

**O-327-16**

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO 3029174  
IN THE NAME OF QUORA LIMITED  
IN RESPECT OF TRADE MARK:

**QUORA**

AND

AN APPLICATION FOR A DECLARATION OF THE  
INVALIDITY THEREOF UNDER NO 500782  
BY QUORA, INC.

## **BACKGROUND**

1. Trade mark No. 3029174 shown on the cover page of this decision stands registered in the name of Quora Limited (the proprietor). It was applied for on 4 November 2013 and completed its registration procedure on 1 August 2014. It is registered for the following goods in the following classes:

### **Class 6**

Metal building and construction materials; prefabricated, portable and/or relocatable buildings; modular portable building units for use on construction sites; prefabricated relocatable buildings constructed of modular portable building units; parts and fittings for all of the aforesaid goods; all made wholly or principally of metal.

### **Class 19**

Building construction materials; materials (non-metallic) for building decoration; materials, and components, all for use in building and construction, namely bricks, timber, cement, plaster, slates, roofing materials, guttering, pipes and ducts; sheds, out buildings, garages, gazebos, summer houses, conservatories; transportable buildings, prefabricated, portable and/or relocatable buildings; all the aforesaid goods wholly or principally of non-metallic materials; parts and fittings for all the aforesaid goods.

### **Class 35**

Assistance and consultancy relating to business management and organisation; provision of commercial information; business management services for the maintenance and repair of industrial, commercial, government and other public sector buildings and infrastructures (including roads, rail, bridges and utility supplies); business management services for the operation of offices, industrial and retail premises, hospitals, clinics, schools and other educational establishments, courts, houses, prisons and secure training centres, armed forces accommodation and facilities, parking and other ancillary facilities; business management of businesses providing services for the foregoing, including catering, cleaning, laundry, security services and recruitment, supply and management of personnel; advice, information and consultancy services relating to all of the aforesaid services; commissioning services, namely, arranging the outsourcing of construction, repair, maintenance, renovation and/or demolition services, hygiene services, catering services, laundry services, security services, recruitment services and supply and management of personnel in respect of private, residential, food retail, mixed use, general retail,

industrial and commercial infrastructure projects, including industrial, commercial, healthcare, retail and residential real estate civil works.

### **Class 36**

Insurance services; provision of financial advice; real estate services; property and real estate management; leasing, letting and renting of offices, industrial and retail premises, hospitals, clinics, schools and other educational establishments, courts, houses, prisons and secure training centres, armed forces accommodation and facilities; land acquisition services; general property dealer services, namely intermediary services between buyers and sellers and managing agents of private, residential, food retail, mixed use, general retail, industrial and commercial, civil works properties and developments and managing agents in all types of properties and developments; property leasing services; advice, information and consultancy services relating to all the aforesaid services.

### **Class 37**

Construction, repair, maintenance, renovation and demolition of buildings and civil engineering structures and infrastructure (including roads, rail, bridges and utility supplies); building services; cleaning and laundry services; hire and repair of plant and equipment for use in building, civil, mechanical and electrical engineering; maintenance and repair of land vehicles; property development; land development; real estate development; construction management for the building, construction and engineering industries; commissioning services, namely, the outsourcing of construction, repair, maintenance, renovation and/or demolition services in respect of private, residential, food retail, mixed use, general retail, industrial and commercial infrastructure projects, including industrial, commercial, healthcare, retail and residential real estate civil works; consultation, supervision and maintenance services in relation to private, residential, food retail, mixed use, general retail, industrial and commercial, civil works and infrastructure projects including industrial, commercial, healthcare, retail and residential real estate civil works and infrastructure projects; supervision services for the maintenance and repair of industrial, commercial, government, civil works properties, private, residential, food retail, mixed use, general retail and infrastructures (including roads, rail, bridges and utility supplies); supervision services for the operation of offices, industrial and retail premises, hospitals, clinics, schools and other educational establishments, courts, houses, prisons and secure training centres, armed forces accommodation and facilities, parking and other ancillary facilities; management of businesses providing services for the foregoing, including catering cleaning;

management of businesses providing services for the foregoing, including catering, cleaning; commissioning (arranging of outsourcing) of hygiene services, catering services, maintenance of landscape and grounds , laundry, security services and recruitment, supply and management of personnel; construction management services; engineering services including civil engineering services; advice, information and consultancy services relating to all the aforesaid services.

**Class 39**

Transport and delivery of machines and material for use in building, construction and engineering industries.


**Class 42**

Design services; architectural services including architectural consultation services; interior and exterior building design services; professional consultancy services relating to design, research and development; advisory, analytical and information services relating to architectural, engineering and environmental matters; professional project management; all for the building, construction and engineering industries; advice, information and consultancy services relating to all the aforesaid services.

2. On 4 March 2015, Quora, Inc (the applicant) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and (b) and sections 5(2)(a) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. The applicant relies upon the following international registrations (IR), goods and services:

<b>Mark details:</b>	<b>Goods and services:</b>
<p><b>IR:</b> 1154759</p> <p><b>QUORA</b></p> <p><b>Priority date:</b> 12 January 2013 (US)</p>	<p><b>Class 9</b></p> <p>Computer software for users to ask and answer questions on a variety of topics of general interest; computer software for users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking.</p>

<p><b>International registration date:</b> 19 February 2013</p> <p><b>Date of protection in the EU:</b> 20 February 2014</p>	
<p><b>IR:</b> 1136913</p>  <p><b>International registration date:</b> 24 September 2012</p> <p><b>Date of protection in the UK:</b> 15 March 2013</p>	<p><b>Class 35</b> Advertising; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; price comparison services; commercial information and advice for consumers [consumer advice shop]; auctioneering; sales promotion for others; compilation of information into computer databases; systemization of information into computer databases; data search in computer files for others.</p>
<p><b>IR:</b> 1145649</p> <p><b>QUORA</b></p> <p><b>International registration date:</b> 10 December 2012</p> <p><b>Date of protection in the EU:</b> 3 December 2013</p>	<p><b>Class 35</b> Advertising on the Internet for others; Advertising services.</p> <p><b>Class 38</b> Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest.</p> <p><b>Class 45</b> On-line social networking services.</p>
<p><b>IR:</b> 1048976</p>	<p><b>Class 42</b> Computer services, namely, providing</p>

<p><b>QUORA</b></p> <p><b>Priority date:</b> 12 February 2010 (US)</p> <p><b>International registration date:</b> 10 August 2010</p> <p><b>Date of protection in the EU:</b> 26 July 2011</p>	<p>customized online web pages featuring user-defined information; computer services, namely, providing a webpage for users to ask and answer questions on a variety of topics of general interest, providing search engines for obtaining information requested by users on a global computer network, providing customized searching of a webpage to locate specific information requested by users, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking; application service provider featuring application programming interface (API) software for use in building software applications.</p>
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4. 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.”

5. The marks relied upon by the applicant are earlier marks, which are not subject to proof of use because, at the date of the application for invalidity, they had not been registered

for five years.<sup>1</sup> Consequently, the applicant is entitled to rely on its full specifications for all of the marks relied on.

6. On 26 May 2015, the proprietor filed a counterstatement in which it accepts that the parties' marks are identical but denies any similarity between the respective goods and services.

7. Both parties filed evidence, written submissions and a skeleton argument. A hearing took place on 5 April 2016. The proprietor was represented by Mr Thomas St Quentin of Counsel who attended by video conference. The applicant was represented by Dr Dominic Murphy of Withers and Rogers LLP, who attended by telephone.

8. Both sides seek an award of costs. In the proprietor's case a request has been made for costs off the scale with which I will deal later in this decision.

## **EVIDENCE**

### **The applicant's evidence**

#### Witness statement of Dominic Murphy with exhibits DM1 – DM14

9. Dr Murphy is a trade mark attorney at Withers and Rogers LLP. His witness statement is dated 11 September 2015.

10. Dr Murphy states at paragraph 2:

*“...the applicant's company was founded in 2009, and the QUORA website was made available to the public in 2010. The news of the launch of the QUORA service to the public was announced in the Wall Street Journal and other major media channels including the Internet.”*

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<sup>1</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.

11. Exhibit DM1 consists of prints taken from The Wall Street Journal. The first is dated 22 June 2010 and is titled, *'Racing to Fill Gaps Left by Google'*. Paragraph 2 of the article reads as follows:

*"One of the hopefuls, Quora, Inc., made its public launch Monday after months of private testing. The Palo Alto, Calif., company, co-founded by two early Facebook Inc. engineers, wants to collect and organise information people have in their heads but that may not be available online, such as background on the inner workings of a company and advice on how to get a reservation at an exclusive restaurant."*

12. The second article is titled, *'A New Social Network Where Inquiring Minds Run Wild'* and is dated 19 January 2011. Paragraphs 2 and 3 include the following:

*"Quora (Quora.com) was launched about six months ago by two former Facebook employees who wanted to create a forum where in-depth questions could be posed and answered. Users vote answers up or down according to how good they are, the idea being that the best answers get pushed to the top of the queue by the community of users. Few of these questions can be answered with a simple yes or no. For example, one question asks, 'What role did social media play with regards to the revolution in Tunisia?'..."*

*One thing to be wary of: There's nothing that qualifies the most popular answers as accurate, nor do people who write the most popular answers necessarily qualify as experts."*

13. The remainder of the exhibits attached to Dr Murphy's witness statement relate to the nature of the proprietor's current business and the fact that there are no other 'QUORA' trade marks on the UK Trade Mark Register. In essence, his position is that the proprietor is a property development company and the applicant has questions relating to property development on its website. In fact only two such questions, which are shown in DM9 and DM10, relate to the UK.



Witness statement of Steven Trieu with exhibits ST1 – ST8.

14. Mr Trieu is the Vice President of Finance at Quora Inc. (the applicant). His witness statement is dated 9 September 2015.

15. He states at paragraph 4 of his witness statement:

*“[The applicant] does not charge its users for access to its website (www.quora.com) nor does it allow advertising on its website such that it does not generate advertising revenue. Instead, it is solely funded by investors. My Company’s estimated worth is currently around US\$800 million.”*

16. Exhibits ST1-ST3 and ST7 relate to the ranking of the applicant’s website on www.similarweb.com. The exhibits show that the ‘quora’ website is ranked 7<sup>th</sup> worldwide and 4<sup>th</sup> in the UK in a list of ‘reference’ websites and 2<sup>nd</sup> worldwide and in the UK for ‘dictionaries and encyclopaedias’. They also show that it is the 68<sup>th</sup> most popular app on the *google play* store, though the figure shown appears to relate to Canada. The exhibits are all dated 8 October 2015, considerably after the relevant date.

17. Exhibit ST4 consists of prints of the applicant’s TM registration certificates.

18. Exhibits ST5 and ST6 relate to the applicant’s mobile app, which was launched in September 2011. They show the app on sale on *itunes* and the *google* app store. Both examples are .com sites rather than .co.uk sites and they are dated 4 September 2015, after the relevant date.

19. ST8 comprises a number of press articles. The first is from www.telegraph.co.uk and is dated 4 September 2015, after the relevant date. It is titled, ‘*Quora – the 10 most unexpected questions.*’ The second is from the same site and is dated 4 January 2011. It is titled, ‘*Quora will be bigger than twitter.*’ The third article is from the US site, www.cnet.com and is titled ‘*Quora collects \$80 million in funding.*’ It is dated 9 April 2014. The fourth is taken from www.slate.com which reproduces a question and answer from Quora. It is titled, ‘*What do British People Think About the UK’s Gun Restrictions?*’ and is dated 1 May 2014. The final article is taken from www.huffingtonpost.co.uk and

reproduces a question and answer from the applicant's website. It is titled, '*What does America Have That Does Not Exist in the UK?*' The answer is provided by a British person living in the US. The article is dated 30 December 2014.

## **Proprietor's Evidence**

### Witness statement of Michaela Selvester with exhibits MSK1 – MSK4

20. Ms Selvester is an attorney at Freeth's LLP, the proprietor's instructing principal. Her statement is dated 5 November 2015.

21. Ms Selvester's evidence relates to the nature of the applicant's business. It shows that the business relates to a question and answer website, that the answers provided on the site are given by members of the 'Quora community' and that one must be a member of that online community in order to ask or answer questions.

## **Applicant's evidence in reply**

### Second witness statement of Steven Trieu with exhibits ST10 – ST20.<sup>2</sup>

22. Mr Trieu's second statement is dated 2 August 2016 and states the following at paragraph 2:

*"...I have been asked to provide evidence in addition to that already submitted that pre-dates the filing date, being November 4, 2013, of the Application that is being contested."*

23. Exhibits ST10, ST12, ST14, ST16 and ST17 are all prints taken from US sites and all appear to be directed at the US market. ST13 is a duplicate of an article already filed at ST8, above. None of the remaining articles indicate the level of use of Quora in the UK. ST15 which is taken from the April 2011 issue of 'Wired', a UK technology magazine, is titled, '*How Quora became the hottest website of the year.*' The article refers to one

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<sup>2</sup> There is no exhibit ST9 included in the evidence.

specific question and answer on the site which refers to staff matters at *google*. Any financial information provided in the articles is shown in dollars.<sup>3</sup>

#### Second witness statement of Dominic Murphy with exhibit DM20<sup>4</sup>

24. Dr Murphy's second statement is dated 10 February 2016. Attached to his statement are mission statements and 'about us' pages from SimilarWeb and Alexa, two companies from which prints have been taken for the purposes of filling the applicant's evidence.

25. Having scrutinised the evidence on file it is clear that the documents provided by the applicant only relate to its question and answer website, quora.com. Evidence relating to the popularity of that website is all dated two years later than the date of application of the proprietor's mark. In the applicant's submissions, dated 10 February 2016, it submits that in January 2011 its website had 160,000 active users. In May 2012 it had 812,245 unique visitors. Given the fast growing nature of such a business, I am unable to conclude that the position of the applicant's website in the marketplace in October 2015 was indicative of its position two years earlier.

26. I do not consider that the evidence shows the earlier marks benefit from any enhanced distinctiveness and nor are the marks shown to have a reputation in the UK. The earlier marks relied upon are international registrations and, whilst a large number of exhibits relate to the US market and are taken from US publications and include financial information in US dollars, in respect of the objection under section 5(3) of the Act, it has to be shown that the mark is known and has a reputation in the UK. The evidence does not support such a finding.

### **DECISION**

27. Section 47(2) reads:

The registration of a trade mark may be declared invalid on the ground-

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<sup>3</sup> For example ST18 dated 31 October 2012 and taken from [www.wellblog.co.uk](http://www.wellblog.co.uk).

<sup>4</sup> There are no exhibits numbered DM15-DM19.

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

28. Sections 5(2)(a) and 5(3) read as follows:

“5. - (2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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.

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

## **The 5(2)(a) ground**

### **Comparison of marks**

29. At paragraph 5 of its counterstatement the registered proprietor states the following:

*“The Registered Proprietor concedes the assertions made in Clause 5 of the Statement of Grounds, namely that the trade mark the subject of the Registration is identical to the trade mark the subject of the Applicant’s Registrations.”*

30. The proprietor’s mark stands registered for the plain word QUORA, with no additional stylisation. Three of the applicant’s earlier marks are also registered for the plain word QUORA with no additional stylisation. These are clearly identical marks. The applicant’s mark under IR1136913 is also for the plain word QUORA but has been registered in a particular typeface. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*<sup>5</sup>, the CJEU stated:

“54. ...Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

31. Given that the typeface used for the applicant’s mark is a standard font with no additional material, it is, in light of the reasoning in *Sadas*, clearly identical to the proprietor’s mark.

**Comparison of goods and services.**

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

<b>The applicants’ goods and services</b>	<b>The registered proprietor’s goods and services</b>
<p><b>Class 9 (IR1154759)</b>            Computer software for users to ask and answer questions on a variety of topics of general interest; computer software for users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking.</p>	<p><b>Class 6</b>            Metal building and construction materials; prefabricated, portable and/or relocatable buildings; modular portable building units for use on construction sites; prefabricated relocatable buildings constructed of modular portable building units; parts and fittings for all of the aforesaid goods; all made wholly or principally of metal.</p>

<sup>5</sup>[2003] FSR 34

<p><b>Class 35 (IR1136913)</b> Advertising; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; price comparison services; commercial information and advice for consumers [consumer advice shop]; auctioneering; sales promotion for others; compilation of information into computer databases; systemization of information into computer databases; data search in computer files for others.</p> <p><b>Class 35 (IR1145649)</b> Advertising on the Internet for others; Advertising services.</p> <p><b>Class 38 (IR1145649)</b> Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest.</p> <p><b>Class 42 (IR1048976)</b> Computer services, namely, providing customized online web pages featuring user-defined information; computer services, namely, providing a webpage for users to ask and answer questions on a variety of topics of general interest, providing search engines for obtaining information requested by users on a global computer network, providing customized searching of a webpage to locate specific information requested by users, creating an</p>	<p><b>Class 19</b> Building construction materials; materials (non-metallic) for building decoration; materials, and components, all for use in building and construction, namely bricks, timber, cement, plaster, slates, roofing materials, guttering, pipes and ducts; sheds, out buildings, garages, gazebos, summer houses, conservatories; transportable buildings, prefabricated, portable and/or relocatable buildings; all the aforesaid goods wholly or principally of non-metallic materials; parts and fittings for all the aforesaid goods.</p> <p><b>Class 35</b> Assistance and consultancy relating to business management and organisation; provision of commercial information; business management services for the maintenance and repair of industrial, commercial, government and other public sector buildings and infrastructures (including roads, rail, bridges and utility supplies); business management services for the operation of offices, industrial and retail premises, hospitals, clinics, schools and other educational establishments, courts, houses, prisons and secure training centres, armed forces accommodation and facilities, parking and other ancillary facilities; business management of businesses providing services for the foregoing, including catering, cleaning, laundry, security services and recruitment, supply and management of personnel; advice, information and consultancy services relating to all of the</p>
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on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking; application service provider featuring application programming interface (API) software for use in building software applications.

**Class 45 (IR1145649)**

On-line social networking services.

aforesaid services; commissioning services, namely, arranging the outsourcing of construction, repair, maintenance, renovation and/or demolition services, hygiene services, catering services, laundry services, security services, recruitment services and supply and management of personnel in respect of private, residential, food retail, mixed use, general retail, industrial and commercial infrastructure projects, including industrial, commercial, healthcare, retail and residential real estate civil works.

**Class 36**

Insurance services; provision of financial advice; real estate services; property and real estate management; leasing, letting and renting of offices, industrial and retail premises, hospitals, clinics, schools and other educational establishments, courts, houses, prisons and secure training centres, armed forces accommodation and facilities; land acquisition services; general property dealer services, namely intermediary services between buyers and sellers and managing agents of private, residential, food retail, mixed use, general retail, industrial and commercial, civil works properties and developments and managing agents in all types of properties and developments; property leasing services; advice, information and consultancy services relating to all the aforesaid services.

**Class 37**

Construction, repair, maintenance, renovation and demolition of buildings and civil engineering structures and infrastructure (including roads, rail, bridges and utility supplies); building

services; cleaning and laundry services; hire and repair of plant and equipment for use in building, civil, mechanical and electrical engineering; maintenance and repair of land vehicles; property development; land development; real estate development; construction management for the building, construction and engineering industries; commissioning services, namely, the outsourcing of construction, repair, maintenance, renovation and/or demolition services in respect of private, residential, food retail, mixed use, general retail, industrial and commercial infrastructure projects, including industrial, commercial, healthcare, retail and residential real estate civil works; consultation, supervision and maintenance services in relation to private, residential, food retail, mixed use, general retail, industrial and commercial, civil works and infrastructure projects including industrial, commercial, healthcare, retail and residential real estate civil works and infrastructure projects; supervision services for the maintenance and repair of industrial, commercial, government, civil works properties, private, residential, food retail, mixed use, general retail and infrastructures (including roads, rail, bridges and utility supplies); supervision services for the operation of offices, industrial and retail premises, hospitals, clinics, schools and other educational establishments, courts, houses, prisons and secure training centres, armed forces accommodation and facilities, parking and other ancillary facilities; management of businesses providing services for the foregoing, including catering cleaning; management of businesses providing services for the foregoing, including catering, cleaning; commissioning



	<p>(arranging of outsourcing) of hygiene services, catering services, maintenance of landscape and grounds , laundry, security services and recruitment, supply and management of personnel; construction management services; engineering services including civil engineering services; advice, information and consultancy services relating to all the aforesaid services.</p> <p><b>Class 39</b></p> <p>Transport and delivery of machines and material for use in building, construction and engineering industries.</p> <p><b>Class 42</b></p> <p>Design services; architectural services including architectural consultation services; interior and exterior building design services; professional consultancy services relating to design, research and development; advisory, analytical and information services relating to architectural, engineering and environmental matters; professional project management; all for the building, construction and engineering industries; advice, information and consultancy services relating to all the aforesaid services.</p>
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33. 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.”*

34. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* <sup>6</sup>(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.

35. 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)”

36. The comments of Daniel Alexander, sitting as the Appointed Person, in *LOVE*<sup>7</sup>, which dealt with similarity of goods but by analogy is relevant to similarity of services, are also to be borne in mind:

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<sup>6</sup>[1996] R.P.C. 281

“18... the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

36. And at paragraph 20 where he warned against applying too rigid a test:

“20. In my judgment, the reference to ‘legal definition’ suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

37. Where appropriate I will, for the purposes of comparison, group related goods and services together in accordance with the decision in *Separode Trade Mark*<sup>8</sup>:

“5. 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.”

38. When considering the parties’ services I am mindful of the decision in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, in which Jacob J stated:

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<sup>7</sup> *BL O/255/13*

<sup>8</sup> *BL O-399-10*

“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 meaning attributable to the rather general phrase.”

39. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

40. I will also bear in mind Floyd, J's statement in *YouView TV Ltd v Total Ltd*:<sup>9</sup>

"...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

41. 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 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

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<sup>9</sup> [2012] EWHC 3158 (Ch) at [12]

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).”

42. I note that the specifications include software and internet related goods and services at a time when the majority of businesses and commercial undertakings are, at least to some extent, reliant on information technology in order to function.

43. In *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-336/03, the GC stated:

“69. Next, the Court must reject the applicant’s argument that all the goods and services covered by the Community trade mark application are linked, in one way or another, to ‘computers’ and ‘computer programs’ (Class 9) covered by the earlier trade mark. As the defendant rightly points out, in today’s high-tech society, almost no electronic or digital equipment functions without the use of computers in one form or another. To acknowledge similarity in all cases in which the earlier right covers computers and where the goods or services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark. Such a position would lead to a situation in which the registration of computer hardware or software would in practice exclude subsequent registration of any type of electronic or digital process or service exploiting that hardware or software”.

44. *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-316/07 concerned the comparison between computer software and software services in classes 9 and 42, respectively, and a range of information, travel and reservation services in classes 39 and 42. The GC upheld the finding of no similarity, including no complementarity, between the goods and services. It stated in its judgment:

“54. The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

55. Computer goods and computer services are used in nearly all sectors. Often, the same goods or services – for example, a certain type of software or operating system – may be used for very different purposes, and that does not mean that they become different or distinct goods or services. Conversely, travel agency services do not become something else – in terms of their nature, intended purpose or method of use – solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

[...]

60 [...] The commercial origin of the software and the computer services which enable the intervener’s website to function is not generally of the slightest interest to the public for which the services covered by the mark at issue, which are supplied via that website, are intended. For that public, the intervener’s website is a mere tool for the online reservation of travel and accommodation. What is of importance is that it functions well and not who provided the software and computer services which enable it to function.

61. If, however, some of the intervener’s customers wonder about the commercial origin of the software and the software development and design services which are necessary for the functioning of the intervener’s website, they are capable, as was correctly pointed out by the Board of Appeal, of making a distinction between the specialised undertaking which supplies those goods and services and the intervener which supplies services relating to the

tourism and travel sector over the internet. Since the services covered by the mark at issue are, by definition, supplied exclusively over the internet, it must be assumed that the intervener's customers have at least some basic knowledge of computing. They are thus aware that an online reservation system cannot be set up by merely any computer user and that it requires software and software development and design services which are provided by a specialised undertaking.

62. The applicant's claim that the intervener's customers cannot distinguish information which comes from the intervener itself from that which derives from software and computer services of the kind covered by the earlier mark is likewise incorrect. The information likely to be of interest to the intervener's customers is that relating to travel arrangements, the availability of hotel accommodation and their prices. The provision of that information is precisely what constitutes the services covered by the mark at issue. The goods and services covered by the earlier mark serve only to convey that information and do not themselves transmit other separate information to the persons concerned".

### **Classes 6 and 19**

45. The goods in the proprietor's specification are, essentially, metal building and construction materials in class 6 and building and construction materials in class 19. The applicant claims that its class 9 goods and class 42 services are similar to, for example, metal building and construction materials, as the applicant's services can provide the user with answers, information, advice and discussion in relation to those goods. In my view, this is to give too broad a scope to information and computer based services and does not take account of the core meaning of the services. The users of the proprietor's goods are purchasing those goods in order to construct, inter alia, buildings. The users of the applicant's goods and services are seeking information/advice/discussion or exchanging information. Whilst the information/discussion may relate to any topic and may, therefore, relate to construction, the core meaning of the applicant's goods and services is clearly different to that of the proprietor's goods. The nature and purpose of the goods and services are clearly different. There is no complementarity in either sense.

One is not indispensable for the use of the other and the consumers of building materials are unlikely to believe that those goods are provided by the same undertaking as is providing information, advertising, software, social networking and the other services contained within the applicant's specification. Consequently, these are dissimilar goods and services.

### **Class 35**

46. With regard to class 35 the applicant refers only to the terms in both specifications which relate to commercial information. The proprietor's specification in this class includes the term, 'provision of commercial information'. The applicant has the term, 'commercial information and advice for consumers' which is included within the proprietor's broader term. These are clearly identical services in accordance with *Meric*.

47. The proprietor's remaining services in class 35 are all for the purposes of business management and organisation. The applicant's services are advertising, presentation of goods, price comparison, auctioneering and services related to databases such as compiling, organising and searching data. In my view these services are different in nature, use and purpose. They are not in competition. It is highly likely that databases may be used in the provision of the proprietor's services in this class, but that is not the test I must apply. In my experience businesses routinely keep information which is necessary in order for them to function and evidently this must be collated and searchable. This does not mean that all databases are similar to all services. In the absence of any indication from the applicant as to why these might be similar, I find these services to be dissimilar.

### **Class 36**

48. These are insurance, financial advice, property and real estate management, leasing, letting and renting of property, land acquisition services, property dealer services and advice services related to the same. As discussed above, whilst it is possible that information about these topics may be sought using the applicant's social network, chat room or question and answer website, this does not mean that the core services are similar. The consumer of the proprietor's services will be seeking insurance or financial



advice and/or services relating to property and land. The applicant provides online community, chat rooms, social networks, electronic message boards, databases and advertising. The nature of these services is different, the users are different, they are not in competition, nor are they complementary. The average consumer is unlikely to expect, for example, property management services to be offered by the same undertaking as that providing online social networking services. In the absence of any evidence to the contrary, I find the proprietor's services in this class to be dissimilar to the applicant's goods and services.

### **Class 37**

49. The specification for these services is lengthy but essentially relates to the construction, repair (and demolition), maintenance, renovation, supervision and management of property and real estate. I accept that the average consumer of these services may seek advice before commissioning, inter alia, repairs, property maintenance services and so on and may do so by searching on the internet or by using a question and answer website. It does not follow, however, that the consumer would believe that the provider of an answer to a question on a website or software to support such a website, would also be responsible for the civil works or demolition services being commissioned. The nature of the parties' services are different, as are the purposes. They are not complementary, nor are they in competition and they are highly unlikely to be available through the same trade channels. The applicant's goods and services are dissimilar to the proprietor's class 37 services.

### **Class 39**

50. These are services for the transport and delivery of machines and material for use in building, construction and engineering industries. The nature and purpose of these services are clearly different to the information related services in the applicant's specifications. These are not complementary services. The consumer seeking delivery of construction machinery is highly unlikely to expect the service to be provided by the same undertaking as one providing websites, databases, chat rooms, and so on. For all of the reasons provided above, these are dissimilar services.

## Class 42

51. The proprietor's services in this class are design services and architectural services. The applicant's services are computer services which provide search engines and web pages generally and more specifically enable user question and answer pages on a number of topics and also include the creation of online communities, chat rooms and social networks. In accordance with decisions such as *Avnet*, I must assess the services according to their core meaning. The fact that a user may ask a design or architectural related question using the applicant's services does not lead to an automatic finding that the services are similar. The applicant's services provide an opportunity to exchange information and to take part in an online community with other interested users; the proprietor's, on the other hand, are specifically design services and architectural services. Their natures, purposes, users and trade channels are all different. They are not in competition and are not complementary. These are dissimilar services.

52. It is clear from case law that in order for there to be a likelihood of confusion there must be some degree of similarity between the parties' goods and services<sup>10</sup>. In *eSure Insurance v Direct Line Insurance*<sup>11</sup> Lady Justice Arden stated that:

“49...I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

53. I have found all of the competing goods and services to be dissimilar, other than the 'provision of commercial information' in class 35 of the proprietor's specification, which I have found to be identical to the applicant's term 'commercial information and advice for consumers' in class 35.

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<sup>10</sup> See, for example, *Waterford Wedgwood plc v OHIM*, C-398/07 P

<sup>11</sup> [2008] ETMR 77

54. Consequently, the invalidation fails under 5(2)(a) and the provisions of 47(2)(a) of the Act in respect of all of the goods and services in classes 6, 19, 36,37,39, 42. It also fails in respect of the services in class 35, except for the following services:

**Class 35**

Provision of commercial information.

55. Clearly, as I have found the parties' respective marks and the remaining service to be identical then it follows that there is a likelihood of confusion.

56. I will now go on to consider the applicant's request for invalidation under section 47(2)(a) and 5(3) of the Act.

Section 5(3) is as follows:

"5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom .... and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

57. In relying on this ground, the applicant relies on the same marks as it did in support of its objection under section 5(2) of the Act. I have already found that the applicant's evidence is not sufficient to show the required reputation so the objection under this ground falls at the first hurdle.

58. The application under section 5(3) of the Act fails.

**59. As a consequence of my decision above the applicant's request to invalidate the proprietor's mark has failed other than for, 'the provision of commercial information' in class 35, which will be removed from the proprietor's specification effective from 4 November 2013 and will be deemed never to have been made.**

## **COSTS**

60. The proprietor has been mostly successful and is entitled to an award of costs in its favour, reduced to take account of the applicant's success in respect of the term 'provision of commercial information' in class 35.

61. In its skeleton argument the proprietor states the following:

*"49. Much of [the applicant's] evidence is wholly irrelevant. Practically the whole of its evidence in chief should be disregarded because it does not consider the position at the filing date, or because it relates to non-UK or EU activity. This evidence was, however, voluminous. Parts of [the applicant's] evidence in reply was also irrelevant. [The proprietor] had to consider it all. It should never have been put to the expense of doing so. As a consequence, [the proprietor] should receive the costs of considering that evidence outside normal scales."*

62. At the conclusion of the hearing I allowed the proprietor a period of time in which to file a breakdown of costs. This includes the following:

*"Attached is a summary schedule of costs relating to the evidence stages. Although difficult to be precise about the time incurred in relation to these issues it is estimated that it equates to something in the order of 80% of the total time spent up to 5 November and approximately 20% of counsel's time; making for a total of [£5470.16]."*

63. The relevant Tribunal Practice Notice (TPN) which is applicable to these proceedings is TPN 4/2007. With regard to awards of actual costs and costs above the standard scale it states the following:

“5. TPN 2/2000 recognises that it is vital that the Comptroller has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. Whilst TPN 2/2000 provides some examples of unreasonable behaviour, which could lead to an off scale award of costs, it acknowledges that it would be impossible to indicate all the circumstances in which a Hearing Officer could or should depart from the published scale of costs. The overriding factor was and remains that the Hearing Officer should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this in itself is not indicative of unreasonable behaviour.”

64. Whilst I accept that the applicant’s evidence could have been better marshalled, in my view the applicant’s behaviour in these proceedings falls a long way short of unreasonable behaviour which would warrant an award above the standard scale.

65. I do consider that the volume of material was excessive and the content did little to support the applicant’s claims. The proprietor has provided only an estimate of the time taken to deal with it. In my view, its content is such that it is unlikely to have required particularly complex consideration by professional representatives and it is appropriate to make an award at the higher end of the standard scale.

66. I make the following award, taking into account the necessary reduction to reflect the applicant’s success with regard to class 35.

Preparing a statement and considering the other side’s statement:	£300
Preparing evidence and considering the other side’s evidence:	£1200
Preparation for and attendance at the hearing:	£600
Total	£2100

67. I order Quora Inc to pay Quora Ltd the sum of £2100. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11th day of July 2016**

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