

O-130-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2533133
BY IMPACT MEDIA LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS
Impact Media
ImpactMedia
IN CLASS 35**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 100324 BY
IMDMS LIMITED**

BACKGROUND

1) On 1 December 2009 Impact Media Ltd (hereinafter the applicant), applied to register the following trade marks:

Number	Mark	Filing Date	Class	Specification
2533133	Impact Media ImpactMedia A series of two marks	01.12.09	35	Search engine optimisation, marketing and/or submission services; marketing and promotional services; Internet marketing services; advertising; production of marketing, promotional and advertising matter and materials; advisory, consultancy and information relating to the above.

2) The application was examined and accepted, and subsequently published for opposition purposes on 1 January 2010 in Trade Marks Journal No.6817.

3) On 25 March 2010 IMDMS Limited (hereinafter the opponent) filed a notice of opposition. The ground of opposition is in summary:

- a) The opponent, and its' predecessors in business have, since 2003, used the trade marks Impact Media Design and Impact Media in relation to design, marketing, print and advertising services. It states that the goodwill was transferred. The opponent claims that the application offends against Section 5(4)(a).

4) On 23 April 2010, the applicant filed a counterstatement which denied the opponent's claims. The applicant puts the opponent to strict proof of its claims, including the transfer of the goodwill.

5) Both parties filed evidence, and both seek an award of costs in their favour. The matter came to be heard on 23 March 2011. At the hearing, the opponent was represented by Ms Edwards-Stuart of Counsel; the applicant was not represented but did provide written submissions which I will take into account in my decision.

OPPONENT'S EVIDENCE

6) This consists of six witness statements. The first, dated 26 July 2010, is by James Coates. He states that he began a business as a sole trader in 2003. On 18 October 2006 IMDMS was incorporated and since this time he has been a director of this company. Both businesses traded under the names IMPACT MEDIA DESIGN, and IMPACT MEDIA. At the time that IMDMS was formed and took over the existing business Mr Coates intended that it should benefit from any goodwill and reputation that he had built up in the three years of existence. However, this was not formalised until 23 March 2010 when a retrospective assignment of goodwill was signed.

7) He states that initially when he began as a sole trader he still had a full time job. He carried out the design, marketing and web-design work for his new business as well as printing leaflets

and posters to promote his business in his spare time. He also devised the name Impact Media but as the domain name for this name was not available he purchased the domain name for Impact Media Design, on 29 September 2003 and began using this name. Another domain name, “i-m-d.co.uk” was acquired on 26 July 2004. Mr Coates states that in October 2004 he left his full time job and worked on “developing company literature and building marketing databases for the company launch” as well as carrying out freelance work for other companies. He goes on to describe in considerable detail the steps taken to build up the business, such as getting a national (0870) phone line, putting advertisements in Yellow pages and putting up posters in and around the area that he lived. He states that the bank account he had set up for the business took its first payment in August 2005.

8) Mr Coates states that he waived his design fee with regard to the printed marketing material in order to “push sales”. In March 2006 the business registered for VAT and in May 2006 moved to its own premises. In October 2006 the Limited company was set up by Mr Coates and his brother. Also included were the following exhibits:

- 7 August 2004: IMD website offered to design websites, business cards, logos, posters and also a printing service. Exhibits 5 & 6.
- October 2004: An eBay account was opened by Mr Coates t/a Impact Media Designs (IMD) selling logos and printed marketing material. Exhibit 4.
- January 2005: The IMD website offers print and design solutions. Exhibit 10.
- March 2005: A national (0800) landline established. Exhibit 12.
- 6 July 2005: An invoice, which seeks payment of £275 to Impact Media Design in relation to the provision of a website and a domain name. Exhibit 27.
- August 2005: Advertisement in YELL by IMD purchased. Exhibit 24.
- August 2005: Bank Account under IMD opened. Exhibit 26
- October 2005: Quote for website design. Exhibit 15.
- October 2005: IMD website offering website design and hosting, domain name registration, Search Engine Optimisation (SEO), pay per click advertising and email and web forwarding. Exhibit 39 & 47.
- November 2005: Advertisement in the Island Times, a local newspaper. Exhibit 23.
- January 2006: IMD named on website of Approved Index.co.uk as one of four leading SEO companies. Exhibit 49.

9) The second witness statement, dated 26 July 2010, is by Martin Geoffrey Coates a director of the opponent company. He confirms much of James Coates evidence. He states:

“Search Engine Optimisation (SEO) increases a website’s online presence by both ensuring that the website is picked up by as many search engines as possible and also improving a website’s ranking by a particular search engine so that it appears near the top of the list of search results.”

10) He states that prior to the incorporation of the opponent company, both he and his brother James Coates worked as sole proprietors. However, they often carried out work for each other due to their different skills. Initially, most of this work was done without payment but on occasion they would invoice each other. At exhibits 3-5 inclusive he provides copies of invoices from himself to his brother, dated 5 September 2005, 17 September 2005, 9 October 2005, 24 October 2005, 9 November 2005 and 22 November 2005; and also copies of invoices from James Coates to Martin Coates dated 2 December 2005 and three dated 9 December 2005. In each instance the invoices were on headed notepaper with “A Computer Specialist” for Martin’s business and “Impact Media Design” for James’ business. He states that Impact Media Designs’ online presence attracted business from all over the UK as by this time it was offering website design, search engine optimisation, pay per click marketing and the production of marketing material in the form of advertisements and online banners. Because Impact Media Design was doing so well Martin Coates took the decision to wind up his business and go into Impact Media Design. Subsequent to the launch of the limited company they have had to move to larger premises twice and have taken on a number of employees to assist to the increasing business. They have also expanded into social network marketing on Facebook and Twitter.

11) The third witness statement, dated 23 July 2010, is by Fred O’Brien who runs his own business called Tax Assist Accountants on Canvey Island. He states that he first came into contact with Impact Media in 2005 when he provided advice to James Coates. Mr O’Brien prepared the accounts for Mr Coates as a sole trader and has continued after IMDMS Ltd was formed. He has also advised on VAT matters and on the issue of the transfer of goodwill from Mr Coates as a sole trader to the limited company.

12) The fourth witness statement, dated 28 June 2010, is by Dawn Sherry who up until at least the end of 2006 worked in two shops on Canvey Island. She states that her shop used to run fashion shows to support local charities and that Impact Media provided free marketing and advertising material in order to promote its business.

13) The fifth witness statement, dated 28 June 2010, is by Charlotte Lee who, since 2005 has operated a hair salon. She states that Impact Media have carried out the design and marketing of her company since its inception and continues to do so up to the date of her statement. She states that at the time of writing the opponent is building a website for her company.

14) The sixth witness statement, dated 22 July 2010, is by Rodney Hall who owns a company called Design 4 Print. He states that his company has acted as a supplier of leaflets, stationery and printed marketing material for the past seven years to Impact Media. He states that Impact

Media have carried out a variety of design jobs for his company as well as redesigning their website.

APPLICANT'S EVIDENCE

15) The applicant filed a witness statement, dated 6 September 2010, by Ben Norman the Managing Director of Impact Media Ltd. He states that his company was formed on 21 February 2006, prior to this he worked as a sole trader as an SEO Consultant under his own name. He states that he became well known in the industry and became the number 1 in Google for the term "SEO Consultant" where he remains to this day. He states that prior to forming his company he reviewed the Internet and no-one was actively using the name IMPACT MEDIA in the sectors in which the opponent trades. In April 2006 the opponent purchased the domain names www.impactmedialtd.co.uk and www.impactmedialtd.com. Mr Norman states that he increased the search engine optimisation of the Impact Media website so that it achieved high placements in search engines. They also had their details listed in various directories and signed up for many industry specific associations. In July 2006 the company moved out of Mr Norman's home into offices and they have moved three times since due to expansion of the workforce. He then goes on to detail the various stages of development of the company up until the date of his statement. However, this is of no assistance to me in my decision.

OPPONENT'S EVIDENCE IN REPLY

16) The opponent filed a witness statement, dated 17 November 2010 by James Coates who has provided an earlier statement in this case. He also provides the following exhibits:

- Exhibit 60: Membership subscription documentation in relation to the Federation of Small Businesses dated 12 July 2006 by Mr Coates.
- Exhibit 62: Invoice, for £3,150, dated 7 November 2008 from Echo Newspapers to Impact Media Design regarding sponsorship of business awards.
- Exhibit 66: Invoices for £1495 and £1,175, dated 8 April 2009 and 8 April 2010, from Newsquest to Impact Media Design regarding corporate sponsorship of Essex Business Awards.
- Exhibit 75: An invoice for £287.50 for monthly Search Engine Optimisation, dated 1 December 2009, from Impact Media Design to Jet Tyres Ltd

17) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

18) The only ground of opposition is under Section 5(4)(a) of the Trade Marks Act 1994 which 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

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.”

19) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

20) I also note the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)*, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

21) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

“Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

22) First I must determine the date at which the applicant’s claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*) Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“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.”

23) In its evidence the opponent claims to have first used its mark when trading as a sole proprietor in the period 2003- October 2006. It is stated in the evidence of Mr James Coates that the goodwill he gained during his time operating the business as a sole trader he invested into the

new limited company when it was set up. To avoid any doubt on the matter an assignment of the goodwill was signed just prior to the opposition being filed in 2010. I regard the assignment as being retrospective, a term which Ms Edwards-Stuart resisted. She stated at the hearing that the intention of Mr Coates at the time of the incorporation in 2006 was clearly set out in his witness statement and that the assignment was merely formalising the situation. However, as a precaution she also requested at the hearing that Mr James Coates be joined as a co-opponent. A request which I granted as it was clear from the beginning of the case that the opponent was relying upon use by Mr Coates as a sole trader. I decided that nothing that the applicant could state would change my view on allowing this change and so comment from the applicant was not sought. The applicant states that it first used the term IMPACT MEDIA when it was incorporated on 21 February 2006, prior to this its founder worked as a sole trader under his own name. The relevant dates are therefore 21 February 2006 and 1 December 2009. As the applicant's use must be taken into account as it could, for example, establish that the applicant is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that the applicant's use would not be liable to be prevented by the law of passing-off – the comments in *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer.

24) I shall now consider the evidence of use put forward by the opponents of their use prior to the claimed first use by the applicant on 21 February 2006. Unless otherwise stated the following exhibits were provided by James Coates.

- 7 August 2004: IMD website offered to design websites, business cards, logos, posters and also a printing service. Exhibits 5 & 6.
- October 2004: An eBay account was opened by Mr Coates t/a Impact Media Designs (IMD) selling logos and printed marketing material. Exhibit 4.
- January 2005: The IMD website offers print and design solutions. Exhibit 10.
- March 2005 a national (0800) landline established. Exhibit 12.
- 6 July 2005: invoice for website issued by IMD. Exhibit 27.
- August 2005: Advertisement in YELL by IMD purchased. Exhibit 24.
- August 2005: Bank Account under IMD opened. Exhibit 26
- September 2005 – December 2005: Copies of invoices from Mr Martin Coates t/a A Computer Specialist (ACS) to his brother Mr James Coates t/a IMD, and vice versa. The services provided by ACS were for customers of IMD and vice versa. The services covered website design, Search Engine Optimisation (SEO), Pay per click marketing and the provision of marketing material in the form of advertisements and online banners. Exhibits 3-5 of Mr Martin Coates' statement.
- October 2005: Quote for website design. Exhibit 15.

- October 2005: IMD website offering website design and hosting, domain name registration, SEO, pay per click advertising and email and web forwarding. Exhibit 39.
- November 2005: Advertisement in local newspaper. Exhibit 23.
- January 2006: IMD named on website of Approved Index.co.uk as one of four leading SEO companies. Exhibit 49.

25) I take into account the following when considering the above evidence. The goodwill must be of more than a trivial nature. In *Hart v Relentless Records* [2002] EWHC 1984 Jacob J stated:

“62 In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994 . The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472 . The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

26) However, one does not need to be a large player to be protected under the law of passing-off. In *Stacey v. 2020 Communications Plc* [1991] F.S.R. 49 Mr. Justice Millett said:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

27) I also note that in *Stannard v Reay (Mr Chippy)*[1967] FSR 140 it was held that:

“...even though the plaintiffs had only been trading for about three weeks, there was evidence of substantial takings by the business which fell when the defendants commenced trading. It was not impossible for goodwill in a new kind of business to be built up in a short period of time...”

(I note that the decisions in both *Stacey* and *Stannard* were made in the context of injunctive relief before full trial).

28) Finally, the following comment of Slade LJ in *Chelsea Man Menswear Limited v Chelsea Girl Limited and Another* [1987] RPC 189 is also relevant:

“However, the authorities show quite clearly that a plaintiff who has established a cause of action in passing off can obtain relief by way of injunction extending beyond the boundaries of the particular areas in which he has proved the existence of his reputation and goodwill.”

29) The evidence clearly shows that the opponents used the trade mark Impact Media Design in relation to designing of logos, websites, business cards, posters and promotional items, in addition to the provision of domain names and SEO services. The opponent also offered printing services for the aforementioned items. All these services were offered to customers in the UK prior to the date of application on 1 December 2009 and also prior to the first use of their mark by the applicant, 21 February 2006. I accept that most of the activities took place in and around Canvey Island but their presence on the internet, their national (0800) phone number and advertisements in publications such as YELL also gave the opponent nationwide coverage. However, even if its activities had been confined to a small geographical location this would not have debarred them from having protectable goodwill in the UK. (*Mr Chippy*). I accept that they have not provided turnover figures, or any promotional budgets. However, to my mind the opponent has provided sufficient evidence to prove that at both relevant dates it enjoyed a protectable goodwill in the mark “IMPACT MEDIA DESIGN” in relation to the services listed earlier in this paragraph.

30) The applicant, in its written submissions sought to have virtually all of the opponent’s evidence considered to be irrelevant on the basis, mainly, that the mere existence of advertisements or phone lines etc did not provide goodwill. I believe that this view is too narrow. I agree that considered individually they may not be determinative, but when looked at in totality which includes invoices for the provision of services, they are enough to show that the opponent enjoyed goodwill in its mark. I also note that whilst they have provided submissions on the opponent’s evidence they have not challenged the evidence provided.

31) I now turn to consider the issue of misrepresentation. The first question surrounds the marks of the two parties. The applicant is seeking registration of a series of two marks “Impact Media” and “ImpactMedia”. The opponent has shown that it has goodwill in the mark “IMPACT MEDIA DESIGN”. To my mind, the word “design” in the opponent’s mark carries little weight or significance as it is the last of three words, and refers to a service, design, offered by the opponent. The marks of the two parties must be considered to be very similar.

32) It is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade. The point can be supported by reference to the following passage from Millet L.J.’s judgment in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by Wynn-Parry J. in *McCulloch v May* [1948] 65 RPC 58 when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example,

Eastman Photographic Materials Co. Ltd v John Griffiths Cycle Corporation Ltd (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* (1902) 2 Ch. 282 (The Times Newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing-off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing-off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

33) Also:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

34) And:

“Passing off is a wrongful invasion of a right of property vested in the plaintiff, but the property which is protected in an action for passing off is not the plaintiff’s proprietary right in the name or get-up which the defendant has misappropriated but the goodwill and reputation of the business which is likely to be harmed by the defendant’s misrepresentations.”

35) The applicant has provided fifteen pages of submissions but does not comment upon the similarity of the marks or whether the activities of the two parties are in a common field. For ease of reference the specification applied for and the services for which the opponent has shown goodwill are set out below:

Applicant’s specification	Opponent’s services
Class 35: Search engine optimisation, marketing and/or submission services; marketing and promotional services; Internet marketing services; advertising; production of marketing, promotional and advertising matter and materials; advisory, consultancy and information relating to the above.	Designing of logos, websites, business cards, posters and promotional items, provision of domain names; Search Engine Optimisation services; Printing services.

36) To my mind there is clearly a considerable overlap of the services offered by both parties. Taking into account all of the above I conclude that use and registration of the applicant’s trade mark in relation to these services would result in misrepresentation of the opponent’s mark.

37) I must go on to consider if the opponent has suffered, or is likely to suffer, damage as a result of this misrepresentation. Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL stated that the opponent must show that “he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill”.

38) In the current case, both parties’ marks effectively consist of the words “Impact Media”. Registration of the applicant’s mark would be in respect of services identical or similar to those on which the opponent uses its mark. This being the case, people and traders familiar with the opponent’s services would expect the types of services in paragraph 31 above under the same name to be from the same undertaking that had used that name in the past. I have already found that, as such, there is a real likelihood of deception amongst a substantial number of the relevant public. Taking all this into account and considering the close similarity between the marks, I conclude that the opponent’s goodwill will be damaged in that, the opponent may lose business to the applicant because of the existence of a mistaken belief that the applicant’s services are in fact those of the opponent. It would therefore be deprived of its benefits. Further, if the services are unsatisfactory in anyway, this will result in the public avoiding the opponent’s services in the mistaken belief that it was also responsible for the applicant’s services. The ground of opposition under Section 5(4)(a) in respect of all the services in the applicant’s Class 35 specification succeeds.

COSTS

39) The opponent has been successful in its opposition and is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£300
Preparing evidence and considering and commenting on the other side’s evidence	£600
Preparing for and attending a hearing	£800
Opposition Fee	£200
TOTAL	£1900

40) I order the applicant to pay the opponent the sum of £1900. This sum 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 12 day of April 2011

**George W Salthouse
For the Registrar,
the Comptroller-General**