

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2384198  
IN THE NAME OF CALYX LIMITED

AND

OPPOSITION THERETO UNDER NO 95977  
BY THE CALLISTA GROUP LIMITED

TRADE MARKS ACT 1994  
IN THE MATTER OF application  
No 2384198 in the name of  
Calyx Limited and opposition  
thereto under No 95977 by  
The Callista Group Limited

## **Background**

1. Application No 2384198 stands in the name of Calyx Limited (“the applicant”) and is for a series of two marks as follows:



2. Notice of Opposition was filed on behalf of The Callista Group Limited (“the opponent”). At that point the specification of goods and services of the application was subject to amendment and registration is now sought in respect only of the following services:

### *Class 37*

*Installation and maintenance of computer and communications equipment and Local Area Networks and Wide Area Networks;*

### *Class 41*

*Education and training relating to computing, networking, and communications, e-learning, and soft skills training;*

### *Class 42*

*Computer consultancy and design services relating to Local Area Networks, Wide Area Networks, database management systems, management systems, information and communications technology, business applications, post-implementation support and technology development.*

3. The amendment of the specification did not overcome the opposition which is brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Under sections 5(2) and (3), the opponent relies on its earlier trade mark No 2223462. Under section 5(4) the opponent relies on use of the mark CALYX since 1999 in respect of computer software for telecommunications monitoring and management systems and in particular for call centre systems.

4. The applicant filed a counterstatement in which it denied the grounds of opposition stating there is no similarity in the respective goods (sic) and requesting the

opponent to provide proof of use of its mark on all the goods for which it is registered.

5. Only the opponent filed evidence in these proceedings. Neither side requested to be heard but both filed written submissions in lieu of attendance. I should mention at this point that attached to the opponent's written submissions is material in the form of screenprints from the applicant's website and from which it seeks to draw a number of conclusions. This material has not been submitted as evidence in proper form and nor was there any request to so do. That being the case, I do not take it into consideration in reaching my decision.

#### Opponent's evidence

6. This takes the form of a witness statement of Patricia Ansin, who has been a Director of the opponent company since 19 March 1988. Ms Ansin states that the mark CALYX was first used by her company in 1999.

7. From Ms Ansin's evidence it seems that the CALYX product is a software package which acts as a reporting tool designed to provide management information to small and medium sized call centres. The package is provided on a disc and operates only in conjunction with the Siemens' HiCom 150E and HiPath PABX telephone systems. The software has a number of features within it, such as Calyx Trunk Monitor and Calyx Group Monitor which, together, provide management information such as real-time and historical monitoring of calls, statistics of agents and queuing times and allows call flows and call queues to be managed automatically.

8. Ms Ansin says that sales of CALYX software were made from 1999 until 2005 when the commercial relationship with Siemens came to an end. Training and maintenance was provided and telephone support and upgrades were available under CALYX COVER though I note the opponent does not base any of its objections on these services and I do not intend to consider them further. The opponent distributed its systems through Callista UK ("Callista"), a company in which the opponent has a 15% shareholding. Callista distributed only the opponent's systems and did so via Siemens UK who resold them for onward sale to the end user. End users entered into a licence agreement with the opponent once the software was installed and were then able to download any updates direct from the Internet. The opponent has continued to provide technical support to existing clients.

9. Ms Ansin explains that as orders for the CALYX software were received, Callista would access the opponent's website to license those systems. This would lead to the generation of an invoice from the opponent to Callista who would then create its own invoice to be sent to the reseller. CALYX software has been marketed through the opponent's website with contact details of Callista being provided for UK customers.

10. The following are exhibited to Ms Ansin's witness statement:

PA1: A copy of a speech given by the then Prime Minister of New Zealand launching the CALYX product, for promotion in Europe, on 22 November 1999;

PA2: a copy of a PowerPoint presentation from 2005 explaining the functions of the software;

PA3: photographic images of the CD bearing CALYX software;

PA4: CD with 2005 updates and copy of license agreement;

PA5: photograph of CD from November 2003;

PA6: sample invoices showing sales of CALYX software and related support package. All are from The Callista Group to Callista UK Ltd;

PA7: copies of invoices from Callista UK Ltd to various companies in the UK which show sales of software under the mark ;

PA8: pages from the Internet Archive Wayback Machine showing historical extracts from the opponent's website;

PA9: a copy of a datasheet relating to CALYX.

11. That completes my summary of the evidence filed in these proceedings.

## **The Law**

12. The first objection is brought under section 5(2)(b) of the Act. This reads:

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.

13. An earlier mark is defined in section 6 of the Act as follows:

6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,

- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.

14. The mark relied on by the opponent is an earlier mark by virtue of section 6 of the Act. It has a registration date of 5 January 2001 which is more than five years before the date of publication of the application (26 October 2007). That being the case, section 6A of the Act is also relevant. It reads:

6A (1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

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

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

(5) .....

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

(7)....”

15. Also of relevance is section 100 of the Act which states:

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

16. In reaching a decision under section 6A(1)(c) of the Act I take into account that the relevant period is the five year period ending with the date of publication of the application, i.e. 27 October 2002 to 26 October 2007.

17. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003]RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

-genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

18. Nothing in the evidence provides me with any information which establishes e.g. the opponent's turnover or advertising under the mark. That said, some of the invoices exhibited at PA6 and PA7 show sales under the mark within the UK at various dates between 30 April 2003 and 31 August 2005 which is within the relevant period. Whilst I have no evidence which would allow me to put those sales into context in terms of the market as a whole, there is nothing to suggest the sales are in any way token. This evidence has not been challenged by the applicant and I am satisfied that the opponent has shown genuine use of the mark. The issue to be determined is on what goods such use has been shown.

19. The earlier mark relied on by the opponent is for the mark CALYX which is registered for the following goods of class 9: *Telecommunications monitoring and management systems, parts and fittings therefor; computer software for all the aforesaid systems*. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification. The court said:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for

a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for “motor vehicles” only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to “dig deeper”. But the crucial question is—how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox’s Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox’s Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

20. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco Whites’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the “fair description” is



one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within this description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday, nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

21. I have to decide upon what goods the mark has been shown to have been used, who the average consumer is for those goods and how that average consumer would describe those goods. The evidence shows use on a reporting tool in the form of a software package. Whilst it is said to have been designed for use in small and medium sized call centres and for use with Siemens’ equipment I do not consider it should be so defined as this would be “pernickety”. The software is intended to provide the operator with management information. The average consumer of such goods is a business operating a call centre. Taking all factors into account I consider a reasonable description of the goods is *call centre management software*.

22. I therefore go on to consider the objection under section 5(2)(b) based on these goods.


23. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen 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) 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 v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) 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;
- (g) in determining whether similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer inc*;
- (h) 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;
- (i) 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*, paragraph 41;
- (j) 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;
- (k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*;
- (l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L Laudato & C. Sas v OHIM*.

24. For ease of reference I set out the respective marks below:

Applicant's mark	Opponent's mark
	<p style="text-align: center;">CALYX</p>
<p><i>Class 37</i>  <i>Installation and maintenance of computer and communications equipment and Local Area Networks and Wide Area Networks;</i></p> <p><i>Class 41</i>  <i>Education and training relating to computing, networking, and communications, e-learning, and soft skills training;</i></p> <p><i>Class 42</i>  <i>Computer consultancy and design services relating to Local Area Networks, Wide Area Networks, database management systems, management systems, information and communications technology, business applications, post-implementation support and technology development.</i></p>	<p><i>Class 9</i>  <i>Call centre management software.</i></p>

### Similarity of goods and services

25. The principles for determining the similarity of goods and services are well established and set out in the *Canon* case (supra) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] RPC 281. The criteria identified in the *Treat* case for assessing similarity between goods and services were:

- (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, taking into account how goods/services are classified in trade.

26. In *Canon*, the ECJ accepted that all relevant factors should be taken into account including the nature of the goods and services, their intended purposes, their method

of use and whether they are in competition with each other or are complementary. Clearly, not all factors will be equally relevant in all cases.

27. The concept of the complementary nature of goods and/or services has been dealt with by the CFI on a number of occasions. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-325/06 the CFI stated:

“82 It is true that goods are complementary if 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 ”.

28. I also take note of the guidance given by Jacob J. in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

29. Bearing in mind the above general guidance, I go on to compare the respective goods and services.

30. The opponent's goods are software packages likely to be sold through specialist software suppliers or through suppliers of telephone systems. Whilst almost everyone uses telecommunication systems in one form or another almost every day, few members of the general public will require any particular monitoring or management of them. These systems (and their components) are most likely to be used where the volume of traffic using the particular form of telecommunication is much higher and therefore the relevant consumer is likely to be a business operating a call centre and wanting to ensure its telecommunications are handled effectively or wanting to extract relevant information e.g. to monitor staff performance or help shape future business strategies.

31. Considering, firstly, the applicant's services in class 37, computer and communications equipment are used by increasingly large numbers of the population and thus those using related installation and maintenance services could be members of the general public or businesses. The specification in this class also includes services for the installation and maintenance of local or wide area networks (LAN/WAN). As these are networks linking multiple computers they are more likely to be used by businesses. Installation and maintenance services are supplied through specialist suppliers and may also be supplied through more general electrical stores. Computers and communications equipment, whether a single apparatus or a LAN/WAN, are hardware. Whilst hardware and software differ in their nature, one is clearly complementary to the other in that neither can operate without the other. It is usual, in my experience, for some software to be preloaded onto the hardware before delivery to the customer and software may be reloaded or upgraded during maintenance of this equipment. I therefore consider there to be a fairly high degree of similarity between the respective goods and services.

32. As far as the applicant's services in class 41 are concerned, these are education and training services. They will be used by those needing to be trained in the particular skills and, whilst they may be used by the general public, they are more likely to be used by business users. They may be provided in many forms, e.g. in a classroom environment but may also be provided through e.g. computer-based training. I am aware that software users are often provided with practical "at the desk" training allowing them to become familiar with using that software, particularly where the software is of a specialist nature as indeed the opponent itself claims to have done. I consider there to be a reasonable degree of similarity between the respective goods and services.

33. The applicant's services in class 42 are very technical and most likely to be provided to business users. Consultancy and design of these systems is likely to involve the creation of bespoke systems to suit the individual customer's requirements and could include the provision of this service to call centres. Again, in my experience, these services also frequently include the supply of the equipment itself and thus there is a fairly high degree of similarity between the respective goods and services.

#### **Relevant consumer and the purchasing act**

34. As per the comments in *Sabel (supra)*, I have to judge matters through the eyes of the average consumer. I have already found that all of the goods and services are likely to be bought by business users though the installation and maintenance of computer and communications equipment could also be bought by the general public. The costs of the goods and services will vary with a software package likely to be much cheaper, relatively speaking, than the design and installation of a bespoke computer system.

35. None of the goods and services are likely to be bought on impulse; instead they are specialist ones bought on an infrequent basis. They are likely to be a considered purchase which may involve a degree of pre-contract discussion taking place. Thus the visual and aural considerations are likely of greater impact though that is not to say that the conceptual aspect will be of no importance.

#### **Comparison of marks**

36. When considering this aspect, I must take into account the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components. The application is for a series of two marks. One of the two is presented in colour but is not limited to colour so, for the purposes of comparison, I intend to treat them as a single mark.

37. The earlier mark is for the word CALYX appearing in plain block capitals. This word, albeit with only its initial letter capitalised, also appears in the mark applied for which is presented in a very slightly stylised font but is still most certainly the word CALYX. This mark also contains a device.

38. Where marks employ a common element, competing considerations are likely to come into play in determining the proper outcome. In *10 Royal Berkshire Polo Club Trade Mark*, [2001] RPC 32, Mr Hobbs QC, sitting as the Appointed Person, said:

“31..... I am satisfied that the use of the word POLO as part of the applicant’s mark does not capture the distinctiveness of the opponent’s earlier trade marks [POLO]. I do not think that people exposed to the use of the applicant’s mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB. The message of the mark comes from the words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things.”

39. The weight of other matter and the context in which the common element occurred was sufficient in that case for the Appointed Person to hold that consumers’ attention would not focus on the element POLO to the point where the marks would be regarded as sharing a distinctive character.

40. In *Cardinal Place Trade Mark*, BL O/339/04, Mr Hobbs QC, again acting as the Appointed Person, had before him the mark CARDINAL (and small device) and CARDINAL PLACE. He held that:

“15. The perceptions and recollections triggered by the earlier mark are likely to have been ecclesiastical whereas the perceptions and recollections triggered by the Applicant’s mark are likely to have been locational as a result of the qualifying effect of the word **PLACE** upon the word **CARDINAL**. A qualifying effect of that kind can be quite powerful as indicated by the examples cited in argument on behalf of the Applicant: **SOMERSET** as compared with **SOMERSET HOUSE**; **COUNTY** as compared with **COUNTRY HALL**; **CANARY** as compared with **CANARY WHARF**.”

41. He posed the following question:

“17. So why should it be thought that the visual, aural and conceptual differences are sufficiently significant to render the marks distinguishable, but not sufficiently significant to enable them to be used concurrently without giving rise to a likelihood of confusion? This, to my mind, is the critical question. The answer to it depends upon how much or how little the word **PLACE** would be likely to contribute to the distinctive character of the mark **CARDINAL PLACE** taken as a whole.”

42. His conclusion was that the overall effect and impact of the combination CARDINAL PLACE was sufficiently different to the word CARDINAL on its own that the two marks could be used concurrently without giving rise to a likelihood of confusion.

43. In Case T-22/04 the Court of First Instance (CFI) annulled the decision of OHIM’s second Board of Appeal in a case involving the marks WESTLIFE and WEST. In its judgment the Court said:

“37. It must also be borne in mind that the Court of First Instance has already held that, on an initial analysis, where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar (Case T-286/02 *Oriental Kitchen v OHIM – Mou Dybfrost (KIAP MOU)* [2003] ECR II-0000, paragraph 39).

38. In this instance one of the two words which alone constitute the word mark applied for is actually identical in appearance to the sole word forming the earlier word mark. Aurally there is a degree of similarity, although the pronunciation of the word ‘west’ is not identical, at least as regards the whole of the relevant public. In this instance, the two words forming the Westlife mark mean something to the relevant public but they do not describe either the goods or services in question or their qualities and therefore do not have any particular connotation in relation to them.

39. Although the approach described at paragraph 37 above is not therefore directly applicable in this case, it must nonetheless be stated that the only visual difference between the two word marks at issue is that one of them contains a further element added to the first. Moreover, as stated above, there is a degree of similarity between the two marks in aural terms and, in particular, in conceptual terms.

40. It must therefore be held, in this case, that the fact that the Westlife trade mark consists exclusively of the earlier West trade marks to which another word, ‘life’ has been added, is an indication that the two trade marks are similar.”

44. The CFI went on to find that the relevant public might consider the mark applied for to be a variant of the earlier mark or at least that there was an economic link between the companies or undertakings marketing goods or services under the marks.

45. It is apparent from these contrasting outcomes that questions of this kind are not susceptible to any single or mechanically applied solution. The test under Section 5(2) is, in essence, whether there are similarities in the trade marks and goods and services which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the trade marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. I should, however, guard against dissecting the respective marks so as to distort the average consumer’s perception of them; the average consumer perceives trade marks as wholes and rarely has the chance to compare marks side by side but must instead rely on the imperfect picture he has of them in his mind.

46. In the *Medion* judgment the ECJ stated:

“29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark use by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

47. And, in *Shaker di Laudato (supra)*, the ECJ stated:

“41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42 As the Advocate General pointed out in point 21 of her Opinion, 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.”



48. I also take note of the decision in *MIP Metro Group Intellectual Property GmbH & Co KG v OHIM* T-290/07 where the CFI stated:

“ For the purpose of the global assessment of the likelihood of confusion, the overall impression created by the two signs at issue must be considered (Case C-206/04 P *Mulhens V OHIM* [2006] ECR I-2717, paragraph 23, and Case C -234/06P *Il Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraph 37) and the signs’ aural, visual and conceptual similarities must be weighed up, taking into account factors such as, in particular, the nature of the goods or services, the way they are marketed and the public’s level of attention. In that regard, it should be pointed out that, although there will not necessarily always be a likelihood of confusion where two signs are found to be only aurally similar, it is nevertheless conceivable that the marks’ aural similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94. However, the conceptual, visual and aural similarities between the signs at issue and the assessment of any aural similarity is only one of the relevant factors for the purpose of that global assessment (*Mulhens v OHIM* paragraphs 21 and 23; see also, to that effect, *Il Ponte* as before paragraphs 35 and 37; and Joined cases T-117/03 to T-119/03 and T-171/03 *New Look v OHIM –Naulover (NLSPORT, NLJEANS, NLACTIVE and NLCollection)* [2004] ECR II-3471, paragraph 49.”

49. The earlier mark consists exclusively of the word CALYX in block capitals. This same word appears in the marks applied for, albeit with only its initial letter capitalised. The marks also contain a device element positioned above the final two letters of the word. The word CALYX is larger than the device element and, visually is the dominant element within the mark but that is not to say the device element is negligible. From a visual perspective there is a reasonably high degree of similarity between the marks. From an aural perspective, the similarity is even higher given that the device element appearing in the mark applied for will not be articulated.

50. From a conceptual viewpoint, the device element, whilst not negligible, does not, in my view, have any readily identifiable meaning though it is somewhat reminiscent of searchlights in an X shape within an elongated oval background. I do not think the device adds anything to the conceptual image behind the marks. The word CALYX is a dictionary word though not perhaps one used in everyday language due to its relatively technical meaning. For many it will be considered an invented word and therefore conceptually neutral. For those who recognise it to be a part of a flower or a type of cavity with the body, the word forming or within the marks will be conceptually identical.

51. The applicant admits the respective marks are similar. I consider them to be highly similar.

### **Distinctiveness of the earlier mark**

52. I also have to take into account the distinctive character of the earlier mark having regard to its inherent characteristics and the reputation it enjoys with the public in respect of the goods for which I have found it to be used. There is nothing within the evidence which enables me to ascertain the extent of that use or its place

within the relevant market. I am therefore unable to find on the evidence that the distinctiveness of the mark has been enhanced through its use. That said, I consider the mark has a very high degree of inherent distinctiveness.

### **Likelihood of confusion**

53. In reaching a decision on whether there is a likelihood of confusion I must make a global assessment based on all relevant factors. I have already found the goods and services to be at least reasonably similar and I have found the marks to have a reasonably high degree of visual similarity and a very high degree of aural similarity. I have found the marks to be conceptually neutral or identical depending on the knowledge of the average consumer. Taking all factors into account, and on a global appreciation, I consider there is a likelihood of confusion and the opposition based on section 5(2)(b) of the Act succeeds under this ground in respect of all of the services of the application.

### **The objection under section 5(3) of the Act**

54. Section 5(3) of the Act reads:

(3) 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 Community trade mark or international trade mark (EC) in the European Community) 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.

55. The opponent relies on the same earlier right as it did under section 5(2)(b) and is required to show that the mark relied on has a reputation in the UK. As set out in paragraph 52 above, there is nothing within the evidence which enables me to ascertain the extent of the use of the mark or its place within the relevant market and therefore the opponent has not shown it has the requisite reputation in the mark. That being so, the objection under section 5(3) falls at the first hurdle and is therefore dismissed. Even if I had gone on to consider the objection on this ground the opponent would not have been in any stronger a position than that under section 5(2)(b).

### **The objection under section 5(4)(a) of the Act**

56. Section 5(4)(a) of the Act reads:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(b) ....

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

57. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person, in *Wild Child Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- 1) That the opponent’s goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- 2) That there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicant are goods of the opponent; and,
- 3) That the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

58. I need to determine the material date at which this objection must be judged. The opponent relies, under this ground, on use of the mark CALYX since an unspecified date in 1999 in respect of “computer software for telecommunications monitoring and management systems and in particular for call centre systems”. A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the Court of First Instance in *Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* joined cases T-114/07 and T-115/07. In that judgment the CFI stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000”

I apply that reasoning to these proceedings. This means that the material date at which the matter must be judged is the filing date of the application in suit, that it to say 11 February 2005.

59. Here again the opponent is in some difficulty in that I am unable to establish, from the evidence, the extent of any goodwill and reputation in the mark at the relevant date. That being so, the objection under section 5(4) is also dismissed.

Again had I considered this objection further the opponent would not have been in any stronger position than that under section 5(2)(b).

### **Costs**

60. The opponent has been successful, albeit on only one ground on which the opposition was brought, and is entitled to an award of costs in its favour. In line with the scale of costs set out in Tribunal Practice Notice 6/2008 I award costs on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Preparing and filing evidence:	£500
Preparing written submissions and considering the other side's written submissions:	£300
Total:	£1200

61. I order Calyx Limited to pay The Callista Group Limited the sum of £1200. 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 17 day of December 2009**

**Ann Corbett**

**For The Registrar  
The Comptroller-General**