

O-048-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2549801
BY
EMAP LIMITED
TO REGISTER THE TRADE MARK

GENESIS

IN CLASSES 09, 16, 35, 38, 41 AND 42

AND

OPPOSITION THERETO UNDER NO. 101372
BY
GENESYS TELECOMMUNICATIONS LABORATORIES, INC.

Trade Marks Act 1994
In the matter of application no. 2549801
by Emap Limited
to register the trade mark

GENESIS

in classes 09, 16, 35, 38, 41 and 42
and the opposition thereto
under no. 101372
by Genesys Telecommunications Laboratories, Inc.

BACKGROUND

1. On 9 June 2010, Emap Limited (the applicant) applied to register the above trade mark in classes 09, 16, 35, 38, 41 and 42 of the Nice classification system¹. Following three requests filed on forms TM21 on 13 and 22 December 2010 and 6 July 2012, to amend the specification, the application stands as follows:

Class 09:

Computer software, computer programs, computer databases; data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; CD-ROMs; CDIs; publications in electronic form but not including any publications relating to religion or rock music, supplied on-line from databases or from facilities provided on the Internet (including web sites); none of the aforesaid relating to computerised telecommunications and telephony control.

Class 16:

Printed matter, books but not including any publications relating to religion or rock music; newspapers and periodicals, magazines, catalogues, directories, printed guides, none of the aforesaid relating to computerised telecommunications and telephony control.

Class 35:

Provision of business and commercial information; provision of business and commercial information provided on-line from computer databases or from the Internet (including web sites); provision of data and statistical information; provision of data and statistical information provided on-line from computer databases or from the Internet (including web sites); computerised data processing, computerised information storage, dissemination and retrieval services; compilation, storage, analysis and retrieval of information and data provided on-line from computer databases or from the Internet (including web sites); provision of business information and intelligence relating to the advertising and media industries provided on-line from computer databases or from the Internet (including web sites); provision of business information and intelligence relating to the advertising and media industries; provision of marketing information; provision of marketing information provision of information and intelligence relating to marketing provided on-line from computer databases or from the Internet (including web sites); statistical analysis, competitor tracking, preparation of reports; compilation and provision of databases and directories; compilation and provision of databases and directories provided on-line from computer databases or from the Internet (including

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

web sites); provision of business research and analysis services; provision of business research and analysis services provided on-line from computer databases or from the Internet (including web sites); respect recruitment services; trade shows and exhibitions; none of the aforesaid relating to religion, rock music, computerised telecommunications and telephony control.

Class 38:

Information services disseminated by telecommunications; telecommunication of information, including web pages, computer programs and any other data; electronic mail services; provision of telecommunications access and links to computer databases and the Internet; distribution and dissemination of news, press releases, and information by electronic means, telecommunication services; communication services; computer network communications; SMS messaging services namely sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; transmission, broadcast, reception and processing of sound, data or images by computer, cable, electronic mail, television or satellite means; receiving and exchanging information, messages, text, sound, images and data; transmission and reception of data and information, broadcasting services; television broadcasting services; radio broadcasting services; none of the aforesaid relating to religion, rock music, computerised telecommunications and telephony control.

Class 41:

Publication of material which can be accessed from databases or from the Internet; interactive information provided on-line from computer databases or the Internet; information provided on-line from computer databases or the Internet; provision of information for accessing via communication and computer networks; electronic publishing; organisation of competition and awards; arranging and conducting competitions; arranging and conducting award ceremonies; arranging the presentation of awards for achievement; arranging and conducting exhibitions, forums, events, shows and displays; none of the aforesaid relating to religion or rock music, computerised telecommunications and telephony control.

Class 42:

Providing access to and leasing access time to computer data bases; computer rental; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; provision of information on-line from a computer database or provided from facilities on the Internet or by other forms of telecommunications, on-line access to databases and reference material; leasing of access time to computer databases; updating of information; rental of digitised materials and databases; on-line access to digital material and databases; providing use of software applications through a website; data transmission and instant messaging services; Internet search engine services; computer services facilitating the provision of and sharing of information over the Internet, none of the aforesaid relating to religion, computerised telecommunications and telephony control.

2. Following publication of the application on 24 September 2010, Genesys Telecommunications Laboratories Inc. (the opponent) filed a notice of opposition against the application.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act) and is directed against all of the applicant's goods and services.

4. The opponent relies on the following earlier mark:

Mark details and relevant dates	Goods and services relied upon
CTM: 816363 Mark: GENESYS Date of application: 6 May 1998 Priority date: 10 November 1997 Date of registration: 14 June 1999	Class 09: Computer software for computerised telecommunications and telephony control. Class 42: Consulting services in the area of computerised telecommunications and telephony control.

5. The opponent claims use on all of the goods and services for which it is registered. It makes clear that in its view the exclusions added by the applicant in classes 9 and 42 are not sufficient to avoid similarity with its own goods and services. In respect of the marks it states:

“1. The mark applied for is visually similar and phonetically and aurally very similar if not identical to the Opponent’s mark.

2. The only significant difference between the Applicant’s mark and Opponent’s mark is the final syllable, which, is spelt with an ‘l’ rather than a ‘Y’ in the Applicant’s mark, and would not be recalled by the average consumer bearing in mind the principle of imperfect recollection.”

6. On 18 March 2011², the applicant filed a counter statement in which it requested the opponent provide proof of use of its marks. It denies the grounds upon which the opposition is based. It states:

“2. The Applicant denies that the goods and services of the Application are identical with or similar to the goods and services recited by the Opponent’s mark. The Applicant denies that there is any likelihood of confusion arising on the part of the public, or any likelihood of association with the Opponent’s trade marks...”

7. The opponent filed evidence and submissions during the evidence period. The applicant filed submissions in response and further submissions in lieu of a hearing. Neither party requested a hearing, both content for a decision to be made from the papers on file. I will refer to the parties’ submissions as necessary below.

² The counterstatement remained unchanged despite the TM21 filed on 6 July 2012.

EVIDENCE

The Opponent's evidence

8. The opponent's evidence consists of a witness statement from Ben Evans, a solicitor at Blake Laphorn, the opponent's representatives. The statement is dated 4 May 2012 and is accompanied by 7 exhibits. The main facts emerging from Mr Evans' statement are, in my view, as follows:

9. Exhibit 1 is the witness statement of Roger Francis Gordon Stanton, dated 27 March 2012. Mr Stanton is the Director of the opponent company. In his summary of his witness statement, Mr Stanton submits that the trade mark GENESYS has been used:

"...for at least the last five years counting from the Applicant's Notice of Defence and Counter statement dated 17 March 2011, in connection with the goods and services covered by the CTM registration No. 816363."

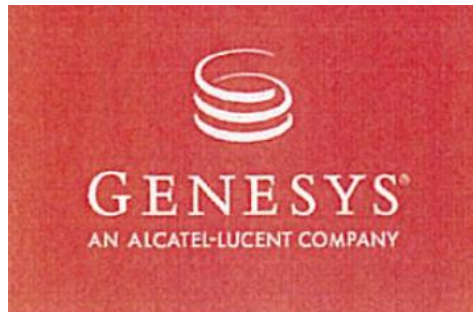
10. Mr Stanton provides the following turnover figures, which he obtained from the audited financial records for each of the Genesys Telecommunications Laboratories - Europe Limited. He states that the figures show:

"7...the total domestic sales for the UK. The sales are recorded in Euros...broken down into four categories, namely, software licences [sic] revenue, revenue from maintenance services, from professional services (including consulting services) and from training services."

	2005	2006	2007	2008	2009	2010
Licenses	12,231,505	14,124,393	22,236,726	16,987,333	12,153,259	9,371,883
Maintenance	6,994,536	8,321,038	10,258,816	11,336,828	11,318,878	11,388,446
Professional	1,522,017	2,990,750	5,762,134	6,005,230	5,169,438	2,799,420
Education	1,337,452	1,509,578	1,492,541	1,520,665	938,697	1,052,491

11. Attached to Mr Stanton's witness statement are three sample invoices, dated 31 March 2009, 21 March 2011 and 18 March 2011. The first of these shows the mark Genesys in the top left hand corner to the right of a spiral device. The second and third invoices show the mark below the same spiral device.

12. Exhibit 2 consists of a series of product brochures for nine „Genesys' software packages. These brochures are titled, Genesys Composer Voice (2009), Genesys Customer Interaction Management Platform (2010), Genesys Customer Interaction Portal (2008), Genesys Interaction Workspace (2010), Genesys Outbound Voice (2010), Genesys Quality Management (2010), Genesys SMS (2009), Genesys Voice Platform (2008) and Genesys Web Collaboration (2010). The dates in brackets are provided by Mr Evans in his witness statement. Each brochure has a version number and date on the bottom left of its back page. This also indicates that these are US versions. The mark, „Genesys', is shown on the top left of the front page of each of the brochures and on each of the interior pages and back cover. It is presented below the spiral device and underneath the word „GENESYS' are the words „AN ALCATEL-LUCENT COMPANY', presented as follows:



The title of each brochure starts with the word „Genesys’ followed by the software product., e.g. „Composer Voice’.

13. Exhibit 3 is a brochure titled „Professional Services’. It is undated. The contact address given on the last page is in Daly City, California. The mark is shown on the front page of the brochure in the top left corner as I have already reproduced in the previous paragraph.

14. Exhibit 4 consists of 3 case studies of „significant Genesys clients’. These are Ladbrokes, dated 2009, Scottish Power, dated 2009 and Thomson, dated 2007. The version details on the back page of each brochure show that these are EU versions and that the Thomson case study was produced in 2008. All three relate to companies based in the UK and show the mark on the front page and all following pages in the style I have reproduced above.

15. Exhibit 5 is the „Genesys UK Market Analysis Report’ dated September 2009. The front cover shows the mark as I have reproduced above, printed in white on a red rectangular background. The report concerns the cost of poor customer service and is focused on the UK market.

16. Exhibit 6 consists of industry reports from Gartner Inc., described by Mr Evans as “the world’s leading information technology research and advisory company” (taken from Gartner, Inc website www.gartner.com). The first report is dated 18 February 2008 and lists Genesys Telecommunications as a leader in the field of „Voice Response Systems and Enterprise Voice Portals’. The second report is dated 18 November 2008 and lists „Genesys’ as a leader in the field of Contact Centre Infrastructure. The third report is dated 11 September 2009 and lists „Genesys’ as a visionary in the field of E-Service Suites. The final report is dated 22 February 2010 and again lists „Genesys’ as a leader in the field of Contact Centre Infrastructure.

17. Exhibit 7 is a price list of Genesys products and services dated 2011. The exhibit has been redacted to remove prices. It shows a list of software products, professional services

and training courses available from Genesys. The mark is shown on the front page in the form I have reproduced above at paragraph 12.

DECISION

18. Section 5(2)(b) of the Act reads as follows:

“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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

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

(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.”

20. In these proceedings the opponent is relying upon the trade mark shown in paragraph 4 above. It constitutes an earlier trade mark under the above provisions. The application was published on 24 September 2010. The opponent's earlier mark completed its registration procedure on 14 June 1999. Consequently, the opponent's registrations are subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, and, as I mentioned above, the applicant has asked the opponent to provide proof of use in respect of all of the goods and services on which it relies. The relevant sections of the Proof of Use Regulations read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(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) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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) Nothing in this section affects –

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2)(application on relative grounds where no consent to registration).”

21. The relevant period is the five year period ending on the date of publication of the application, namely 25 September 2005 to 24 September 2010. The onus is on the opponent, under section 100 of the Act, to show genuine use of its mark during this period in respect of those goods and services relied on or, alternatively, to show that there are proper reasons for non-use of the mark during this period.

Proof of use

22. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

23. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed Person in O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the

“legal learning” that flows from them, adding in references to Silberquelle where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

24. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“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."

25. The comments of Mr Justice Jacob in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

"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 pernicky 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 threeholed razor blades imported from Venezuela (Mr T.A. Blanco White'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 his 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.”

26. The comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (España), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub- divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of „part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

27. First, I have to identify, as a matter of fact, whether the trade mark relied on by the opponent has actually been used and if so, in respect of which goods and services. Having reached a conclusion on that point, I must then go on to decide what, from the perspective of the average consumer of the goods and services, constitutes a fair specification.

In these proceedings the opponent relies upon the following goods and services in classes 9 and 42:

Class 09: Computer software for computerised telecommunications and telephony control.

Class 42: Consulting services in the area of computerised telecommunications and telephony control.

28. The opponent’s evidence provided by Mr Evans, which has not been contested or challenged by the other side, shows the mark in two forms. All of the brochures shown in exhibit 2 have a mark on the front cover and on each page of the brochure which features the word GENESYS presented underneath or to the right of a spiral device mark, with the

words „AN ALCATEL-LUCENT COMPANY’ presented in smaller capital letters underneath. I have reproduced these versions of the mark above at paragraph 12. In addition to these, the plain word „Genesys’ is used throughout the evidence in title case. Examples of this can be seen in the product descriptions „Genesys Composer Voice’ and „Genesys Customer Interaction Management Platform 8.0’. In my view, the differences between the earlier mark as registered and the examples provided by Mr Evans of the mark in title case simply come down to whether individual letters are presented in lower or upper case and would go unnoticed by the average consumer.

29. Mr Stanton’s evidence shows turnover figures in respect of software licenses in the UK between 2005 and 2010 amounting to 87,105,099 Euros. For professional services throughout the same period the figure is 24,248,989 Euros. These figures combined with trade reviews of GENESYS products and services and associated product brochures lead me to conclude that when considered as a totality the opponent’s evidence clearly shows genuine use of the mark throughout the relevant period. Having established that there has been genuine use, I must now go on to consider what constitutes a fair specification.

30. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

31. In his witness statement Mr Stanton states that the opponent’s goods are „computer software for computerised telecommunications and telephony control’ while its services include „consulting services in the area of computerised telecommunications and telephony control’.

32. The software products shown in evidence to be supplied under the „Genesys’ mark clearly relate to telecommunications and telephony. The brochure relating to professional services and the associated price list showing fees for professional services indicate that these services relate to „architects, solution experts and implementation consultants’. Telecommunications and telephony control are terms which the average consumer would use in order to describe the services, particularly as these are not goods and services which would be purchased by a member of the general public but are high value technical products and services used within a professional context. As a consequence I conclude that „computer software for computerised telecommunications and telephony control’ and „consulting services in the area of computerised telecommunications and telephony control’ are how the average consumer would describe the goods and services in respect of which the mark has been used and represents a fair specification (which is neither too broad nor too pernicky) and is the basis on which I intend to proceed.

Section 5(2)(b) case law

33. In his decision in *La Chemise Lacoste SA v Baker Street clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR

11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

34. *Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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 of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

Comparison of marks

35. The marks to be compared are:

The opponent's mark	The applicant's mark
GENESYS	GENESIS

Dominant and distinctive components

36. Both marks consist of a single word. Neither splits into separate distinctive and dominant components. They will both be viewed as single words, GENESYS and GENESIS which are their only constituent part.

Visual similarities

37. In its submissions filed with its evidence the opponent states:

“8. Both marks are 7 characters long with the only difference being that the Applicant's mark replaces the letter 'Y' with the letter 'I'. Visually this has little effect on the similarity of the marks as it features as the second last letter, a consumers focus is drawn to the first few letters of a word mark and as such visually (and bearing in mind the average consumer's imperfect recollection of marks) the marks are highly similar if not identical.”

38. I agree. The only point of difference between the two marks is the sixth letter which is an 'I' in the applicant's mark and a „Y' in the opponent's mark. In marks of this length, where the first five letters and the final letter are identical, the change from a Y to an I of the sixth letter of a seven letter word is a minor point of difference. I find these marks to be highly visually similar.

Aural similarities

39. The opponent states:

*“9. Phonetically and aurally both marks are identical and would be pronounced by the English speaking public as: **gen-e-sis.**” (opponent's emphasis added).*

40. I agree. There is no difference in sound between a „Y' when used within a word to substitute a vowel and the sound made by the letter 'E'. Both words will be pronounced GEN-E-SIS. I find these marks to be aurally identical.

Conceptual similarities

41. For a conceptual meaning to be relevant it must be one capable of immediate grasp by the average consumer.³

42. The opponent states:

“10. Conceptually the marks are identical since both will be read by the relevant public as ‘genesis.’”

43. I agree. The applicant’s mark, the word „GENESIS’, is a plain dictionary word with which the average consumer will be familiar. The average consumer may see the opponent’s mark as being a reference to the known word GENESIS, either because the words are so similar or because they do not notice the difference in spelling. If this is the case, then the marks are conceptually identical. Even if the change in spelling is noticed, in my view, the average consumer will either consider the opponent’s mark to be the word „GENESIS’ or will see it as a reference to it. Consequently, I find the marks to be conceptually identical.

Distinctive character of the earlier mark

44. I must now assess the distinctive character of the opponent’s earlier trade mark. The distinctive character of the opponent’s earlier trade mark must be appraised first, by reference to the goods and services upon which I have found it has been used and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

45. While the word GENESYS does not have a dictionary meaning, I have concluded that the average consumer is likely to consider the mark to be the word GENESIS or a reference to it. As such, it will be seen as a dictionary word meaning a beginning or origin of something. In relation to the goods in class 9 and services in class 42 the trade mark is neither descriptive nor allusive. As a consequence the mark enjoys a reasonably high level of inherent distinctive character.

46. I have considered the proof of use of the opponent’s mark earlier in this decision. Turnover figures indicate business in respect of software licences and professional services in the region of 110 million Euros in the period 2005-2010. While this is sufficient to indicate genuine use of the mark in respect of the goods and services relied upon for the purposes of these proceedings, the evidence is silent with regards to the size of the market or the applicant’s share of the market specifically. Trade publications relating to the industry and put into evidence indicate that the opponent company is known within its field, nevertheless, in the absence of any indication of the size of the market I am unable to conclude that the distinctive character of the mark has been enhanced to any material

³ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r. I-643; [2006] ETMR 29.

extent through use. I have already indicated a reasonably high level of inherent distinctive character.

Comparison of goods and services

47. In comparing the goods and services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

48. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* in which the CJEU stated, at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

49. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are 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.

50. I also bear in mind the decision in *El Corte Inglés v OHIM* Case T-420/03, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

51. I also take note of the case of *Les Éditions Albert René V Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM) T-336/03*, where it was held:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

52. Additionally, there is the guidance provided in *Avnet Incorporated v Isoact Limited - [1998] F.S.R. 16 (HC)*:

“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.”

53. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark BL O-399-10 (AP)*:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

54. The goods and services to be compared are as follows:

Opponent’s goods and services	Applicant’s goods and services
<p>Class 9 Computer software for computerised telecommunications and telephony control.</p>	<p>Class 9 Computer software, computer programs, computer databases; data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; CD-ROMs; CDIs; publications in electronic form but not including any publications relating to religion or rock music, supplied on-line from databases or from facilities provided on the Internet (including web sites); none of the aforesaid relating to computerised telecommunications and telephony control.</p>
	<p>Class 16 Printed matter, books but not including any publications relating to religion or rock music; newspapers and periodicals, magazines, catalogues, directories, printed guides, none of the aforesaid relating to computerised telecommunications and telephony control.</p>

	<p>Class 35: Provision of business and commercial information; provision of business and commercial information provided on-line from computer databases or from the Internet (including web sites); provision of data and statistical information; provision of data and statistical information provided on-line from computer databases or from the Internet (including web sites); computerised data processing, computerised information storage, dissemination and retrieval services; compilation, storage, analysis and retrieval of information and data provided on-line from computer databases or from the Internet (including web sites); provision of business information and intelligence relating to the advertising and media industries provided on-line from computer databases or from the Internet (including web sites); provision of business information and intelligence relating to the advertising and media industries; provision of marketing information; provision of marketing information provision of information and intelligence relating to marketing provided on-line from computer databases or from the Internet (including web sites); statistical analysis, competitor tracking, preparation of reports; compilation and provision of databases and directories; compilation and provision of databases and directories provided on-line from computer databases or from the Internet (including web sites); provision of business research and analysis services; provision of business research and analysis services provided on-line from computer databases or from the Internet (including web sites); respect recruitment services; trade shows and exhibitions; none of the aforesaid relating to religion, rock music, computerised telecommunications and telephony control.</p>
--	--

	<p>Class 38: Information services disseminated by telecommunications; telecommunication of information, including web pages, computer programs and any other data; electronic mail services; provision of telecommunications access and links to computer databases and the Internet; distribution and dissemination of news, press releases, and information by electronic means, telecommunication services; communication services; computer network communications; SMS messaging services namely sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; transmission, broadcast, reception and processing of sound, data or images by computer, cable, electronic mail, television or satellite means; receiving and exchanging information, messages, text, sound, images and data; transmission and reception of data and information, broadcasting services; television broadcasting services; radio broadcasting services; none of the aforesaid relating to religion, rock music, computerised telecommunications and telephony control.</p> <p>Class 41: Publication of material which can be accessed from databases or from the Internet; interactive information provided on-line from computer databases or the Internet; information provided on-line from computer databases or the Internet; provision of information for accessing via communication and computer networks; electronic publishing; organisation of competition and awards; arranging and conducting competitions; arranging and conducting award ceremonies; arranging the presentation of awards for achievement; arranging and conducting exhibitions, forums, events, shows and displays; none of the aforesaid relating to religion or rock music, computerised telecommunications and telephony control.</p>
--	---

<p>Class 42 Consulting services in the area of computerised telecommunications and telephony control.</p>	<p>Class 42: Providing access to and leasing access time to computer data bases; computer rental; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; provision of information on-line from a computer database or provided from facilities on the Internet or by other forms of telecommunications, on-line access to databases and reference material; leasing of access time to computer databases; updating of information; rental of digitised materials and databases; on-line access to digital material and databases; providing use of software applications through a website; data transmission and instant messaging services; Internet search engine services; computer services facilitating the provision of and sharing of information over the Internet, none of the aforesaid relating to religion, computerised telecommunications and telephony control.</p>
--	---

55. In its submissions dated 3 September 2012, the applicant states:

“The specification of the Applicant’s mark in class 9 has been amended to specifically exclude the specific and highly specialised goods of ‘computer software for computerised telecommunications and telephony control’.

Likewise, the specification of services currently recited in Class 42 of the Application does not include ‘Consulting services in the area of computerised telecommunications and telephony control’, it does not include consultancy services of any kind and, following amendment, specifically excludes any services relating to ‘computerised telecommunications and telephony control’...

The Opponent’s registration does not include Classes 16, 35, 38 and 41. It is submitted that none of the goods or services recited by the Application in these classes are the same or of the same description as the specialised goods and services of the Opponent’s mark. We mention that in Avnet Inc v Isoact Ltd, the court commented that specifications should be confined to the substance, or core, of the possible meanings attributable to the words and phrases used. As such, the specifications should not be extrapolated to cover goods and services which they clearly exclude.

Neither are the goods and services of the Application ancillary to and/or complementary to those recited by the Opponent’s mark. The Applicant’s specifications clearly exclude goods and services relating to ‘Computer software for computerised telecommunications and telephony control’ and ‘Consulting services in the area of computerised telecommunications and telephony control’. As such, there is not 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.

Accordingly, there is no likelihood of confusion arising on the part of the public, or any likelihood of association with the Opponent's trade mark."

56. In its statement of grounds the opponent states:

"4. The specification for the Applicant's mark was amended post publication in December 2010. For the purposes of this opposition the key amendment is the inclusion of the wording 'none of the aforesaid relating to computerised telecommunications and telephony control' against each class. The amendment to the specifications is very narrow in scope and accordingly the specifications within each class remain broadly drafted covering goods and services which are similar to those covered by the Opponent's mark. In addition in some classes the proposed amendment cannot work to limit the specification, taking for example class 38. The services listed within this class include for instance 'electronic mail services', 'provision of telecommunications access and links to computer databases and the internet', 'telecommunications services', 'communication services' and 'computer network communications' which due to their very nature cannot exclude computerised telecommunications and telephony control rendering the exclusion wording at best ambiguous, at worst confusing. Despite the amended wording the average consumer will perceive the Applicant's goods and services to be associated under the umbrella of 'computer programs and software, and telecommunications and telephony control', and seeing the highly similar mark, will assume the goods and services of the Applicant are connected with, or otherwise endorsed by, the Opponent."

57. In its submissions, filed with its evidence, the opponent reiterates its submissions reproduced above and states:

"14.2 The Applicant's classes 35, 38, and 41 provides for services that are ancillary to and/or complimentary(sic) to the goods and services contained in the Opponent's Mark.

14.3 The Applicant's class 42 provides for services that are similar to and ancillary to and/or complimentary (sic) to the services in class 42 of the Opponent's Mark, namely 'consulting services in the area of computerised telecommunications and telephony control'.

58. The opponent continues by making a comparison of goods and services in accordance with the test laid down in Canon, which I have provided earlier in this decision. It states:

"17. Applying these criteria it is clear that both the Applicant's and Opponent's goods and services are (in so far as the Applicant's goods/services are extremely broadly drafted):

17.1 similar in nature;

17.2 directed towards the same end users i.e. commercial clients.

17.3 subject to the same methods of use

17.4 are likely to be in competition"

The limitation clauses

59. I have considered the opponent's submissions and agree that in some cases the limitations applied to particular classes cannot operate successfully to give a clear indication of what is and what isn't included within the applicant's specification. However, before I consider this in more detail there is another point which in my view has a significant impact on the comparison of goods and services in these proceedings.

60. All of the limitations applied to the goods and services in the applicant's specification begin with the words „none of the aforesaid relating to...’ This is a common form of words used in limitations in respect of a „subject matter’ limitation. The words „relating to’ mean „being about’. This can be seen in the applicant's specification in respect of religion and rock music, presumably to avoid a publication being about the music group „GENESIS’ or the first book of the old testament, „GENESIS’. However, it is not the type of limitation which can be used in respect of the type of goods and services at issue here. A limitation which excludes software from being **about** telecommunications or telephony control does not exclude that software from being **used for** telecommunications and telephony control. Consequently, the limitations do not prevent the applicant's goods and services being used in telecommunications and telephony control.

Class 9

61. Computer software in the applicant's specification is clearly a broad term which includes computer software for computerised telecommunications and telephony control. Consequently, in accordance with *Meric*, these are identical goods. Computer programs are a subset of computer software and are also identical.

62. Computer databases are simply collections of data which are invariably operated and maintained by a type of software. The users of the opponent's software are clearly professional users operating computerised telecommunication systems or controlling a telephony system. The users of the applicant's databases may be anyone, including professional users. The uses of the opponent's goods are clearly identified within the specification. The applicant's goods may be used for any number of purposes but may include the use identified in the opponent's specification since they are limited to the extent that they are not about computerised telecommunications and telephony control but this doesn't prevent them being used for those purposes. The goods are complementary since databases require software in one form or another in order to be able to operate. The goods are not in competition. I find these goods to be highly similar.

63. Data recorded in electronic, optical or magnetic form can include computer software and is also identical in accordance with *Meric*.

64. The users of the opponent's software products are professionals; users of the applicant's data carriers, audio and visual recordings, CD-ROMs, CDIs can be anyone, including professional users. Software products have to be fixed in some way in order to be used. They can be made available either in a hard form or, increasingly, online. The uses of the opponent's goods are identified in its specification while the applicant's goods may have a wide number of uses. However, the applicant's goods may be used to hold software for the uses outlined in the opponent's specification. There may be some overlap in trade channels, for example, a website supplying complex software may also provide data carriers, CD ROMs etc., though these are likely to be located in a separate area.

Taking all of these factors into account I find there to be a low level of similarity between these goods.

65. Computer software in the opponent's specification is aimed at professional users. The applicant's publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites) may be used by members of the general public or specialists. The publications may be used for any number of purposes though publications generally provide information, whether that is the form of, inter alia, specific user guides or reviews of latest products. In this case, the subject matter of those publications is limited and cannot be about telecommunications or telephony control. The trade channels for these goods are likely to be different. In my experience, a publication which relates to a particular type of software may be sold in a newsagent, or be made available online by the supplier or another third party, rather than be purchased through the same trade channel as the software itself. Since the applicant's specification excludes publications which relate to the type of software included in the opponent's registration, I find these goods to be dissimilar.

66. Consulting services of the type relied upon by the opponent are specialist services, their use will be confined to professionals wishing to seek expert advice in relation to telecommunications and telephony control. The users, uses and trade channels for these services are clearly different from those of the applicant's goods in class 9. They are not complementary nor in competition and I find these services to be dissimilar to the applicant's class 9 goods.

Class 16

67. Printed matter in the application can include printed computer programs. Consequently, in accordance with Meric, these are identical goods to software in the opponent's specification.

68. Books in the application are limited to not being about telecommunications and telephony control. As I have already found, the limitation works in respect of subject matter exclusions and is sufficient to avoid any similarity with the opponent's goods in class 9, or services in class 42. Consequently, I find these goods to be dissimilar.

69. Newspapers and periodicals, magazines, catalogues, directories and printed guides are also subject to the limitation referred to above. Consequently, for the same reasons, I find these goods to be dissimilar.

70. I have concluded above at paragraph 66 that consulting services of the type relied upon by the opponent are specialist services, their use will be confined to professionals wishing to seek expert advice in relation to telecommunications and telephony control. The users, uses and trade channels for these services are clearly different from those of the applicant's goods in class 16. They are not complementary nor in competition and I find these services to be dissimilar to the applicant's class 16 goods.

Class 35

71. All of the applicant's services in class 35 are business information services which either provide information or store or process that information. The opponent's consulting services (in class 42) are specialist services which will be used by professionals to obtain expert opinion in a particular area, in this case, telecommunications and telephony control.

Provision of business information, its management and storage are services which may be used by professionals or by a member of the general public for any number of reasons. For example reviews of a particular business or price comparisons between businesses. The trade channels are different. A consulting service is a specialist service which will only be available from a limited number of providers. Business information can be specialist but can also include general information such as, inter alia, company addresses, shareholders and price lists. The services are complementary in the sense that a consultant will need business information in order to provide consultancy services. The services are not in competition. However, in accordance with the guidance in *Avnet* I must look at the core meaning of the parties' services. In my view a consultancy service provides advice and is different from the provision of business information, which provides facts and figures. Taking all of these factors into account I find the services to be dissimilar.

72. Computer software of the type relied upon by the opponent is limited to use in computerised telecommunications and telephony control. These are specialist goods, their use will be confined to professionals. The users, uses and trade channels for the applicant's services in class 35 are clearly different from those of the applicant's goods in class 9. They are not complementary nor in competition and I find these services to be dissimilar to the applicant's class 9 goods.

Class 38

73. In respect of the applicant's specification in class 38 the opponent states:

"The amendment to the specifications is very narrow in scope and accordingly the specifications within each class remain broadly drafted covering goods and services which are similar to those covered by the Opponent's mark. In addition in some classes the proposed amendment cannot work to limit the specification, taking for example class 38. The services listed within this class include for instance "electronic mail services", "provision of telecommunications access and links to computer databases and the Internet", "telecommunications services", "communication services" and 'computer network communications' which due to their very nature cannot exclude computerised telecommunications and telephony control rendering the exclusion wording at best ambiguous, at worst confusing."

74. I agree that in respect of the services listed in class 38 of the applicant's specification the limitation does not work to limit the services. There can be no clarity in, for example, „telecommunication services not relating to telecommunication services'. Consequently, I will make the assessment based on the services in class 38 without the limitation clause.

75. The users of the opponent's software in class 9 are likely to be professionals who will use the goods to operate telecommunication and telephony systems. The users of the applicant's services in class 38 may be a member of the general public or a professional user accessing telecommunication systems. The trade channels for these goods and services include a degree of overlap. It is not uncommon for downloadable software to be supplied by a telecommunication provider in order to access their services. Since telecommunications have become increasingly computerised there is clearly a relationship between the systems themselves and the software used to operate them. In some cases the systems cannot operate without software and are complementary in the sense that one is indispensable for the use of the other. The goods and services are not in competition. Taking all of these factors into account, I find there to be a moderate degree

of similarity between the opponent's goods in class 9 and the applicant's services in class 38.

76. In considering the applicant's class 38 services and the opponent's class 42 services I must, accordance with the guidance in *Avnet*, look at the core meaning of the parties' services. Consulting services of the type relied upon by the opponent are specialist services, their use will be confined to professionals wishing to seek expert advice in relation to telecommunications and telephony control. The users of the applicant's services in class 38 may be a member of the general public or a professional user accessing telecommunication systems. In my view a consultancy service provides advice and is different from the provision of access to telecommunication systems. The users, uses and trade channels for these services are different. They are not complementary nor in competition. Taking all of these factors into account I find the services to be dissimilar.

Class 41

77. The applicant's services in class 41 fall into two distinct categories. The first of these relates to electronic publication of information. As discussed above, in respect of electronic and paper publications, the limitation is effective in respect of the subject matter of the information being provided. As above, I find these services to be dissimilar to the goods and services of the opponent.

7784. The second category of service relates to the organisation and arrangement of competitions, awards and ceremonies. The subject matter of these events cannot relate to telecommunications or telephony but, even if that were not the case, the users of such services are self evidently different to the users and uses of the opponent's software and consultancy services. The trade channels are also entirely different and they are not complementary or in competition. These services and the goods and services of the opponent are dissimilar.

Class 42

79. Included within the applicant's class 42 specification is the term 'data transmission and instant messaging'. These services are proper to class 38 rather than class 42. The significance of classification and the relevance of class numbers have been considered by the courts in *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2002] RPC 639 and *Avnet Incorporated v Isoact Limited* [1998] FSR 16. In *Proctor & Gamble Company v Simon Grogan*, O-176-08, Anna Carboni, sitting as the appointed person, referred to *Altecnic* and said:

"34.....The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2001] EWCA Civ 1928, [2002] RPC 639. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored."

80. Data transmission and instant messaging are services of the type I have discussed above in my assessment of class 38. Consequently, I find these services to have a moderate degree of similarity with the goods in class 9 of the opponent's specification.

81. Design, drawing and commissioned writing, all for the compilation of web pages on the Internet in the applicant's specification are specialist services which may be used by a member of the general public or a professional in order to have a suitable presence on the internet. Consulting services of the type relied upon by the opponent are also specialist services but their use will be confined to professionals wishing to seek expert advice in relation to telecommunications and telephony control. The trade channels for these services are clearly different. They are not complementary nor in competition and I find these services to be dissimilar. The software relied upon by the opponent clearly has no relationship to these services in class 42 of the application and are also dissimilar.

82. The following services in the applicant's specification all relate to the provision of access: „Providing access to and leasing access time to computer data bases; on-line access to databases and reference material; leasing of access time to computer databases; on-line access to digital material and databases'. These services may be used by anyone, in order to access electronic information and are available from a large number of providers. The opponent's services are specialist consultancy services, available from very limited number of sources. The services are not complementary, nor are they in competition. I find these services to be dissimilar.

83. Computer rental and rental of digitised materials and databases are evidently „rental services', the core meaning of these services is rental and is different from the consultancy services relied upon by the opponent. I find these services to be dissimilar.

84. „Provision of information on-line from a computer database or provided from facilities on the Internet or by other forms of telecommunications', „computer services facilitating the provision of and sharing of information over the Internet' and „updating of information', in the applicant's specification, are information services. I have considered information services in class 35 and have found the services to be dissimilar. For the same reasons as those outlined above, these are also dissimilar services.

85. Internet search engine services in the application are used by everyone for the purpose of accessing specific information from the worldwide web. They are accessed online. These are self evidently completely different services to those offered by the opponent in class 42. They are not complementary nor in competition. These services are dissimilar.

86. The applicant's specification includes the service of providing use of software applications through a website. The opponent has a registration for software for telecommunications and telephony control in class 9. The limitation to the applicant's specification prevents the software being accessed through a website from being about telecommunications and telephony control but does not prevent it from being used for telecommunications and telephony control. Consequently, I find there to be a moderate degree of similarity between the opponent's class 9 goods and these services in class 42.

Likelihood of confusion

87. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the

consumer relying instead on the imperfect picture of them he has kept in his mind.⁴ I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa.

88. I have found the marks to be highly similar visually and identical both conceptually and aurally. I have also identified a high level of inherent distinctive character in the opponent's earlier mark.

89. Given the nature of goods and services on which this opposition is based it is clear that the average consumer will include anyone from a member of the general public, making a low price relatively frequent purchase, such as a CD-ROM, to a professional seeking to purchase consulting services in the field of computerised telecommunications and telephony control. The latter self evidently requires a higher level of attention to be paid. It is also clear that some of the goods and services are identical, some are similar and some are entirely different. In the case of goods and services which are dissimilar, I need not go on to consider the similarity of the marks.⁵ In respect of the remaining goods and services, taking all of these factors into account, the similarity of the marks is such that in the context of identical or similar goods and services there will, in my view, be direct confusion (where one mark is mistaken for the other). Even if I am wrong in this, the similarity between the parties' marks is such that there will be indirect confusion (where the average consumer believes the respective goods originate from the same or a linked undertaking).

89. In respect of the parties' goods and services I have concluded as follows:

90. Identical goods and services

Class 9

Computer software, computer programs and data recorded in electronic, optical or magnetic form.

Class 16

Printed matter

91. Similar goods and services

Class 9

Computer databases, data carriers, audio and visual recordings, CD ROMs, CDIs.

Class 38

Information services disseminated by telecommunications; telecommunication of information, including web pages, computer programs and any other data; electronic mail services; provision of telecommunications access and links to computer databases and the Internet; distribution and dissemination of news, press releases, and information by electronic means, telecommunication services; communication services; computer network communications; SMS messaging services namely sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these

⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

⁵ *The test is a cumulative one, see Vedial SA v OHIM C-106/03*

formats; transmission, broadcast, reception and processing of sound, data or images by computer, cable, electronic mail, television or satellite means; receiving and exchanging information, messages, text, sound, images and data; transmission and reception of data and information, broadcasting services; television broadcasting services; radio broadcasting services; none of the aforesaid relating to religion, rock music, computerised telecommunications and telephony control.

Class 42

Data transmission and instant messaging, providing use of software through a website.

92. Dissimilar goods and services

All of the other goods and services of the application I have found to be dissimilar.

Conclusion

93. The opponent has succeeded in respect of the goods and services I have identified as identical or similar to its own goods and services. The opponent has failed in respect of those goods and services which I have identified as being dissimilar.

The continuing application

94. As a consequence of my findings above the application should be amended in the following terms:

95. The following goods should be removed from class 9 of the application:

~~data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; CD-ROMs; CDIs; publications in electronic form but not including any publications relating to religion or rock music, supplied on-line from databases or from facilities provided on the Internet (including web sites); none of the aforesaid relating to computerised telecommunications and telephony control.~~

96. In class 16 the term printed matter in the application can include computer programs in printed form. It also includes a wide range of other goods which are not subject to objection. In accordance with TPN 1/2012 the term printed matter should have the following words added:

Printed matter not including printed computer programs, books but not including any publications relating to religion or rock music; newspapers and periodicals, magazines, catalogues, directories, printed guides, none of the aforesaid relating to computerised telecommunications and telephony control.

97. Class 35 of the application remains unchanged, as follows:

Provision of business and commercial information; provision of business and commercial information provided on-line from computer databases or from the Internet (including web sites); provision of data and statistical information; provision of data and statistical information provided on-line from computer databases or from the Internet (including web sites); computerised data processing, computerised

information storage, dissemination and retrieval services; compilation, storage, analysis and retrieval of information and data provided on-line from computer databases or from the Internet (including web sites); provision of business information and intelligence relating to the advertising and media industries provided on-line from computer databases or from the Internet (including web sites); provision of business information and intelligence relating to the advertising and media industries; provision of marketing information; provision of marketing information provision of information and intelligence relating to marketing provided on-line from computer databases or from the Internet (including web sites); statistical analysis, competitor tracking, preparation of reports; compilation and provision of databases and directories; compilation and provision of databases and directories provided on-line from computer databases or from the Internet (including web sites); provision of business research and analysis services; provision of business research and analysis services provided on-line from computer databases or from the Internet (including web sites); respect recruitment services; trade shows and exhibitions; none of the aforesaid relating to religion, rock music, computerised telecommunications and telephony control.

98. Class 38 should be removed entirely.

99. Class 41 remains unchanged, as follows:

Publication of material which can be accessed from databases or from the Internet; interactive information provided on-line from computer databases or the Internet; information provided on-line from computer databases or the Internet; provision of information for accessing via communication and computer networks; electronic publishing; organisation of competition and awards; arranging and conducting competitions; arranging and conducting award ceremonies; arranging the presentation of awards for achievement; arranging and conducting exhibitions, forums, events, shows and displays; none of the aforesaid relating to religion or rock music, computerised telecommunications and telephony control.

100. Class 42 should be amended as follows:

Providing access to and leasing access time to computer data bases; computer rental; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; provision of information on-line from a computer database or provided from facilities on the Internet or by other forms of telecommunications, on-line access to databases and reference material; leasing of access time to computer databases; updating of information; rental of digitised materials and databases; on-line access to digital material and databases; ~~providing use of software applications through a website; data transmission and instant messaging services;~~ Internet search engine services; computer services facilitating the provision of and sharing of information over the Internet, none of the aforesaid relating to religion, computerised telecommunications and telephony control.

101. The remaining terms on which I have yet to draw a conclusion are „computer software, computer programs and computer databases’. These are broad terms which include a range of goods which are not similar to the specific goods named in the opponent’s specification. For example „computer software for computerised telecommunications and telephony control’ cannot be said to be similar to computer software for e.g. the design of nuclear power stations.

102. The Registry's practice in this regard is stated in Tribunal Practice Notice (TPN) 1 of 2012 at paragraph 3.2.2(c) which states:

"c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services."

103. In respect of the specific goods at issue I am mindful of the comments of Laddie J in the *Mercury Communications* case⁶ in which he said:

"In my view it is thoroughly undesirable that a trader who is in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those far removed from his own area of interest. If he does he runs the risk of his registration being attacked on the grounds of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act."

104. The applicant is allowed 21 days from the date of this decision to consider my comments above and to provide me with submissions/proposals for a list of goods which fall within the broad phrase "computer software, computer programs, computer databases" which, in its view, do not clash with the opponent's goods in class 9. These submissions should be copied to the opponent, who will then be allowed a further 21 days from receipt of the applicant's submissions to provide any submissions they may have on the applicant's proposals. I will review both parties' submissions and issue a supplementary decision in which I will also determine costs.

105. The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision and so will not commence until the supplementary decision is issued.

Dated this 30th day of January 2013

**Ms Al Skilton
For the Registrar,
The Comptroller General**

⁶ *Mercury Communications Limited v Mercury Interactive (UK) Limited* [1995] FSR 850