

O-190-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2362857  
BY RAJESH SHRINIWAS RANSING  
TO REGISTER THE TRADE MARK:**

**X1RECALL**

**IN CLASS 9**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 92915  
BY X1 TECHNOLOGIES, INC**

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### **BACKGROUND**

1) On 10 May 2004 Rajesh Shriniwas Ransing applied to register the trade mark X1RECALL (the trade mark). The application was published for opposition purposes in the *Trade Marks Journal* on 30 July 2004 with the following specification:

*computer software for use in data analysis; computer software for use in management and organisation of data and or databases; computer software for use in correlation of causes and effects in industry, business, or medicine; computer software.*

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 1 November 2004 X1 Technologies, LLC, filed a notice of opposition to the application. During the proceedings X1 Technologies, LLC changed its corporate status to become X1 Technologies, Inc, which I will refer to as XT. XT is the owner of Community trade mark registration no 3630217 for the trade mark **X1**. It is registered for *software for locating electronic files stored on local network drives*; these goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The application for registration was made on 26 January 2004, claiming an international priority date of 28 July 2003 from the United States of America. The trade mark was registered on 8 June 2005. XT claims that the respective trade marks are similar and that the respective goods are identical or similar. Consequently, registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Mr Ransing filed a counterstatement. He denies that the trade marks are similar. He denies that the goods are similar. In relation to *computer software* at large he states:

“With regard to unqualified reference to ‘computer software’ in the specification of the Application, the vast majority of computer software is totally dissimilar to the goods of the Registration in terms of purpose, expected user and method of

use. Such computer software is neither in competition with or complementary to the goods of the Registration.”

Mr Ransing states that “all or at least the vast majority of the Application should not be refused on the basis of Section 5(2)(b) of Trade Marks Act 2004 (sic).”

4) Both sides seek an award of costs.

5) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing; XT has filed written submissions.

## **EVIDENCE**

### **Evidence of XT**

6) This consists of a witness statement by Josh Jacobs. Mr Jacobs is president of XT. Mr Jacobs states that XT was founded in 2003 with the aim of developing search software which would allow corporate entities to search and locate data and information on their own corporate network in the same way as there are search engines/tools for the Internet. He states that XT’s trade mark is used in relation to a computer software search tool used to search and manage data that resides on the desktop or across a corporate network. Mr Jacobs states that the software has been a huge success in the United States and has been selling well in the United Kingdom. Mr Jacobs refers to what the X1 software comprises: the X1 software as described above, a server, content connectors and a software development kit. Mr Jacobs exhibits at Exhibit A a report showing details of United Kingdom orders processed since the first recorded sale, 13 March 2003. Only the first three pages of the report cover sales prior to the date of application. The majority of the sales during this period were to what appear to be private individuals. Up to 10 November 2003 the price of the software was normally \$49.99, after that it rose to be normally \$99.00. Up to the date of application XT appears to have had around 200 customers in the United Kingdom. Mr Jacobs does not give a figure for the sales value up to the date of application but my own rough and ready calculation gives a sales value of approximately \$15,500. (Using the Oanda® currency converter, at the date of application this would have amounted to £8,685.91.) Mr Jacobs states that he uses Software Paradise, Software House International and Software Spectrum, to “fulfil the UK requirement”.

7) Mr Jacobs states that X1 branded software has received acclaim and publicity, particularly by way of Internet articles. He exhibits copies of four articles from the Internet; these all emanate from after the date of application.

## **Evidence of Mr Ransing**

8) This consists of a witness statement by Antony Xavier Gallafent, who is the trade mark attorney of Mr Ransing.

9) Mr Gallafent states that he has reviewed the website of XT and exhibits at Annex 1 a document from the site dated May 2005; it is entitled *X1® Desktop Search Platform*. Mr Gallafent states that it can be seen from the document that the software sold by X1 just locates files.

10) Mr Gallafent exhibits at Annex 2 an extract from the website [ukinvest.gov.uk](http://ukinvest.gov.uk). In the extract it is stated that in 2003 the United Kingdom software sector generated £7.2 billion.

## **DECISION**

### **Likelihood of confusion – section 5(2)(b) of the Act**

11) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

### **The evidence**

12) The turnover of XT at the date of application was small. The number of products that it had sold was small. There is no evidence of any publicity or promotion prior to the date of application. The use that XT had made of its trade mark, prior to the date of application, can have no bearing upon the case. Mr Jacobs and Mr Gallafent refer to the nature of the software. I do not consider that there is any necessity for this. The nature of the software is clearly and specifically defined in the specification; there is no ambiguity as to its nature. It is not search software at large for computers at large but software for locating files on local network drives. This represents the umbra of the protection, from which the penumbra will emanate.

### **Average consumer and nature of purchasing decision**

13) The purchaser of software has to make sure that it is compatible with the operating system that he or she is using. Software at large is not normally bought on the spur of the moment, it is bought with a degree of care and research. (I would enter the caveat that games software could be bought on the spur of the moment.) The average consumer for software is the public at large. The specifically identified software of the application is likely to be bought by some form of commercial undertaking rather than the home-user. Nowadays home-users can have their own local networks, consequently the goods of the earlier registration could be bought by the public at large, although, as that public is using a local network, it is likely to be reasonably well versed in the art. Consequent upon the above I consider that the purchasing process in relation to the goods of the earlier registration and the specifically identified software of the application, will be bought as the result of a careful and educated purchasing decision. The nature of the purchasing decision will limit the possible effects of imperfect recollection.

### **Comparison of trade marks**

14) The trade marks to be compared are:

**Trade mark of XT:**

**X1**

**Trade mark of Mr Ransing:**

**X1RECALL**

15) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>i</sup>. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>ii</sup>. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>iii</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>iv</sup>.

16) In his counterstatement Mr Ransing claims:

“The Mark of Community Application (now Registration) 0036302171 (hereafter ‘the Registration’) is very different to that of UK Application 2362857 (hereafter ‘the Application’) visually – a string of two characters compared to a string of eight characters; phonetically – the Registration would be pronounced ‘X-one’ or ‘times one’ whilst the application is likely to be pronounced ‘XIRE-CALL’ or ‘XI (to rhyme with eye) – RECALL’ because it is likely that a viewer of the Mark of the application would interpret the ‘1’ and an ‘I’ and conceptually – the Mark of the Registration is likely only to give rise to the concept of multiplication whereas

the sign of the Application gives rise to the principle concept of recollection or seeking to have something returned, for example, a product recall.

17) Recall is a common English word. Seeing Mr Ransing's trade mark I consider that it is most likely that the average consumer will readily identify this word and perceive two distinct parts; X1 and RECALL. Mr Ransing's own comments concede that this may be the case. My impression of the trade mark is that it will be seen as 'X one RECALL'. There is no explanation as to why, if the trade mark is divided into these two components, the first part will be seen as 'X eye', whilst the same average consumer will see XT's trade mark as 'X one' or 'times one', as proposed by Mr Ransing. It did not occur to me that XT's trade mark would be seen as 'times one', it seems a strained and unlikely rendering of the trade mark. It is also at odds with Mr Ransing's comments as to how the X1 element of his trade mark would be seen. In the context of the goods, I do not consider that X1 will be seen as the Roman numeral for eleven; if one was in the field of cricket this would be a plausible view of X1. I consider that the most likely perception of XT's trade mark is as 'X one'. It may well be that some average consumers will perceive the trade marks in different ways, one cannot legislate for perception. However, I consider that it is reasonable to believe that a good number of the average consumers will see XT's trade mark as 'X one' and Mr Ransing's trade mark as 'X one RECALL'. I will assess similarity on the basis of this potential cohort of consumers; that there may be another cohort of consumers does not gainsay this approach.

18) I do not consider that XT's trade mark can be divided into distinctive and dominant components, no one element strikes me as being stronger than the other. This is a case where the distinctiveness very much rests in the trade mark as a whole. The X1 element of Mr Ransing's trade mark comes at the beginning of the trade mark, and so gains from this. It has no obvious meaning in relation to the goods. RECALL has a clear meaning and it could have an allusion to software that has a retrieval function. The nature of the trade mark means that there is a clear hiatus between X1 and RECALL. RECALL following the X1 element strikes me as being subsidiary to that element, potentially as a qualifier of a specific type of X1 product. Consequently, I consider that X1 is the dominant and distinctive component of Mr Ransing's trade mark. To state the obvious, the X1 element is common to the trade marks and the RECALL element is alien to the earlier trade mark, in terms of vision, speech and concept. Considering the trade marks in their entirety and taking into account the likely perception of the average consumer in relation to the goods, I consider that the respective trade marks are similar. I am of the view that there is a reasonably high degree of similarity.

### **Comparison of goods**

19) The goods of the earlier registration are: *software for locating electronic files stored on local network drives*. The goods of the application are:

*computer software for use in data analysis; computer software for use in management and organisation of data and or databases; computer software for use in correlation of causes and effects in industry, business, or medicine; computer software.*

Words in specifications should be given their natural meaning, subject to their being construed by reference to their context; they should not be given an unnaturally narrow meaning<sup>v</sup>. When construing a word in a specification one is concerned with how the product is regarded for the purposes of trade<sup>vi</sup>.

20) Goods can be considered to be identical when the goods of an earlier trade mark are included in a more general category in the specification of a later application<sup>vii</sup>. Consequently, *computer software* must be considered to be identical to the goods of the earlier registration. I will say no more about *computer software* at large in relation to the similarity of the goods.

21) In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose<sup>viii</sup>, their method of use and whether they are in competition with each other or are complementary<sup>ix</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

22) In *Mercury Communications Limited v Mercury Interactive (UK) Limited* [1995] FSR 850, Laddie J held that defining characteristic of “computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs”. In this passage Laddie J was looking at the breadth of protection that a specification for computer software. He was not stating that there could not be similarity between computer software for different purposes. I can envisage situations where the types of software are so distant and their uses so distant that although they have the basic similarity of being software, they cannot be considered to be similar (having similarities and being similar cannot, of course, be conflated); this could be the case, for instance, for games software and software for detecting dark matter. In this case I do not consider that there is that immensity of distance between the types of software.

23) All of the goods are computer software, they are all types of application software; they have this in common. *Software for locating electronic files stored on local network drives* could be used as a tool in *management and organisation of data and or databases*.

Consequently, I am of the view that these goods could be identical and, at the least, are highly similar. The other products in Mr Ransing's specification do not appear to serve a common function with the goods of XT's registration. One would not substitute one set of goods for the other, they are not in competition. There is nothing to suggest that there is a symbiotic, mutually dependent or essential relationship between these sets of goods; they are not complementary. However, one might use the goods of XT to locate files held on Mr Ransing's software. I consider that *computer software for use in data analysis; computer software for use in correlation of causes and effects in industry, business, or medicine* has a limited degree of similarity with the goods of the earlier registration.

## Conclusion

24) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>x</sup>. In my view there is a good deal of similarity between the respective trade marks. *Computer software* is identical to the goods of the earlier registration; *computer software for use in management and organisation of data and or databases* is identical, or, at the very least, very similar, to the goods of the earlier registration. There is a limited degree of similarity in relation to the other goods of the application. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion<sup>xi</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>xii</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods 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<sup>xiii</sup>. There is nothing to suggest that X1 is in anyway descriptive or allusive of the goods of the earlier registration. There is no evidence to suggest that X plus a number is commonly used in the trade for software. X1 is a trade mark, in my view, that is easy to remember. I consider that X1 enjoys a reasonable degree of inherent distinctiveness. In considering if there is a likelihood of confusion I need to take into account the nature of the purchasing decision and the average consumer; as I have indicated above I consider that in this case this will limit the effects of imperfect recollection. In considering the matter I also take into account that the software of XT is of such a nature that it could sit on any computer, which is part of a local network, and so be present with virtually any other type of application software. So the software of XT could easily be on the same machine as the software of Mr Ransing, indeed could be used to search for files in the latter's software. Taking into account all the above factors I consider that there is a clear and direct likelihood of confusion in respect of *computer software* and *computer software for use in management and organisation of data and or databases*. In relation to the other, less similar goods, I consider that there is a likelihood



that the average consumer will consider that the goods come from the same or an economically linked undertaking<sup>xiv</sup> and so there is a likelihood of confusion.

**25) The application is refused in its entirety.**

**COSTS**

26) XT has been successful and is entitled to a contribution towards its costs. The evidence filed by XT not only had no effect upon the decision, there was no possibility that it would have any effect. Therefore, I do not consider that it should receive any compensation for this evidence. I award costs on the following basis:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£200
Considering evidence of the applicant	£50
Written submissions	£200
<b>TOTAL</b>	<b>£950</b>

I order Rajesh Shriniwas Ransing to pay X1 Technologies, Inc the sum of £950. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 9th day of July 2007**

**David Landau**  
**For the Registrar**  
**the Comptroller-General**

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<sup>i</sup> *Sabel BV v Puma AG* [1998] RPC 199

<sup>ii</sup> *Sabel BV v Puma AG* [1998] RPC 199

<sup>iii</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77

<sup>iv</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02

<sup>v</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

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- <sup>vi</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.
- <sup>vii</sup> *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05.
- <sup>viii</sup> The earlier incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected.
- <sup>ix</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.
- <sup>x</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.
- <sup>xi</sup> *Sabel BV v Puma AG*.
- <sup>xii</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91
- <sup>xiii</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.
- <sup>xiv</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.