

O-130-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2567394  
BY  
KARL STORZ ENDOSCOPY-AMERICA, INC  
TO REGISTER THE TRADE MARK

**VIEW1**

IN CLASS 9

AND

THE OPPOSITION THERETO  
UNDER NO 102136  
BY  
DAEJA IMAGE SYSTEMS LIMITED

## BACKGROUND



1. On 16 December 2010, Karl Storz Endoscopy-America Inc (the applicant) applied to register the above trade mark in class 9 of the Nice Classification system.<sup>1</sup>
2. The application was subsequently amended in respect of the specification of goods; the applicant now seeks registration in respect of:

„Equipment, namely, computer hardware and peripherals and computer software, in the nature of medical imaging apparatus and embedded computer software, namely, picture archiving and communication systems used for collecting, controlling, categorizing, managing and disseminating patient medical information in the nature of images from medical imaging instruments for use by medical practitioners.’
3. Following publication of the application on 22 April 2011, Daeja Image Systems Limited (the opponent) filed notice of opposition against the application.
4. The grounds of opposition were brought under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (the Act).
5. The opposition is directed at all of the applicant’s goods in class 9. The opponent relies upon the three marks shown below in respect of the 5(2)(b) ground.

<b>Mark details and relevant dates</b>	<b>Goods and services</b>
<p><b>TM:</b> 2310658</p> <p><b>viewone</b></p> <p><b>Filing date:</b> 14 September 2002</p> <p><b>Registration date:</b> 18 June 2004</p>	<p><b>Class 09:</b> Computer software programs; computer software.</p> <p><b>Class 16:</b> Printed publications; printed matter; manuals; users manuals relating to computers; users manuals relating to computer software and/or computer programs.</p> <p><b>Class 42:</b> Computer software advisory services.</p>

---

<sup>1</sup> *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).*

<p><b>TM:</b> 2310661</p>  <p><b>Filing date:</b> 14 September 2002</p> <p><b>Registration date:</b> 18 June 2004</p>	<p><b>Class 09:</b> Computer software programs; computer software.</p> <p><b>Class 16:</b> Printed publications; printed matter; manuals; users manuals relating to computers; users manuals relating to computer software and/or computer programs.</p> <p><b>Class 42:</b> Computer software advisory services.</p>
<p><b>CTM:</b> 3782703</p>  <p><b>Filing date:</b> 20 April 2004</p> <p><b>Registration date:</b> 22 July 2005</p>	<p><b>Class 09:</b> Computer software programs; computer software.</p> <p><b>Class 16:</b> Printed publications; printed matter; manuals; users manuals relating to computers; users manuals relating to computer software and/or computer programs.</p> <p><b>Class 42:</b> Computer software advisory services.</p>

6. In its statement of grounds the opponent states that the applicant's mark is phonetically and conceptually identical and visually highly similar to its three earlier marks. It also submits:

*"4. The goods applied for in the applicant's class 09 are identical to those of the opponent's class 09 in so far as the applicant's class 09 are computer software for use in the medical industry, the opponent's class 09 covers computer software in general, this is identical. The applicant's class 09 also covers computer hardware for use in the medical industry this is highly similar to the opponent's class 09 of computer software."*

7. Under 5(4)(a) of the Act the opponent relies on the plain word VIEWONE and states:

*"4. The opponent contends that it has built up sufficient goodwill in the mark 'VIEWONE' in order to allow for a common law claim of passing off against the applicant, accordingly the opponent relies on these rights under s5(4)(a)."*

8. Having reiterated the similarity between the marks and goods at issue the opponent concludes:

*"This would cause a misrepresentation to consumers and would result in damage to the opponent through loss of sales and also through dilution and tarnishing of the opponent's mark."*

9. The opponent's marks are earlier marks which are subject to proof of use because, at the date of publication of the application, they had been registered for five years.<sup>2</sup> The opponent claims use on all of the goods and services for which the marks are registered.

10. On 26 August 2011, the applicant filed a counter statement in which it denied the grounds upon which the opposition is based and requested the opponent to provide proof of use in respect of all three earlier marks relied upon.

11. A hearing took place on 19 February 2013 at which the applicant was represented by Alan Bernard of Cleveland and the opponent was represented by Christopher Hall of counsel instructed by Lawdit Solicitors Limited.

## EVIDENCE

### The opponent's evidence

12. The opponent's evidence consists of a witness statement from Stu Moss, Managing Director of Daeja Image Systems Limited, a position he has held since 14 November 1997. The statement is dated 1 December 2011 and has nineteen exhibits attached.

13. The main facts emerging from Mr Moss's witness statement are as follows:

- VIEWONE was first used in the UK *'on or around September 1999'*.
- *"Between 1997 to 1999 the VIEWONE product was developed with the intention of producing an all purpose image viewer."*
- VIEWONE is now available in standard and professional versions.

14. Revenue and expenditure figures for products sold under the VIEWONE mark are as follows:

Year	Revenue (£)	Operating Profit (£)
2005	1,069,169	281,260
2006	1,647,029	556,642
2007	1,982,390	631,542
2008	2,351,208	912,305
2009	3,497,571	1,643,960
2010	3,786,452	1,830,356

15. With regard to his customers Mr Moss states:

*"18. Over a 12 year period my Company has acquired thousands of customers internationally and certainly hundreds within the UK (my Company has a history of*

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

*sales of its VIEWONE and VIEWONE Pro image viewers within the healthcare sector dating back to 1999). Many of these UK customers are resellers who provide further end-user customers with my Company's VIEWONE products. Many of these customers are in the healthcare industry such as hospitals etc.*

*19. We currently have over 30,000 VIEWONE server licences. Each server licence can be for between 100 and 2500 users. Therefore, we are talking about 10s of millions of people, customers, and users appreciating the VIEWONE brand for the goods and services we have protection for."*

16. In respect of advertising Mr Moss states:

*"20. My Company is primarily a business to business company and therefore we have used the appropriate business to business mechanisms to advertise our VIEWONE product."*

17. He defines these mechanisms as the company website, trade shows and a network of 100+ resellers. He also states that VIEWONE is also advertised on *Google AdWords* at a cost of approximately £5,000 per month for the VIEWONE keyword.

18. Economic sectors using the VIEWONE product include accountancy, automotive, aerospace, banking & finance, business consultancy, communications, construction, document management, education, fashion & retail, Government (national and local), HR & training, industrial engineering, insurance, IT services/software, legal, libraries, manufacturing, media, medical & healthcare, military & defence and transportation & logistics.

19. Exhibit ST1-1 consists of prints taken from the Daeja Systems website. These are undated but in his witness statement Mr Moss states that they are screenshots of the 1999 and 2011 version of the company website. On the first page (which appears to be the 1999 website page) the product brand is shown as the word „View' overlaying a number 1 or in text as „viewONE'. On the print from the 2011 website the product is referred to as „viewone' in text and using the stylised version of the mark (which can be seen above at paragraph 5).

20. Exhibit ST1-2 is a sample of six pages (Mr Moss states that the full version consists of 127 pages) from the „viewONE HTML and Installation Manual'. It is version 3.1, last updated 20 October 2011.

21. Exhibit ST1-3 is a two page product overview of VIEWONE standard edition. An image of the boxed software product is shown in the top right corner and has the stylised VIEWONE mark clearly visible on the front. The product is described as „viewONE' throughout the text, which consists of a list of product features. Daeja Image Systems' mark is shown in the bottom right corner of both pages. Neither page is dated.

22. Exhibit ST1-4 is described by Mr Moss as „an example of a viewed image'. The page contains a screen shot which shows an x-ray of a right hand open on the desktop. The page is not dated.

23. Exhibit ST1-5 shows a list of image formats supported by „viewone' software. An image of the boxed product showing the stylised mark is visible at the top of the page. The page was printed on 30 November 2011.

24. Exhibit ST1-6 consists of a page titled „Annotations Security within viewone and viewone pro’. The boxed product can be seen in the top right corner of the page and shows the stylised „viewone’ mark. The page describes a range of options for annotation security available with the product. The page is not dated.
25. Exhibit ST1-7 consists of a four page list comparing the features of „viewone’ and „viewone’ pro. Images of both products can be seen on the top right of the page. Both bear the stylised „viewone’ mark. The pages are not dated.
26. Exhibit ST1-8 is a page which describes the key benefits of „viewone’ software. The page was printed on 1 December 2011, though it is not clear where it was printed from. The source address at the bottom of the page suggests that the document is currently stored on a computer C drive.
27. Exhibits ST1-9 - ST1-16 are information pages which provide outlines of various modules available within the „viewone’ software product. All show an image of the boxed product which features the stylised „viewone’ mark. None of the pages is dated.
28. Exhibit ST1-17 is described by Mr Moss as „an example of a brochure’. It consists of seven pages and is titled „viewone pro’. The boxed product can be seen throughout the brochure and features the stylised „viewone’ mark. Where referred to in the text the product is referred to as „viewONE’. None of the pages is dated.
29. Exhibit ST1-18 is described as examples of banners used at trade shows. There are two pages which both feature the Daeja Image Systems mark and an image of the boxed product, showing the stylised mark „viewone’. Both banners feature the phrase „Find out why millions use viewone pro as their viewer of choice.’ The word „viewone’ is presented in the stylised form. The banners are not dated.
30. Exhibit ST1-19 is a copy of a certificate of incorporation for VIEWONE LIMITED dated 14 October 2002.

### **The applicant’s evidence**

31. The applicant’s evidence consists of a witness statement by Steve Curd, dated 19 April 2012, accompanied by two exhibits. Mr Curd is the General Manager of Global Care Quest, a division of Karl Storz Endoscopy-America Inc.
32. The main facts emerging from Mr Curd’s statement are as follows:
33. The applicant company uses a variety of marks with the suffix „1’. These include IMAGE-1, OFFICE-1, VISITOR-1 and NETWORK-1.
34. Exhibit 1 is a series of prints of the applicant’s registered trade marks. Mr Curd concludes the VIEW-1 mark clearly fits into this family of marks.
35. The VIEW 1 product is a combination of hardware and software for use by medical/surgical practitioners.
36. Exhibit 2 is described by Mr Curd as a number of pages showing the VIEW 1 product. For ease of reference I have separated these documents according to their page numbers.

37. Page 1 appears to be a photograph of a memory stick. The words VIEW 1 can be seen on the front of the item. The page is not dated.
38. Page 2 appears to be a photograph of a memory stick. The words „global care quest’ can be seen on its front face. The page is not dated.
39. Page 3 has two black rectangles on it. They may be presentation slides, though this is not clear. The first has VIEW 1 written at a ninety degree angle on its right side. The main image on that „slide’ is a brain scan. The second rectangle is titled „conversation starters’ and begins „...ever have patients bring imaging studies on disks?’ The page is not dated.
40. Page 4 is a photograph of a tablet computer with „VIEW 1 Image Station’ in the top left corner. To the right of those words is the phrase *‘visual clinical intelligence instantly through minimally invasive software’*. The screen shows medical images of scans and x-rays on a tablet and on larger medical apparatus of the type found in hospitals and clinics. The page is not dated.
41. Page 5 is a photograph of a tablet computer with the heading on the screen reading „SURGEON Connect’. Under this are the words „Instant Access for Surgeons’. The screen shows two medical professionals in face masks discussing images in a large clinical environment. To the right of this image is a list of some features of the product and below the list is a photograph of a mobile telephone and tablet computer showing medical images.
42. Page 6 is a photograph of a tablet computer. The computer screen has the heading „command & control’ and features an image of a desktop computer and a rectangle containing some of the product features. The page is not dated.
43. Page 7 is a photograph of a tablet computer. The top quarter of the tablet computer screen shows a list of four names followed by a series of numbers and a medical diagnosis. Below the names the screen is split into four rectangles. Two of these contain abstract 3D medical images, one a graph and the other a picture of a person in a hospital bed with another person at the bedside. The page is not dated.
44. Pages 8 and 9 are duplicates of pages 6 and 7.
45. Page 10 shows a photograph of a medical screen and a tablet computer, both with medical images on the screens. The right side of the page contains contact details for sales and marketing personnel at Global Care Quest. The page is not dated.
46. Page 11 shows a photograph of a medical screen and a tablet computer, mobile telephone, desktop screen and a square box. All have medical images on the screens. The right side of the page contains a logo and the words „global care quest’. The page is not dated.
47. Pages 12 - 28 appear to be a brochure for the VIEW1 image station. Each page features a logo in the top left corner with the words „global care quest’ to the right of it. The pages feature images of tablet computers, mobile phones and desktop screens which are displaying a variety of medical images. At page 3 of the brochure there is an image of a square box with the words „universal reader and viewer’. None of the brochure pages is dated.

48. Pages 37-39 is a sales brochure titled „internal information only’. The first page shows a medical scanner with images displayed on a screen; a tablet computer, with images of a medical nature displayed on the screen and the side of the square box featured in pages 12-28 and described as a „universal reader and viewer’. The following pages ask a variety of questions relating to access and storage of medical images and data. The brochure is not dated and is presumably only made available to prospective customers, as the front page states, „The following information is for your reference in the sales process only, and not for external presentation’.

### **Opponent’s evidence in reply**

49. The opponent’s evidence in reply consists of a further witness statement from Stu Moss (dated 8 August 2012), Managing Director of Daeja Image Systems Limited. There is one exhibit attached which is a print from the opponent’s website. Neither the screenshot nor the page is dated.

50. The main facts emerging from this statement are as follows:

- VIEWONE is written using JAVA technology but is marketed on the basis of its function not its language.

Mr Moss states:

*“8. We have been supplying imaging solutions to the healthcare and pharmaceutical industry since 1999. Many of my Company’s customers currently are hospitals and others in the healthcare industry or companies that provide solutions to the healthcare and pharmaceutical industry. These customers use and/or supply resolutions using VIEWONE and VIEWONE Pro software to deal with the display, marking up and management of images and documents. It is also used by the medical field to display both negative and positive x-rays.”*

### **DECISION**

51. First I will deal with the opposition based upon section 5(2)(b) of the Act which 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,

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

52. 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.”

53. At the hearing Mr Hall amended the opponent’s position and stated that it now sought only to rely on UK trade mark 2310658 and the goods in class 9 of the specification. The application was published on 22 April 2011. The opponent’s earlier mark completed its registration procedure on 18 June 2004. Consequently, the opponent’s registrations would be subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004 if the applicant requested it. As I mentioned above, in its counterstatement the applicant asked the opponent to provide proof of use in respect of all of the goods and services on which it relies however, in his skeleton argument Mr Bernard states:

*“18. The Applicant accepts that the Opponent has shown use of the mark viewone in the form registered or in a manner not altering its distinctive character.*

*19. The Applicant accepts that the Opponent has shown use of the mark in [sic] United Kingdom.”*

56. I confirmed the applicant’s position at the beginning of the hearing and consequently, I need not assess whether there has been genuine use of the mark „viewone’. However, the parties did not agree in respect of the specification which was an accurate reflection of that use. Consequently, I must now go on to consider what constitutes a fair specification for the use shown.

57. 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.”

58. At the hearing the parties agreed that the opponent’s specification „computer software’ could not be maintained in those broad terms. In *Mercury Communications Ltd v Mercury Interactive (UK) Ltd*<sup>3</sup> Laddie J stated:

“39. 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

---

<sup>3</sup> [1995] FSR 850

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.”

59. In its skeleton argument the applicant states:

*“20. However, the Opponent has shown use only on a very limited type of software or computer program. In paragraph 7 of the first statement of Mr Moss, he describes what they have used viewone on. Leaving out the laudatory words it can be summarised:*

*„a java-based applet for embedding into a website page to allow online viewing and mark-up of scanned documents and image formats.”*

60. In its skeleton argument the opponent states:

*“22. Mr Moss says in paragraph 7 of his first witness statement that the product is a document and image viewing and mark-up program. In paragraph 9 he explains that there are many configuration options , and he goes on to list some of these in paragraph 14 and exhibits ST1-9-ST1-16.”*

61. Mr Hall states that these exhibits show:

VIEWONE supports over 300 file formats including emails (Outlook), spreadsheets (Excel) and CAD drawings.

VIEWONE can be used to manipulate pdf files.

VIEWONE provides the opportunity for image sharing and collaborative image viewing - essentially document management.

An overview of VIEWONE and VIEWONE Pro states that VIEWONE Pro is for viewing, annotating, sharing and storing documents and images.

62. Mr Hall concludes:

*“23. A concise summary then, of what the program does, is to handle numerous file types in a way such that each file can be stored, viewed and generally manipulated, in the form of an image, by a number of people acting in collaboration. This, however, is an unnaturally verbose way of describing the program, and is not a description which is appropriate for the average consumer to adopt as a fair one.*

...

*25. ...if a narrower description is appropriate, [which was the agreed position of the parties at the hearing] it should reflect the multiple file types and multiple uses. A fair and sensible description might be ‘computer software for storage and manipulation, including viewing of electronic files.’”*

63. At the hearing Mr Bernard stated that in his view the limitation suggested by Mr Hall was not acceptable as it includes other goods within it. By way of example he suggested that a digibox, an information system on a train and an *itunes* store would all be included within such a specification.

64. Mr Hall suggested a further limitation, namely:

*“software for document viewing, mark-up and sharing”*

65. In reaching a decision on what constitutes a fair specification I am mindful of Mr Hobbs’ comments in *Euro Gida* which I have outlined above. I must identify the category of goods, not particular examples of those goods and should frame the resulting specification in terms which accord with the understanding of the average consumer. The totality of evidence filed by the opponent clearly shows that the software product in question can be used by many different platforms for a range of purposes. It does not have one single use which can be easily identified. Consequently, the resulting fair specification cannot be achieved by simply identifying the purpose of the software.

66. Having taken account of the evidence filed, relevant jurisprudence and the submissions of both parties, I find Mr Hall’s second submission regarding what constitutes a fair specification to be an accurate reflection of the category of goods on which use of the earlier mark has been made. I discuss the nature of the average consumer in detail below, however, for the purposes of arriving at a fair specification suffice it to say the average consumer of the goods at issue here may be a professional, responsible for purchasing the software, or the end user who regularly uses the software. In my view, „software for document viewing, mark-up and sharing’ is how the average consumer would describe the goods 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**

67. 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**

*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.”

### **The average consumer and the nature of the purchasing act**

68. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

69. In its skeleton argument the opponent submits:

*“36. The average consumer of the relevant goods is simply the end user who wants to make use of software for managing and manipulating images. This does not constitute a higher-than-average degree of attentiveness, since the purpose of the software is a very simple and straightforward one. The fact that the Application concerns medical practitioners should not alter this analysis because software does not itself concern matters of a medical nature. Were we talking about ‘knives’, clearly surgeons would pay more attention to scalpels than the average restaurant diner might to his cutlery. There is no reason why doctors should have any special interest in the relevant software over and above that of any other user.”*

70. In its skeleton argument the applicant submits:

*“30. Such apparatus [the applicant’s goods in class 9] will only be purchased by medical practitioners or those responsible for their management. It is highly specialised. It is a customer-facing product in that the end user – the doctor will use it and be conscious of its branding.*

*31. By contrast the Opponent’s software is the sort of software that only an IT specialist would be interested in. It is particularly directed at developers and builders of websites.”*

71. At the hearing both parties made much of the definition of the average consumer for these goods. Mr Hall for the opponent emphasised the end user while Mr Bernard was keen to stress (in the case of the opponent’s goods) that the average consumer would be an IT specialist. In my view the end user of both parties’ goods is unlikely to be the purchaser of those goods. Both will be purchased by a professional who will enable the end user to use the goods in question. Consequently, the goods of both parties will have two distinct types of average consumer; the professional purchasing the goods for use by multiple end users and, the end users themselves who will use the goods on a regular basis.

72. The professional purchaser is likely to pay a fairly high level of attention to what is an expensive and infrequent purchase. He is likely to consider, inter alia, cost, purpose, ease of use and compatibility. The end user is likely to pay attention to the goods to the extent that they enable him to carry out required tasks. Both average consumers are likely to encounter the goods in a way that is likely to be primarily visual, though I do not discount aural considerations.

## Comparison of goods

73. The goods to be compared are as follows:

Opponent's goods	Applicant's goods
Class 9: Software for document viewing, mark-up and sharing.	Class 9: Equipment, namely, computer hardware and peripherals and computer software, in the nature of medical imaging apparatus and embedded computer software, namely, picture archiving and communication systems used for collecting, controlling, categorizing, managing and disseminating patient medical information in the nature of images from medical imaging instruments for use by medical practitioners.

74. In comparing the goods, 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.”

75. 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.”

76. 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.

77. 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)”

78. In his skeleton argument on behalf of the opponent, Mr Hall concludes that the software element of the applicant's specification is identical to the opponent's software [in its original form or in its limited form, suggested in the same document].

79. In his skeleton argument Mr Bernard states:

*“30. The applicant's specification is directed to medical imaging apparatus with embedded software for medical practitioners.*

*This is a machine with software in it. As such it is like many other electronic devices, a television, CD player, and users are not bothered what software is in it.”*

80. At the hearing Mr Bernard was keen to reiterate that the comparison is one between hardware and software.

81. In making a finding on the similarity of the parties' goods I must consider the applicant's specification on a fair and notional basis and the opponent's specification on the basis of the fair specification I have identified at paragraph 66. The applicant's specification includes software and hardware while the opponent's is only for a type of software of the sort I have identified above.

82. The applicant's software is described as *„picture archiving and communication systems used for collecting, controlling, categorizing, managing and disseminating patient medical information in the nature of images from medical imaging instruments for use by medical practitioners.’* The opponent's software is for document viewing, sharing and mark-up. The terms used to describe the nature of the applicant's software are included within the broader terms *„viewing, sharing and mark-up’* in the opponent's specification. The fact that the applicant's software has a specific medical use does not prevent a finding of similarity, since the opponent's software is not limited in any way that would prevent it from being used to manage medical documents and Mr Moss's evidence shows some use by the medical profession. In accordance with the principles in *Meric* I find the software element of the applicant's specification to be identical to that of the opponent.

83. In respect of the hardware element Mr Hall concludes:

*“35. Computer software and computer hardware are similar goods. They occupy the same industry, are sold through the same channels under the same brands (consider, e.g, Apple, or Google), and have the same end users. They are always used in combination - computer hardware achieves nothing without computer software and vice versa - such that they share a common intended purpose. We suggest that software and hardware are inextricably linked, and that they share a very high degree of similarity.”*

84. Mr Bernard states:

*“32...In their submissions the Opponent’s solicitors make much of the fact that both parties process images, but this is superficial and would make a camera like a TV.*

*The Opponent’s software is concerned with being able to open and see, certain encoded documents on a computer which would otherwise not open. These documents might be text or images.*

*The Applicant’s hardware brings together relevant medical data on one screen. It has nothing to do with opening documents. It is a data management apparatus.*

...

*34. The above deals with nature, purpose and manner of use. It is evident that the products are not in competition.*

*35. Trade channels are quite different because the Opponent’s products can and are actually delivered online. To buy it you do not need to get a physical thing. In contrast, the Applicant’s products will be delivered in boxes and obtained from specialised suppliers to the medical industry. You do not buy such products from a general electronic goods supplier.*

*36. The products defined by the respective specifications of goods are therefore not similar.”*

85. In respect of the opponent’s hardware and the applicant’s software, the opponent’s goods may be used by a member of the general public or a professional. The applicant’s goods are used by medical practitioners. There may be some degree of overlap since the opponent’s goods may include use by medical practitioners. The opponent’s goods are used for viewing, marking-up and sharing a range of documents, which may be text or image documents and are not limited by subject matter. The applicant’s goods are used for collecting, controlling, categorizing, managing and disseminating patient medical information in the nature of images. The trade channels for both parties’ goods are unlikely to be a high street electronics retailer. They are both likely to be purchased from fairly specialist suppliers in the first instance, in order to provide a system which can be accessed by a number of end users.

86. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 the General Court (GC) explained when goods were to be considered complementary:

*“82. It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the*



use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

87. The applicant’s hardware is entirely dependent upon software of some sort in order to function. Hardware and software clearly have a complementary relationship to some degree. In this case the applicant’s hardware is for use by medical practitioners to manage medical documents. The opponent’s software enables viewing, mark-up and sharing of documents. The opponent’s software could, in my view, be used with a piece of hardware to carry out the same functions as those identified in the application. These are complementary goods.

88. There is a degree of competition between the parties’ respective goods in the sense that both may have the same users and purpose and they are complementary goods.

89. Taking all of these factors into account I find the applicant’s hardware goods in class 9 to be highly similar to the opponent’s goods in class 9.

### Comparison of marks

90. The marks to be compared are as follows:

Opponent’s mark	Applicant’s mark
Viewone	VIEW1

91. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components,<sup>4</sup> but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. In addition, s/he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them s/he has kept in his or her mind.

### Dominant and distinctive components

92. The applicant’s mark consists of the four letters V-I-E-W followed by the number 1. These are joined to form a mark five characters in length. The mark naturally separates into its component parts, VIEW and the numeral 1. However, neither of these elements is dominant, the distinctiveness of the mark rests in the whole.

<sup>4</sup> *Sabel v Puma AG*, para. 23.

93. The opponent's mark, 'viewone', naturally breaks into its separate components, 'view' and 'one'. However, no part of the mark is dominant and that the distinctiveness rests in the whole. I will now approach the visual, aural and conceptual comparison with the above conclusions in mind.

### **Visual similarities**

94. In its skeleton argument the opponent stated:

*“38. Visually the marks are similar. They both consist of two parts – the former of two conjoined words, the latter a word and a number. The first part of each mark, VIEW, is common to both. The only difference is the word ONE and the number 1.”*

95. In its skeleton argument, filed on 15 February 2013, the opponent stated:

*“24. Visually however the marks are recognisably different and the goods of concern in this case are likely to be purchased with the marks in view.”*

96. At the hearing Mr Bernard confirmed that, in his view, the purchase is a visual one and while the marks are similar, there are visual differences which would not go unnoticed by the average consumer.

97. In my experience, it has become increasingly commonplace in advertising and branding for numerals to be used in place of their equivalent word to the extent that the average consumer may not even notice any difference, even where the marks are not strictly identical. In my view these marks contain differences *„so insignificant they may go unnoticed by the average consumer’* which, in accordance with the decision in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34 (*Sadas*), results in a finding of identity. However, if I am found to be wrong in this, they are at least very highly similar.

### **Aural similarities**

98. Both parties state that the marks are aurally identical. I agree.

### **Conceptual similarities**

99. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>5</sup>

100. The opponent submits in its skeleton argument:

*“38. Since both words VIEW and ONE have a meaning, there is a conceptual meaning to the marks, particularly in the context of the relevant goods, which is of a single view. Conceptually the two marks are therefore identical.”*

101. I am not convinced that the average consumer of the goods at issue will see the marks as a reference to a single view. They are just as likely to see them as referring to a first or best view. However, the actual meaning is irrelevant in this case because whatever the conceptual message, it will be the same for both marks. The marks are conceptually identical.

---

<sup>5</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

## **Distinctive character of the earlier mark**

102. 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 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.

103. The opponent's mark consists of the word „viewone'. In respect of its distinctive character the applicant states in its skeleton argument:

*“25. It is also necessary to consider the distinctive character of the earlier mark. VIEWONE is not inherently a particularly distinctive mark. It is made up of two common English words VIEW and ONE. ‘View’ is obviously relevant to the software’s purpose and one signifies ‘the first’. It is likely that any trader in this type of software will use the word VIEW in a descriptive way, as of course the Opponent does itself.”*

104. The opponent's mark is a single word made up of two individual words, „view' and „one'. I do not think the word „one' necessarily signifies „the first'. It could equally be taken to mean a single view or the best view. The mark in its totality does not serve to describe the goods at issue and is a normal trade mark possessed of an average degree of inherent distinctive character.

The opponent has provided turnover figures which are sufficient to show an established business and it is clear from Mr Moss's witness statement that there are customers of goods sold under the „viewone' mark in the UK. However, the turnover figures have not been broken down to show UK turnover. The size of the software industry in the UK is no doubt substantial and I am unable to conclude, from the evidence provided, what proportion of this is made up of the opponent's goods. I am unable to conclude that the distinctive character of the earlier mark has been enhanced through the use made of it.

## **Likelihood of confusion**

105. 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.<sup>6</sup> I must also keep in mind the average consumer for the goods, 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 vice versa.

106. I have found that the marks are visually identical or at least very highly similar and are aurally and conceptually identical. I have found there to be an average level of inherent distinctive character in the earlier mark, which has not been enhanced through use. I have found the applicant's software to be identical and its hardware to be highly similar to the opponent's software. I have identified the average consumer, namely a professional purchasing the goods for use by a number of end users and those end users themselves. I

---

<sup>6</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

have concluded that a fairly high degree of attention will be paid to the purchase of such goods (which will be primarily visual), to the extent that the purchaser will consider, inter alia, cost, purpose and ease of use and compatibility. The end users of the goods will pay an average level of attention in using the goods to complete everyday tasks.

107. Taking all of these factors into account the similarity of the marks is such that in the context of identical and highly similar goods, purchased, for the most part, visually, there will, in my view, be direct confusion (where one mark is mistaken for the other), even where the average consumer is a professional purchaser paying a high degree of attention to what might be an expensive purchase. Even if I am wrong in my finding that there is likely to be direct confusion, there will be indirect confusion (where the average consumer believes the respective goods originate from the same or a linked undertaking).

### **Conclusion**

108. The opposition having succeeded under 5(2)(b) it is not necessary for me to make an assessment under section 5(4)(a) of the Act which would not put the opponent in any better position.

### **Costs**

109. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£300
Preparing evidence and considering the other side's evidence:	£700
Preparation for and attendance at a hearing:	£600
Official fee:	£200
<b>Total</b>	<b>£1800</b>

110. I order Karl Storz Endoscopy-America, Inc to pay Daeja Image Systems Ltd the sum of £1800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 20th day of March 2013**

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