use of the mark;
- (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them;
- (f) the evidence that the proprietor is able to provide; and
- (g) the territorial extent of the use.

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule.

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

...

[107] The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act ... The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: ... It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use. In *Awareness Ltd v Plymouth CC* [2013] R.P.C. 24 Daniel Alexander QC sitting as the Appointed Person said:

"19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...



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

17. The Appointed Person in *Awareness Ltd v Plymouth City Council (Plymouth Life Centre Trade Mark)* [2013] RPC 34 provided further pertinent guidance at [28]:

"[28]... The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted. Excising the unjustifiable is as much a part of the exercise of dotting the i's and crossing the t's of the evidence (referred to in *Laboratoires Goemar*) as is reinforcing the justified."

18. The Court of Appeal in *Merck KGaA v Merck, Sharp & Dohme* [2017] EWCA Civ 1834 at [245]-[248] deals with the applicable legal principles when genuine use has only been demonstrated in relation to a smaller subsection of the earlier mark's specification:

"[245] First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period."

*[246] Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.*

*[247] Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.*

*[248] Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.”*

19. Ms Berkeley correctly noted that I need to consider two aspects of the evidence filed by IVO Media on genuine use as provided by Section 6A(3)(a). First, I must consider (a) whether the evidence provided adequately demonstrates that the Earlier Trade Mark has been put to genuine use in relation to any of the goods and services for which it is registered in the United Kingdom, and if so which specific goods and/or services and (b) whether the use demonstrated (if any) has in fact been use made by the proprietor of the Earlier Trade Mark or with his consent.

### **Evidence of proof of use of the Opponent's goods and services**

20. IVO Media claimed that the earlier UK Trade Mark No. 3032848 has been used in relation to all goods and services for which it has been registered, which are as follows:

**Class 9:** *Computer software for creating, editing and manipulating text and multimedia content in print and digital format; Computer software for publication of digital content to digital devices including mobile phone, computers, laptops, phablets, tablet, desktop and televisions; Computer software for triggering, managing, delivering*

*and providing multimedia content to digital devices including mobile phone, computers, laptops, phablets, tablet, desktop and televisions; downloadable media; on-line publications; downloadable publications.*

**Class 35:** *Advertising; advertising services provided via the Internet and telecommunication networks; advertising services provided on digital devices enabling creation, editing and manipulation of digital advertising content; information, advisory and consultancy services relating to all the aforesaid.*

**Class 41:** *Education services relating to digital publishing; entertainment services; digital publishing; informational, advisory and consultancy services relating to digital publishing.*

**Class 42:** *Design and development of computer software; design and development of computer software for digital devices; design and development of computer software for providing and hosting advertising platforms to allow others to create, deliver, and manage digital advertising content; providing temporary use of online non-downloadable software in the field of digital advertising; interactive design and development services; internet design services; brand design services; graphic design services; design of marketing materials; design services; web site maintenance; computer programming services; information, advisory and consultancy services relating to all the aforesaid*

21. I agree with Ms Berkeley that the proof of use evidence filed in these oppositions is scant in the extreme. I note too that at a Case Management Conference held on 14 September 2023 IVO Media was given an extension of time to file its evidence and submissions in support of these proceedings. My post-CMC letter of the same date noted that *"the opponent acknowledged the need to strive for clarity in their evidence which must clearly show the extent to the opponent's claimed genuine use, reputation and goodwill"*. Despite IVO Media providing this acknowledgement, I agree with Ms Berkeley that it has failed to properly detail the specification in relation to which it maintains it can provide evidence of genuine use. It was incumbent upon IVO Media to put forward a sensibly limited case concerning genuine use based on the evidence it was able to collate. It has not done so.

22. The Opponent's evidence is indeed very flimsy and limited. It included a witness statement of James Booth, dated 27 September 2023. James Booth states that he is the 2008 founder of Rockabox Media Ltd (which is not the Opponent) and its CEO since 2013.<sup>4</sup> He states the facts in his witness statement come either from his recollection or from the financial records of Rockabox Media. He states that he has full authority from the Opponent and Rockabox Media to give his witness statement, which he states is to prove the use of "the Earlier Trade Mark by the Opponent in the United Kingdom by [Rockabox Media]" [sic].
23. He states that the Earlier Mark was filed in November 2013 by Wayve Ltd (again, not the Opponent) and that Rockabox Media took over the IP of Wayve Ltd,<sup>5</sup> when Rockabox and Wayve merged at some point seemingly after early 2018. He states that *"both before and after the merger and acquisition, the WAYVE mark was used as the name for a cloud-based creative-build software product used for building advertising formats for the digital marketing industry."*
24. On the basis of Mr Booth's evidence, it seems clear that, despite the initial breadth of the Opponent's claimed use, there is no stated use of Wayve in relation to any goods or services beyond a single software product with a very narrow purpose, that of *"building advertising formats for the digital marketing industry"*. I agree with Ms Berkeley that this limitation to IVO Media's case is effectively conceded by Mr Booth in his statement, even before the documentary evidence that has been Exhibited to Mr Booth's witness statement is actually considered and assessed.
25. Case law is conservative in its approach to interpreting broad and/or vague terms, especially services. In *Sky v Skykick [2020] EWHC 990 (Ch)*, Lord Justice Arnold set out the following summary of the correct approach to interpreting broad and/or vague terms:
- "(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
- (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

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4 Rockabox Media Ltd trades as "Scoota" – Exhibit JB03 and JB05.

5 There are allusions to this prospect in the few emails from Scoota in August 2017 at Exhibit JB03.

- (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
- (4) A term which cannot be interpreted is to be disregarded.”
26. On the basis of the concession implicit in Mr Booth’s witness statement, I agree that IVO Media has evidenced no positive claim that the Earlier Trade Mark has been used in either of the relevant periods in relation to any services in Class 35 and Class 41. Even if a *“cloud-based creative-build software product used for building advertising formats for the digital marketing industry”* may be considered to have a degree of similarity with services in Class 35 and Class 41, such as *“advertising services provided on digital devices enabling creation, editing and manipulation of digital advertising content”* and *“consultancy services relating to digital publishing”*, there is no evidence at all of the Earlier Mark having been used in respect of those specific services. The Opponent is not able to rely on the Earlier Mark for its services in **Class 35** and **Class 41**.
27. Ms Berkeley submitted that “with regards the **Class 42** services of the Earlier Trade Mark specification it is clear that IVO Media has no positive claim to genuine use in relation to the following parts of this specification: *“Design and development of computer software; design and development of computer software for digital devices; design and development of computer software for providing and hosting advertising platforms to allow others to create, deliver, and manage digital advertising content; ... interactive design and development services; internet design services; brand design services; graphic design services; design of marketing materials; design services; web site maintenance; computer programming services; information, advisory and consultancy services relating to all the aforesaid”*.
28. Ms Berkeley submitted that, on the basis of Mr Booth’s witness statement, the only possible positive case that the Opponent appears able to assert, is for genuine use in relation to *“providing temporary use of online non-downloadable software in the field of digital advertising”* in Class 42. I agree that that term in the specification most closely reflects the account of the product for which Mr Booth asserts use of the Earlier Mark. I find that there is no assertion (let alone substantiating evidence) of the Earlier Mark having been used for the *“design and development of computer software for*

*providing and hosting advertising platforms to allow others to create, deliver, and manage digital advertising content”, notwithstanding that the asserted cloud-based software for that purpose must itself have been designed and developed.*

29. I also agree that the witness statement evidence of Mr Booth does not equate to an assertion of use of the Earlier Trade Mark in respect of its **Class 9** goods specification, because the software product is stated by Mr Booth to be “*cloud-based*”. Therefore, claimed software is not a downloadable product which would fall under a Class 9 specification. Further, Mr Booth states at paragraph 8 of his witness statement that the software was to be available on a “subscription” basis, which again indicates that the referenced product should relate to a Class 42 services specification, at best limited to “*providing temporary use of online non-downloadable software for building advertising formats in the field of digital advertising.*” (In any event, the genuine use allegedly demonstrated could only relate to a very narrow subcategory of “*a computer software product used for building advertising formats for the digital marketing industry*”.)
30. However, I further agree with Ms Berkeley that the documentary evidence actually filed to purportedly substantiate a claim to genuine use is simply not satisfactory or sufficient to demonstrate any use whatsoever, even in respect of a potentially limited Class 42 specification of services “*providing temporary use of online non-downloadable software for building advertising formats in the field of digital advertising*”.
31. I note the preliminary explanatory remark at paragraph 8 of Mr Booth’s witness statement, where he states that the software to which he refers is “*not standard software which is sold to the general public and so the methods of promoting it are not those that one might expect if one were promoting general software intended the general market. Instead promoting it required trying to get meetings with key stakeholders in substantial businesses and trying to gain opportunities to have the prospect use the software and then retain it on a subscription.*” Mr Booth further moderates expectations of the evidence by stating at paragraph 9 that “*as an innovative piece of software, substantial work has to be done to establish a market*

*and also try to drive sales/subscriptions, and so much of the hard work done on the product by [Rockabox] will not have necessarily borne fruit as customers.”*

32. I largely agree with the analysis of the evidence set out in the Applicant’s skeleton argument. The documents relied upon by IVO Media in the Exhibits to Mr Booth’s and Mr Evans-Parker’s witness statements simply do not adequately demonstrate any genuine use of the Earlier Trade Mark.
33. Mr Booth at his paragraphs 17-25 exhibits some documents which are said to demonstrate genuine use of the trade mark “Wayve” in relation to the computer software for building advertising formats in the field of digital advertising. In fact, the documents exhibited do not show any genuine use of the trade mark ‘Wayve’ in relation to any of the goods or services for which it is registered at all.
34. The relevant periods in which genuine use must be shown span from 25 February 2017 to 28 March 2022. The actual documents relied on by the Opponent are thin in the extreme and do not amount to solid and objective evidence of effective and sufficient use of the trade mark in the market concerned, nor do these documents amount to clear, precise, detailed and well-supported evidence as to the nature of the use and as such they do not demonstrate genuine use of the Earlier Trade Mark No. 3032848. Subject to my occasional edits and qualifications, I agree with Ms Berkeley’s account of the documents, as set out in the following paragraphs.
35. The email chain found at **Exhibit JB06** is dated April 2018, and does not amount to genuine use of the Earlier Trade Mark. It starts with an email dated 3 April 2018 by Ms Baker, who is the technical Project Manager at “Oath.com”, addressing her email to “Scoota team”. She says *“We have Wayve on file as a certified third party vendor at Oath (AOL & Yahoo) & it appears that Wayve was acquired by Scoota”*. Ms Baker asks for confirmation as to whether *“any of the legacy technology associated with Wayve is still in production and being used in order to update our documentation and tools. Can you please confirm if tags are still being generated for campaigns using the wayve.co domain?”*
36. Accordingly, Ms Baker is making enquiries of the new owners (using the trading name ‘SCOOTA’) of a business with which Oath appears to have, in the past, had some

dealings, though the nature of those dealings is not clear. On 20 April 2018, Ms Baker emails further to [support@scoota.com](mailto:support@scoota.com) and addresses her email to “Hi Hannah & Scoota team”. Later, on 20 April 2018, Mr Booth responds from his “[@scoota.com](mailto:@scoota.com)” email address, with an email with “SCOOTA” in large letters on the footer. Mr Booth states “*We are very much keeping the Wayve platform alive and there is good demand for it.*” I do not consider this single use of the word “Wayve” to be of any significant assistance in the task of establishing genuine trade mark use of the Earlier Trade Mark. All this email from Mr Booth indicates is that the SCOOTA business asserts an interest in sustaining a “platform”, but it is not clear as to what that means. It does not demonstrate genuine use of the “Wayve” trade mark in relation to any specific goods or services for which the Earlier Trade Mark has been registered within the relevant periods. Nor, as will be seen, does the other evidence filed substantiate Mr Booth’s account that Scoota is “*very much keeping the Wayve platform alive and there is good demand for it.*”

37. The email chain evidenced at **Exhibit JB07** is again from April 2018. It is an exchange between Jamie Evans-Parker (then of Scoota and using a Scoota email address) and Jon Clarke, who is a Commercial Digital Producer at ITV using the email address “[jon.clarke@itv.com](mailto:jon.clarke@itv.com)”. The email exchange starts with an email from Mr Evans-Parker dated 11 April 2018. His email does not mention of the word “Wayve” at all, but refers Mr Clarke having “a login to the platform” and asking if he would like to see some updates. It appears this follows “a brief run through of the platform” by a colleague of Mr Evans-Parker to Mr Clarke in 2017. Although none of the emails sent by Mr Evans-Parker uses the word “Wayve”, Mr Clarke of ITV, states “*we are looking at third party platforms to use to help us produce our current display product suite - namely rich media app display/takeovers and premium display ads on itv.com. If you think this sounds like something you could help us create then it would be great to sit down and discuss what we need and how you might be able to help us with Wayve.*” It does not appear that this exchange led to any sales of goods or services under the Earlier Mark. This single use of the word “Wayve” by Mr Clarke of ITV is not use by the Proprietor of the Earlier Trade Mark or with its clear consent.



38. The emails found at **Exhibit JB08** are dated 23 May 2018 and are emails exchanged between individuals within the Scoota business.<sup>6</sup> Therefore, these emails are internal business communications, which, as stated in the *Easygroup* case law quoted earlier, cannot amount to genuine trade mark use. Further although there is a reference to “Wayve revenue” within this internal email exchange, these emails provide no actual evidence as to what products or services this revenue related to or how these products or services were actually externally marketed to customers i.e. what (if any) brand name they were actually sold under (if any actual external marketing took place), or when that external marketing of those goods or services (if any) actually took place. These emails are therefore of no assistance to demonstrate genuine use of the Earlier Trade Mark within the relevant periods.
39. The documents found at **Exhibit JB09** are internal documents with a date 4/07/2018 at the top of page 1. As these documents are internal business documents, they cannot amount to evidence of genuine trade mark use. Further the documents are headed “Rockabox Media Ltd trading as Scoota”, so are referring to a business trading under the brand name “Scoota”. On the first page in the second line there are the words “Investment Analysis – Wayve” but these words are of no evidential assistance. The internal documents provide no actual evidence as to what precise products or services this revenue related to or how these products or services were actually externally marketed to customers e.g. what (if any) brand name they were sold under (if any actual external marketing took place), or when that external marketing (if any) took place. These emails are therefore of no assistance to demonstrate genuine use of the Earlier Trade Mark within the relevant periods.
40. The email found at **Exhibit JB10** is an email dated 1 June 2018 from James Booth (@scoota.com) to a Mr Ollerhead at Amazon in the UK. The email is titled “Deck” and is an email providing two internet links. It says within this email *“the second [link] is for another platform (Wayve) we’ve built that is a dedicated solution for publishers and their direct brand activity; and that’s really exciting publishers like FT.com, Bloomberg, Economist, ITV, DMG and a load of others.”* This reference to the word Wayve does not amount to evidence of genuine trade mark use of the Earlier Trade Mark. The word ‘Wayve’ is not clearly being used as a trade mark (to guarantee the identity of

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6 This can be seen from the email addresses.

the origin of the goods and services to the end user). Further the email provides no evidence of how any products or services are actually being marketed to external customers (if at all). Further, this single email is such slight use that it cannot amount to a sensible foundation proving genuine use of a trade mark.

41. The invoice found at **Exhibit JB11** is dated 28 February 2018. Therefore, it just and only falls within the relevant period for Opposition relating to Trade Mark Application 3758801 (for the Class 42 Services). In any event this £1750 invoice to Media IQ Digital has no mention of the word “Wayve” at all. In fact, it is an invoice headed “SCOOTA” with a footer that states “Scoota is a trading name of Rockabox Media Ltd”. Therefore, this invoice is of no relevance or assistance in demonstrating genuine use of the Earlier Trade Mark. Nor is there anything in this invoice which shows what goods or services this invoice relates to so again it is of no assistance in demonstrating genuine use of the Earlier Trade Mark in relation to any goods or services for which it has been registered, within the relevant periods.
42. The invoice found at **Exhibit JB12** is dated 31 March 2018. Again, this £2500 invoice to Media IQ is headed “SCOOTA” with a footer that states “Scoota is a trading name of Rockabox Media Ltd”, and makes no mention of the word “Wayve” at all. Therefore, this invoice is of no relevance or assistance in demonstrating genuine use of the Earlier Trade Mark. Nor is there anything in this invoice which shows what goods or services this invoice relates to so again it is of no assistance in demonstrating genuine use of the Earlier Trade Mark in relation to any goods or services for which it has been registered within the relevant periods.
43. **Exhibit JB13** consists of a printout of an interview with Jamie Evans-Parker, which appears to have been published on [www.uktech.news](http://www.uktech.news). The interview identifies Mr Evans-Parker as “CEO of Wayve, a UK AdTech startup”. It appears that this interview was not published within either of the relevant periods (which span 25 February 2017 to 28 March 2022) and therefore is of no assistance for proving genuine use of the Earlier Trade Mark in the context of either of the Oppositions. Mr Booth gives no date for this interview in his witness statement, but it can be inferred from the numbers at the end of the bottom line of text on each page “20161120” that it was published on 20 November 2016. The content of the interview also indicates that it is one that took

place in 2016: for example on the fourth printed page there is a question “*What are your plans for the next 12 months?*” and Mr Evans-Parker answers “*Breaking into the US market is our key focus for the next year, and we plan to be there from early 2017*”. **Exhibit JB13** falls outside the relevant periods and is therefore not relevant.

44. The documents found at **Exhibit JB14** consist of a print out from web.archive.org/web of a website or App. Mr Booth does not give the date of these documents, but they appear to fall outside the relevant periods, since the fourth page of the Exhibit has at the top “© 2015 Wayve Ltd”, and on each page of the bottom line of text there is the text “https: :// webarchive.org/web/20150626 ...” which suggests that these prints outs relate to a website or app captured on 26 June 2015. Therefore, these documents relate to internet activity which is dated outside both relevant periods and so cannot be used to demonstrate genuine use of the Earlier Trade Mark.
45. The Opponent’s evidence in chief also included a witness statement of Jamie Evans-Parker, dated 27 September 2023. Mr Evans-Parker is the founder of IVO Media Holdings Ltd and has been its CEO since November 2018. He states that IVO Media Holdings Ltd was previously known as IVO Media Ltd. Mr Evans-Parker states that IVO Media Holdings Ltd is the current owner of the Earlier Mark (3032848), though I note that the register continues to indicate that the Earlier Mark is owned by IVO Media Ltd, which is the name of the Opponent as recorded in these proceedings. He states that he previously founded Wayve Ltd in 2012, which filed the Earlier Mark and which was registered on 9 May 2014. He confirms that Wayve Ltd merged with Rockabox Media Ltd in late 2017, to whom it subsequently assigned its IP. He states that “during this period he worked with Rockabox to continue use of the Wayve platform and associated branding”.
46. Mr Evans-Parker exhibits one document **Exhibit JEP01**, which he states is provided to “*illustrate and prove the significant use and reputation that there has been of the Earlier Trade Mark by the Opponent in the United Kingdom by [IVO Media Holdings Ltd]*”. The document that is exhibited at JEP01 is an email to Mr Evans-Parker at Scoota, dated 12 June 2018, from a personal email account of an industry colleague. Her email says that she has “heard highly positive feedback about Wayve’s creative tech”, but her email is no more than a speculative expression of interest in a possible

future job opportunity with the Scoota business. This email cannot amount to genuine use of the Earlier Trade Mark by the Proprietor or with his consent. Further this email does not provide any evidence of genuine trade mark use in relation to specific goods and services for which the Earlier Trade Mark is registered. Nor is it specific about the time any goods or services were provided so as to determine whether the alleged genuine use falls within the relevant periods as required. Therefore, this document is also irrelevant for demonstrating genuine use of the Earlier Trade Mark.

47. A finding of genuine use does not depend on economic success or large-scale commercial use; rather, it is concerned with the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods and services. Even standing back and taking the whole of the evidential picture in the round, I find that the documentary evidence provided by the Opponent falls hopelessly short of satisfying the requested proof of genuine use of the Earlier Trade Mark in relation to **any** of the goods or services for which it is registered by the Trade Mark proprietor or with his consent within the two relevant periods. Consequently, the Opponent has no earlier registered rights, and its **section 5(2)(a) and 5(3) objections inevitably fail**.
48. I have noted the Applicant's secondary alternative position that the only possible genuine use that IVO Media could demonstrate, on its widest fair construction, would be services characterised "*providing temporary use of online non-downloadable software in the field of digital advertising*" in Class 42. Even had I been satisfied that the evidence were substantial enough to consider an objection based on this limited part of the specification of the Earlier Trade Mark, the section 5(2)(a) objections would nonetheless fail, because the goods and services are not similar, as explained below.
49. Section 5(2)(a) of the Act states: "*5(2) a trade mark shall not be registered if because (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trademark 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.*"

50. If there is no similarity between the goods and services of the earlier trade mark and the goods and services of the later trade mark applications a section 5(2)(a) objection cannot apply. The factors under the relevant case law for assessing similarity of goods and of services are well established, as including:

- (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) the extent to which the respective goods or services are competitive;<sup>7</sup>
- (f) their method of use;
- (g) whether they are in competition with each other;<sup>8</sup>
- (h) whether they are complementary,<sup>9</sup> in the sense that there is a close connection between them, in the sense that “one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.<sup>10</sup>

51. The relevant goods and services of the two opposed trade mark applications are found in the table at **Annex 2** to this skeleton argument, which may be considered as being certain services in Class 42 (broadly relating to self-driving vehicles), certain goods in Class 9 (broadly autonomous vehicle software) and certain services in Class 39 (broadly transportation services). I agree with Ms Berkeley that even if those goods and services were compared, applying the above case law factors, to the Class 42 services of “*providing temporary use of online non-downloadable software for building advertising formats in the field of digital advertising*” or “*providing temporary use of online non-downloadable software in the field of digital advertising*” there is no similarity at all.

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<sup>7</sup> *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 Jacob J (as he then was) - the *Treat* factors.  
<sup>8</sup> *C-39/97 Canon KKK v Metro Goldwyn Mayer Inc* [1999] RPC 117, the Court of Justice of the European Union (CJEU) at [23].

<sup>9</sup> *Ibid*

<sup>10</sup> The General Court held in the case of *Boston Scientific Ltd v OHIM* (Case T-325/06, EU:T: 200: 428) at [82].

52. The uses and end users of non-downloadable software services in the field of digital advertising are completely different to the uses and end users of machine learning software for robotic applications including autonomous vehicles (Class 9), arrangement of transport services (Class 39) and technical, scientific and research services in the field of robotics, self-driving car and autonomous vehicle technology (Class 42). The Earlier Trade Mark Class 42 services are for uses within a very narrow business field of digital advertising and will be used by marketing departments of business and advertising agencies to build advertising campaigns. The goods and services of the two opposed trade mark applications are all connected with robotics and autonomous cars and transport and the arrangement of transport services – these goods and services are specialised and complex - this field of activity is far removed from the field of advertising.
53. There is no complementarity: the Class 42 services of the Earlier Trade Mark and the goods and services of the two opposed trade mark applications are not indispensable or important for the use of the other. There is no reason why consumers would reasonably think, for example, that “responsibility for the non-downloadable software in the field of digital advertising” lies with the same undertaking providing “machine learning software for robotics applications including autonomous vehicles” these services are simply too far apart for any connection to be made between them. Bearing in mind, too, the case law emphasis that services should not be afforded a wide construction, the only reasonable conclusion is that there is no similarity between the specifications at issue and therefore the Opponent’s section 5(2)(a) objection must be dismissed on this basis, too.
54. For the sake of completeness, even if there could be said to be a very low similarity between the parties’ goods and services - premised for instance on their shared nature software - I also accept that a global assessment would not produce a likelihood of confusion, despite the marks themselves being identical. There is no evidence of acquired distinctiveness as at the relevant dates (the filing dates of the contested trade mark applications). The goods and services in issue are of relatively high value and/or of the type that the average consumer will pay high attention to when purchasing. The level of similarity (if there is any at all) could only be considered so low that there is no

likelihood of confusion, and the section 5(2)(a) objection would be dismissed on that further basis.

### **Failure to show use by the true Trade Mark Proprietor or with his consent**

55. Ms Berkeley put forward an additional part of the Applicant's case concerning genuine use, which is that IVO Media has not demonstrated that any use of the Earlier Trade Mark relied upon was use by the actual Proprietor of the Earlier Trade Mark or with his consent. This argument is linked to the Applicant's submissions under Article 2 of the Trade Mark (Relative Grounds) Order 2007, which I deal with subsequently.
56. In summary, the Earlier Trade Mark was originally filed by Wayve Limited on 29 November 2013 and this mark was registered on 9 May 2014. As explained in the witness statement of Louisa Dixon, (the solicitor acting on behalf of Wayve Technologies) dated 28 November 2023, Wayve Ltd was dissolved on 15 November 2018. Further as her evidence explains, before it was dissolved, Wayve Ltd went through an administration process. **Exhibit LVD2** and **Exhibit LVD3** are copies of Forms AM10 Notice of Administrator's Progress report issued in connection with the administration of Wayve Ltd, dated 5 March 2018 and 31 July 2018. For example, on page 8 of the March 2018 report in the section headed "Intellectual Property" it is stated that "*As previously reported, on 14 August 2017, I completed a sale of the Company's intellectual property to RML for £20,000 plus Vat (the consideration)*". The Company "RML" is defined on page 6 of the report at point 2 as "Rab Media Limited".
57. Therefore, according to this evidence, from 14 August 2017 the owner (and true proprietor) of the Earlier Trade Mark was Rab Media Ltd. This means that any relevant genuine use of the Earlier Trade Mark that is to be relied upon from 14 August 2017 must be made by Rab Media Ltd or with its consent.
58. Exhibits JB06-JB12 relied upon by IVO Media are all internal documents and emails generated by the business Scoota, which is the trading name for Rockabox Media Ltd. According to the evidence filed in this case Rockabox Media Ltd has never been the true proprietor of the Earlier Trade Mark. None of the evidence relied upon by IVO Media can be said to show use of the Earlier Trade Mark by Rab Media Ltd. No trade mark licence has been put in evidence showing that any use made by Rockabox Media Ltd was made with the consent of Rab Media Ltd. Therefore, it cannot be said that

the use qualifies as genuine use in accordance with the requirements of section 6A of the Act 1994.

59. For the purposes of the section 5(2)(b) claim, this point may be superfluous, since I have already found the evidence falls short of establishing genuine use for any goods or services. However, I also agree with the analysis above, although I note the Applicant's evidence regarding the connection between Rab Media Ltd and Rockabox, as explained below in the wider context of the Applicant's position that IVO Media has no right to bring the Opposition at all since it lacks standing according to the requirements of Article 2 of the Trade Mark (Relative Grounds) Order 2007.

### **Opponent's lack of standing**

60. Another of the Applicant's pleaded defences is that IVO Media is not entitled to bring these proceedings. Although IVO Media is currently listed on the UK Trade Marks Register as the proprietor of Earlier Trade Mark No. 30328484, the Applicant disputes in its counterstatements that IVO Media Ltd is in fact the Proprietor of this Trade Mark or the owner of any earlier right relied upon under Section 5(4).

61. The Trade Marks (Relative Grounds) Order 2007, states:

*"(2) The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right."*

62. Section 72 of the Act states:

*"In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it."*

63. While the Opponent stands named as the proprietor named in the trade marks register, I agree that the Applicant's clear evidence from Louisa Dixon is sufficient to displace the rebuttable presumption regarding the status and implications of the registered



proprietor.<sup>11</sup> In response, IVO Media has not managed to provide evidence that establishes that IVO Media is the proprietor of Trade Mark No. 3032484. Ms Berkeley further detailed the evidence, from which the following points are clear:

- i) The Trade Mark Register lists IVO Media Ltd as the proprietor of Earlier Trade Mark No. 3032484, but the Event History profile at **Exhibit LVD4** shows that it was originally filed by Wayve Ltd., which remained listed as the proprietor until 11 July 2022.
- ii) The Event History also shows that on 1 July 2022 the Trade Mark Registry received notice that two trade mark assignments had occurred in relation to UK Trade Mark No. 3032848. The first of these (unsubstantiated) assignments was said to have an effective date of 14 August 2017, which was said to be an assignment of the Earlier Trade Mark from Wayve Ltd to Rockabox Media Ltd; the second (unsubstantiated) assignment was said to have an effective date of 19 November 2018 and was said to transfer the Earlier Trade Mark from Rockabox Media Ltd to IVO Media Ltd.
- iii) However, it is clear from the evidence provided by Ms Dixon in **Exhibits LVD2** and **LVD3** that in fact the original proprietor of UK Trade Mark No. 3032848 Wayve Ltd sold that trade mark to a different, separate company called “Rab Media Ltd”.<sup>12</sup> As Ms Dixon explains, before Wayve Ltd was dissolved on 15 November, it went through an administration process. The Notice of Administrator’s Progress report dated 5 March 2018 at **Exhibit LVD2** details the sale of the Wayve Ltd’s intellectual property to Rab Media Limited on 14 August 2017. According to these formal documents filed by Wayve Ltd’s company administrators at Companies House, from 14 August 2017 the owner (and true proprietor) of the Earlier Trade Mark No. 3032848 was Rab Media Ltd. **Exhibit LVD5** shows that Rab Media Ltd was dissolved on 24 September 2019. I agree with Ms Berkeley that it therefore appears clear that the details entered into the UK Trade Marks Registry concerning the alleged transfer of proprietorship of Earlier Trade Mark No. 3032848 are simply wrong and do not record the true proprietor of this trade mark.

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11 See paragraphs 7 and 8 of the decision of Geoffrey Hobbs QC, as the Appointed Person at *Binti Marine v Sunchalk Ltd* (O/207/22) that “the word “proprietor” as used in Article 2 of the 2007 Order did not simply mean “registered proprietor”: see, for comparison *Cinpress Gras Injection v Melea* [2008] RPC 17; [2008] EWCA Civ 9

12 Exhibit LVD5

64. Section 24(3) of the Act “(3) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative....”. IVO Media has provided no documents in evidence which amount to written assignments of UK Trade Mark No. 3032848 from Wayve Ltd to Rockabox Media Ltd (or indeed a written assignment of UK Trade Mark No. 3032848 from Rockabox Media Ltd to IVO Media Ltd).
65. In response to Ms Dixon’s witness statement, IVO Media filed a second witness statement of Mr Evans-Parker dated 22 January 2024. This witness statement does not provide any written relevant assignments concerning Trade Mark No. 3032848 and at paragraph 4 admits that “*RAB Media Ltd was a company owned by James Booth CEO of Rockabox Media Ltd and was used to purchase Wayve’s Intellectual property in 2017...*”. IVO Media thus confirms that it was Rab Media Ltd that purchased Wayve Ltd’s intellectual property, not Rockabox Media Ltd. Contrary to the information that appears to have been provided in the relevant form to the UK IPO by IVO Media on 1 July 2022, there does not seem to have ever been an assignment from Wayve Ltd to Rockabox Media Ltd of the Trade Mark No. 3032848.
66. Mr Evans-Parker also exhibits some documents that appear to show that Rockabox Media Ltd transferred to IVO Media Ltd an ordinary share of Rab Media Ltd on 19 November 2018. However, this share transfer between IVO Media and Rockabox Media Ltd cannot constitute an assignment of Trade Mark No. 3032848 from Rab Media Ltd to Rab Media Ltd or to IVO Media. Mr Evans-Parker provides no evidence that supports the position that Rockabox Media Ltd was ever the true proprietor of Trade Mark No. 3032848 at all. Rockabox Media Ltd was never in a position to assign Trade Mark No. 3032848 to IVO Media Ltd because Rockabox Media Ltd itself was never actually the proprietor of Trade Mark No. 3032848. The evidence before me in these consolidated Oppositions shows that on 14 August 2017 the Intellectual Property of Wayve Ltd was sold to Rab Media Ltd and there is no evidence of any written assignment transferring Trade Mark No. 3032848 from Rab Media to any other entity; not to Rockabox Media Ltd nor to IVO Media Ltd.

67. I therefore find that it has not been established that IVO Media is the proprietor of the Earlier Trade Mark in these proceedings and therefore does not have the required status to bring these oppositions. The claims under section 5(2)(b) and section 5(3), reliant on the earlier registered mark must inevitably be dismissed.

### **Section 5(3) objection**

68. The legal principles on section 5(3) are well established and I do not consider it necessary to set them out here,<sup>13</sup> since this ground of opposition was not seriously pursued at the hearing. Not only does the section 5(3) ground fail (i) for lack of status and (ii) for lack of proof of genuine use, but it is clear from my earlier account of the evidence that it fails to demonstrate that the Earlier Trade Mark had as at the filing dates of the Contested Marks the reputation required to found a section 5(3) objection in relation to any of the goods and services for which it is registered, and that ground can additionally be dismissed on that third fundamental basis. Nor did the Opponent file evidence relating to the issues of link, unfair advantage or detriment required to be demonstrated under a section 5(3) objection.

### **Section 5(4)(a) objection**

69. Section 5(4)(a) of the Act states:

#### **Relative grounds for refusal of registration.**

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,

...

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<sup>13</sup> See for instance, the summary in *Easygroup Limited v Easyfundraising Limited* [2024] EWHC 2323 (Ch) at [266] to [278].

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

70. It is settled law that for a successful finding of passing off, three factors must be present: goodwill, misrepresentation and damage. Her Honour Judge Melissa Clarke, sitting as Deputy Judge of the High Court, conveniently summarised the essential requirements of the law in *Jadebay Limited, Noa and Nani Limited (trading as The Discount Outlet) v Clarke-Coles Limited (trading as Feel Good UK)* [2017] EWHC 1400 IPEC

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

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

71. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that

the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

72. I accept Ms Berkeley's submissions that IVO Media has failed to provide any evidence that establishes that it owned any protectable goodwill in relation to the claimed Computer software by reference to the sign "Wayve" as at the relevant dates. I have previously found that the evidence fails to establish genuine use of the sign for any goods or services for which the Earlier Trade Mark is registered, not even the potentially limited specification of *"providing temporary use of online non-downloadable software for building advertising formats in the field of digital advertising"* in Class 42. Such use in internal documents and emails to single persons

in early 2018 cannot be sufficient to create a protectable goodwill to be assessed at the relevant dates in 2022. The classic definition of goodwill is taken from the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 as “*It is the attractive force which brings in custom*”. It requires the existence of customers or potential customers, and IVO Media has failed to provide evidence of any customer awareness of trade being carried out under the sign “Wayve” as at the relevant dates in 2022.

73. On the issue of establishing the required misrepresentation or deception, the guidance found at paragraph 309 of Halsbury's Laws of England Vol 97A (2014 issue) is also of assistance. As stated in this guidance one of the important factors to be taken into account when determining whether the necessary misrepresentation can be demonstrated is the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business. The fact that the parties are trading in different fields adds to the evidential burden on the opponent to that there is a real risk of confusion or deception. I also bear in mind that where the fields of activity are far removed as in this case, it cannot be assumed that even if a small amount of confusion did arise, it would necessarily result in damage to the opponent.
74. It is quite clear in this case that, even if IVO Media had been able to establish that it owned any protectable goodwill at all, such goodwill only related to a very narrow field of activity around digital advertising software, which is so far away from the goods and services of the specifications of Trade Mark applications Nos. 3770700 and 3758801 that there is no likelihood of misrepresentation occurring at all, nor any damage. Therefore, this section 5(4)(a) objection must also be dismissed on all these grounds.
75. Furthermore, in line with the analysis of ownership set out earlier in this decision in respect of the registered trade mark, it appears at least questionable that IVO Media could claim ownership of the goodwill (had any been shown), and as such it would not be the proprietor of an earlier right as required under Article 2 of the Trade Mark (Relative Grounds) Order 2007. The section 5(4)(a) claimed would be dismissed on that basis too.

**OUTCOME:** The oppositions fail on all grounds. Subject to any successful appeal, trade marks application numbers 3758801 and 3770700 may proceed to registration.

## **COSTS**

78. The Applicant is entitled to a contribution towards its costs in these proceedings, in line with the scale set out in Tribunal Practice Notice 2/2016. I award the sum of £4700, which is calculated as follows:

- Considering statements of grounds and preparing counterstatements: £350 (x2)
- Considering the other side's evidence and preparing response: £2200
- Preparation for and attending a hearing: £1600
- Attendance at case management conference £200

I order IVO Media Ltd to pay Wayve Technologies Ltd the sum of £4700. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 1<sup>st</sup> day of May 2025**

**Matthew Williams**

Hearing Officer

For the Registrar

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## **Annex 1**

### **Parallel proceedings between the parties**

**Opposition No. 450183:** This is an attack against another trade mark application (No. 4034887) by Wayve Technologies Ltd - filed in April 2024. That application is for a series of two 'wayve' marks featuring a figurative device, applied for in respect of the same goods and services in Classes 9, 39 and 42 as covered by the two marks in the present consolidated oppositions. At the time of writing, IVO Media Ltd's Form TM7 notice of opposition has been filed, and subsequently amended, but is yet to served. The grounds of opposition in Opposition No. 450183 are based on sections 5(2)(b), 5(4)(a) and 3(6) of the Act. For its claim based on section 5(2)(b), the Opponent relies on earlier registered trade mark No. 3032848, which is the same earlier trade mark on which it relied for its section 5(2)(a) and section 5(3) claims in the present consolidated oppositions. As confirmed in this present written decision, I am not satisfied that the evidence filed in the consolidated oppositions is sufficient to establish the claimed genuine use.

**Cancellation No. 508138:** Following the oral hearing of the consolidated oppositions, the Applicant has applied to revoke the Opponent's earlier registered trade mark No. 3032848 on the grounds of non-use. The Form TM26(N) filed in application for revocation has yet to be served.

## **Annex 2**

### **Services applied for under TM application 3758801**

**Class 42:** *Technical, scientific and research services in the field of robotics, self-driving car and autonomous vehicle technology; research, design and development of computer software in the field of self-driving cars, autonomous vehicles and robots; research, design and development of machine learning software and systems for self-driving cars, autonomous vehicles and robots; research, design and development of reinforcement learning software and systems for self-driving cars, autonomous vehicles and robots; research, design and development of artificial intelligence software and systems for self-driving cars, autonomous vehicles and robots; research, design and development of virtual reality software for the purpose of training self-*



*driving cars, autonomous vehicles and robots; research, design and development of machine learning, reinforcement learning and artificial intelligence algorithms for the purpose of training self-driving cars, autonomous vehicles and robots; research, design and development of computer software for fleet management; research, design and development of computer software for vehicle and robot control, navigation, deployment, scheduling, booking and dispatching; research, design and development of computer software for analysing, collecting, interpreting, processing, displaying, managing, visualising, and mining data in the field of self-driving cars, autonomous vehicles and robots; software-as-a-service and cloud computing services for machine learning, reinforcement learning and artificial intelligence in the field of self-driving cars, autonomous vehicles and robots; software-as-a-service and cloud computing services in the field of self-driving cars, autonomous vehicles and robots; providing virtual computer systems and environments through cloud computing for the purpose of training self-driving cars, autonomous vehicles and robots; virtual testing of self-driving cars, autonomous vehicles and robots using computer simulations; creation, development, programming and implementation of simulation software in the field of self-driving cars, autonomous vehicles and robots; simulation programs for autonomous vehicles; software-as-a-service and cloud computing services for fleet management; software-as-a-service and cloud computing services for vehicle and robot control, deployment, navigation, scheduling, booking and dispatching; software-as-a-service and cloud computing services for analysing, collecting, interpreting, processing, displaying, managing, visualising, and mining data in the field of self-driving cars, autonomous vehicles and robots; information, advisory and consultancy services in relation to all of the aforesaid.*

## **Goods and services applied for under TM application 3770700**

**Class 9:** *Artificial intelligence, computer vision, reinforcement learning and machine learning software for robotics applications including autonomous vehicles Software for self driving cars or autonomous vehicles; Sensor to control software for robotics; Data collection software for robotics algorithms; Autonomous taxi fleet software; Self driving truck delivery software.*

**Class 39:** *Arrangement of transport; Arrangement of transportation; Arrangement of transportation of passengers by cars; Arrangement of transportation of people; Arrangement of transportation of travellers; Arrangement of travel; Arrangement of vehicle rental; Arranging and conducting of mail order delivery services; Arranging for the transport of air freight; Arranging for the transportation of passengers; Arranging of car hire; Arranging of transport; Arranging of vehicle hire; Arranging of vehicle rental; Arranging transportation of goods; Arranging transportation of passengers; Arranging vehicle hire; Arranging vehicle rental; Automobile vehicle renting services; Booking of hire cars; Booking of transport; Booking of transportation via a website; Car sharing services; Car transport; Car transport services; Collection of packages by road; Delivery and storage of goods; Delivery by road; Freight and cargo services; Freight and cargo transportation and removal services; Freight transportation; Freight transportation services; Information services relating to methods of transport; Passenger transportation services by land; Passengers (Transportation of -).*

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