

O-321-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2441874
BY ROB HALLIDAY (TRADING AS FOCUSTRACK)
TO REGISTER THE TRADE MARK:**

FocusTrack

IN CLASSES 9 & 42

AND

**IN THE MATTER OF OPPOSITION NO 95521
BY INFORMATION BUILDERS INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2441874
By Rob Halliday (trading as FocusTrack)
to register a trade mark in classes 9 & 42**

and

**IN THE MATTER OF Opposition No 95521
By Information Builders Inc**



BACKGROUND



1. On 15 December 2006 Rob Halliday (“RH”) (trading as FocusTrack) applied to register the sign FocusTrack as a trade mark in classes 9 & 42. Registration is sought in respect of:

Class 09: Computer software relating to entertainment lighting.

Class 42: Computer services in relation to entertainment lighting.

2. On 27 September 2007 Information Builders Inc (“IB”) opposed the above application on the sole ground of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). IB relies on six of its earlier trade marks for the purposes of its opposition; the details of IB’s earlier trade marks are:

Trade Mark	Relevant Dates	Specification
UK registration 934918 FOCUS	Filed: 5/12/1968	Class 09: Magnetic tapes and magnetic discs, all being for use with data processing apparatus and instruments or with computers in class 9.
UK registration 1362427  FOCUS	Filed: 27/10/1988	Class 09: Computer programs, magnetic tapes, disks, wires and filaments, all for use with computers; encoded tapes, disks, wires, cards and filaments, all for use with computers; parts and fittings for all the aforesaid goods; all included in Class 9.
UK Registration 1362428  FOCUS	Filed: 27/10/1988	Class 42: Computer programming; consultancy services relating to the design, development and operation of computer memories, integrated circuits and computer programs; all included in Class 42.

<p>CTM¹ registration 558650</p> <p>WebFOCUS</p>	<p>Filed: 18/6/1997</p>	<p>Class 09: Measuring, regulating and testing apparatus; computers, computer peripheral devices, computer terminals, word processors, apparatus for the storing and reproduction of data; office machines; products, including data carrying products, in the form of tapes, sheets, discs and similar products, for use with all the aforesaid apparatus and machines, including registered programs.</p> <p>Class 16: Printed matter; tapes, cards, discs, and other similar products of paper or cardboard, for use with all the aforesaid apparatus and machines in class 9; office machines.</p> <p>Class 42: Computerization services and computer programming; consultancy in the field of computerization and computer programming; updating and customising of software.</p>
<p>CTM registration 68585</p> <p></p>	<p>Filed: 01/04/1996</p>	<p>Class 09: Measuring, controlling and analysing apparatus; computers, computer peripheral devices, computer terminals, word processing apparatus, apparatus and equipment for the storing and reproducing data; office machines; data carrying or non-data carrying products in the form of tapes, records, disks, and other similar products, for use in connection with all the aforementioned apparatus and equipment, including registered computer programs; excluding apparatus, equipment, products and computer programs coming within the field of photogrammetry.</p> <p>Class 16: Tapes, cards, disks, and other similar products of paper or cardboard, for use in connection with all the apparatus and equipment named in class 9; office machines; excluding products within the field of photogrammetry.</p> <p>Class 42: Computerisation services, computer programming, consultancy in the field of computerisation, computer programming and automatic data processing; excluding services coming within the field of photogrammetry.</p>
<p>CTM registration 963611</p> <p></p>	<p>Filed: 21/10/98</p> <p>Registered: 9/10/2000</p>	<p>Class 09: Measuring, checking and analyzing apparatus; computers and computer peripheral; computer terminals; word processing apparatus; data processing apparatus; office machines belonging to this class; recording media in the form of tapes, disks or in other forms, said goods being used with all the apparatus and machines</p>

¹ Community Trade Mark

		<p>mentioned above, including registered computer programs.</p> <p>Class 16: Manuals with respect to computers, computer peripheral apparatus, computer terminals and data processing apparatus.</p> <p>Class 42: Computer services, computer programming, consultancy, services related to computer systems, computer programming and to automatic data processing.</p>
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3. Neither side filed evidence. Neither side requested a hearing or filed written submissions. I will, however, take into account the arguments presented in IB's notice of opposition and in RH's counterstatement.

DECISION

Proof of use regulations

4. In opposition proceedings, earlier marks for which the registration procedure was completed before the end of the five year period ending with the date of publication of the applied for mark (RH's mark) may only be relied upon to the extent that they have been used (or that there are proper reasons for non-use)². RH's mark was published on 29 June 2007. The registration procedures for IB's earlier marks range between 1970 to 2000, consequently, all of IB's earlier marks completed their respective registration procedures before the end of the five year period ending on 29 June 2007. **The proof of use provisions, therefore, apply to all of IB's earlier marks.**

5. In its notice of opposition, IB made various "statements of use" in relation to its earlier marks. This is a requirement (given the applicability of the proof of use provisions) of rule 13(2)(d) of the Trade Marks Rules 2000 (as amended)("the Rules"). In his counterstatement, RH did not require IB to provide actual proof of use. Therefore, I must accept that IB has used its marks to the extent claimed, namely:

- 934918:** Computer programs supplied on disc.
- 1362427:** Computer programs supplied on disc.
- 1362428:** Computer services
- CTM 558650:** Computer programs and computer services.

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

CTM 68585: Computer programs and computer services

CTM 963611: Computer programs and computer services

6. However, that it is not the end of it. I say this because the claim must, of course, tie in with the actual goods and services that have been registered. I cannot utilise claimed goods and services if they differ from, or are wider than, those for which they are registered. After assessing the claims against the goods and services as registered, I come to the following findings:

7. In relation to 934918, the specification as registered covers “magnetic tapes and magnetic discs, all being for use with data processing apparatus and instruments or with computers”. Use has been claimed in relation to “computer programs supplied on disc”. The question that arises here is whether the magnetic tapes and discs include actual content such as computer programs? In my view, a magnetic tape or disc for use with a computer is that and that alone, namely, the magnetic tape or disc. Although magnetic tapes and discs may act as carriers for computer programs, this does not, in my view, equate to a finding that such a term includes within its ambit other goods that are capable of being carried by it. This is not a question as to whether they are similar or not, it is a question about whether the goods are there or not. **Given that the statement of use relates to goods not covered by the specification as registered, this earlier mark cannot be relied upon for the purposes of this opposition.**

8. In relation to 1362427, the specification as registered expressly includes computer programs but subject to a limitation of “all for use with computers”. In view of the registered specification and the statement of use, **this mark may be taken into account in respect of “computer programs on disc; all for use with computers”**

9. In relation to 1362428, the specification as registered reads “computer programming; consultancy services relating to the design, development and operation of computer memories, integrated circuits and computer programs”. Use is claimed for “computer services”. The term computer services is a wide one, and whilst I am prepared to accept that this includes the services as registered, it also goes wider to cover computer related services not actually covered by the registered specification. **For this reason, the earlier mark may be included but for its registered specification (as they are computer services) not the claimed use.**

10. In relation to CTM 558650, the statement of use is made in relation to “computer programs and computer services”. Looking firstly at the goods in class 9, the specification as registered includes the terms:

“products, including data carrying products, in the form of tapes, sheets, discs and similar products, for use with all the aforesaid apparatus and machines, including registered programs.”

11. The above term covers the program content itself given the wording “including registered programs”. However, I cannot go wider than those goods claimed to have been used. **I will consider the opposition in relation to:**

Computer programs registered on data carrying products, in the form of tapes, sheets, discs and similar products

12. In respect of the class 42 services, the use claimed (computer services) is wider than the services as registered even though the services of the registered specification are what could be described as computer services. **For this reason, the earlier mark will be considered in relation to its registered specification not the claimed use.**

13. In relation to CTM 68585, the relevant goods registered in class 9 are worded in the same manner as CTM 558650, although, certain goods have been excluded from the registered specification. **I will therefore consider:**

Computer programs registered on data carrying products, in the form of tapes, sheets, discs and similar products; excluding products within the field of photogrammetry.

14. For the services, the same principles as 1362428 apply because only certain “computer services” are registered. I should also add that the registered term “consultancy in the field of automatic data processing” is unlikely to be regarded as a computer service and cannot, therefore, be considered. **I will consider:**

Computerisation services, computer programming, consultancy in the field of computerisation and computer programming; excluding services coming within the field of photogrammetry.

15. In relation to 963611, in class 9 the same principles as 68585 & CTM 558650 apply, therefore, the earlier mark will be considered for:

Computer programs registered on recording media in the form of tapes, disks or in other forms.

16. In relation to the services, the use claimed appears as a term in the registered specification. **The mark will be considered for “computer services”.**

The law and the leading authorities

17. Section 5(2)(b) of the Act states:

“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.”

18. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which read:

“6.-(1) In this Act an “earlier trade mark” means –

(a) 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.”

19. When reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments germane to this issue, notably in: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) 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; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the purchasing act

20. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who this is. RH seeks his registration in relation to computer software and computer services in the field of entertainment lighting. Although IB's goods are wider than this (no specific field is mentioned) this is still the field in which any clash will manifest itself. Entertainment lighting strikes me as a highly specialised field - the goods and services are certainly not those that would be purchased or utilised by the general public at large. Instead, the goods are likely to be purchased, and the services utilised, by a relevant professional or knowledgeable amateur who is engaged in the setting up of stages in an entertainment setting (a stage or lighting manager) or perhaps such a person working in TV or film production with a particular role in relation to stage or lighting management. Either way, the

average consumer is likely to be knowledgeable about lighting requirements in an entertainment setting.

21. In terms of the purchasing act, I believe that this will be a considered purchase. The goods will need to be reliable if they are to be used in an entertainment setting and the particular functions that they perform will be critically assessed before purchase. They are unlikely to be regular purchases, a factor which increases the degree of attention likely to be utilised³. Similar considerations apply in relation to the utilisation of the services. **Overall, the average consumer is likely to be a knowledgeable person with a specific role in stage or lighting management and the purchasing act is likely to be a highly considered one.**

Comparison of the goods and services.

22. All relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of the judgment:

“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 end users and their method of use and whether they are in competition with each other or are complementary.”

23. Other factors may also be taken into account such as, for example, the distribution channels concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance of the European Communities (“CFI”) in Case T-164/03 *Ampafrance S.A. v OHIM – Johnson & Johnson GmbH (monBeBé)*).

24. RH’s goods and services are computer software and computer services in the field of entertainment lighting. All five of LB’s earlier marks (934918 having been removed from my consideration given my finding in relation to proof of use) cover goods in class 9. They all cover goods in the form of computer programs. RH highlights in his counterstatement that IB has made no claim in relation to anything to do with entertainment lighting. This may be true, however, IB’s computer programs are not limited to a particular field, and, therefore, they must be taken to include all computer programs including those used in relation to entertainment lighting. I see no difference between the term “software” (RH’s term) and “programs” (IB’s term). Given this, and given the broad coverage of

³ See *Inter-Ikea Systems BV v OHIM* (Case T-112/06).

IB's computer programs at large, **RH's goods fall within the ambit of IB's goods and must, therefore, be considered to be identical**⁴.

25. In relation to the clash with RH's services, I note, with the exception of 934918 (which in any event can no longer be considered) and 1362427 (which covers only class 9), that the earlier marks cover services in class 42 that are, essentially, computer services, be it programming, design etc. IB's services are, again, not limited to a particular subject and must be considered as broad terms that would include services provided in the field of entertainment lighting. RH's service must, therefore, include services that are identical to those of IB. **A finding of identical services must, consequently, be made.**

Comparison of the trade marks

26. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective trade marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). There are five earlier marks to consider. Three are for the word FOCUS with a graphical element to the left of the word. The other two marks have the additional word WEB, one of them also has a graphical element to its left. I consider IB's greatest prospect of success to lie with the marks that contain the word FOCUS without additional verbal elements, the other two marks (with the additional word WEB) create greater visual, aural and potentially conceptual differences which will render them less similar in comparison to RH's mark. The marks under comparison are replicated below for ease of reference:

IB's mark

RH's mark



FocusTrack

27. IB's claim in relation to similarity is based on the word FOCUS being the dominant part of both marks, particularly because, it argues, the word TRACK is non-distinctive in the field of lighting. RH argues in his counterstatement that his mark is a compound word and, furthermore, that the word FOCUS plays a descriptive role in his trade mark (the word "focus" describing the positioning of beams of light on a stage) and, therefore, in the field of entertainment lighting the respective marks would not be mixed up.

28. Before making the usual comparisons of the visual, aural and conceptual similarities that may exist between the marks, I should begin by assessing the

⁴ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05

dominant and distinctive elements they possess, not least because the parties' statements and counterstatements make divergent claims on what aspect of dominance and distinctiveness the respective words play in the respective marks. Looking firstly at RH's mark, I note that IB says that TRACK is a non-distinctive word in the lighting field, so making FOCUS the dominant and distinctive element, whereas RH highlights the descriptive nature of the word FOCUS in the entertainment lighting field and, thus, that the word plays a descriptive role in his mark qualifying what is being tracked.

29. Both sides have claimed certain facts in terms of distinctiveness in the relevant field but, neither has chosen to file any evidence to prove it. Therefore, I do not know if these are terms of art or not. Nevertheless, I can still make assessments on what the average consumer will make of the respective marks when encountered in the marketplace. Taking into account standard English dictionary definitions⁵, particularly those that relate to lighting, the word FOCUS means either the point of convergence of light, the state of an optical image when it is clear and distinct, and the point on which attention is placed or to fix attention upon. This, to my mind, creates a clear link of some sort with the goods and services in question. Entertainment lighting is utilised to light a stage or set and will operate in such a way so as to focus light on a particular area or person or to light the stage in such a way so as to give greater or less focus to a particular area. The word TRACK also has a number of meanings, but in relation to the goods and services, those meanings that relate to the following of a passage, course or trail (e.g. to keep track of something) seem most relevant. In view of these meanings, it strikes me, in the context of RH's mark as a whole, that the word FOCUS qualifies the word TRACK, in other words, the computer program in some way performs a tracking function in relation to the lighting focus required during a particular entertainment event. Although this could be said to be more of a suggestive combination, I note that in relation to conceptual meanings it is acceptable to consider suggestive connotations. In *Usinor SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-198/05) the CFI stated at paragraph 69:

“As is apparent from the examination of the conceptual similarity of the signs at issue, their common prefix ‘galva’ is likely, as regards the relevant public, to carry a suggestive connotation in respect of the goods concerned, to the effect that they have undergone a process of galvanisation. The same applies in respect of the suffixes ‘alloy’ and ‘allia’, which are likely to carry a connotation that is descriptive of the alloy process so far as the former is concerned and suggestive of that process so far as the latter is concerned. Given that the concepts conveyed by the two marks at issue refer to the characteristics of the goods concerned, their ability to contribute to the identification of the designated goods as coming from a specific undertaking, and therefore their ability to

⁵ Collins English Dictionary (5th Edition)

distinguish those goods from those of other undertakings, may be weakened as a result.”

30. In view of the above, my view is that neither the word FOCUS or TRACK will be regarded as the dominant and distinctive element of the mark. It is the mark as a whole and its particular construction in which any distinctiveness is likely to lie.

31. The above assessment is important given that the word FOCUS cannot be the part of the mark on which sole assessment is made given that the word TRACK can in no way be said to be negligible in the context of the mark as a whole (see *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42). I note the judgment of the ECJ in *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (paragraph 30) that an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element of it. However, the question here is whether the word FOCUS plays an independent distinctive role within RH’s mark – in my view it does not, it plays a qualifying role not an independent role.

32. I am conscious of the danger in inferring too much knowledge on the part of the average consumer; Anna Carbonni (sitting as the Appointed Person) in *Chorkee Trade Mark* (BL 0/048/08) stated:

“37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

33. However, I also take into account the decision of Mr Richard Arnold QC (sitting as the Appointed Person) in *South Beck Trade Mark* (BL O/160/08) when he stated at paragraph 22:

“Counsel for the opponent accepted, however, that the dictionary meaning of the word “beck” was “a brook, a rivulet; spec. a mountain, hill or moorland stream” (*Shorter Oxford English Dictionary*, 5th ed); and that, if the hearing officer had relied upon his own knowledge of the English language in reaching his conclusion as to how the word would be understood by the average consumer, that conclusion would not have been open to challenge. In these circumstances I consider that there was no material error in the hearing officer’s assessment.”

34. This is not a case involving a word such as CHEROKEE and the degree to which that word may or may not be known. It is more a matter of simple language construction and how the average consumer will understand the words in question. I am, therefore, fortified in my view on how the average consumer will regard RH’s mark.

35. In relation to IB’s mark, there is no other verbal aspect to its mark so, from an aural point of view, the word FOCUS must be the dominant element. Having said that, given my findings in relation to the meaning of the word in relation to entertainment lighting, it may not be regarded as the most distinctive of words. In terms of visual impact, the word FOCUS certainly has visual dominance over the other visual element. However, I cannot say that the device element is negligible in the context of the mark and so, it is still the whole mark that must be compared. Where does all this leave the comparison?

36. Given my earlier observations, I am prepared to accept that there is some visual and aural similarity given that both marks contain the word FOCUS. However, whilst the word may be the most dominant part of IB’s mark, it does not play an independent distinctive role in RH’s mark and, given the other features present in the respective marks, any similarity must be regarded, bearing in mind dominant and distinctive elements, as quite low.

37. In relation to conceptual similarity, whilst both marks contain the word FOCUS and that this word is likely to be taken as a descriptive or, at the very least, a suggestive reference, it is difficult to see that any conceptual convergence will make these marks more similar. Indeed, it could be argued that there is a divergence of concept. In *Mundipharma AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-256/04, the CFI stated at paragraph 58:

“Next, the Court notes that, in the present case, the conceptual perception of the opposing marks will be different for the two groups making up the relevant public. The professional public, because of its knowledge and experience, will generally be able to understand the conceptual meaning of the terms referred to by the different components of the opposing marks, namely ‘respiratory’ for ‘respi’, ‘cure’ or ‘heal’ for ‘cur’ and ‘corticoids’ for ‘cort’. Thus, by breaking down the two marks into their

respective components, they will interpret the mark applied for as corresponding to a 'cure for respiratory problems' and the earlier mark as designating 'corticoids intended for respiratory illnesses'. Those two interpretations indicate a degree of conceptual divergence, the earlier mark carrying a more specific meaning than the mark applied for, but they nevertheless share the general idea of being linked to respiratory issues. Accordingly, although the conceptual difference weakens the visual and phonetic similarity established above, it is not however sufficiently pronounced to counteract it in the minds of the professional public."

38. There is only one average consumer to consider here and I have already found them to be knowledgeable and that they will take the meanings from the word FOCUS and FOCUS TRACK as I have identified. Therefore, in line with the above judgment, whilst both marks may be linked to the idea of focus, in a lighting sense, one carries a more specific meaning than the other, thus creating a degree of conceptual divergence.

39. In summary, taking into account the conceptual meanings likely to be taken by the average consumer, and bearing in mind the dominant and distinctive components of the mark, it is my view that **whilst there is a degree of similarity, any similarity is at the lower end of the spectrum.**

Distinctiveness of the earlier marks

40. The distinctiveness of an earlier mark is another important factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). However, as IB has not filed any evidence of its use of any of its marks, I have only the inherent qualities to consider.

41. The earlier marks' specifications are not limited to a particular field, although, as I have already found, the fact of non-limitation means that the specification covers goods and services used in the entertainment lighting field. This presents something of a problem because distinctiveness must, of course, be measured in relation to the goods and services at issue. In my view, the inherent distinctiveness of the earlier marks will vary between the type of goods and services and the field to which they relate. For example, a computer program (or service) provided in the field of railway management sold under IB's marks may be regarded as having at least a reasonable (or even a high) degree of inherent distinctiveness. However, for goods and services relating to entertainment lighting it strikes me that the word FOCUS has, at the very least, some suggestive quality. The device element can be said to contribute to the overall distinctiveness, but this element is relatively small, and indeed, it is difficult to see how any increase in distinctiveness due to the presence of the device element will increase the likelihood of confusion given that this is not a point of similarity between the marks. For these reasons, I consider IB's earlier mark to possess

only a low degree of relevant distinctiveness when considered against the goods and services at issue.

Likelihood of confusion

42. When reaching my decision in relation to a likelihood of confusion I need to consider the possibility of both direct and indirect confusion. In relation to direct confusion (where one mark is mistaken for the other) I consider that the points of difference (particularly the presence of the word TRACK in RH's mark and the conceptual whole that this creates) mitigates against this. I must of course take into account that the average consumer rarely has the chance to make direct comparisons between marks but must instead rely upon the imperfect picture of them that he has kept in mind⁶ however, even when taking into account that identical goods are in play, it seems to me, given the differences in the marks and also the fact that the average consumer is likely to be a knowledgeable person undertaking a considered purchase, unlikely that the marks will be mistaken for one another. The distinctiveness of the mark (low), or at least of the word FOCUS, further supports this proposition. For all these reasons, **my finding is that direct confusion is not likely.**

43. In relation to indirect confusion (where an association between the marks may cause the average consumer to wrongly believe that the respective goods or services come from the same or an economically linked undertaking⁷), whilst I bear in mind that the goods and services are identical, it seems to me that the fact that the word FOCUS does not play an independent distinctive role in the context of RH's mark, and that, instead, it plays a qualifying role mitigates against the average consumer relying upon the common presence of the word FOCUS to inform him that the goods come from the same or an economically linked undertaking. This, in itself, may not rule out the likelihood of confusion, particularly if the point of similarity between the marks was of a highly distinctive or fanciful nature. However, I have not found this to be the case. Also to be factored in is the nature of the average consumer and the purchasing act. The considered purchaser of the goods and services is, in my view, unlikely to make any form of connection that would lead him to understand that the goods come from the same or an economically linked source on the basis of a point of similarity in a word for which he will perceive either some form of descriptive or, at the very least, a suggestive quality. For all these reasons, **my finding is that indirect confusion is unlikely.**

44. Before concluding, I should add that I have also considered whether IB's WEB FOCUS marks place them in any better position. My view is that they do not. They create further visual, aural and conceptual differences over and above those already identified. **In summary, IB's opposition fails.**

⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27,

⁷ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

COSTS

45. RH has been successful and is entitled to a contribution towards his costs. I hereby order Information Builders Inc to pay Rob Halliday the sum of £350. This sum is calculated as follows:

Considering notice of opposition	£150
Preparing and filing counterstatement	£200
Total	£350

46. It should be noted that when calculating the above costs, I have taken into account the fact that RH has not been legally represented and the guidance given by the Appointed Person on the relevance of this factor⁸.

47. The above sum should 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 5th day of December 2008

**Oliver Morris
For the Registrar
The Comptroller-General**

⁸ See the decisions of Mr Simon Thorley QC in *Adrenalin* (BL O/040/02) and Mr Richard Arnold QC in *South Beck* (BL O/160/08).