

O-213-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2440234
IN THE NAME OF BESTOUTCOME LIMITED

AND

OPPOSITION THERETO UNDER NO 96394
BY PROJECT MANAGEMENT INSTITUTE, INC

Background

1. Application No. 2440234 is for the trade mark PM3 and has a filing date of 1 December 2006. It stands in the name of Bestoutcome Limited (“BOL”) and, as originally filed, sought registration of various goods and services in classes 9 and 42.

2. Following publication of the application in the *Trade Marks Journal* on 23 November 2007, Notice of Opposition was filed on behalf of Project Management Institute, Inc. (“PMI”). The single ground of opposition is based on section 5(2)(b) of the Act and in support of this ground PMI relies on the following community trade mark:

Mark	No	Specification of goods and services
OPM3	3299476	Goods and services in classes 9, 16 and 35

3. The mark relied upon by PMI has a registration date of 8 February 2005 and is an earlier mark. But this date is less than five years before the date of publication of the application in suit. That being the case, the provisions of Section 6A of the Act do not apply and PMI is not required to prove use of its earlier mark.

4. BOL filed a counterstatement in which it claimed, essentially, that neither the respective marks nor respective goods and services were similar. On 29 October 2009 BOL sought amendment of the specification of its application (which, PMI indicated, did not overcome the opposition) and registration is now sought only in respect of the following specification of goods in class 9:

Computer software and computer programs relating wholly to management and the provision of business information

5. Only BOL filed evidence. PMI filed written submissions dated 8 May 2009 and 3 August 2009. BOL filed written submissions on 6 October 2009. Neither party requested to be heard. I therefore give this decision after a careful review of all of the material before me. I do not intend to summarise either the evidence or submissions but will refer to it as necessary in this decision.

The law

6. As indicated above, there is a single ground of opposition based on section 5(2)(b) of the Act. This reads:

(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.

7. 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 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723. 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) 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 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*, 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.

8. In essence the test under Section 5(2)(b) is whether there are similarities in the marks and the goods and services which, when taking into account all the surrounding circumstances, 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 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.

Comparison of goods and services

9. Whilst PMI relies on goods and services in classes 9, 16 and 35, I intend to carry out the comparison in relation to the goods as appear in class 9 as, in my view, this represents PMI’s best prospect of success. If they fail in respect of these goods they will be in no better position in relation to the remaining goods and services. That being the case the respective goods to be compared are as follows:

BOC’s application	PMI’s earlier mark
Class 9 Computer software and computer programs relating wholly to management and the provisions of business information	Class 9 Electronic publications, especially reference books featuring project management standards recorded on computer media; computer applications for determining the project management capabilities of individual businesses and government organizations, and software related to project management

10. PMI submits that each of the respective specifications of goods includes computer software and that:

“the goods applied for in the now restricted Application are either identical or similar with the goods or services covered by the Opponent’s registration.....The nature of the goods and/or services is identical in that the respective marks relate to project management software and related services and this similarity is compounded by the specialist and technical nature of project management software services”.

11. For its part, BOL does not dispute that both specifications of goods include computer software but says they are not identical or similar goods because its product:

“is a management tool designed to assist an organisation’s entire project portfolio for realisation of maximum commercial benefits. It helps ensure that the consumer has a consistent view of projects across the portfolio, detects and addresses “at risk” programmes and projects increasing the efficiency and effectiveness, in both cost and time, of the portfolio.”

12. I am required to consider the issue on a notional basis across the goods as registered and applied for and not just on the goods on which the marks may have been used. In doing so I take into account the well established guidance given in *Canon (supra)* and in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281. In short, I am required to consider the nature of the goods, the users, the uses/intended purpose, the channels of trade and issues as to whether the goods are complementary or in competition with one another.

13. “Computer programs”, “software” and “computer applications” are all synonyms for “computer software”. That being the case, each of the respective specifications include computer software (in BOL’s case, exclusively so), however, that does not necessarily mean that identical goods are involved. In *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850, Laddie J said:

“In my view the defining characteristic of a piece 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.”

14. BOL’s computer software as applied for is limited to relate “wholly to management and the provisions of business information”. In contrast, PMI’s software is limited so as to “relate[-] to project management” or “for determining the project management capabilities of individual businesses and government organizations”.

15. In *Gérard Meric v OHIM* Case T-133/05 it was held that goods can be considered as identical when those designated by an earlier mark are included in a more general category designated by a later trade mark application (and vice versa).

16. “Management” is a broad term which covers e.g. the identification, planning organising, use and supervision of various resources, whether across the board or for a specific assignment. “Project management” has become a somewhat fashionable term in business over the years but also means the identification of, planning, organising, use and management of various resources usually so as to achieve specific goals. In my view the term “project management” is a sub category of “management” and thus these are identical goods. BOL’s application also includes software relating to the “provisions (sic?) of business information”. In my view, the management of a business is likely to involve the identification, collection and distribution of information about that business or its wider environment (and possibly other businesses) and thus these are also identical goods.

The relevant consumer and the purchasing act

17. Given the respective goods are computer software relating to management (whether management per se or more specifically project management) and business information, it is most likely that the relevant consumer would be a business. Whilst computers and related software are almost ubiquitous, and, perhaps, more especially so in business, these are technical goods which, by their nature, have very specific purposes in terms of their subject matter. This, coupled with the fact that they are likely to be bought by business users, indicates that they will be a considered and potentially costly purchase, with those responsible for buying them likely to spend time researching to ensure the product suits their business's needs. This is both from the wider commercial sense of ensuring it will do what he wants it to do and but also from a technical view in ensuring it is compatible with whatever systems may already be in use.

Comparison of marks

18. For ease of reference, I set out below the respective marks to be compared:

BOL's application	PMI's earlier mark
PM3	OPM3

19. Clearly, each mark is made from a combination of letters and a numeral. Whilst letters have different purposes or uses to those of numerals, which may lead to a degree of separation between the letters and numerals appearing in the respective marks, I do not consider the marks to have any dominant or distinctive components. Rather, the distinctiveness of the marks rests in the marks as wholes.

20. In its written submissions PMI says of the marks:

“It has to be noted that only their beginnings are different”

and that the two letters and one numeral making up BOL's mark are:

“replicated exactly as they appear in the Opponent's mark” .

21. For its part, BOL says:

“The addition of the letter O at the beginning of the Mark exacerbates the differences between the two Marks...Emphasis is place (sic) on the beginning of a word... with the remainder of the Mark of lesser significance...”

22. There is no dispute that the whole of BOL's mark appears in the earlier mark and that the only difference between them is the addition of the letter O at the beginning of that earlier mark. However, each of the respective marks is a relatively short one consisting, as they do, of just three and four characters. That being the case, even small differences will be noticed, particular where the difference appears at the beginning of the mark. Taking all matters into account, I am of the view that the marks have a degree of similarity from a visual perspective but that there are also clear differences.

23. Similar considerations apply when judged from an aural perspective. In my view, as the marks are made up of characters which do not form pronounceable words, the marks will be pronounced as individual characters with the earlier mark being one character longer than the mark for which registration is applied. It is the initial letter which differs, a difference that is likely to be clearly articulated given its position. Again, I am of the view that the marks have a degree of similarity from an aural perspective but that there are also clear differences.

24. In relation to the conceptual comparison, PMI submit:

“[T]he earlier mark...is to be found on the World Wide Web in relation to the provision of project management services, referring to the trade mark owned by the Opponent. The contest mark...can also be found on the World Wide Web in relation to the provision of the same services provided by the Applicant, and thus the marks are conceptually identical. In both marks the letters “PM” stand for “project management”....[I]t is foreseeable that the acronyms are and would be understood by members of the project management industry and by those seeking project management services, especially since the acronyms relate directly to the goods...to which they apply. ...The “O” in OPM3 stand for “Organisational” but since both the Opponent and Applicant supply goods and services to organisations or are seeking to analyse and enhance project management capabilities and functions within organisations, the “O” therefore does not have any predominant significance over the suffix “PM3” in the Opponent’s mark”.

25. Perhaps not surprisingly, BOL challenge this submission and say:

“this argument is devoid of logic. The fact that both Marks are found on the World Wide Web is an indication of the marketing, sales and publicity demanded of modern businesses and products and clearly has no relevance to the conceptual derivation of use of the Marks discussed...[PMI] argues in one line that the public at large will not understand the acronym of PM, and in the next line that it is entirely likely that the general public will be confused because they are “entirely likely” to be consumed because they will understand the acronym and relate it to the goods...[PMI] argues that the letter O carries little prominence with the relevant consumer because the average consumer will understand the acronym PM and as the O stands for Organisational when the goods ...relate to organisations. [BOL] contends these points and argues to the contrary that it is the O that distinguishes between the Marks as the average consumer will understand the acronym and thus the unusual inclusion of the letter O in the Mark will differentiate between [them]. Further, the “general public” is not the correct testing ground...”

26. In my view the average consumer for the goods will recognise each of the respective marks as being an acronym and presume the letters and numeral making up each mark “means” something in the context of the relevant goods. Those responsible for coining the marks may have done so with a specific meaning in mind. However, whilst some may hazard as guess as to the meaning of each of the marks

(and may arrive at something which may or may not differ from that intended by those coining them), I am far from convinced that the average consumer will bring anything particular to mind. I consider the marks to be conceptually neutral.

Distinctive character of the earlier mark

27. I also have to take into account the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the relevant public. PMI submits its earlier mark is:

“highly distinctive for the purposes of this test given that it is an acronym, the fact that it incorporates the numbers “3” and the specialist nature of the goods...to which it relates”.

28. BOL reply that the mark

“is not “highly distinctive” because...two of the four letter (sic) of the Opponent’s Mark refer to an acronym well known in the relevant industry for project management”.

29. As I indicated above, the earlier mark consists of a combination of letters and a numeral and that whilst there may be a degree of separation, in the mind of the average consumer, between the letters and the numeral, I do not consider the mark has any dominant or distinctive components. The mark will be seen as a whole with the distinctiveness resting in that whole. And, whilst the goods covered by the registration are related to project management for which the letters PM may well be a recognised acronym, I do not consider these letters “stand out” in any way from the other letter and the numeral within the mark. The combination of three letters and a single numeral appears to be a somewhat random grouping and when considered as a whole the mark has an average level of inherent distinctive character.

30. As I indicated above, PMI filed evidence. It comes in the form of a witness statement from Lawrence E Bull who is PMI’s Director of Organization Products, a post he has held since January 2008. Mr Bull says that PMI was founded in 1969 and “currently” has around 300,000 members in over 170 countries. The “UK chapter” was established in 1995 and has approximately 5,500 individual members. The earlier mark is said to have been used for the first time in the UK in 1999 and to have been used continuously since then in relation to the sale of books, CDs and online tools. From November 2005 the CD was replaced by an online tool. Mr Bull says that total worldwide payments to PMI are in the region of \$275,460. Turnover in the UK since 2003 is given as, approximately, \$36,566 in relation to books, CDs and online tools but this figure is not broken down in any way between these particular goods. Turnover in relation to training and certification (which is not explained further) amounts to approximately \$35,000.

31. Mr Bull says that its customers in the UK include individuals, organizations and governmental departments though he gives no further details of how many customers it has or who these might be. He also says that there are “presently” four individuals in the UK who have been tested and certified as consultants though he

does not say whether or not these people are actively practising and if so, what their roles involve.

32. Mr Bull says that the earlier mark has been promoted throughout the UK and that it promotes it via its website. Articles are also said to have been run periodically in the company's own publications which are distributed to its members. He confirms that he "presented on the subject of OPM3 at Project UK, the semi-annual project management event of the International Project Management Association (IPMA) in March of 2007" though gives no details of where this took place, who may have been in attendance or what form the presentation may have taken.

33. The evidence suffers from a number of defects. The turnover figures are not broken down in such a way that I can apportion it to particular goods or period of trading. No details are given of how the mark might have been promoted on the PMI website, nor are details given of e.g. whether that material has been accessed (and if so the volume of that access). The published articles (which are not exhibited) have not been on general circulation but instead are said to have been distributed to members though again, no details of these are given. In short, whilst I accept (and it is not disputed) the earlier mark has been used, I am unable, on the basis of the evidence before me, to find that its distinctiveness has been enhanced through the use made of it.

Likelihood of confusion

34. In determining whether there is a likelihood of confusion, a number of factors must be borne in mind. There is the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the goods and vice versa. There is the distinctive character of the earlier trade mark as the more distinctive it is (either inherently or through use) the greater the likelihood of confusion. I must also keep in mind the average consumer for the relevant goods and the nature of the purchasing decision.

35. I have found that whilst there is a degree of similarity between the respective marks from both a visual and aural perspective there are also clear differences between them. I have found them to be conceptually neutral. I have also found that the earlier mark is of average distinctive character which has not been enhanced through its use.

36. I have found that identical goods are involved. In my view, the goods are such that the average consumer will pay a very high degree of attention to them when selecting them given their nature, technical requirements as to content, purpose and compatibility with existing systems and the likely cost both in terms of actual expenditure on purchase and the implications for the future running of the business whether those goods are bought online for download or in a physical sense.

37. Taking all factors into account and applying the global approach as I am required to do, I have come to the conclusion that there is no likelihood of either direct or indirect confusion. In my view the differences between the respective marks outweigh the similarities even where identical goods are concerned.

38. The opposition based on section 5(2)(b) of the Act fails.

Costs

39. The opposition having failed, BOL is entitled to an award of costs in its favour. I take account of the fact that minimal evidence was filed (and by one party only) and that the decision has been reached without a hearing taking place. I award costs on the following basis:

Considering Notice of opposition	£200
Preparation of and filing counterstatement	£300
Consideration of evidence	£400
Preparing and reviewing written submission	£400
Total	£1300

40. I order Project Management Institute, Inc to pay Bestoutcome Limited the sum of £1300 as a contribution towards its costs. This 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 should any appeal against this decision be unsuccessful.

Dated this 1st day of July 2010

**Ann Corbett
For the Registrar
The Comptroller-General**