

O/644/22

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3656045
BY LINKWIRE LIMITED
TO REGISTER THE TRADE MARK:

KALEIDOSCOPE

IN CLASSES 9, 35 & 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 429039
BY WILDLIFE ACOUSTICS, INC.

Background and pleadings

1. On 16 June 2021, Linkwire Limited (“the applicant”) applied to register the trade mark **KALEIDOSCOPE** in the UK, under number 3656045 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 10 September 2021. Registration is sought for the following goods and services¹:

Class 9: Computer software; software, software packages, software applications, mobile applications and web applications; applied software for companies; communication and network software; computer software for data and file management; database software; office and business application software; software for applications and database integration; business process management software; business performance management software; management information system software; business management software; computer software for use as an application programming interface (API); cloud computing services software; machine learning software; artificial intelligence software; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals.

Class 35: Business management; business administration; business project management; preparation of business and commercial reports; providing statistical information relating to business; statistical analysis and reporting services for business purposes; information, advisory and consultancy services in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet.

Class 42: Design and development of computer software; design and development of computer software for machine learning and artificial

¹ The applicant sought to restrict its goods and services by filing Form TM21B on 10 December 2021.

intelligence; software as a service (SAAS); design, development, provision, implementation, updating, upgrading and maintaining communication systems, software, software applications, mobile applications, web applications and portals; data integration services; platform as a service (PaaS); infrastructure as a service (IaaS); function as a Service (FaaS); integration platform as a service (iPaaS); platforms for artificial intelligence as software as a service [SaaS]; providing artificial intelligence computer programs on data networks; development of computer systems for the internet of things (IoT); web development services; consultancy and information services relating to information technology architecture and infrastructure; communication technology consultancy; designing, developing and maintaining systems for data input, output, processing, display and storage; data storage; website testing, analysis and optimization services hosting services and provision of software (SaaS) and rental of software; software programming services; information, advisory and consultancy services in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals.

2. On 10 December 2021, Wildlife Acoustics, Inc. (“the opponent”) filed a notice of opposition. The opposition is brought under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods and services of the application. The opponent relies upon its International Registration designating the UK number WO0000001144653, **KALEIDOSCOPE** (“the earlier mark”) to support its claim. The earlier mark was registered on 3 December 2012. With effect from the same date, the opponent designated the UK as a territory in which it sought to protect the International Registration under the terms of the Madrid Agreement. The earlier mark claims a priority date of 27 June 2012 from the Office of Origin in the US. Protection in the UK was granted on 27 June 2013 in respect of goods in class 9, which the opponent relies on for the purpose of this opposition,

namely: “downloadable software for measuring, classifying, analyzing, and generating reports about wildlife audio signals”.

3. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. As it had been registered for more than five years at the filing date of the application, it is subject to the proof of use requirements specified within section 6A of the Act.

4. The opponent essentially argues that the marks are identical and that many of the goods in class 9 are identical to those covered by the earlier mark. The opponent argues that as a result of identical marks for identical goods, the contested mark should be refused registration pursuant to section 5(1) of the Act. In addition, the opponent also argues that the goods and services are similar to the goods of the earlier mark and that the combination of identical marks and similar goods and services gives rise to a likelihood of confusion. The contested mark should therefore be refused registration under section 5(2)(a) in the alternative.

5. The applicant filed a counterstatement denying the grounds of opposition. Within its counterstatement, the applicant denies that the goods and services are identical or similar² and challenges the opponent’s use of the mark. It also disputes that there is a likelihood of confusion.

6. The opponent is professionally represented by Mewburn Ellis LLP, whereas the applicant is professionally represented by Withers & Rogers LLP. Evidence has been filed by the opponent in these proceedings. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. However, both parties filed written submissions in lieu of an oral hearing. Whilst I do not intend to summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon

² Counterstatement, paragraphs 8-12.

in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

Evidence and submissions

8. The opponent's evidence comprises a witness statement of Andrew King together with Exhibit ATK1, which concerns the similarity of the goods and services. The evidence also includes three witness statements of Ian Agranat. The first and second are dated 18 March 2022 and the third is dated 21 April 2022, together with Exhibits IA1 to IA23. Ian Agranat confirms that they are President and the CEO of the opponent company, a position they have held since 19 December 2003. The purpose of their statement is to give evidence as to the history and activities of the opponent, as well as to its use of the earlier mark.

9. As stated above the applicant did not file evidence but has provided written submissions in lieu of the hearing. The opponent has also provided written submissions.

10. Whilst the parties' evidence and submissions will not be summarised here, I have taken it all into consideration in reaching my decision and will refer to it below, as and where necessary.

DECISION

Proof of use

11. The relevant statutory provisions are as follows:

“6A - (1) This section applies where

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

[...]

(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.”

12. The onus is on the opponent, as the proprietor of the earlier mark, to show use made of the mark as section 100 of the Act states:

“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.”

13. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the filing date of the application at issue, i.e. 17 June 2016 to 16 June 2021.

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

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

[EU:C:2014:2089] and Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

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

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

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

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

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

15. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.

Genuine use

16. Ian Agranat gives evidence that the opponent’s company was founded in Massachusetts in the USA on 19 December 2003 under the original name “Bird Sounder, Inc.” before changing its name to “Wildlife Acoustics, Inc.” on 15 July 2004.³

17. Ian Agranat explains that the company offers “downloadable software providing access to a range of features for measuring, classifying, analysing and generating reports about wildlife audio signals under the company’s mark.”⁴ Ian Agranat sets out three licenses that are available in the UK for the company’s software under its mark: KALEIDOSCOPE Pro License, KALEIDOSCOPE Viewer license and KALEIDOSCOPE UK license.⁵

18. Ian Agranat explains that there are two routes to the UK market, direct sales through the company and sales through its UK distributors.

19. Screenshots of the wildlifeacoustics.com website have been provided to demonstrate the software products that have been sold under the mark, which include the three software licenses.⁶ At first glance these screenshots appear undated. However, the “Wayback Machine” web address includes the digits “20170716” and “20160606” which would seem to corroborate the dates provided in Mr Agranat’s narrative evidence,⁷ i.e. 16 July 2017 and 6 June 2012.

20. A further screenshot of the wildlifeacoustics.com website, obtained using the internet archive ‘Wayback Machine’, has also been provided.⁸ The screenshot is clearly dated

³ Ian Agranat’s first witness statement, paragraph 4 & Exhibit IA1

⁴ Ian Agranat’s first witness statement, paragraph 6

⁵ Ian Agranat’s first witness statement, paragraph 7

⁶ Exhibit IA4

⁷ Ian Agranat’s first witness statement, paragraph 11

⁸ Exhibit IA5

4 July 2017. This document details the opponent's UK distributors, which include "Wildcare", "NHBS" and "Wildlife & Countryside Services". Further screenshots have then been provided of the opponent's UK distributors websites,⁹ showing software products under the mark, either advertised, or for sale. The screenshot of Wildcare's company website wildcare.co.uk¹⁰ shows the mark advertised in their fall 2015 brochure. In addition, there is a screenshot of the product for sale under the mark on Wildcare's company website¹¹, however this screenshot was obtained on 8 November 2022, i.e. after the relevant period. The remaining screenshots of the other distributors' websites www.nhbs.com¹² and www.wildlifeservices.co.uk¹³ clearly show software products bearing the earlier mark for sale. These screenshots cover a range of dates from 23 October 2016 to 04 March 2021, (using the internet archive 'Wayback Machine'), all within the relevant period. I note that screenshots of paper copies of two Wildcare catalogues are in evidence dated 2016/2017 and 2018/2019.¹⁴ These also advertise for sale goods relied on under the mark.

21. Ian Agranat also provides approximate turnover figures in relation to sales in the UK under the mark between 16 June 2016 and 15 June 2021. From this I note that 1,920 units were sold during the relevant period, generating a turnover of over US\$692,000.¹⁵ This is further supported with a detailed breakdown of sales figures for the types of software sold under the mark, the date on which they were sold, and the customer location of those purchases.¹⁶ This detailed information shows regular and frequent sales of software products bearing the earlier mark to customers spread across the UK. I note that the overall figure shown in this detailed breakdown is higher than the figure provided by Ian Agranat in his witness statement. However, the detailed breakdown covers additional dates to those displayed in the witness statement: the witness statement covers only the "relevant period", whereas the detailed breakdown also includes sales made before the relevant period when the product was first launched under the opponent's mark.

⁹ Exhibits IA6, IA7 & IA9

¹⁰ Exhibit IA7

¹¹ Exhibit IA8

¹² Exhibit IA6

¹³ Exhibit IA9

¹⁴ Exhibit IA19

¹⁵ Ian Agranat's first witness statement paragraph 16

¹⁶ Exhibit IA10

22. The opponent has provided a selection of sample invoices relating to software sold under the earlier mark, and whilst a small number of them fall outside the relevant period, most fall within the relevant period and further demonstrate that such products were sold to customers throughout the UK.¹⁷ These invoices confirm the type of software sold under the mark, the quantities purchased, the amount paid and the location of the customer.

23. Ian Agranat provides a variety of studies, reports, and academic articles that refer to the use of “KALEIDOSCOPE” software for their research within the relevant period.¹⁸ Examples include: a report published in August 2017, entitled “Assessing woodland management, habitat structural features and landscape characteristics as predictors of bat activity in a complex managed landscape” co-produced by Marwell Wildlife and the University of Southampton.¹⁹ The evidence also consists of an extract from “Geckoella’s” company website “geckoella.co.uk/project/teignbridge-district-council-wolborough-bat-surveys”, dated 2019, which demonstrates the use of “Kaleidoscope Pro Software” for a bat survey they conducted for Teignbridge District Council.²⁰ This report refers to the use of “Kaleidoscope Pro Software” in collecting data for research. Evidence also includes an academic article published in the “Journal of Ornithology” published online on 19 March 2019, headed “Comparison between lek counts and bioacoustic recording for monitoring Western Capercaillie”. Within this article it discusses the use of “Kaleidoscope software” in environmental studies, for monitoring certain bird species.²¹ In addition, there is training material from Batability²² demonstrating to consumers how to use “KALEIDOSCOPE” products once purchased.

24. Ian Agranat claims in his witness statement that the company organised, sponsored and attended numerous conferences and events throughout the UK, with banners and displays promoting the company’s “KALEIDOSCOPE” software products. Ian Agranat lists the location and dates of these events,²³ and provides

¹⁷ Exhibits IA11 & IA17

¹⁸ Exhibits IA12, IA13, IA21, IA22 & IA23

¹⁹ Exhibit IA12

²⁰ Exhibit IA13

²¹ Exhibit IA21

²² Exhibits IA15 & IA16

²³ Ian Agranat’s first witness statement, paragraph 20

photographs claimed to be from these events with the dates typed below.²⁴ Although these photographs are not time stamped, the dates provided have not been challenged. From the photographs evidencing these events, it would appear that the main banners and displays were advertising and promoting the company's name "Wildlife Acoustics". However, I can see that the "KALEIDOSCOPE" mark is also present from the photographs of these events.

25. I note that some of the evidence relating to sales figures predates the relevant period, and that no advertising or marketing figures have been provided. However, I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²⁵

26. The evidence shows that the opponent has been selling software in the UK under the "KALEIDOSCOPE" mark since May 2013. These sales have been made either directly by the company or through its UK distributors. The unchallenged turnover figures provided show that the opponent sold almost 2000 units of software during the relevant period in the UK, generating a turnover figure of over US\$692,000. This is not an insignificant sum given the potentially niche market for this specific software. Even accounting for a potentially larger market, it is still not an insignificant amount. Further, I remind myself that use does not need to be quantitatively significant to be genuine. A number of invoices spanning the relevant period are in evidence which demonstrate that "KALEIDOSCOPE" branded software has been sold to a customer-base across various regions of the UK. Printouts for the opponent's website www.wildlifeacoustic.com in addition to its distributors' websites www.wildcare.co.uk, www.nhbs.com and www.wildlifeservices.co.uk, demonstrate that the earlier mark has been used in relation to the goods it relies upon, i.e. "downloadable software for measuring, classifying, analysing and generating reports about wildlife audio signals", within the relevant period. I note on these websites the prices are given in pound sterling, a strong indicator that their target audience is the UK. The evidence suggests that the software sold under the mark is used by various UK universities and wildlife organisations to gather information during studies and compile reports on bats and

²⁴ Exhibit IA20

²⁵ New Yorker SHK Jeans GmbH & Co KG v OHIM, Case T-415/09

birds, and that certain organisations even provide training on this software. The unchallenged evidence also shows that the opponent has attended events throughout the UK to promote its goods. Although the evidential value of the photographs is somewhat limited, they at least show that software products bearing the earlier mark have been promoted at such events. In light of all of this, it is clear the opponent has attempted to create and maintain a market for its goods under the “KALEIDOSCOPE” mark. Taking all the evidence as a whole into account, I am satisfied that the opponent has demonstrated genuine use of its earlier mark within the relevant period.

Form of the mark

27. The word “KALEIDOSCOPE” appears on the Wildlife Acoustic Inc. company website www.wildlifeacoustic.com in addition to the websites of its UK distributors www.wildcare.co.uk, www.nhbs.com and www.wildlifeservices.co.uk. The mark is presented throughout the evidence in both upper and lower case; I consider this to be use of the earlier mark as registered word-only marks provide protection for the words themselves, irrespective of the case that they are presented in. Often, the word “KALEIDOSCOPE” is followed by words such as “software”, “pro”, “pro analysis software” and other such variants which clearly differ from what is registered. For instance, the word “KALEIDOSCOPE” followed by various descriptive words for the specific software sold under the mark, appears on invoices as well as on the breakdown of the turnover figures, academic articles, catalogues and training material. However, as the words “software”, “pro”, “pro analysis software” and the like are allusive or descriptive of the goods relied upon, their impact is minimal as it would not be attributed any trade mark significance. I remind myself that that ‘use’ of a mark encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.²⁶ In the context of the evidenced marks as wholes, the word “KALEIDOSCOPE” continues to be the indicator of economic origin. As such I consider the evidenced marks to be acceptable variant use of the mark registered.

²⁶ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

Fair specification

28. The applicant has argued that the evidence establishes that software under the mark is only used for bat calls and, therefore, the specification should be narrowed to reflect this.²⁷ I remind myself that fair protection is not to be achieved by identifying and defining particular examples of goods for which there has been genuine use, but, rather, the particular categories of goods they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer for the goods and services concerned.²⁸ In arriving at a fair specification, I must consider how the average consumer would fairly describe the goods shown in evidence; the task is not to describe the use made by the earlier mark in the narrowest possible terms, unless that is what an average consumer would do. I remind myself that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods covered by the registration.²⁹ Comparing the goods shown in evidence and the goods registered in class 9, I am satisfied that the use made of the earlier mark warrants the term for which it is registered. The opponent's software appears to be predominantly, though not exclusively, used in relation to bat audio signals. Bats are a particular kind of wildlife. In my view, the average consumer would fairly describe the opponent's goods as being used in relation to wildlife. To restrict the opponent's specification further would be to strip the proprietor of protection for goods which the average consumer would consider belonging to the same group or category. In support of this finding, the evidence shows use of the opponent's software in relation to birds as well as bats. As a result, I am satisfied that the evidence establishes genuine use in relation to "downloadable software for measuring, classifying, analysing and generating reports about wildlife audio signals". Accordingly, the opponent may rely upon its specification as registered for the purposes of the opposition.

²⁷ Applicant's submissions, paragraph 15

²⁸ *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

²⁹ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

Sections 5(1) and 5(2)(a)

Legislation and case law

29. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

30. Section 5(2)(a) of the Act reads as follows:

“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 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”.

31. I am guided by the following principles which 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;

[...]

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

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

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

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

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

32. Section 5A of the Act states as follows:

“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.”

Identity of the marks

33. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

34. I note that the applicant has accepted that the competing marks are identical.³⁰ I agree. The earlier mark and the contested mark are both word-only marks consisting of the word “KALEIDOSCOPE” with no additional elements. They are self-evidently identical.

Comparison of the goods and services

35. The goods that the opponent relies upon can be found in paragraph 2. The applicant’s goods and services which form the subject of the opposition can be found in paragraph 1.

36. For the purposes of this decision, I am required to assess the comparison of the goods and services in respect of separate grounds under sections 5(1) and 5(2)(a) of the Act. For the purposes of my assessment under section 5(1), the matter will only proceed if I find identity between the parties’ goods and services. For any goods and services that are not identical, the opposition based on section 5(1) must fail. The matter may, however, proceed in relation to any goods and services that are similar under section 5(2)(a).

37. 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 CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

³⁰ Applicant’s written submissions, paragraph 21

“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”.

38. Guidance on this issue has also come from Jacob J. (as he was then) 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.”

39. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

40. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

41. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-325/06, the GC stated that ‘complementary’ means:

“[...] 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”.

Class 9

42. The applicant’s class 9 specification consists of a limitation that states “all the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals”. This restricts the applicant’s goods and introduces exhaustive examples of their uses. For the avoidance of doubt, I have factored this limitation into my comparison below and I will only refer to it where it is necessary to do so.

43. As the applicant has limited its specification to exclude the particular goods for which the earlier mark has protection, the goods cannot be identical. However, the

applicant has not gone as far as to exclude goods that may be similar. I find that the applicant's class 9 goods: "Computer software; software, software packages, software applications, mobile applications and web applications; [...] computer software for data and file management; database software; [...] software for applications and database integration; [...] machine learning software; artificial intelligence software; [...] all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, [...], spreadsheets, reporting, visualisation, analytics, [...]; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals", and the opponent's class 9 term "Downloadable software for measuring, classifying, analysing, and generating reports about wildlife audio signals" overlap in nature, to the degree that they are both software. The intended purpose and method of use are likely to be similar as "computer software [...] relating to data modelling and analytics" could include computer software for analytics relating to migration patterns of wildlife. Trade channels would be similar as there would be an overlap in producing and marketing software outside of the applicant's limitation. Users of the goods are likely to be the same, i.e. professional users rather than the general public. These goods may be competitive in nature, as a professional electing to study the environmental impact on wildlife could use the opponent's goods or they could use similar software, such as software that analyses the visual identification of wildlife, that isn't excluded under the applicant's specification. Therefore, overall, I find the goods to be similar to a high degree.

44. In relation to the applicant's term "cloud computing services software; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, [...], spreadsheets, reporting, visualisation, analytics, [...]; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals" and the opponent's class 9 goods, they are similar in nature insofar as they relate to software. The method of use and the intended purpose may overlap as the applicant's cloud computing services software is not for a specific purpose, such as for business. Therefore, the applicant's software could be used in a similar way to the opponent's software. There could be an overlap in trade channels as it would be reasonable to expect the same company to provide both the cloud computing services software to upload and store the opponent's

software online. Users would also overlap. Consequently, overall, I find that these goods are similar to a medium degree.

45. The applicant's terms "computer software for use as an application programming interface (API); communication and network software; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals" and the opponent's class 9 goods, although they overlap in nature as both relate to software, they differ in intended purpose and method of use as the applicant's term relate to computer software which is specifically used to connect networks and allow these networks to share information with each other. For example, software that allows a computer to connect to a printer. The trade channels differ as consumers would not typically expect companies that provides software for the purpose of enabling networks to connect to one another to also provide software for the purpose of studying wildlife. Any overlap in users would be at such a general level that it would not engage in similarity. As a result, I find that these goods are dissimilar.

46. The remaining terms in class 9, "applied software for companies; [...]; office and business application software; [...]; business process management software; business performance management software; management information system software; business management software; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals" and the opponent's class 9 term overlap in nature insofar as they are both software products, but differ in method of use and intended purposes, as the applicant's software is used specifically in a relation to businesses unlike the opponent's software. The trade channels would differ as it would be unreasonable to expect a company providing software for businesses to also provide software for the purpose of monitoring wildlife. Users would also differ, as the users of the applicant's

goods would be business owners, whereas the users of the opponent's goods would be professionals such as ecologists. Neither are the goods competitive or complementary in nature. Accordingly, I find these goods to be dissimilar.

Class 35

47. The applicant's class 35 services and the opponent's class 9 goods are fundamentally different in nature as one is a good and the other is a service. The method of use and intended purpose are also different: the applicant's services all relate to businesses and will be used to assist the running of a business, whereas the opponent's goods will be used by researchers and scientists for the purpose of collecting and analysing data to learn more about the environment and its inhabitants. The trade channels would differ as undertakings that offer business management services, statistical information for businesses and business reports do not typically provide downloadable software related to ecological studies. Equally, the users for these goods and services are likely to differ as users of the opponent's goods are likely to be professionals, scientists, ecologists, conservationists or students, and the users of the applicant's services are likely to be businesses. The services are neither complementary nor competitive in nature. Therefore, I find that these goods and services are dissimilar.

Class 42

48. The applicant's class 42 specification consists of the same limitation as the class 9 goods above and states "all the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals". This restricts the applicant's services and introduces exhaustive examples of the applicant's specification. Equally, for the avoidance of doubt, I have factored this limitation into my comparison below and I will only refer to it where it is necessary to do so.

49. The applicant's services in class 42, "design and development of computer software; design and development of computer software for machine learning and artificial intelligence; software as a service (SAAS); design, development, provision, implementation, updating, upgrading and maintaining [...] software, software applications, mobile applications, web applications and portals; data integration services; [...]; consultancy and information services relating to information technology architecture and infrastructure; communication technology consultancy; designing, developing and maintaining systems for data input, output, processing, display and storage; data storage; [...] analysis and optimization services, [...] provision of software (Saas) and rental of software; software programming services; information, advisory and [...] in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, [...], spreadsheets, reporting, visualisation, analytics, [...]; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals", are all services which require the use of software, or where the creation of software is the end result. Accordingly, these goods and services overlap in method of use and intended purpose with the opponent's goods. However, the competing goods and services clearly differ in nature. The relationship is likely to be complementary with the average consumer perceiving the same undertaking to provide both these goods and services. For example, it is common for software providers to offer updates to develop the software further and to provide continuing technical support for the users of the software. Therefore, it would not be uncommon for these trade channels to overlap and for users to be the same. Therefore, I find that for these services there is a medium degree of similarity.

50. The opposed services, "platform as a service (PaaS); infrastructure as a service (IaaS); function as a Service (FaaS); integration platform as a service (iPaaS); platforms for artificial intelligence as software as a service [SaaS]; providing artificial intelligence computer programs on data networks; development of computer systems for the internet of things (IoT); [...]; hosting services [...]; information, advisory and consultancy services in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database

management, spreadsheets, reporting, visualisation, analytics, none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals” are intrinsically different in nature to the earlier class 9 software. However, users of computer software such as the opponent’s will often also use cloud services to store data generated through that software, resulting in an overlap in method of use and intended purpose. Trade channels may also overlap as it would not be uncommon for undertakings to offer both goods such as the opponent’s software and the services to facilitate the online hosting and storing of these goods, users of these goods and services would also overlap. There is also likely to be an element of competition as consumers could choose to use the opponent’s downloadable software or software provided by the applicant through a streaming platform under the applicant’s specification. Overall, I consider the goods and services to be similar to at least a low degree.

51. The remaining class 42 terms, “design, development, provision, implementation, updating, upgrading and maintaining communication systems,[...]; web development services; website testing, [...]; information, advisory and consultancy services in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals” compared against the opponent’s class 9 goods differ in nature, as one is a good and the other is a service. They also differ in method of use and intended purpose as the applicant’s services are in relation to specific services that the opponent’s software does not relate to, such as, communication systems, web development and web testing, rather than facilitating software on an online platform. The trade channels would differ as an undertaking offering the above services in class 42 would not reasonably offer the specified goods in class 9. The users would also be different, except for on a very generalised level. Neither would the goods and services be competitive or complementary in nature. Consequently, I find that these services are dissimilar.

52. As noted above, for an opposition under section 5(1) to succeed, the goods and services are required to be identical. As I have found that none of the goods and services are identical, the opponent's claim under section 5(1) must fail.

53. For section 5(2)(a) to apply, there needs to be some degree of similarity between the goods and services. My findings above mean that the opposition must fail against goods and services of the application that I have found to be dissimilar, namely:³¹

Class 9: Computer software for use as an application programming interface (API); communication and network software; applied software for companies; office and business application software; business process management software; business performance management software; management information system software; business management software; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals.

Class 35: Business management; business administration; business project management; preparation of business and commercial reports; providing statistical information relating to business; statistical analysis and reporting services for business purposes; information, advisory and consultancy services in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet.

Class 42: Design, development, provision, implementation, updating, upgrading and maintaining communication systems,[...]; web

³¹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

development services; website testing, [...]; information, advisory and consultancy services in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals.

54. In respect of the remaining goods and services, I have found above in paragraphs 42 to 51, that the goods and services vary in similarity, from a high degree of similarity to a low degree of similarity. The opposition may therefore proceed in relation to these goods and services under section 5(2)(a). For the remainder of the decision I will be focusing on only the goods and services where a level of similarity has been found.

The average consumer and the nature of the purchasing act

55. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

56. 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. 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.”

57. The applicant argues in its counterstatement that the average consumer will consist of highly educated professionals, and in practice the actual users of the software products offered by the parties are different. However, I note that the applicant has not adduced any evidence to that effect. Further, I am required to determine who the average consumer is in the context of notional use of the marks across the applicant’s specifications and in the terms outlined in the above case law.

58. I find that the relevant consumers of the goods and services at issue will predominantly be professional users.

59. The price of the goods and services is likely to vary, depending on their nature and type, but, overall, it is unlikely to be at the highest end of the scale. The frequency at which the goods and services are purchased is also likely to vary from a single one-off purchase at one end of the spectrum, to repeat monthly purchases, at the other. The selection of the goods and services would be relatively important for consumers from the professional community, such as scientists and ecologists, for example, as they will wish to ensure that the products meet their professional needs, and they would be alert to the potentially negative impact of choosing the wrong product on any ongoing studies. Professional users are also likely to assess whether the goods and services are appropriate for use in a professional capacity (such as, their specification, precision, and reputation within the field). In light of the above, I find that the level of attention of members of the professional community would be higher than normal. The goods and services are likely to be advertised in magazines, on the internet or at trade events. Goods are likely to be purchased from physical retail establishments, or their online equivalents, after viewing information on physical displays or on the internet, whereas the services are likely to be purchased directly from the service provider after viewing information in brochures or on the internet. In these circumstances, visual considerations would dominate, however, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods and services would involve discussions with sales representatives or word of mouth recommendations.

Distinctive character of the earlier mark

60. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. 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).”

61. Registered trade marks possess varying 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. Dictionary words which do not allude to the goods and services will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood

of confusion. The distinctive character of a mark may be enhanced as a result of use on the market.

62. The opponent claims³² the distinctive character of the earlier mark has been enhanced due to use evidenced in these proceedings.

63. I have received no comments from the applicant regarding enhanced distinctiveness of the mark through use.

64. Evidence regarding use of the earlier mark has been outlined above and I am now required to assess whether the opponent has demonstrated that the earlier mark has an enhanced degree of distinctive character.

65. Financial information is in evidence which relates to the goods relied upon by the earlier mark. This shows that the earlier mark has been in use from 30 May 2013 to the relevant date, with a steady increase of sales most years and a turnover since May 2013 of almost \$1m from 2346 unit sales. The evidence also shows that the opponent's customer-base is geographically spread across the UK. I find the turnover figures respectable in the context of a relevant market that appears specialised. However, no specific details as to the size of the relevant markets have been provided and I have no evidence or submissions from the opponent in relation to the share of the market held by the earlier mark. Neither do I have information which pertains to the expenditure on advertising and promotional activities to raise awareness of the mark. There is also no information regarding the number of internet users which have accessed UK websites referring to the earlier mark to demonstrate the extent of the marks' exposure. Equally, there is no information in evidence relating to the number of people that attended the events where the earlier mark was promoted. I note that the earlier mark is also mentioned within reports and academic articles within journals, however, there is no further information evidencing the number of people that buy/subscribe to those journals whether online or in print. Taking into account the evidential picture as a whole, on balance, the evidence before me does not support a finding that the distinctiveness of the earlier mark has been enhanced by virtue of use.

³² Opponent's written submissions, paragraphs 60-61.

I am unable to assess how strongly the earlier mark indicates to consumers in the UK that the goods originate from the opponent.

66. Turning now to the inherent position, the earlier mark is in word-only format and encompasses the word “KALEIDOSCOPE”. As the earlier mark is comprised of one plain word with no other elements, its distinctiveness lies indivisibly in the word itself. In my view, the word “KALEIDOSCOPE” will be understood by the average consumer in accordance with its ordinary dictionary definition, meaning “a toy in the shape of a tube, that you look through to see different patterns of light made by pieces of coloured glass and mirrors”³³. The word is not descriptive or allusive of the goods in respect of which it is protected. Overall, I consider that the earlier mark possesses a medium degree of inherent distinctive character.

Likelihood of confusion

67. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be aware of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

68. I have found that the applicant’s goods and services are similar to various degrees to the goods of the earlier mark. I have found that the average consumer of the goods and services will be professional users who will pay a higher than normal level of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. I have found the marks to be identical. I have also found that the distinctive character of the earlier mark has not been

³³ <https://dictionary.cambridge.org/dictionary/english/kaleidoscope>

enhanced through use, and that the earlier mark has a medium degree of inherent distinctive character.

69. Given the identity between the competing marks, it is my view that the average consumer will be directly confused, even for goods and services that are similar to a low degree; this is due to the interdependency principle, i.e. a lesser degree of similarity between the respective goods and services may be offset by a greater degree of similarity between the respective marks. Consequently, I consider there to be a likelihood of direct confusion between these marks. I consider this to be the case notwithstanding the average consumer's higher than normal degree of attention during the selection process, especially given the level of distinctive character held by the earlier mark.

Conclusion

70. The opposition has failed under section 5(1), but has succeeded under section 5(2)(a) in relation to the goods and services that I have found to be similar. As a result, the application is refused for the following goods and services:

Class 9: Computer software; software, software packages, software applications, mobile applications and web applications; [...]; computer software for data and file management; database software; [...]; software for applications and database integration; [...]; cloud computing services software; machine learning software; artificial intelligence software; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, [...], spreadsheets, reporting, visualisation, analytics, [...]; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals.

Class 42: Design and development of computer software; design and development of computer software for machine learning and

artificial intelligence; software as a service (SAAS); design, development, provision, implementation, updating, upgrading and maintaining [...], software, software applications, mobile applications, web applications and portals; data integration services; platform as a service (PaaS); infrastructure as a service (IaaS); function as a Service (FaaS); integration platform as a service (iPaaS); platforms for artificial intelligence as software as a service [SaaS]; providing artificial intelligence computer programs on data networks; development of computer systems for the internet of things (IoT); [...]; consultancy and information services relating to information technology architecture and infrastructure; communication technology consultancy; designing, developing and maintaining systems for data input, output, processing, display and storage; data storage; [...] analysis and optimization services hosting services and provision of software (SaaS) and rental of software; software programming services; information, advisory and consultancy services in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals.

71. Those goods and services which I have found dissimilar will proceed to registration, namely:

Class 9: Computer software for use as an application programming interface (API); communication and network software; applied software for companies; office and business application software;

business process management software; business performance management software; management information system software; business management software; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals.

Class 35: Business management; business administration; business project management; preparation of business and commercial reports; providing statistical information relating to business; statistical analysis and reporting services for business purposes; information, advisory and consultancy services in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet.

Class 42: Design, development, provision, implementation, updating, upgrading and maintaining communication systems,[...]; web development services; website testing, [...]; information, advisory and consultancy services in relation to all the aforesaid services; the aforesaid services also provided via electronic networks, such as the Internet; all of the aforesaid relating to data modelling, data integration, data collection, data transformation, database management, application building, spreadsheets, reporting, visualisation, analytics, planning, forecasting, process management, project management and collaboration; none of the aforesaid relating to measuring, classifying, analysing and generating reports about wildlife audio signals.

Costs

72. As both parties have achieved what I consider as a roughly equal measure of success, I direct that each party should bear their own costs.

Dated this 28 day of July 2022

Sarah Wallace

For the Registrar