

O/0426/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NUMBERS

3560092 AND 3560097

BY

ACER TREE INVESTMENT MANAGEMENT LLP

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 9, 35, 36 and 38

ACER TREE

AND



AND CONSOLIDATED OPPOSITIONS THERETO UNDER NUMBERS

424212 AND 424227

BY

ACER INCORPORATED

Background and Pleadings

1. On 24 November 2020, Acer Tree Investment Management LLP (“the Applicant”), applied to register in the UK the trade marks numbered 3560092 (“092”) and 3560097 (“097”) as outlined on the front cover page, for goods and services in classes 9, 35, 36 and 38 as set out in full in the attached annex. The trade marks were accepted and published in the Trade Marks Journal on 29 January 2021.

2. On 29 April 2021, Acer Incorporated (“the Opponent”) issued opposition proceedings under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 relying on the following EU trade marks¹ under both grounds of opposition:

(i) EUTM 018009603

ACER

Filed on 15 January 2019

Registered on 24 January 2020

Whilst registered for a number of classes, for the purposes of this opposition it relies only on its goods and services in classes 9, 35, 38 and 42 as set out in full in the annex attached hereto.

“first earlier mark”

(ii) EUTM 018009607



Filed on 15 January 2019

Registered on 24 January 2020

¹ Whilst the opposition proceedings were issued after 31 December 2020 (“IP Completion Day”), the applications were filed before IP Completion Day and therefore the EUTMs are the appropriate rights to be relied upon for the purposes of this opposition even though the EUTMs have now gained status as comparable marks in the UK.

Whilst registered for a number of classes, for the purposes of this opposition it relies only on its goods and services in classes 9, 35, 38 and 42 as set out in full in the annex attached hereto.

“second earlier mark”

3. Under section 5(2)(b) the Opponent claims that the goods and services are either identical or similar and that the marks are similar such that a likelihood of confusion including a likelihood of association will arise.

4. Under section 5(3) it is contended that each mark has built up a reputation and use by the Applicant would take unfair advantage of, or be detrimental to, the distinctive character built up in the marks. In addition, given that the Opponent claims to have built up considerable reputation for the manufacture and sale of computer equipment, including desktop and mobile computers, computer software, computer hardware and the provision of telecommunication services, it states the relevant public are likely to believe that there is an economic connection between the respective parties.

5. The Applicant filed a defence and counterstatement denying each ground of opposition in particular that the marks are similar or that the goods/services are similar/identical such that would lead consumers to be confused. Furthermore, in relation the ground of opposition under section 5(3) it is denied that the registration and use of the contested marks would, without due cause, take unfair advantage of or be detrimental to the distinctive character or repute of the Opponent’s marks.

6. Given their filing dates, the Opponent’s trade marks qualify as earlier marks in accordance with section 6 of the Act. Since they completed their registration process within five years of the date the application was filed, the Opponent does not need to establish proof of use of its marks pursuant to section 6A of the Act. It may therefore rely on the entirety of the goods and services of its registrations, without needing to demonstrate what use it has made of them on the market.

7. In these proceedings the Opponent is represented by Swindell & Pearson Ltd, and the Applicant is represented by Farrer & Co LLP. Both parties filed evidence albeit that the Applicant’s evidence consisted of submissions in reply filed in the form of a witness statement. The Opponent asked to be heard on the matter, that hearing took place before me on 14 December 2022 via video conference. At the hearing Mr Kieron Taylor

of Swindell & Pearson Ltd, appeared on behalf of the Opponent and Mr Jamie Muir Wood (counsel) instructed by Farrer & Co LLP, attended on behalf of the Applicant.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence and submissions

9. The Opponent's evidence consists of the witness statements of Kieron Taylor dated 4 February 2022 and Lydia Wu dated 17 February 2022, accompanied by a number of exhibits. The purpose of these statements is to set out the reputation held by the Opponent. In its original pleadings, the Opponent claimed a reputation for the full extent of the goods and services specification as relied upon, but in its letter to the registry dated 23 September 2022 and at the hearing it accepted that it only wished to rely on a claimed reputation for *data processing equipment, computers*. At the hearing, Mr Muir Wood confirmed that the Applicant conceded the Opponent's reputation for these goods.

10. The Applicant filed a witness statement of Alan Baker dated 30 July 2022 which was filed as submissions in reply to the Opponent's evidence.

11. Given the Opponent's concessions and the Applicant's acceptance of the Opponent's reputation for those goods, this dispenses with the need to summarise the evidence at this stage. Suffice to say, I have considered the statements and submissions in full and where appropriate I shall refer to any salient points later in my decision.

Case Management

12. A case management conference was held before me on 10 May 2022 regarding an application by the Opponent to file evidence which exceeded the 300 page limit, as set by Tribunal Practice Notice 1/2015. At the same time the Opponent also requested that Mr Alan Baker's original statement dated 8 April 2022 be struck out as "it did not constitute evidence but pure pleadings". I refused to allow the evidence above the limit and directed that the Opponent refile its evidence. I declined to direct which evidence

the Opponent should remove as it was not appropriate for me to restrict the way in which the Opponent ran its case. I refused to strike out Mr Baker's statement. I took the view that I was in a position to assess what material was evidence of fact and what was submissions. Having in mind the additional costs which would be incurred and taking a proportionate approach, I felt it was unnecessary for the Applicant to refile the submissions in reply, only so that they appeared in a different format. I gave my reasons in a letter to the parties soon after the CMC and I adopt those reasons here.

Confidentiality

13. At the CMC a request was made for paragraphs 12, 13 and 14 and exhibits 2, 7, 8 and 9 of Ms Wu's original statement to be regarded as confidential. When the Opponent refiled its evidence, it no longer relied on exhibit 2 and therefore no order was necessary for this exhibit. In relation to exhibits 7, 8 and 9 I granted the confidentiality request. In relation to the sales figures and geographical locations contained within paragraphs 12, 13 and 14 of Ms Wu's statement, I granted the request preventing the breakdown of sales figures by individual country from being disclosed to the public. Given the concessions made by the Applicant as to the Opponent's reputation, it is unnecessary for me to refer to the breakdown of sales per country in any great detail. At the hearing it was agreed that I was able to refer to the financial information in general terms within my decision.

My approach

14. At the hearing Mr Taylor accepted that the Opponent's word only first earlier mark offered the Opponent its best case and accepted that if the Opponent did not succeed with regards this mark it was unlikely to be in any better position with its stylised mark. He was content therefore for me to initially proceed with my assessment based on the first earlier mark, only returning to consider the second earlier mark if it became necessary to do so.

Section 5(2)(b)

15. Section 5(2)(b) of the Act states as follows:

"5(2) A trade mark shall not be registered if because-

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of the goods and services

17. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 that:

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

18. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(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.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM - Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. 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”.

21. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

22. Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

23. Mr Taylor filed a table setting out the list of goods and services which the Opponent considered to be similar/identical. At the hearing Mr Muir Wood conceded that some of the goods/services were identical namely *electronic publications software* and *telecommunications*, however, he argued that not all the terms as outlined were identical or similar. I have taken account of the submissions put forward by both parties at the hearing and in their pleadings, and shall go through the terms in turn, grouping terms together where appropriate.²

Class 9

downloadable electronic publications

24. These goods are self-evidently identical to the Opponent’s term *electronic publications, downloadable* in the same class.

computer programs for financial analysis and measurement, communications and data processing in the financial, investment and wealth management fields

² *Separode* Trade Mark BL O-399-10 (AP)

25. These goods will be encompassed within the Opponent's broad term *computer software* and are thus identical in accordance with *Meric*.

audio visual recordings in the financial, investment and wealth management fields;

26. Mr Taylor submitted that these goods are identical to the Opponent's *computer software goods* or in the alternative are similar to the Opponent's *apparatus for recording transmission or reproduction of sound or images*. He argued that they are also a form of *electronic publications, downloadable* which would not necessarily be a traditional printed publication but could be in electronic format particularly if they are published online or by way of a video/sound file for example. Although Mr Muir Wood rejected the argument advanced by Mr Taylor in so far as identity with computer software he accepted that there was a degree of similarity between these contested goods and the Opponent's *electronic publications, downloadable*. I consider that the term *downloadable electronic publications* is sufficiently broad that it would encompass sound or visual electronic publications specifically relating to the financial sector. These terms are, therefore, identical according to the principles in *Meric*. If I am wrong then I consider that they are highly similar sharing in purpose, nature, user and channels of trade.

prospectuses, financial reports, financial booklets, financial newsletters, financial brochures, and financial books, in the financial, investment and wealth management fields;

27. I agree with Mr Taylor's analysis that these goods would not necessarily only be in traditional printed format and could be electronic, particularly if they are published online. Mr Muir Wood accepted that these publications would plainly include downloadable versions of the same. On this basis I agree that they are included within the Opponent's broad term *electronic publications, downloadable* and are therefore identical according to the principles in *Meric*.

Class 35

database management; computerised file management; data processing; office functions;

28. Mr Taylor argued that these terms were identical to the Opponent's class 35 services, namely *maintaining files and records concerning the medical conditions of*

individuals; maintaining personal medical history records and files whereas, Mr Muir Wood disputed identity but nevertheless accepted similarity.

29. I consider the provision of office functions to be sufficiently broad that it would include the managing and maintaining a database of files and/or an information/data keeping system, which could include the maintaining of computerised or digital files/records concerning the medical history and condition of individuals (clients or employees). Similarly, the Applicant's terms for the processing and maintaining of data generally are also sufficiently broad, that they would encompass the maintaining of files and records for medical purposes as covered by the Opponent's specification and are therefore *Merit* identical. If I am wrong in this assessment then I consider that they are similar to a high degree overlapping in purpose, nature, provider, distribution channels, and relevant public.

data aggregation, reporting and analysis for the purposes of financial, investment and wealth planning

30. Unlike the preceding services, these terms are not drafted so broadly and in my view are limited to the collecting, reporting and analysis of data specifically for the purposes of financial and monetary planning. Whereas the Opponent's terms, namely *maintaining files and records concerning the medical conditions of individuals; maintaining personal medical history records and files*, as argued by Mr Taylor, relate to the keeping and maintaining of medical files and records of individuals. I see no obvious similarity between these services, nor have I been provided with any evidence or specific submissions as to similarity, other than in broad terms. I find these services dissimilar.

Business management and business consulting services in the financial, investment and wealth management fields; provision of business statistical information (which relates to family or personal wealth); economic forecasting services; accounting; preparation of statements of accounts;

31. Mr Taylor argued that these terms were similar to the Opponent's *computer software; management software goods and big data management software* in class 9. Mr Muir Wood argued however that in relation to the Applicant's Class 35 services the Opponent's computer software is not similar to anything within this class. He argued that business management and business consulting services specifically related to the

financial investment and wealth management sector and are not identical or similar to computer software as suggested by Mr Taylor. He argued that the term computer software in the Opponent's specification does not have an overarching ability to be similar to every term, absent evidence.

32. I agree. I see no obvious similarity between these services and those of the Opponent in the same class or in any other class relied upon. Contrary to Mr Taylor's argument that the Opponent's software could be used by the Applicant to perform its business functions, this is not enough for a finding of similarity in accordance with the caselaw. The question of 'use in combination' and complementarity was considered by Ms Emma Himsworth, sitting as the Appointed Person in *Everest Dairies Limited v Everest Food Products Private Limited*,³ where she stated that:

"The question of whether goods are 'complementary' is to be distinguished from use in combination, where goods are merely used together, whether for choice or convenience."

33. This is the position here. I do not consider that those providing accounting, business management and consulting services in the financial sector would also produce the management/accounting software relating to the same. Consumers would not expect that these goods and services will be provided for by the same commercial undertakings. The goods and the services differ in nature and method of use. There is no obvious overlap in the relevant public, provider/producer or distribution/trade channels. Absent evidence to the contrary these services are dissimilar to the Opponent's goods and services.

Class 36

Financial services, namely advisory services in the financial, investment and wealth management fields; custodial and pension services; financial advice; financial planning advice; investment advice; investment planning advice; tax advice; tax planning advice; wealth management advice; individual pension plans; discretionary investment and portfolio management services; investment portfolio monitoring services; investment portfolio performance analysis services; credit brokerage services; services related to administration of assets namely custody and settlement;

³ [23] O/0107/23

services related to the management of pooled funds and pension funds; trust and estate services; investment management services; trust management services; wealth management services.

34. All these services are broadly services relating to the management of financial, monetary and investment affairs where advice is given on a range of financial transactions. The Opponent submits, as its best case, that these services are similar to the Opponent's *computer software; management software* and *big data management software* in class 9 because again the software will be used in the provision of these services. Whilst Mr Taylor made submissions on the point, there is no evidence before me to satisfy me that the terms overlap.

35. Although many financial service providers use specialised computer software to perform their duties and to give advice to clients, for example to provide online banking platforms and applications, in such situations whilst the software is an integral part of the financial services themselves, it is not sold independently from those services. Financial institutions and companies are not normally engaged in the provision or development of highly specialised software. Rather, it is probable that the provision and development of such software would be outsourced to a specialised IT company. The goods and services will clearly be provided by different undertakings who have expertise in completely different areas. The goods and the services do not overlap in nature, purpose, method of use or distribution channels. They are neither in competition nor complementary according to the caselaw. Acknowledging that many financial institutions such as banks provide mobile banking applications, and in such circumstances the services and the computer software may overlap in user and trade channels, however, these banking customers do not usually see banks/financial institutions as software developers/designers or computer software providers even where specialised software is being used to facilitate the financial transactions. The Opponent's software terms are too broad, and without being limited or specifically directed to the banking or financial sector I do not find similarity between the Applicant's services in class 36 and the Opponent's class 9 goods *computer software; management software* and *big data management software* as argued. They are dissimilar.

36. Furthermore, as this will be relevant for reasons that will become apparent later in my decision, given that computer hardware is one step removed from the software, my reasoning as outlined in paragraphs 30 to 35 above would apply equally to a comparison of similarity between the applied for services in classes 35 and 36 and the Opponent's *data processing equipment, computers*. I do not find that consumers would consider that a retailer/manufacturer of these goods would also provide accounting, business management and consulting services in the financial sector. There would be no overlap in user, provider, purpose, nature or channels of trade. Nor would the goods and services be in competition or be complementary in accordance with the case law. The fact that computers may be used in the delivery of the services is insufficient for a finding of similarity on this basis alone, in accordance with the caselaw.

Class 38

Internet portal services; electronic communication services for preparing financial information; providing user access to data on the internet in the financial, investment and wealth management fields; online provision of data relating to financial, investment, tax, pension, and wealth planning; arranging access to databases via the internet; distribution of data via the internet; internet based telecommunications; provision of an online platform for financial, investment, tax, pension, and wealth planning services; data relating to financial, investment, and wealth management services.

37. Mr Muir Wood submitted that not all the services in Class 38 for which the Applicant seeks registration are strictly *telecommunication services* and thus would not all be encompassed within the Opponent's broad term as argued by the Applicant. Whilst disputing identity he nevertheless accepts that there is a degree of similarity between the Applicant's *online provision of data relating to financial, investment, tax, pension, and wealth planning; arranging access to databases via the internet; distribution of data via the internet;* and the final two terms of the Opponent's specification namely *providing multiple-use access to a global computer information network in the field of health care; providing an Internet web site for medical professionals and medical patients that allows for the exchange of information from remote locations using devices that feed information to the web site that is then processed and can be accessed in real-time by users.*

38. To my mind *telecommunication services* is such a broad term that it covers all sorts of communication services allowing users to talk with one another and transmit messages and information to each other via electronic means, computer networks or other mediums. Contrary to Mr Muir Wood's submissions, therefore, I consider that the Applicant's services as outlined are all encompassed within the Opponent's *telecommunication services* term and are thus identical in accordance with *Meric*. If I am wrong, however, and as argued they are not identical but similar, they are similar to a high degree overlapping in nature, purpose, user, provider and distribution channels.

39. To establish a likelihood of confusion between the marks, it is essential for there to be identity or similarity between the goods or services.⁴ It follows that in so far as the services I found to be dissimilar (as set out below), there would be no likelihood of confusion:

Class 35: Business management and business consulting services in the financial, investment and wealth management fields; provision of business statistical information (which relates to family or personal wealth); economic forecasting services; accounting; preparation of statements of accounts; data aggregation, reporting and analysis for the purposes of financial, investment and wealth planning.

Class 36: Financial services, namely advisory services in the financial, investment and wealth management fields; custodial and pension services; financial advice; financial planning advice; investment advice; investment planning advice; tax advice; tax planning advice; wealth management advice; individual pension plans; discretionary investment and portfolio management services; investment portfolio monitoring services; investment portfolio performance analysis services; credit brokerage services; services related to administration of assets namely custody and settlement; services related to the management of pooled funds and pension funds; trust and estate services; investment management services; trust management services; wealth management services.

⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Average consumer and the purchasing process

40. When considering the opposing marks the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods/services in question.⁵

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

42. Mr Taylor in his skeleton argument argued that the average consumer would be a member of the general public paying an average to low level of attention when selecting the goods. Mr Muir Wood submitted that the level would vary, given the types of goods and services under consideration. He submitted that the level of attention undertaken for the purchase of computer software goods, for example, would be dependent on the intended purpose of the software, ranging from a low to high level. Furthermore, the selection of the respective services which involve the investment of money, would be at the highest level, as would the maintenance of medical records for individuals, who are trusting a third party to maintain their medical history. Those individuals, it was argued, would expect careful consideration to be given as to who is providing those services. The Applicant's submissions, overall, are that the average consumer, when it comes to the services for which registration is sought, would pay a very high degree of attention in the selection of those services such that the differences between the respective marks would be noticeable.

⁵ *Lloyd Schuhfabrik Meyer*, case c- 342/97.

43. Despite my findings of dissimilarity in relation to the services in classes 35 and 36 in the preceding paragraphs, I will continue to undertake the assessment for all the goods/services since it will have a bearing on my assessment under section 5(3), later in my decision.

44. Given the nature of the goods/services at issue, which range from those in the telecommunication and business fields, to IT and finance, the average consumer is both the public at large and the business user. The goods used for computing purposes in class 9, for example, may be purchased for home use by individuals as well as business users in order to run their businesses. The same applies to the services in class 36 and 38 which are directed at both types of consumer. I consider that the provision of the class 35 services is more likely to be a business user but the end user may well include a member of the general public as well as professionals. For all the goods and services under consideration, the selection/purchase is likely to be primarily undertaken visually, via online searches, websites, brochures and advertisements or from signage at the actual business premises. Aural aspects cannot be discounted, however, following word of mouth recommendations or telephone enquiries.

45. In so far as the level of attention paid, I agree with Mr Muir Wood that this will vary, depending on the nature of the goods/services, who is buying them and for what purpose. The downloadable electronic publications in class 9, for example, could include both general newspapers and financial reports where the level of attention is dependent on the content and the recipient of the publications, ranging between low to average in the former's case to a higher than average level in the latter's, particularly if the report relates to details of the company's financial performance for potential investors.

46. Likewise individuals purchasing computer related goods for home use will pay an average level of attention in the selection process, taking into account considerations such as price, suitability and ease of use. Whereas the selection of software for the operating systems of a business will involve a more considered approach. The same applies to the services in class 35 and 38 where they are directed more towards the business user which will warrant a higher than average level of attention but not considerably so.

47. Similarly the factors taken into account by those seeking financial advice and investment services in class 36 whether a professional or a member of the public is influenced by risk considerations, the reputation and stability of the provider, as well as the return on the investment, which would lead to a high level of attention being undertaken.

48. In summary, other than those services in class 36, overall, the goods and services directed toward the business user will attract a higher than average level of attention, whereas for the member of the public, I do not consider overall that more than an average level of attention will be paid. For the services in class 36 across both sets of consumer a high level of attention will be paid in the selection process.


Comparison of the trade marks

49. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

50. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

51. The respective trade marks are shown below:

Applicant's Marks	Opponent's Marks
<p data-bbox="204 331 343 365"><u>Mark 092</u></p> <p data-bbox="204 387 483 432">ACER TREE</p> <p data-bbox="204 495 343 528"><u>Mark 097</u></p> 	<p data-bbox="809 331 1054 365"><u>First earlier mark</u></p> <p data-bbox="809 387 903 421">ACER</p>

52. Mr Taylor submitted that as a whole the respective marks are similar despite the word TREE not being shared between the marks. The marks, he submitted, are both visually and aurally similar and despite the presence of the device and the words INVESTMENT MANAGEMENT in the 097 mark, the consumer will naturally be drawn to the larger central element **Acer Tree**. Furthermore, given the descriptive nature of the words INVESTMENT MANAGEMENT for the Opponent's services in classes 35 and 36 the average consumer is unlikely to take these words into account and will instead focus on the Acer Tree element. It was argued that the average consumer may interpret the TREE aspect as indicative of a 'sub-branch' of the Acer brand causing direct confusion or in the alternative indirect confusion.

53. Mr Muir Wood accepted that the average consumer focuses on the beginning of signs, but given that trade marks are not artificially dissected, the average consumer will notice the differences both visually and aurally between the two sets of trade marks. He submitted that the contested 092 mark was double in length to the earlier marks and the 097 device mark creates an even starker difference both visually and aurally. The average consumer it was argued will not fail to notice the marks for which registration is sought, where they contain the additional word TREE such that no confusion is likely.

Overall impression

54. The first earlier mark is for the word ACER presented in capitals. The overall impression of the mark resides in the entirety of the word.

The 092 Mark

55. The 092 mark consists of the two words ACER and TREE presented in an unremarkable black font. Given that there are no other elements which contribute to the mark, both these words play a role in the overall impression of the mark.

The 097 Mark

56. The 097 mark includes a number of elements; the words **Acer Tree** presented in title case in an unremarkable black emboldened font; a coloured orange and red spike shaped device; and the words INVESTMENT MANAGEMENT presented in capital letters underneath the words **Acer Tree**, in considerably smaller font. Since the eye is naturally drawn to the element of a mark that can be read, given their relative size and central position, the words **Acer Tree** naturally draw the eye and play the greater role in the overall impression of the mark. The device contributes to the mark overall, but to a lesser extent as it will be seen as a decorative element. The words INVESTMENT MANAGEMENT will play a limited role, due to their size and position and because they will be seen as descriptive of the nature of the services provided by the undertaking. These words cannot be dismissed entirely, however, as they still contribute to the distinctiveness of the mark when regarded as a whole.

57. I will bear these conclusions in mind when comparing the competing trade marks.

Visual Comparison

58. The 092 mark and the first earlier mark coincide with the word ACER, which is the entirety of the first earlier mark and the first word of the 092 mark. They differ to the extent that the 092 mark includes the word TREE. The variance in font will make little impact to the assessment given that a word only mark may be presented in any font, colour or case.⁶ Given that consumers pay more attention to the beginning of marks, as accepted by Mr Muir Wood, I consider that the marks are visually similar to a medium to high degree.

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, GC

59. This visual similarity is reduced in the 097 mark, by the additional elements present, which include the device and the words INVESTMENT MANAGEMENT there being no counterpart in the first earlier mark. Given these factors and weighing up the similarities against the differences, overall, I consider that the 097 mark and the first earlier mark are visually similar to a medium degree.

Aural Comparison

60. The 092 mark will be pronounced as AY-SIR-TREE whereas the earlier mark will be pronounced as AY-SIR. Given that the first two syllables in each mark will be pronounced identically only differing in the last syllable of the contested mark, the marks are aurally similar to a medium to high degree.

61. In relation to the 097 mark, no pronouncement will be given to the device and therefore the only difference in pronunciation between this and the 092 mark is the part the words INVESTMENT MANAGEMENT play in the 097 mark. Given their size, position and role within the mark, as indicative of the nature of the business on offer, the average consumer may not articulate these words, focusing solely on the words ACER TREE. If this occurs, this will result in the same level of aural similarity as I found between the 092 mark and the first earlier mark, namely a medium to high degree. However, if all the verbal elements are articulated in the 097 mark, I consider that the ACER TREE component will still be articulated first, leading to a low to medium degree of aural similarity.

Conceptual comparison

62. Mr Muir Wood argued that the addition of the word 'tree' to the contested marks alludes to stability, growth and strength characteristics which are very important for the financial services in class 36. For a conceptual message to be apparent, however, it must be capable of immediate grasp. I do not consider that the concept of growth in terms of investment services would necessarily be at the forefront of consumers' minds when immediately coming across the 092 and 097 marks, and certainly not without further scrutiny.

63. In its written submissions, the Applicant put forward other meanings that may be attributed to the word ACER namely as an acronym or the name/brand of other unrelated companies. However, at the hearing Mr Muir Wood accepted the primary

position that the word ACER is a dictionary word understood to mean a tree. I consider that a significant proportion of the relevant public would understand this meaning.

64. In relation to the 092 mark whilst the words ACER and TREE are two words, they will, in my view, be seen as compound words with an etymological status of a single word. That is, the ordinary dictionary definition of the word ACER will be understood to mean a type of tree, and therefore, adding or removing the word TREE to the word ACER will make no difference to the meaning conveyed. Consequently, the marks are conceptually identical.

65. With regards the 097 mark, given that the leaf of an acer is spiked shaped and is known for its vibrant autumnal colours, the device will be seen as merely reinforcing the concept of the Acer tree. Otherwise, the device will purely be seen as a coloured decorative element with no meaning. The words INVESTMENT MANAGEMENT will be regarded as describing the nature of the goods/services on offer and is a point of conceptual difference. These elements, however, will make little impact as a point of conceptual difference overall, as a result of the shared identical concept created by the use of the elements ACER/ACER TREE which I have already found to be conceptually identical. Consequently, overall, the 097 mark is conceptually highly similar to the earlier mark.

Distinctive character of the earlier mark

66. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case 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).”

67. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, to those with high inherent distinctive character such as invented words which have no allusive qualities. 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.

Inherent Distinctive Character

68. The Opponent’s first earlier mark is for the word ACER. The mark will to a significant proportion of the relevant public be understood to mean the tree. Given that the mark is neither allusive nor descriptive of the goods and services in question it is nevertheless a dictionary word with a known meaning. On this basis I consider that the mark is inherently distinctive to a medium degree.

Enhanced Distinctive character

69. The Opponent claims that it has enhanced the distinctive character of its mark further due to the use it has made of it. Mr Muir Wood however argues that enhanced distinctive character has not been specifically pleaded and even if it had it would only apply to computers in any event.

70. In so far as the question of whether enhanced distinctive character needs to be specifically pleaded this was addressed in *YS Garments, LLC v Next Retail Limited*.⁷ In that decision the Hearing Officer stated:

“21....whilst I accept the general point that pleadings should be as full as possible so as to set out the scope of the dispute, the absence of any specific reference in the pleadings to enhanced distinctiveness is not fatal to the opponent’s case. This is because the assessment of distinctiveness is one of the fundamental factors that needs to be assessed in every case and, as is clear from the case-law, this can come from either the inherent nature of the mark, its use, or indeed a combination of both. Therefore, if evidence has been filed, which it has in the case before me, it is incumbent upon me to factor that evidence into the assessment to decide upon the overall distinctiveness of the earlier mark. It would be perverse to do otherwise, as it would require a pretence as to the true level of distinctiveness on the part of the average consumer, based on a technicality.”

71. Accepting that that decision is a first instance decision and not binding on me, I nevertheless adopt the same approach.

72. Furthermore, the Applicant accepts, that the Opponent has a reputation for “computers and data processors”. Phillip Johnson sitting as the Appointed Person on appeal in *CX02*⁸ stated as follows:

“39.reputation in itself does not make a mark highly distinctive. However, while distinctiveness and reputation are different, the nature, factors, and evidence used to prove enhanced distinctiveness are the same as for reputation. Furthermore, reputation for the purposes of section 5(3) is a higher threshold than for acquired distinctiveness. In other words, if there is a reputation then distinctiveness should be enhanced. Where it fits on the distinctiveness scale after this enhancement is a question of fact in each individual case.”

⁷ BL O/379/19

⁸ BL O/393/19

73. It follows therefore that if a mark has a reputation for such goods, it would also equally have enhanced its distinctive character in relation to those goods by the use it has made of its mark. It is only a question then, of assessing the extent of the enhancement, by considering the nature, extent (including geographical extent) and length of the use demonstrated, taken from the viewpoint of the UK consumer.

74. The Opponent's evidence shows that:

- Its revenue figures for the company were approximately £6.2 billion for its key Acer brand of products, particularly notebooks and desktops computers.
- It employs over 7,000 employees worldwide with 95,000 retail locations across 160 countries to include the UK.
- It advertises its mark through its sponsorship deals, at exhibitions and trade shows.
- It has in the past sponsored various major sporting events and competitions to include the 2012 London Olympic Games, the Inter Milan Italian football team and a F1 Formula Racing team.
- The total value of sales in 2018 across Europe to include the UK exceeded £1.4 billion.
- It sold over 600,000 Acer branded units of notebooks, laptops and PCs in the UK in 2018, amounting to a sales value in excess of €288 million.
- Sales of units across the EU and UK in 2020 increased to nearly 4 million units amounting to nearly £1.6 billion in sales value.
- As of 2020 the Opponent is the fifth largest computer company worldwide
- The Opponent is the fourth largest company for Notebooks, laptops and PCs in Europe and UK.
- As of 2020 the Opponent held 9% of the notebook market in the EU and UK.

75. The majority of the information contained within Mr Taylor and Ms Wu's statements are of some age and are directed to use outside the UK and the EU, however, considerable sales from 2018 running into over £1 billion have been demonstrated.

Furthermore, I note that as at 2020 the company held 9% of the market share for notebook computers under the 'acer' brand across the EU and UK.

76. Whilst reference to the sponsorship of sporting events date back to 2012 and 2013, of particular note is that the Opponent's sponsorship deals included the 2012 Olympic Games held in London. Notwithstanding that the date of this event falls well before the relevant date, I note that the Olympic Games only takes place every four years, and it is televised worldwide. Such was the publicity and excitement surrounding the Games in the UK at that time, as a major sponsor its mark would have been visible to millions of UK consumers. Furthermore, the Opponent's revenue and figures for laptops, computers, notebooks and PCs in the years 2018, 2019 and 2020 specifically for the UK are extensive running into hundreds of millions of pounds. It was also the fourth largest company for these goods across the EU and the UK.

77. Based on this evidence and the concessions made by the Applicant, I have no hesitation in finding that the Opponent has enhanced its distinctive character in the UK to a high degree, by the use it has made of its mark but only in relation to computers, laptops, notebooks and PCs all of which are covered by the term '*data processing equipment, computers*' within its specification. There was little or no evidence produced to enable it to claim an enhanced degree of distinctive character for any of the other goods and services within its specification as relied upon.

Likelihood of Confusion

78. When considering whether there is a likelihood of confusion between the marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion; where the consumer recognises that the marks are not the same but, nevertheless, puts the similarities between the marks and the respective goods/services down to the same or related source.

79. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first 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/services and vice versa. It is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider 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 he has retained in his mind.

80. The differences between the two types of confusion were explained in *L.A. Sugar Limited v By Back Beat Inc*,⁹ by Mr Iain Purvis Q.C.(as he then was), sitting as the Appointed Person, who noted that:

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

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

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

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

⁹ BL O/375/10

or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

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

81. Earlier in my decision, I found the 092 mark was visually and aurally similar to a medium to high degree to the first earlier mark. In so far as the 097 mark, due to the presence of the additional elements, I found the visual similarities to be reduced to a medium degree and aurally either a low to medium or medium to high degree of similarity depending on whether the words ‘INVESTMENT MANAGEMENT’ would be articulated. I found the earlier mark and the 092 mark to be conceptually identical and the 097 mark overall to be conceptually highly similar. In so far as some of the goods and services in classes 9, 35 and 38 of the application I found them to be identical either self-evidently or in accordance with the principles in *Meric*, or highly similar. I identified the average consumer for these goods/services to be both the general member of the public and a business user paying an average to higher than average level of attention. I found that the goods and services would be selected primarily through visual means but with aural considerations not being discounted. I found the first earlier mark to possess a medium degree of inherent distinctive character and in relation to *data processing equipment, computers* that it had enhanced its distinctive character to a high degree by the use it had made of its mark for such goods. I remind myself that for those services in classes 35 and 36 of the application, which I found to be dissimilar there can be no likelihood of confusion.

82. Insofar as a likelihood of confusion Mr Muir Wood argued that there was no case for direct confusion because primarily the average consumer will simply not separate the mark ACER TREE from ACER let alone the differences arising from the figurative mark. He stated that “these elements will not go on unnoticed by the average consumer. Even for goods that are closer in terms of identity/similarity, the average consumer is unlikely to break the applied for mark into its constituent components and insofar as class 36 there is no similarity and so the claim to Section 5(2)(b) must fail from the outset.” In the other classes it was accepted that there “is a possibility of success” but “the average consumer would be able to differentiate between the

respective marks even more so for the device mark because the figurative element will not go unnoticed such that it will not be mistaken for the mark ACER. Insofar as indirect confusion the addition of the word tree is not typically one of the brand extensions set out by the case law and it does not therefore fall within one of the sub brands as set out by Mr Ian Purvis in *LA Sugar*.”

83. Mr Taylor argued that due to the similarities between the marks and given that there is no conceptual dissonance between them by the addition of the word TREE, the applied for mark ACER TREE will be seen as a ‘sub branch’ of the Acer brand causing direct confusion to the average consumer.

84. I recognise that a shared common element alone, does not necessarily lead to a likelihood of confusion,¹⁰ and that it is important for me to note the aspects of the other elements present in the respective marks and the part they play when making my assessment. Furthermore, the examples as set out in *L.A.Sugar* (above) are not exhaustive and that they are only intended to be illustrative of the general approach.¹¹

85. Lord Justice Arnold stated in *Liverpool Gin* that “trade mark law was about consumers’ unwitting assumptions, not what they could find out if they thought to check.” It is necessary, therefore, for me to bear this in mind when undertaking the assessment and whether the common element ‘ACER” when viewed within the application is sufficiently powerful when weighed against the differences, that despite these differences the average consumer’s imperfect recollection of either mark on encountering the other, gives rise to a belief that the two entities are connected, leading to a likelihood of confusion.¹²

86. Mr Muir Wood referred me to the decision in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*,¹³ arguing that the combination of the word Acer and Tree formed a unit such that the word Acer did not have distinctive significance independently of the whole in the contested marks. This, he stated, when assessing the marks, would not lead consumers to believe that the undertakings were connected.

¹⁰ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹¹ *Liverpool Gin Distillery Limited v Sazerac brands LLC* [2021] EWCA Civ 1207

¹² James Mellor as the Appointed Person on appeal in *Ashish Sutaria v Cheeky Italian Limited* O/219/16

¹³ [2015] EWHC 1271 (Ch),

87. I disagree. The words Acer and Tree in combination do not have a different meaning in combination to the meaning of the word Acer solus. ACER is still a tree irrespective of the addition or omission of the word TREE to the mark. In light of this it is the word Acer which will be retained in the minds of the relevant public when seeing the applied for marks.

88. Taking account of my conclusions and the fact that consumers rarely have the opportunity to compare marks side by side, it is my view that in so far as the 092 mark the identical conceptual meaning conveyed by the word ACER and ACER TREE will mean that those elements are likely to be mistakenly recalled or misremembered by the average consumer. I have considered that a high degree of attention will be paid in some circumstances, but I do not consider that that prevents direct confusion from arising, when bearing in mind the principle of imperfect recollection. It is the concept of the ACER TREE which will remain in the mind of the consumer, and that is identical for the 092 Mark and the earlier mark. I consider it entirely possible that having encountered the opponent's ACER brand, that when encountering the Applicant's ACER TREE brand at some point in the future, the average consumer may overlook the addition of the word TREE given the minimal impact that it has on the conceptual message conveyed. Consequently, I find that there is a likelihood of direct confusion in relation to the 092 Mark.

89. In relation to the 097 Mark, I recognise that the device and the words INVESTMENT MANAGEMENT are unlikely to be overlooked by the average consumer. However, given that the common elements ACER/ACER TREE will convey the identical conceptual message and that those elements are likely to be mistakenly recalled or misremembered as each other, the additional device and wording are likely to be seen simply as an alternative mark being used by the same undertaking. It is not unreasonable for consumers to conclude that a manufacturer of computer and electronic related equipment which has acquired a highly distinctive character for computer related goods, would diversify into related fields, particularly those which are aligned to the IT sector, such as computer software, data management systems and telecommunications and conclude that the two entities are connected. Consequently, I find there to be indirect confusion in relation to the 097 Mark.

90. I have considered the possibility that the 097 mark will merely bring to mind the earlier mark in circumstances as envisaged by Mr James Mellor in *Duebros*, but dismiss this on the basis that such is the degree of distinctive character acquired by the Opponent for computers and data processing equipment that this will spill over to those goods and services which are computer related. In my view any use of the word ACER in a sector which is closely linked to the computer or telecommunications industry will be more than just a bringing to mind, consumers will consider that no one else will be using this mark, leading to a likelihood of confusion.

91. For those goods and services found to be highly similar/identical, as set out below, the opposition under section 5(2)(b) succeeds:

Class 9: Downloadable electronic publications; prospectuses, financial reports, financial booklets, financial newsletters, financial brochures, and financial books, in the financial, investment and wealth management fields; computer programs for financial analysis and measurement, communications and data processing in the financial, investment and wealth management fields; audio visual recordings in the financial, investment and wealth management fields.

Class 35: Data processing; office functions; database management; computerised file management.

Class 38: Internet portal services; electronic communication services for preparing financial information; providing user access to data on the internet in the financial, investment and wealth management fields; online provision of data relating to financial, investment, tax, pension, and wealth planning; arranging access to databases via the internet; distribution of data via the internet; internet based telecommunications; provision of an online platform for financial, investment, tax, pension, and wealth planning services; data relating to financial, investment, and wealth management services.

92. Given these findings the Opponent would be in no better position in relation to its second earlier stylised mark and therefore it is unnecessary for me to go on to consider the opposition based on the second earlier mark and I decline to do so.

93. Given my earlier findings, the opposition under section 5(2)(b) fails for those services I found to be dissimilar as set out in paragraph 39.

Section 5(3)

My Approach

94. Under section 5(2)(b) the Opponent successfully opposed the Applicant's marks for goods and services in classes 9, 35 and 38 as outlined in paragraph 91, it will, therefore, be in no better position under section 5(3) for these goods/services. I shall, therefore, focus my attention on those services I found to be dissimilar in classes 35 and 36 as previously outlined, given that under section 5(3) there is no necessity for the goods/services to be identical/similar.

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

“A trade mark which-

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

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

96. The relevant case law can be found in the following judgements of CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

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

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

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

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

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation

and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

97. The conditions of section 5(3) are cumulative. The Opponent must show similarity between the respective marks; that the first earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public and that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the first earlier mark being brought to mind by the later mark. Assuming that the first three conditions have been met, section 5(3) requires that one or more of the types of damage claimed by the Opponent will be suffered. It is unnecessary for the purposes of section 5(3) for the goods/services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between them. For the purposes of section 5(3) the relevant date for the assessment is 24 November 2020.

Similarity between the respective marks

98. In relation to the similarity between the marks this first condition is satisfied. For the reasons set out earlier, I found that the marks were similar overall ranging between a low to medium and medium to high degree.

Reputation

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

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

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

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

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

100. In assessing whether the first earlier mark has a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates "the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it."¹⁴

101. Given that the first earlier mark relied upon is a EUTM the Opponent must show that it has achieved a reputation amongst a significant part of the public in the EU at the relevant date which will include the UK. I have summarised the Opponent's evidence at paragraphs 73-75 in relation to its claim to enhanced distinctiveness, which in light of my findings will apply equally to the assessment of whether it holds a reputation. The Applicant has also conceded that the Opponent has a reputation for *data processor equipment, computers*. I have no hesitation in finding that the evidence supports the Opponent's claim to a strong reputation in the UK for such goods.

Link

102. Having found a reputation I must now go on to consider whether this reputation would give rise to the necessary mental link being made between the respective trade marks. The factors to be taken into account to establish as to whether a link would be made, are those as set out in *Intel*.¹⁵ Taking each of the factors in turn.

The degree of similarity between the conflicting marks

¹⁴ *General Motors* para 28

¹⁵ *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU).

In *Adidas-Salomon*, the CJEU held that the similarity of signs must be assessed in the same way for section 5(2)(b) and 5(3) of the Act. Accordingly, my findings at paragraphs 58-65, apply equally here and I adopt those findings.

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

The Applicant's services as applied for in classes 35 and 36, are those relating to business management and services rendered for financial and monetary affairs. The Opponent's evidence demonstrates that it is a manufacturer and retailer of computers, laptops and PCs with a strong reputation for the provision of data processing equipment, computers in class 9. I have already found that the Applicant's services are dissimilar to the Opponent's computer software goods in class 9 and therefore given that the hardware is one step removed from the software, I do not find that the Opponent's *data processing equipment, computers* will be any closer in terms of similarity than that which I have already determined. Other than on a very high level of generality that computers and data processors may be used in the provision of the Applicant's services or used to complete the various tasks, there is no overlap between them, they are dissimilar. I do not find that the goods and services overlap in nature, purpose, trade channels or producers. They are neither in competition nor complementary in accordance with the caselaw.

The relevant public for the Opponent's goods and the Applicant's services under consideration, is both the general member of the public and the business user, who are deemed to be reasonably informed and reasonably observant and circumspect.

The strength of the first earlier mark's reputation

I have found that based upon the evidence filed, the Opponent has a strong reputation for *data processing equipment, computers*.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

I found that the earlier mark is inherently distinctive to medium degree, as a result of it being an English dictionary word with no connection to the goods. By virtue of the evidence filed, I found that the Opponent has enhanced the degree of distinctiveness further to a high degree for the goods for which it has a reputation.

Whether there is a likelihood of confusion

For there to be a likelihood of confusion there has to be some similarity between the relevant goods and services. Although I found a likelihood of confusion, this was only in so far as those goods and service that were found to be similar/identical. Given my findings that the Opponent's data processing equipment, computer goods as relied upon and the services as applied for in classes 35 and 36 are dissimilar there can be no likelihood of confusion.

103. For a link to be found the burden is on the Opponent to show that it holds enough of a reputation to overcome any dissimilarity between the goods/services which would cause the earlier mark to be brought to mind by the later mark. The Opponent's argument is that providers who use computer related equipment branded with a similar name to the name of an entity offering business management/financial advice services is sufficient for a link to be made. I disagree. The fact that a commercial enterprise uses computer products to deliver its services, is insufficient in accordance with the caselaw for the relevant public to make a connection.

104. The two entities are in completely different fields, the one being in the financial and business management industry, the other is a manufacturer of computers and data processors. There is no reason to believe that consumers would call to mind a manufacturer famous for computers and data processing equipment, when coming across a provider of business management and financial advice services, just because they happen to use computers branded with the Opponent's mark when delivering those services. When encountering the Opponent's mark for computers and data processors I am not satisfied that consumers would call to mind the earlier mark on services, which are in an entirely different industry and unrelated to the IT industry.

105. The goods and the services in my view are completely removed from one another despite the Opponent's strong reputation for data processing equipment and computers. The distance between the goods and the services is sufficient to offset any similarity between the respective marks.

106. Even if I am wrong and the earlier mark were brought to mind, it would be fleeting at best and insufficient for one of the heads of damage to be suffered. Further, given the distance between the goods/services, I cannot see any basis for damage to arise even if a link was made. Taking all the factors into consideration I conclude that the relevant public will not make the necessary link between the marks. Again, given these findings the Opponent will be in no better position in relation to its second earlier mark given that it is a stylised version of the first earlier mark and further away in terms of similarity where a link is even more unlikely.

107. Consequently, the opposition under section 5(3) in relation to the Applicant's remaining services in classes 35 and 36 must fail.

Conclusion

108. The opposition under section 5(2)(b) has succeeded in part. Subject to any successful appeal, each application shall be refused for the following goods and services:

Class 9: Downloadable electronic publications; prospectuses, financial reports, financial booklets, financial newsletters, financial brochures, and financial books, in the financial, investment and wealth management fields; computer programs for financial analysis and measurement, communications and data processing in the financial, investment and wealth management fields; audio visual recordings in the financial, investment and wealth management fields.

Class 35: Data processing; office functions; database management; computerised file management.

Class 38: Internet portal services; electronic communication services for preparing financial information; providing user access to data on the internet in the financial, investment and wealth management fields; online provision of data relating to financial, investment, tax, pension, and wealth planning; arranging access to databases via the internet; distribution of data via the

internet; internet based telecommunications; provision of an online platform for financial, investment, tax, pension, and wealth planning services; data relating to financial, investment, and wealth management services.

109. The opposition has failed under sections 5(2)(b) and 5(3) in relation to the following services, subject to appeal each application may proceed to registration for:

Class 35: Business management and business consulting services in the financial, investment and wealth management fields; provision of business statistical information (which relates to family or personal wealth); economic forecasting services; accounting; preparation of statements of accounts; data aggregation, reporting and analysis for the purposes of financial, investment and wealth planning.

Class 36: Financial services, namely advisory services in the financial, investment and wealth management fields; custodial and pension services; financial advice; financial planning advice; investment advice; investment planning advice; tax advice; tax planning advice; wealth management advice; individual pension plans; discretionary investment and portfolio management services; investment portfolio monitoring services; investment portfolio performance analysis services; credit brokerage services; services related to administration of assets namely custody and settlement; services related to the management of pooled funds and pension funds; trust and estate services; investment management services; trust management services; wealth management services.

Costs

110. The parties have roughly had an equal measure of success, each succeeding and failing in part, on this basis I make no award of costs as between the parties and order that each bears their own costs.

Dated this 5th day of May 2023

Leisa Davies

For the Registrar

Annex

Applicant's goods and services for both 3560092 and 3560097

Class 9: Downloadable electronic publications; prospectuses, financial reports, financial booklets, financial newsletters, financial brochures, and financial books, in the financial, investment and wealth management fields; computer programs for financial analysis and measurement, communications and data processing in the financial, investment and wealth management fields; audio visual recordings in the financial, investment and wealth management fields.

Class 35: Business management and business consulting services in the financial, investment and wealth management fields; provision of business statistical information (which relates to family or personal wealth); economic forecasting services; data aggregation, reporting and analysis for the purposes of financial, investment and wealth planning; data processing; office functions; accounting; preparation of statements of accounts; database management; computerised file management.

Class 36: Financial services, namely advisory services in the financial, investment and wealth management fields; custodial and pension services; financial advice; financial planning advice; investment advice; investment planning advice; tax advice; tax planning advice; wealth management advice; individual pension plans; discretionary investment and portfolio management services; investment portfolio monitoring services; investment portfolio performance analysis services; credit brokerage services; services related to administration of assets namely custody and settlement; services related to the management of pooled funds and pension funds; trust and estate services; investment management services; trust management services; wealth management services.

Class 38: Internet portal services; electronic communication services for preparing financial information; providing user access to data on the internet in the financial, investment and wealth management fields; online provision of data relating to financial, investment, tax, pension, and wealth planning; arranging access to databases via the internet; distribution of data via the internet; internet based telecommunications; provision of an online platform for financial, investment, tax, pension, and wealth planning services; data relating to financial, investment, and wealth management services.

Opponent's goods and services

EUTM 018009603

Class 9: Scientific, measuring, signalling, and checking (supervision) apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, other than ignition coils, induction coils and antennae; Apparatus for recording, transmission or reproduction of sound or images; Compact discs, DVDs and other digital recording media; Data processing equipment, computers; Computer software; Electronic display apparatus for use with exercise equipment; Application software (apps), including mobile apps, hybrid apps and web apps; Computer hardware and software, for use with medical patient monitoring equipment, for receiving, processing, transmitting and displaying data; Computer software for controlling and managing patient medical information; communication software for providing access to the internet; Communications servers; Communications software for connecting computer network users and global computer networks; database management software for remote patient monitoring and electronic health record; software for monitoring and controlling communication between computers and automated machine systems; telecommunications hardware and software for monitoring and alerting remote sensor status via the Internet; Transmitters of electronic signals; Detectors; Frequency meters; Frequency modulators; Actinometers; Integrated circuit chips; Smart cards [integrated circuitcards]; Apparatus for the recording, transmission and presentation of medical data; Computer software for medical use; Computerised devices for formatting and displaying of medical data, namely infrared interfaces for transfer of device commands and configuration of information from a personal computer to glucose meters and insulin pumps, and vice versa; Wireless electronic apparatus for the transmission of sound, images or data; Wireless electronic apparatus for monitoring and controlling the functioning of other electronic apparatus; Speed indicators; Personal electronic apparatus for displaying, measuring, recording, organising, handling, analysing and receiving data, text, images and audio files, in particular in the field of healthcare; Electric or electronic sensors for use in detecting, measuring, processing, collecting, recording and transmission of variables relating to health, namely in particular blood glucose levels, blood pressure, heart rate and temperature; Computer software applications for portable devices used for recording, organisation, reception and

analysis of text, data, images and files, particularly in the field of health; Computer software applications for portable devices for wireless transmission of data, for receiving and processing the aforesaid and for the transmission and display of information relating to blood glucose levels, blood pressure, body temperature, heart rate and oxygen concentration; Thermometers; Personal information management software, Cameras; Camcorders; Webcams, apparatus for recording, transmission or reproduction of sound or images; Image scanners; Downloadable image files; Accelerometers; Connected watches and bracelets for communicating data to personal digital assistants, smartphones, mobile devices and personal computers through sensors, online websites and other computer and electronic communications networks; Bracelets equipped with functions for monitoring and reporting data relating to health, physical fitness, blood pressure, neurological, muscular and postural control disorders, body temperature, heart rate and oxygen concentration; Smartphones; Cell phones; portable communication apparatus namely handsets, walkie-talkies, satellite telephones, personal digital assistants and portable multimedia players; Monitors to measure, monitor, record, and transmit physiological and biometric data such as heart rate, pulse, body temperature, perspiration, blood pressure, sleep patterns, time, distance, pace, calories burned, and other fitness measurements; Electronic publications, downloadable; Computer application software; software interfaces with multi health devices to record health conditions; Watchbands that communicate data to personal digital assistants, smart phones and personal computers through internet websites and other computer and electronic communication networks; Bracelets that communicate data to personal digital assistants, smart phones and personal computers through internet websites and other computer and electronic communication networks; Smartwatches; Wrist bands with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Bracelets with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Rings for with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Ear rings with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Necklaces with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Jewelry with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Smart watches comprised primarily of a

wristwatch also featuring a telephone, software and display screens for viewing, sending and receiving texts, emails, data and information; Wearable digital electronic devices comprised primarily of a wristwatch and also featuring a telephone, software and display screens for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computers; Oxygen concentration meters; Sensors, monitors and display screens in the field of healthcare; Scientific apparatus and instruments; application software; computer software; software applications; mobile apps; databases; electronic databases; computer databases; electronic databases recorded on computer media; Computer software platforms; computer software relating to the medical field; computer software for database management; database engines; data management software; big data management software; computer software for use in medical decision support systems; pedometers; application software for cloud computing services.

Class 35: Maintaining files and records concerning the medical conditions of individuals; maintaining personal medical history records and files.

Class 38: Telecommunication services; instant messaging services and e-mail messaging services, in particular providing real-time electronic messaging and electronic communications to individuals regarding their health and well-being concerns; providing multiple-use access to a global computer information network in the field of health care; providing an Internet web site for medical professionals and medical patients that allows for the exchange of information from remote locations using devices that feed information to the web site that is then processed and can be accessed in real-time by users.

Class 42: Providing temporary use of on-line non-downloadable software for health risk assessment and profiling for use in the field of preventative health; providing temporary use of non-downloadable health database management software for use in evaluating a person's health status by analyzing answers to a questionnaire and generating a report that provides behavior modification suggestions to reduce health risks; application service provider featuring software for providing business decision information, clinical information, and analysis for health care payers, providers, employers, consultants and pharmaceutical companies; data warehousing and data mining services for the health care industry; application service provider, namely,

providing, hosting, managing, developing, researching, analyzing, reporting, and maintaining applications, software, web sites, and databases in the fields of healthcare, benefits programs, employee productivity, and risk management; Development and design of databases; development and design of software and hardware for monitoring and control of apparatus and instruments; providing virtual computer systems and computer environments, for monitoring and controlling apparatus and instruments, via cloud services; monitoring services relating to medical apparatus and instruments, including on-line, including in the form of action management and feedback; consulting services in the field of cloud computing; infrastructure as a service [IaaS]; platform as a service [PaaS]; software as a service [SaaS].

EUTM 018009607

Class 9: Scientific, measuring, signalling, and checking (supervision) apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, other than ignition coils, induction coils and antennae; Apparatus for recording, transmission or reproduction of sound or images; Compact discs, DVDs and other digital recording media; Data processing equipment, computers; Computer software; Electronic display apparatus for use with exercise equipment; Application software (apps), including mobile apps, hybrid apps and web apps; Computer hardware and software, for use with medical patient monitoring equipment, for receiving, processing, transmitting and displaying data; Computer software for controlling and managing patient medical information; communication software for providing access to the internet; Communications servers; Communications software for connecting computer network users and global computer networks; database management software for remote patient monitoring and electronic health record; software for monitoring and controlling communication between computers and automated machine systems; telecommunications hardware and software for monitoring and alerting remote sensor status via the Internet; Transmitters of electronic signals; Detectors; Frequency meters; Frequency modulators; Actinometers; Integrated circuit chips; Smart cards [integrated circuitcards]; Apparatus for the recording, transmission and presentation of medical data; Computer software for medical use; Computerised devices for formatting and displaying of medical data, namely infrared interfaces for transfer of device commands

and configuration of information from a personal computer to glucose meters and insulin pumps, and vice versa; Wireless electronic apparatus for the transmission of sound, images or data; Wireless electronic apparatus for monitoring and controlling the functioning of other electronic apparatus; Speed indicators; Personal electronic apparatus for displaying, measuring, recording, organising, handling, analysing and receiving data, text, images and audio files, in particular in the field of healthcare; Electric or electronic sensors for use in detecting, measuring, processing, collecting, recording and transmission of variables relating to health, namely in particular blood glucose levels, blood pressure, heart rate and temperature; Computer software applications for portable devices used for recording, organisation, reception and analysis of text, data, images and files, particularly in the field of health; Computer software applications for portable devices for wireless transmission of data, for receiving and processing the aforesaid and for the transmission and display of information relating to blood glucose levels, blood pressure, body temperature, heart rate and oxygen concentration; Thermometers; Personal information management software, Cameras; Camcorders; Webcams, apparatus for recording, transmission or reproduction of sound or images; Image scanners; Downloadable image files; Accelerometers; Connected watches and bracelets for communicating data to personal digital assistants, smartphones, mobile devices and personal computers through sensors, online websites and other computer and electronic communications networks; Bracelets equipped with functions for monitoring and reporting data relating to health, physical fitness, blood pressure, neurological, muscular and postural control disorders, body temperature, heart rate and oxygen concentration; Smartphones; Cell phones; portable communication apparatus namely handsets, walkie-talkies, satellite telephones, personal digital assistants and portable multimedia players; Monitors to measure, monitor, record, and transmit physiological and biometric data such as heart rate, pulse, body temperature, perspiration, blood pressure, sleep patterns, time, distance, pace, calories burned, and other fitness measurements; Electronic publications, downloadable; Computer application software; software interfaces with multi health devices to record health conditions; Watchbands that communicate data to personal digital assistants, smart phones and personal computers through internet websites and other computer and electronic communication networks; Bracelets that communicate data to personal digital assistants, smart phones and personal computers through internet websites and other computer and electronic

communication networks; Smartwatches; Wrist bands with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Bracelets with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Rings for with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Ear rings with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Necklaces with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Jewelry with the function of measurement/analysis/storage/transfer of the wearer's physiological/biological/activity data; Smart watches comprised primarily of a wristwatch also featuring a telephone, software and display screens for viewing, sending and receiving texts, emails, data and information; Wearable digital electronic devices comprised primarily of a wristwatch and also featuring a telephone, software and display screens for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computers; Oxygen concentration meters; Sensors, monitors and display screens in the field of healthcare; Scientific apparatus and instruments; application software; computer software; software applications; mobile apps; databases; electronic databases; computer databases; electronic databases recorded on computer media; Computer software platforms; computer software relating to the medical field; computer software for database management; database engines; data management software; big data management software; computer software for use in medical decision support systems; pedometers; application software for cloud computing services.

Class 35: Maintaining files and records concerning the medical conditions of individuals; maintaining personal medical history records and files.

Class 38: Telecommunication services; instant messaging services and e-mail messaging services, in particular providing real-time electronic messaging and electronic communications to individuals regarding their health and well-being concerns; providing multiple-use access to a global computer information network in the field of health care; providing an Internet web site for medical professionals and medical patients that allows for the exchange of information from remote locations using devices that feed information to the web site that is then processed and can be accessed in real-time by users.

Class 42: Providing temporary use of on-line non-downloadable software for health risk assessment and profiling for use in the field of preventative health; providing temporary use of non-downloadable health database management software for use in evaluating a person's health status by analyzing answers to a questionnaire and generating a report that provides behavior modification suggestions to reduce health risks; application service provider featuring software for providing business decision information, clinical information, and analysis for health care payers, providers, employers, consultants and pharmaceutical companies; data warehousing and data mining services for the health care industry; application service provider, namely, providing, hosting, managing, developing, researching, analyzing, reporting, and maintaining applications, software, web sites, and databases in the fields of healthcare, benefits programs, employee productivity, and risk management; Development and design of databases; development and design of software and hardware for monitoring and control of apparatus and instruments; providing virtual computer systems and computer environments, for monitoring and controlling apparatus and instruments, via cloud services; monitoring services relating to medical apparatus and instruments, including on-line, including in the form of action management and feedback; consulting services in the field of cloud computing; infrastructure as a service [IaaS]; platform as a service [PaaS]; software as a service [SaaS].