

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2603479 BY
BYTEMARK INC.
TO REGISTER THE TRADE MARK
BYTEMARK
IN CLASSES 9 & 35
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 103100 BY
BYTEMARK COMPUTER CONSULTING LIMITED**

**AND
IN THE CONSOLIDATED MATTER OF REGISTRATION No. 2605360
STANDING IN THE NAME OF
BYTEMARK COMPUTER CONSULTING LIMITED**

**AND
IN THE MATTER OF A JOINT REQUEST FOR A DECLARATION
OF INVALIDITY THERE TO UNDER No.84607 BY
BYTEMARK LIMITED AND BYTEMARK INC.**

BACKGROUND

1) On 2 December 2011, Bytemark Inc. (hereinafter BIN) applied under No.2603479 to register the trade mark "Bytemark" in respect of the following goods:

In Class 9: Computer communications software to allow customers to access bank account information and transact bank business; Computer software for controlling self-service terminals; Computer software that provides web-based access to applications and services through a web operating system or portal interface; Computer software, namely, an application allowing sales and field service employees to update and receive data stored in an enterprise's computer databases in real time, using a mobile device, with full telephony integration with the telephone and/or software features of the mobile device; Customer self service electronic checkout station for point of sale; computer software that resides on a mobile device for the purposes of managing, storing, editing, and conducting a financial transaction.

In Class 35: Electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; data processing; provision of business information.

2) The application was examined and accepted, and subsequently published for opposition purposes on 13 January 2012 in Trade Marks Journal No.6922.

3) On 12 March 2012 Bytemark Computer Consulting Limited (hereinafter BCCL) filed a notice of opposition. The grounds of opposition are in summary:

a) BCCL has been using the mark BYTEMARK in the UK since 2001 in relation to internet hosting services, rental of computers for data storage, processing and serving to internet users, data storage, processing and serving services to internet users, electronic data storage, data processing, provision of business information, computer consultancy services, computer software updating services, computer software, computer software updates, computer software that provides web-based access to applications and services through a web operating system or portal interface, computer communications software facilitating customers to remotely access the opponent's services, domain name registration services. BCCL has acquired goodwill and reputation as a result of substantial use such that use of the mark in suit will amount to misrepresentation causing damage to BCCL's goodwill, reputation and mark. Use of the mark in suit will offend against Section 5(4)(a).

4) On 15 May 2012, BIN filed a counterstatement denying all the grounds.

5) The following trade mark is registered in the name of BCCL:

Mark	Number	Date of filing / registration	Class	Specification
BYTEMARK	2605360	22.12.2011 / 26.10.12	35	Automated data processing; electronic data processing; online data processing services; presentation of companies on the Internet and other media; advertising on the Internet, for others; computerised file management, data storage, database services, namely systematisation and collating of data in computer databases, digital data processing, auctioneering, including on the Internet, investigations, research in databases and on the Internet, for others, promotion of companies on the Internet and other media, rental of advertising space, including on the Internet (banner exchange), arranging commercial and business contacts, including via the Internet, advertising in the Internet, for others.
			36	Automated payment of accounts; collection of payments; credit card payment processing; credit services for payment of insurance premiums; credit services for the payment of insurance premiums; electronic payment services; financial payment services; information services relating to the automated payment of accounts; payment administration services; payment transaction card services; processing of payments for banks; processing of payments in relation to charge cards; processing of payments in relation to credit cards; arranging financial transactions; automated banking services relating to charge card transactions; automated banking services relating to credit card transactions; financial transaction services; payment transaction card services; processing charge card transactions for others; processing credit card transactions for others; processing debit card transactions for others; provision of information relating to credit card transactions; money transfer services utilising electronic cards.
			38	Telecommunications services; communications services; telephone, mobile telephone, facsimile, telex, message collection and transmission, radio-paging, call diversion, answerphone, directory enquiries and electronic mail services; forwarding of messages of all kinds to Internet; transmission, delivery and reception of sound, data, images, music and information; telecommunications services over the Internet including but not limited to services provided using voice over Internet protocol (VOIP); provision of access and/or connectivity to broadband networks whether fixed, portable or wireless; transmission of text, messages, sound and/or pictures; provision of audio visual content; electronic message delivery services; on-line information services relating to telecommunications; data interchange services; transfer of data by telecommunication; satellite communication services; broadcasting services; broadcasting or transmission of radio or television programmes and of films, teleshopping and web shopping programmes; videotext, teletext and viewdata services; broadcasting and delivery of multimedia content over electronic communications networks; video messaging services; video conferencing services; video telephone services; telecommunication of information (including web pages), computer programs and any other data; providing user access to the Internet; providing telecommunications connections or links to the Internet or databases; providing user access to the Internet (service providers); provision and operation of electronic conferencing, discussion groups and chat rooms; providing access to digital music websites on the Internet; providing access to MP3 websites on the Internet; delivery of digital music by telecommunications; providing access to telecommunications infrastructures for other operators; telecommunication access services; computer aided transmission of messages and images; communication by computer; news agency services; transmission of news and current affairs information; hire, leasing or rental of apparatus, instruments, installations or components for use in the provision of the aforementioned services; advisory, information and consultancy services relating to all the aforementioned.

			42	Web hosting services; maintaining and hosting the web sites of others; hosting of Internet sites; hosting of digital content on the Internet; computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for searching and retrieving information from databases and computer networks; providing platforms on the Internet, operating chatlines, chat rooms and forums; technical consultancy and aid in the field of computer hardware and computer software; providing technical advice and assistance for the operation of data processing equipment; services of the creation, design and development of a data bank including electronic information; consultancy services relating to computer hardware and computer software; leasing of computer hardware and computer software; development of computer programs; maintenance and updating of computer software; design and development of computer hardware; creating, operating and maintaining web sites, web pages and portals for logging text, images and music provided either via computers or mobile telephones; hosting websites; rental of database servers; operating and providing search engines.
			45	Compilation, creation and maintenance of a register of domain names.

6) By an application dated 13 July 2012, subsequently amended, BIN and Bytemark Limited, jointly applied for a declaration of invalidity in respect of this registration. For ease of reference I shall in the course of my decision simply refer to the joint applicants in the singular as BIN. The grounds are, in summary:

- a) BIN is the registered proprietor of the mark shown in paragraph 1 above.
- b) BIN contends that the mark in suit is similar to its trade mark and that the goods and services are similar such that the mark in suit offends against Sections 5(1) and 5(2)(a). BIN also contends that as a result of its use in the UK since February 2011 it has obtained a reputation in the UK in relation to mobile payment and ticketing system. As such the mark in suit offends against Sections 5(3) and section 5(4)(a) of the Act.

7) BCCL provided a counterstatement, dated 5 February 2013, in which it denies the above grounds and claims. BIN is put to strict proof of its claimed earlier use.

8) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 19 November 2013 when BCCL was represented by Mr Colley of Counsel instructed by Messrs Groom Wilkes & Wright LLP. BIN was not represented, but had previously provided written submissions.

BCCL'S EVIDENCE

9) BCCL filed two witness statements. The first, dated 23 July 2012, is by Matthew Bloch, the co-founder and Managing Director of BCCL a position he has held since 2002. He states that his company "runs a comprehensive managed hosting service" for large companies such as Asda, Bostik, and Retail Eyes as well as government departments such as the Department of Health and Central Office of Information. BCCL's customers also include web developers who trust their clients to BCCL's "solid

infrastructure and understanding of their software". He states that the mark BYTEMARK was first used by the partnership he formed in 2001 which provided "computer software consulting services of all kinds". In July 2002 BCCL was formed and has used the same mark on the services listed at paragraph 3a above. He states that they introduce themselves on the phone etc. as "BYTEMARK" and that this is how customers refer to them. They have, since 2001, used the domain name "bytemark.co.uk" and in 2003 added the domain name "bytemark-hosting.co.uk". The bytemark.co.uk domain name is used by their clients in their publicity simply adding a preface of their own to BCCL's domain name. He also states:

"8. My company has consistently used the trade mark BYTEMARK over the years in respect of internet hosting services, rental of computers for data storage, processing and serving to internet users, data storage, processing and serving goods and services to internet users, electronic data storage, data processing, provision of business information, computer consultancy services, computer software updating services, computer software, computer software updates, computer software that provides web-based access to applications and services through a web operating system or portal interface, computer communications software facilitating customers to remotely access my company's services, and domain name registration goods and services ("the goods and services")."

And:

"12. With regard to "computer communications software to allow customers to access bank account information and transact bank business" my company does provide computer software via a web interface onto many of its hosting goods and services (and have done so since at least 2005), including billing updates and ordering. Financial information is available through my company's web interface software. We also store our customers' credit card details for billing purposes, and could not reliably run our business without automatic billing functions built into my company's software. Additionally, we do have customers who operate in the banking sector (for example, Banque Francaise Commerciale and Al Mawarid Bank of Lebanon). As mentioned in paragraph 7 above many of our customers store data remotely on our systems. Their customers then access that data using an electronic link through web addresses ending bytemark.co.uk. The data stored may include sensitive financial information. My company's customers, particularly its financial customers, may therefore be concerned that there would be a risk of confusion and misdirection of data given the closeness of the applicant's [BIN's] mark and use by the Applicant of their related domain name bytemark.co.

13. With regard to "computer software for controlling self service terminals; computer software that provides web-based access to applications and services through a web operating system or portal interface" many of the services are provided by my company through a web operating system or portal interface directly accessible by customers remotely. These include, but are not limited to, domain registration, billing updates and ordering. These services are core to my

company's business. Hosting services involve the remote storage of data for our customers, clearly therefore my company must provide applications and services that facilitate access to that data on the web. We could not operate otherwise. We have provided these goods and services since use began.

14.Many of our customers use the goods and services to implement field working and data collection interfaces (for example, doppr.com). In addition, my company also supplies software for remotely accessing and updating data (including financial billing data) on our customers' sites. There is now produced and shown to me marked exhibit MB4 an extract from my company's websitereferring to our "Symbiosis system" software which has documentation running into hundreds of pages. Further our "watchdog system" is software that monitors customers' servers and provides updates to them in real time by email, or SMS to customers' mobile phones."

10) He then goes on to detail how they became aware of BIN's activities, what occurred between the parties and he compares the services of the two parties. I shall refer to the comparison as and when required later in my decision. Mr Bloch states that his company provides goods and services throughout the UK and to sixty six other countries. He also provides the following turnover figures for goods and services. However, the figures are not broken down according to the type of goods or services they relate to, nor even which country/ countries the figures relate to.

Year	Turnover	Advertising
2005	255,682	-
2006	382,146	-
2007	652,727	-
2008	988,669	-
2009	1,278,393	-
2010	1,543,612	46,759
2011	1,906,343	54,174

11) Mr Bloch states that the advertising figures include items such as flyers, brochures, exhibitions and conferences as well as promotional items. He states his company has also sponsored various conferences around the UK in the years 2007-2012. BCCL has also advertised its goods and services in the national media. BCCL have also run joint advertising campaigns with clients such as Hewlett Packard and have also been mentioned by other clients in their advertising and blogs.

- MB4: Extracts from BCCL's website including pages from the "wayback machine" which shows that BCCL has offered hosting servers and software which monitors these servers and provides customers with real time updates. These date from March 2005 - February 2011. All the website pages show the name "**BYTEMARK** HOSTING" at the top of the page, i.e with the word BYTEMARK emboldened.

- MB5: A current price list for goods and services. This shows the mark **“BYTEMARK HOSTING”** at the top of the page but also refers to the list being “a snapshot of Bytemark’s complete price list”. It offers prices on, inter alia, virtual machines, servers, storage, dedicated hosts, domains, IP blocks, bandwidth and software licences.
- MB6: A selection of nine invoices 1 July 2004 – 28 November 2011 showing a total of £27,526 of sales (including VAT) in respect of virtual machine rental and server rental. Eight of the nine invoices relate to the UK and show addresses across the UK. These show the mark **“BYTEMARK HOSTING”** at the top of the page but also refers to BCCL.
- MB7: A map of the UK showing the locations of a large number of customers which covers all areas of the UK with the exception of Northern Ireland.
- MB8: Examples of company literature with “Bytemark” upon it, which also have the mark **“BYTEMARK HOSTING”** on them. These describe BCCL as offering hosting services, service monitoring and domain name services.
- MB9: Copies from BCCL’s website, including pages from the “wayback machine” from April 2001 to date. These show use of the BCCL’s full name as well as the terms **“BYTEMARK”** and **“BYTEMARK HOSTING”**. These describe BCCL as offering hosting services, service monitoring, anti spam software and domain name services. At page 130 there is also a paragraph from the BCCL website offering custom-built software; this is dated 5 February 2003.
- MB10: Copies of company documents showing use of BYTEMARK. These mostly use the term **“BYTEMARK HOSTING”**, but also have the full name of BCCL and also refer to the company simply as **“BYTEMARK”**. These show that BCCL offers hosting services.
- MB11: Photographs of promotional items and details of sponsored events. These show use of the BCCL’s full name as well as the terms **“BYTEMARK”** and **“BYTEMARK HOSTING”**.
- MB13: A copy of a Google search for the term “bytemark” which gave Bytemark Hosting as the number one hit with BIN as the second company.
- MB14: Details of some of the exhibitions attended and the attendee numbers. This shows the company name as “Bytemark Hosting”.
- MB15 & 16: A selection of media advertisements and other press mentions. These show use of the terms **“BYTEMARK”** and **“BYTEMARK HOSTING”**. These mostly relate to the hosting services offered by BCCL.

- MB 17, 18 & 19: Joint promotions and mentions by clients. These show use of the terms “BYTEMARK” and “**BYTEMARK HOSTING**”. Again these mention the hosting service.
- MB22: Copies of emails received by BCCL but meant for BIN.

12) The second witness statement, dated 6 April 2012, is by Sylvie Tate BCCL’s Trade Mark Attorney. She provides, at exhibit ST1, a copy of an email which indicates that BCCL received a telephone call which was meant for BIN.

BIN’S EVIDENCE

13) BIN filed eight witness statements. The first, dated 3 October 2012, is by Micah Bergdale the co-founder, Director and shareholder of BIN. He states that the company was incorporated in 2011. He states that he is also a Director and shareholder of Bytemark Limited (BL) which was incorporated in August 2011. He states that BL is a UK trading entity which operates under an exclusive licence agreement granted by BIN. He states that the term “BYTEMARK” was created independently by himself and some colleagues in New York on 15 December 2010. He states that at the time they had no knowledge of BCCL. His company offers a system whereby transactions such as payments and ticketing can be carried out via a mobile phone. The mark BYTEMARK was registered in the USA in 2012 and a domain name registered in February 2011. He states that there is minimal cross over between the businesses of the two parties and states the following as being areas where this does occur: data storage; advertising services provided via the internet and data processing. He states that the mobile ticketing and payment platform offered by his company is significantly different to the hosting and support services offered by BCCL. He points out that his business is not aimed at the end users but at the merchants, venues and stadiums and trading partners such as financial institutions, whereas BCCL is aimed at the end users. He states that the emails referred to in the evidence of BCCL are the result of simple mistypes not confusion.

14) The second witness statement, dated 3 October 2012, is by Alexander Ian Stewart a Director of Bytemark Limited. He reiterates much of what Mr Bergdale states. He comments that the Google search carried out by BCCL makes it clear from the descriptions that the companies offer very different goods and services. He contends that as such no confusion will arise. He comments that the majority of on-line services use “cloud servers” and “API” (application programming interface). He points out that his company has not attended any of the events sponsored or attended by BCCL as their businesses are different and these events are of no interest to BIN. He provides numerous exhibits which show that his company is providing ticketing and payment services to companies who are selling products or services to the general public. However, these are either undated or are after the date of their trade mark application.

15) BIN also filed six proforma witness statements where various companies have stated that when they hear the name Bytemark they think of BIN and that they have

never heard of BCCL. These are of no assistance to me in reaching my decision as the wording is virtually identical and the individuals are merely providing an opinion.

BCCL'S EVIDENCE IN REPLY

16) BCCL filed a witness statement, dated 25 March 2013, by Mr Bloch who has provided evidence earlier in this case. Attached as exhibits he provides details of nine emails and two phone calls received by his company from, inter alia, a bank, a football club, a journalist, a conference organiser and a corporate video company. Some of these had previously met or been in contact with BIN yet still contacted BCCL. He states that on average, over the 15 months prior to his statement, his company had received at least one misdirected email or phone call per month. He speculates that BIN would also have received a similar number of emails/calls meant for BCCL.

BIN'S FURTHER EVIDENCE IN REPLY

17) BIN filed two witness statements, dated 14 April 2013 and 31 May 2013, by Mr Stewart who has provided evidence previously in this case. He provides details of exhibitions and conferences that his company has attended recently. He also states that BCCL was not in attendance at any of these events as they were aimed at those requiring mobile payment and ticketing. He contends that his company has "become one of the fastest growing players in the market of mobile ticketing and payment platforms in the UK" and that as a result their mark is becoming well known in the sector. He states that there have been no recent instances of BIN receiving any communication intended for BCCL. He also states:

"9. By way of background, mobile ticketing is the process whereby customers can order, pay for, obtain and validate tickets from any location and at any time using mobile phones or other mobile handsets. Mobile tickets reduce the production and distribution costs connected with traditional paper-based ticketing channels and increase customer convenience by providing new and simple ways to purchase tickets. Mobile ticketing is a prime example of horizontal telecommunications convergence.

10. Further, mobile payment, also referred to as mobile money, mobile money transfer, and mobile wallet generally refer to payment services operated under financial regulation and performed from or via a mobile device. Instead of paying with cash, cheque or credit cards, a consumer can use a mobile phone to pay for a wide range of services and digital or hard goods."

And:

"11. By contrast a web hosting service is a type of Internet hosting service that allows individuals and organisations to make their website accessible via the World Wide Web. Web hosts are companies that provide space on a server owned or leased for use by clients as well as providing internet connectivity, typically in a data centre. Web hosts can also provide data centre space and connectivity to the Internet for other servers located in their data centre, called collocation.

12. Specifically, managed hosting is where the user gets his or her own Web server but is not allowed full control over it (user is denied root access for Linux/administrator access for windows); however, they are allowed to manage their data via FTP or other remote management tools. The user is disallowed full control so that the provider can guarantee quality of service by not allowing the user to modify the server or potentially create configuration problems. The user typically does not own the server. The server is leased to the client. This is the type of service offered by the opponent [BCCL].”

18) At exhibits AS4 & 5 he provides independent documentation from, inter alia, Wikipedia which backs up these statements and definitions. He also points out that both BIN and BCCL have individuals working for them named Alex and the domain names, www.bytemark.co.uk (BCCL) and www.bytemark.co (BIN), are very similar. He contends that any businesses with similar domain names could face the same issues. He comments individually on the instances of miscommunication reported by BCCL, but effectively states that they are all a result of simple mistakes by the person seeking to contact him and/or his company and that they have not received any communications intended for BCCL.

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

DECISION

20) The only ground of opposition against application 2603479 is under section 5(4)(a) which reads:

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

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

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

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

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see

Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

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

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

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

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

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

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

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

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

23) In the instant case BIN's application has a filing date of 2 December 2011. If BIN has used its trade mark prior to this, then this use must also be taken into account. It could, for example, establish that BIN is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could

mean that BIN's use would not be liable to be prevented by the law of passing-off – the comments in *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer. However, having considered the evidence filed by BIN there is no evidence of use of its mark in the UK market prior to the filing date. Therefore, the material date is 2 December 2011.

24) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

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

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

25) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL 0/191/02.

26) I turn to assess the evidence filed by BCCL in the present proceedings as set out earlier in this decision. Although its evidence is flawed in that its turnover figures appear to relate to world wide sales it has provided a sample of invoices over a number of years which, whilst modest in the sums involved, cannot be regarded as anything other than genuine, and have not been so challenged by BIN. To my mind, BCCL has clearly demonstrated that it has used the word “Bytemark” in relation to hosting services and also software allowing the data stored to be amended and retrieved. It also monitors customers' accounts and sends them alerts as well as offering services such as domain name rental and software licences. BIN contended that BCCL had used the mark “bytemark hosting”. Whilst there is clear use of the mark “bytemark hosting” when used in relation to hosting services I do not consider that the average consumer will view the word “hosting” as having any trade mark or origin significance. Further, there is clear evidence of the use of “bytemark” solus. BCCL has overcome the first hurdle in showing that at the material date it had goodwill in the mark Bytemark in relation to hosting services and computer software.

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

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by Wynn-Parry J. in *McCulloch v May* [1948] 65 RPC 58 when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* (1902) 2 Ch. 282 (The Times Newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing-off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing-off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

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

Also:

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

And:

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

28) In the instant case BIN is seeking registration of the following specification:

In Class 9: Computer communications software to allow customers to access bank account information and transact bank business; Computer software for controlling self-service terminals; Computer software that provides web-based access to applications and services through a web operating system or portal interface; Computer software, namely, an application allowing sales and field service

employees to update and receive data stored in an enterprise's computer databases in real time, using a mobile device, with full telephony integration with the telephone and/or software features of the mobile device; Customer self service electronic checkout station for point of sale; computer software that resides on a mobile device for the purposes of managing, storing, editing, and conducting a financial transaction.

In Class 35: Electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; data processing; provision of business information.

29) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

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

30) To my mind there is a clear overlap between the goods and services applied for by BIN and those in which BCCL has shown it has goodwill. Mr Stewart of BCCL provided the following definition of hosting as “a web hosting service is a type of Internet hosting service that allows individuals and organisations to make their website accessible via the World Wide Web” (see paragraph 17 above). It is clear that BCCL has a number of different clients including a bank which conduct financial transactions via the servers they rent from BCCL and that BCCL provides a range of software to monitor the customers’ data. There is clear evidence that BCCL provides software licences, and at exhibit MB9 an unambiguous reference to custom built software to meet specific client requirements. When this is added to the unquestionable identity of the marks there is clearly misrepresentation. The evidence of emails being received by BCCL which were meant for BIN merely strengthens my view and also provides evidence of potential damage. BIN’s explanation that the confusion was due to both parties having someone called Alex working for them is risible.

31) The opposition under Section 5(4)(a) is therefore successful against all the goods and services in the application’s specification.

32) I now turn to consider the invalidity action against UK trade mark 2605360. Section 47 of the Trade Marks Act 1994 reads:

“47.-(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

33) Because of my earlier finding BIN does not have an earlier mark to rely upon under its invalidity request. Therefore, its invalidity grounds based upon Sections 5(1), 5(2)(a) and 5(3) must all fail. Moving onto the section 5(4)(a) ground, I have found earlier in this decision that BCCL is clearly the senior user of the mark and therefore BIN cannot succeed under this ground either.

CONCLUSION

34) BCCL has been successful in its opposition and has also successfully defended its mark in the invalidity action.

COSTS

35) As BCCL has been successful it is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side's statement x2	£500
Preparing evidence and considering the evidence of the other side	£1200
Preparing for and attending a hearing	£1000
TOTAL	£2,900

36) I order Bytemark Limited and Bytemark Inc. to pay Bytemark Computer Consulting Limited the sum of £2,900. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of November 2013

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