

BL O/757/21

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3388422

AND

OPPOSITION THERETO UNDER NO. 600001172

AND

TRADE MARK REGISTRATION NO. 3327595

AND AN APPLICATION FOR INVALIDATION THEREOF UNDER NO. 503164

Background and pleadings

1. This decision concerns an application to invalidate trade mark registration number 3327595 and an opposition against trade mark application number 3388422. The cases were consolidated.

Application for invalidation of trade mark registration number 3327595

2. Trade mark registration number 3327595 for the trade marks “TREEVIEW” and “TreeView” (series of two) stands registered in the name of Simon Powell. As nothing turns on the difference between the registered marks, I will refer to them in the singular. The application for registration was filed on 27 July 2018 and the mark was registered on 11 January 2019 in respect of the following goods and services:

Class 9: Computer software; Software development kit [SDK]; Software development tools; Software drivers; Software for diagnostics and troubleshooting; Software for embedding online advertising on websites; Software for searching and retrieving information across a computer network; Software for the analysis of business data; Software for the processing of business transactions; Application development software; Application software for cloud computing services; Application software for mobile devices; Business intelligence software; Business management software; Computer game software; Computer software for accessing, authorising or managing databases; Computer software for producing financial models; Computer software for use in computer access control; Computer software to automate data warehousing; Computer software to enable searching and retrieval of data; Interactive computer software; Internet access software; Simulation software for use in digital computers.

Class 42: Advice and development services relating to computer software; Advisory services relating to man-machine interfaces for computer software; Computer hardware and software design; Computer programming and software design; Computer software research; Consultancy and advice on computer software and hardware; Design and development of computer software for

reading, transmitting and organising data; Design and development of computer software for supply chain management; Design and development of computer software for use with medical technology; Design and development of data processing software; Design and development of data retrieval software; Design and development of software for inventory management; Design and development of software in the field of mobile applications; Design of software for processing and distribution of multimedia contents; Design services relating to virtual reality software; Design, maintenance and updating of computer software; Rental and updating of computer software; Development and testing of computing methods, algorithms and software; Development and testing of software; Development of computer software for logistics, supply chain management and e-business portals; Providing information, advice and consultancy services in the field of computer software; Providing online non-downloadable software for use in supply chain management; Providing temporary use of non-downloadable computer software; Providing temporary use of non-downloadable software for analysing financial data and generating reports; Rental of computer hardware; Rental of computer software; Research and development of computer software; Services for the writing of computer software; Software as a service [SaaS].





3. Genealogy Supplies (Jersey) Limited (“GSJ”) seeks invalidation of the trade mark under sections 3(1)(b), 3(1)(c), 3(1)(d), 3(6) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under each of these grounds, the application for invalidation is directed against all of the goods and services in the registration.

4. GSJ claims that “TREE VIEW” is a term commonly used in software for displays and hierarchical lists, primarily for file manager applications. GSJ says that the mark is not capable of indicating trade mark origin. It also says that the term is descriptive of the intended purpose of the goods and services for which it is registered. It is asserted that the term should be kept free for traders in the same or related fields, namely software developers and programmers, particularly as there is no apparent alternative definition. Consequently, GSJ says that the mark is invalid under ss. 3(1)(b) and 3(1)(c).

5. Under s. 3(1)(d), GSJ claims that the term “TREE VIEW” has moved into common parlance in the field of software and is known in the trade as a term to designate software for displays and hierarchical lists.

6. In addition, GSJ claims that Mr Powell must have known of the existence of GSJ's sign. It is asserted that GSJ has been using “TREEVIEW” since 2006 and has attempted to reach a settlement with Mr Powell but that GSJ's offers have been refused. It is said that Mr Powell's opposition to GSJ's trade mark application shows that he intends to prevent GSJ from continuing to use its sign. No use has been made of the contested mark and it has “accrued no further protection beyond a trade mark registration”. Mr Powell's behaviour is said to have fallen below the standards of acceptable commercial behaviour. GSJ therefore asserts that the mark is invalid under s. 3(6).

7. Under s. 5(4)(a), GSJ relies upon the word sign “TreeView” and the four figurative signs shown below:

- i) 
- ii) 
- iii) 
- iv) 

8. The claim is that each of these signs has been used throughout the UK since November 2007 in respect of the following goods and services:

Computer software; Software development tools; Software drivers; Software for searching and retrieving information across a computer network; Software for the analysis of data; Application development software; Application software for mobile devices; Computer software for accessing, authorising or managing databases; Computer software to enable searching and retrieval of data; Interactive computer software; Application software; web application and server software; all relating to genealogy.

Development services relating to computer software; Advisory services relating to man-machine interfaces for computer software; Computer software design; Computer programming and software design; Computer software research; Consultancy and advice on computer software; Design and development of computer software for reading, transmitting and organising data; Design and development of data processing software; Design and development of data retrieval software; Design and development of software in the field of mobile applications; Design, maintenance and updating of computer software; Rental and updating of computer software; Development and testing of computing methods, algorithms and software; Development and testing of software; Providing information, advice and consultancy services in the field of computer software; Providing online non-downloadable software; Providing temporary use of non-downloadable computer software; Providing temporary use of non-downloadable software for analysing data and generating reports; Rental of computer software; Research and development of computer software; Services for the writing of computer software; Software as a service [SaaS]; all in the field of genealogy.

Genealogy research services.

9. GSJ submits that its use of the signs has resulted in a protectable goodwill of which the signs are distinctive. It is said that use of the contested mark would confuse the relevant public. This will result in deception because the relevant public would believe that there is a business connection between the parties or that the source is the same, constituting a misrepresentation as to the origin of the goods and services. It is also

submitted that Mr Powell “is sitting on the registration with no use, to stop [GSJ] from obtaining a legitimate registration”. It is said that his motives and intentions are to deceive the relevant public. GSJ says that use of the contested mark would take the benefit and advantage of the good name, reputation and connection of GSJ’s business, freeriding on GSJ’s reputation. There would, therefore, be damage through the dilution of GSJ’s signs and a corresponding change in the economic behaviour of GSJ’s customers.

10. Mr Powell filed a counterstatement in which he denies the basis of the application for invalidation and puts GSJ to proof. I note in particular:

- It is denied that GSJ has goodwill as claimed;
- The meaning of “TREE VIEW” posited by GSJ does not appear to be disputed. However, it is said that “being able to name and distinguish a specific desktop environment stub correctly and associate it with the product or service provider [...] does not fall into the category of a knowledge possessed by a reasonably well-informed customer, who is a member of the general public”. It is denied that the mark is devoid of distinctive character;
- It is claimed that the mark does not describe any of the “specific modes of viewing information” and is not an indication of the intended purpose of the goods and services;
- An entry on Wikipedia is not sound evidence that the term has moved into common parlance;
- The fact that “TREE VIEW” exists on the market does not mean it cannot be used to identify the goods and services offered by Mr Powell. Further, “even if the name ‘TREE VIEW’ is used for a specific graphical control element it doesn’t mean that the customers will be confused as to the use of the name [...] for different goods and services than graphical control elements”;
- GSJ is put to proof of Mr Powell’s knowledge of its alleged business;

- It is denied that Mr Powell only sought registration to prevent GSJ from continuing to use its sign;
- The allegation that Mr Powell is “sitting on” the registration is unfounded. There is no obligation to use the mark immediately and he does have a bona fide intention to use the mark.

Opposition against trade mark application number 3388422

11. GSJ filed the application for trade mark number 3388422 “TREEVIEW” on 1 April 2019. Registration is sought for goods and services in classes 9 and 42.

12. The application is opposed by Mr Powell under s. 5(2)(a) of the Act. The opposition is directed against the goods in class 9 only, namely “Computer software; Application software; web application and server software; all relating to genealogy”.

13. Mr Powell relies upon UK trade mark number 3327595, the details of which are at paragraph 2, above. He relies upon all of the goods and services for which the trade mark is registered. Given its filing date, Mr Powell’s trade mark is both an earlier mark under s. 6 and not subject to the use provisions at s. 6A. Mr Powell may, therefore, rely upon all of the goods and services in the mark’s specification without showing that it has been used.

14. Mr Powell claims that the competing trade marks are identical and that the goods for which registration is sought are included within the scope of the earlier mark’s specification, which will give rise to a likelihood of confusion.

15. GSJ filed a counterstatement. It accepts that the marks are identical. It accepts that there is identity between some of the goods but points out that the contested goods are limited to GSJ’s specific area of use and interest (genealogy). It says that the parties’ areas of business are significantly different and target different audiences. Consequently, it says that there is no likelihood of confusion.

16. Only GSJ filed evidence. Both parties filed written submissions during the evidence rounds, which I will take into account. Neither party requested a hearing, nor did they file submissions in lieu of a hearing. This decision is taken following a careful reading of all of the papers.

17. GSJ is represented by Script IP Limited. Mr Powell is represented by Basck Limited.

Evidence

18. Two witnesses gave evidence for GSJ, namely Nigel John Bayley and Mark John Bayley.

19. Mr Nigel Bayley filed two witness statements, with accompanying exhibits. However, there appears to be no difference between these two statements and their exhibits, other than the references to the opposition/invalidity details in the headers, so it is not necessary to distinguish between them. For the avoidance of doubt, references in this decision are to the statement filed in invalidation number 503164. Mr Nigel Bayley is the Managing Director of GSJ and he gives evidence about the use which has been made of the signs relied upon.

20. There is also a witness statement, with exhibits, from Mark John Bayley. Mr Mark Bayley is a Director of S&N British Data Archive Ltd, as well as head of development. His evidence goes to the alleged non-distinctiveness/descriptiveness of the word "TREEVIEW".

21. Neither witness was cross-examined. I will return to the details of the evidence as necessary later in this decision.

Application for invalidation of UK 3327595

22. As the opposition will fall away if the application to invalidate Mr Powell's trade mark is successful, I will consider the invalidation first. Mr Powell has not claimed that the mark has acquired distinctiveness, nor has he filed any evidence of the mark having been used.

Consequently, the relevant date for all of the grounds of invalidity is the date of application, i.e. 27 July 2018.

23. Grounds under ss. 3 and 5 have application in invalidation proceedings through the provisions of s. 47. So far as it is relevant, that section reads:

“47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) [Subject to subsections (2A) and (2G), the] registration of a trade mark may be declared invalid on the ground—

(a) [...]

(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. (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed”.

24. It is convenient to begin with the grounds under s. 3(1). The relevant parts of the Act state:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it”.

Section 3(1)(c)

25. The case law under s. 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation)¹ was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. [...] due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for

¹ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to refer to EU trade mark law.

refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs

than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And,

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application.

By using, in Article 7(1)(c) of Regulation No 40/94 , the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’, the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

26. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]).”

27. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, EU:C:2006:164, the Court of Justice of the European Union (“CJEU”) held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50)”.

28. In *Exalation v OHIM*, Case T-85/08, EU:T:2010:303, the General Court (“GC”) confirmed that, at least where technical terms are concerned, it is appropriate to take account of meanings known to those in the trade. However, if a specialised public to whom a particular meaning would be known forms only a negligible part of the relevant public, this is unlikely to be sufficient to sustain an objection under ss. 3(1)(b) and (c): *MCM Products AG v EUIPO*, Case T-285/20, EU:T:2021:397.

29. It is also settled law that merely combining descriptive words does not provide them with a distinctive character unless there is a perceptible difference between the combination and the mere sum of its parts: *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, EU:C:2004:87 (CJEU) at [39] to [41].

30. All of the relevant facts and circumstances must be taken into account when examining the distinctive character of a trade mark. In the absence of other indications, this means taking into account the types of use which, in the light of the customs in the sector concerned, can be “practically significant”: *AS v Deutsches Patent – und Markenamt*, Case C-541/18, EU:C:2019:725. This means that the reaction of average consumers to uses of the mark which are possible in theory but unlikely in practice do not need to be factored into the assessment.

31. The relevant public for the goods and services at issue is composed of both the general public, as end users of software goods and services, as well as professionals.

The latter may be business consumers or a more specialised public, such as computer programmers. I accept that the general public is unlikely to purchase the goods and services obviously directed at a business user (e.g. business intelligence software; development of software for supply chain management). However, I am not persuaded that specialist computing professionals will be the only relevant user for any of the remaining goods or services. In the absence of any submissions in this regard, it seems to me that computer enthusiasts or more technologically minded members of the public will not only easily be able to access the goods and services but may well do so, for example, to build or modify their computing setup.

Evidence

32. The evidence concerning the s. 3 grounds is contained in Mr Mark Bayley's statement and exhibits.

33. An extract from a book, *Programming .NET Windows Applications*, which was published in 2003, is exhibited.² The extract explains that:

"A TreeView control displays a collection of items in a hierarchical view. Tree views are very common in the computer world, as seen in Windows Explorer, Microsoft Outlook, and Outlook Express, the Solution Explorer in Visual Studio .NET, and countless other applications.

Each item in a tree view is encapsulated within a TreeNode object. Each TreeNode can have zero, one, or many child nodes. The Nodes property of the tree view represents the collection of TreeNode objects that comprise the root, or top level, nodes in the hierarchy. Each node in turn has its own Nodes collection that contains all of that node's child nodes, and so on down the hierarchy. Your program can iterate through each of these collections, recursively if necessary, to walk the entire tree structure, as demonstrated shortly".

² Exhibit MJB2.

34. In addition, a print from Microsoft Windows Developer, said to be official documentation for the C++ Windows 32 applications, describes “Tree View” and “tree-view” controls as windows which control hierarchical lists; there appear to be links to information about using/creating “tree-view controls”.³ This is dated 31 May 2018.

35. “TreeView” is said most commonly to be seen in file manager applications such as Windows Explorer, “where file system directories (or ‘Folders’) are represented by nodes”.⁴ However, it is said that ‘TreeViews’ can be used to represent any type of hierarchical data and that most of the popular programming languages, such as .NET, Java and C++ Windows 32 Applications, have a TreeView library.⁵

36. A definition of “TreeView” by the World Wide Web Consortium (“W3C”) is also provided.⁶ W3C is said to be the main international standards organisation for the World Wide Web.⁷ The definition of a “tree view” is broadly the same as that provided in the 2003 book extract. There is also a print from docs.oracle.com which says that “[the] TreeView control provides a view on to a tree root [...]”.⁸ It contains similar comments as to “children” or “leaf nodes” as the prints detailed above, along with instructions on how to create a “TreeView”. These definitions are undated; they appear to have been accessed on 8 January 2021 (i.e. after the relevant date).

37. It is said that a search for “TreeView” on an open source repository produces many hits but there is no documentation to support this and the use of the present tense suggests a search carried out on or around the date of the witness statement (11 January 2021).

Discussion

38. The evidence is limited and that which pre-dates the relevant date is very scant. However, both the book extract and the Microsoft Windows definition support GSJ’s

³ Exhibit MJB4.

⁴ M. Bayley, §2.

⁵ Ibid.

⁶ Exhibit MJB1.

⁷ M. Bayley, §2.

⁸ Exhibit MJB3.

assertion that “tree view” is a term in computer programming which means the hierarchical view of information. The article says that “tree views” are common in the computing world, although the fact that hierarchical views are common is not the same as the term “tree view” itself being commonly used to describe them. Nevertheless, the evidence which postdates the relevant date suggests that the term “tree view” continues to be used in the same way in 2021.

39. It also seems to me that one of the several meanings of “tree” with which all the relevant groups of average consumer will be familiar is that of a branching structure used to represent information in diagrammatic form. An example of this is the phrase “family tree”, used to represent the generations of a family diagrammatically. I find support for my understanding in two major dictionaries, which provide the following definitions of “tree”:

“6. a. a branching diagrammatic representation of something, such as the grammatical structure of a sentence

b. (as modifier) a tree diagram”,⁹

and

“6. Something resembling a tree with its branches.

a. A diagram or table of a family, indicating its original ancestor as the root, and the various branches of descendants; in full, family tree or genealogical tree. Also figurative a family, race, stock.

b. Any structure or figure, natural or artificial, of branched form”.¹⁰

⁹ *Collins English Dictionary*, viewed through <https://www.collinsdictionary.com/dictionary/english/tree> [accessed 4 October 2021].

¹⁰ *Oxford English Dictionary*, <https://www.oed.com/view/Entry/205416?rskey=YXzG3x&result=1&isAdvanced=false#eid> [accessed 4 October 2021].

40. “View” is also a common word with multiple meanings. The average consumer will be familiar with its use to indicate something seen or looked at. Its use in computing to indicate a visual representation of information in a particular way will also be known, particularly as ordinary file manager or file explorer systems usually include a “view” option to enable one to see files in a list or with icons, or word-processing packages generally have a “view” option for reading a document in print, web, or reading mode.

41. It therefore seems to me that a computing professional is likely to understand “tree view” in computing as meaning a particular way in which information is presented. Whilst this association is more likely for the software developer or programmer, I do not think it will be restricted to the computing professional, given the ordinary meanings of the words, the use in end-user computing packages of the term “tree”, “tree view” or “view”, and the fact that non-specialists may encounter the term when in discussion with, for example, computer software developers. Consequently, business users or the user who is a member of the public are likely to perceive “TREEVIEW”, when used in relation to software whose purpose is or includes the presentation of information to the user, as indicating the kind or intended purpose of the goods, i.e. software which will display data in a tree structure. GSJ does not rely under s. 3(1) upon a descriptiveness objection based on the likelihood of “tree view” being used and understood as descriptive in relation to software for creating and displaying family trees. However, given that a family tree is a term widely known for the presentation of genealogical information in a particular diagrammatic structure, evidenced by the *OED* definition above, and bearing in mind the evidence filed in relation to the s. 5(4)(a) grounds, which concerns GSJ’s use of “TreeView” for such software, I think it is open to me to consider that possibility. It seems to me that “TREEVIEW” is also excluded from registration in relation to goods apt for use in genealogical research, and related services, where it would be perceived as descriptive of the purpose of the goods and services. The presentation as one word or two makes no difference to the message conveyed to the average consumer: the words “tree” and “view” are common dictionary words, both of which will be identified in the mark and their meaning will readily be perceived. The juxtaposing of the words does not alter the message they send. I should add that the evidence, such as it is, indicates there was at the relevant date and remains clear potential for the mark “TREEVIEW” to be adopted

more widely in future, even if there were at the relevant date other, more usual signs for designating the goods. I consider the same applies to software services in class 42 which are or include the design, development or provision of software for the presentation of information in hierarchical lists which may be described as tree views: the mark will be perceived as indicating a characteristic of the service (i.e. that the services concern such software).

42. However, it seems to me that “tree view” will not be descriptive in relation to goods and services the purpose of which is not the management or presentation of information, or the development, design or provision of software for that purpose. In *Fissler GmbH v EUIPO*, case T-423/18, EU:T:2019:291, the GC decided that the word VITA, meaning ‘white’ in Swedish, was not descriptive of characteristics of food processors, cookers and cooking apparatus. This was because the name of the colour was not an intrinsic characteristic of the goods. Rather, it was merely an incidental property of some of the goods bearing the trade mark (others being marketed in different colours). This would be apparent to average consumers of the goods. The court contrasted the facts in this case with those in *Colgate-Palmer v OHIM (VISIBLE WHITE)*, case T-136/07, EU:T:2008:553 and *Cree v OHIM (TRUE WHITE)*, Case T-208/10, EU:T:2011:340, in which registration of the marks was refused in relation to toothpaste and light emitting diodes, respectively. The court pointed out that colour was intrinsic to the purpose of those goods and, therefore, a relevant characteristic.

43. Absent a clear connection with hierarchical lists or “tree views”, and/or family trees, my view is that for goods other than those concerning software which provides tree view functions or for services relating to such software, “TREE VIEW” would not be perceived as descriptive because any ‘tree view’ functionality is incidental to the goods and services rather than being an intrinsic characteristic. No evidence has been provided and there are no submissions to explain why the descriptiveness objection should extend to such goods.

44. I find that the mark is excluded from registration for the goods and services shown below:

Class 9: Computer software; Software development kit [SDK]; Software development tools; Software for searching and retrieving information across a computer network; Software for the analysis of business data; Application development software; Application software for cloud computing services; Application software for mobile devices; Business intelligence software; Business management software; Computer software for accessing, authorising or managing databases; Computer software for producing financial models; Computer software to enable searching and retrieval of data; Interactive computer software.

Class 42: Advice and development services relating to computer software; Computer software design; Computer programming and software design; Computer software research; Consultancy and advice on computer software; Design and development of computer software for reading, transmitting and organising data; Design and development of data processing software; Design and development of data retrieval software; Design and development of software for inventory management; Design and development of software in the field of mobile applications; Design, maintenance and updating of computer software; Rental and updating of computer software; Development and testing of software; Providing information, advice and consultancy services in the field of computer software; Providing temporary use of non-downloadable computer software; Providing temporary use of non-downloadable software for analysing financial data and generating reports; Rental of computer software; Research and development of computer software; Services for the writing of computer software; Software as a service [SaaS].

45. The objection under s. 3(1)(c) fails in respect of:

Class 9: Software drivers; Software for diagnostics and troubleshooting; Software for embedding online advertising on websites; Software for the processing of business transactions; Computer game software; Computer software for use in computer access control; Computer software to automate data warehousing; Internet access software; Simulation software for use in digital computers.

Class 42: Advisory services relating to man-machine interfaces for computer software; Computer hardware design; Consultancy and advice on computer hardware; Design and development of computer software for supply chain management; Design and development of computer software for use with medical technology; Design of software for processing and distribution of multimedia contents; Design services relating to virtual reality software; Development and testing of computing methods and algorithms; Development of computer software for logistics, supply chain management and e-business portals; Providing online non-downloadable software for use in supply chain management; Rental of computer hardware.

Section 3(1)(b)

46. Trade marks which are excluded from registration on descriptiveness grounds necessarily lack the distinctive character required to avoid objection under s. 3(1)(b). It follows that “TREEVIEW” is devoid of any distinctive character in relation to the goods and services caught by the s. 3(1)(c) objection.

47. Although marks which are free from objection under s. 3(1)(c) may be caught by s. 3(1)(b), the only reason put forward in this case is that the mark is descriptive. Therefore, to the extent that I have rejected the objection under s. 3(1)(c), I see no reason to come to a different conclusion under s. 3(1)(b).

Section 3(1)(d)

48. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, EU:T:2006:87, the GC summarised the case law of the Court of Justice under the equivalent of s. 3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services

in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)".

49. The evidence is very thin. Only two documents are dated before the relevant date. I acknowledge that both refer to Microsoft Windows applications and that they suggest that controls for certain hierarchical lists may be called "tree view" controls. However, even

though I do not doubt that Windows is a popular application, they are dated fifteen years apart and there is no information about their distribution. Other than these two documents, there is no evidence of the term's use by third parties (e.g. in the trade press) before the relevant date. The evidence is insufficient to show that the sign had become customary in the trade for any of the goods or services at issue. This ground is rejected.

Section 3(6)

50. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith”.

51. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal summarised the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. So far as it is relevant to this case, that summary reads:

“68. [...]”

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined

by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46]".

52. Bad faith is a serious allegation which must be distinctly proved. It is not enough for an opponent to prove facts which are also consistent with good faith. The burden, and it is a heavy one, is on GSJ to show that the trade mark application was made in bad faith. GSJ has signally failed to discharge that burden. There is no evidence at all to support the claim. It does not appear to be disputed that there were some negotiations between the parties but it is far from clear that these took place prior to the application date for Mr Powell's trade mark. In any event, the fact alone of negotiations goes no distance to establishing that the application was made in bad faith. It is for GSJ to establish that the motivation was illegitimate and it has not done so.

53. GSJ has also argued that certain of the contested goods and services "could be argued to encompass every single possible field of commerce" and that "[if] the Opponent does not intend to use TREEVIEW in the field of genealogy, then it is submitted that he has registered the mark in bad faith knowing that the registration encompasses goods in relation to which he does not intend to use the mark".¹¹ However, not only is there no evidence to cast serious doubt on Mr Powell's intentions at the relevant date but the Court of Appeal has now held that it is not bad faith to apply to register a category of goods if

¹¹ GSJ's written submissions in opposition 600001172.

there is a commercial interest in only a subcategory of those goods: *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121. This ground is rejected.

Section 5(4)(a)

54. Section 5(4)(a) states:

“(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, where the condition in subsection (4A) is met,

[...]

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”.

55. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

56. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood

of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)".

Goodwill

57. The House of Lords considered goodwill in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, saying:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start".

58. Goodwill which is protectable under the law of passing off must be more than trivial: *Hart v Relentless Records* [2002] EWHC 1984 (Ch). However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of

customers was, as the judge at first instance put it, “very limited”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the defendant’s trade under “LUMOS”. In *Stannard v Reay* [1967] F.S.R. 140, a mobile fish and chip van had been trading for three weeks, generating around £130 per week, which was held to be sufficient for an interlocutory injunction to prevent the defendants using the same sign (“MR CHIPPY”).

59. More recently, in *Smart Planet Technologies, Inc. v Rajinda Sharm* [BL O/304/20], Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. Mr Mitcheson concluded that:

“[...] a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon”.

60. *Smart Planet Technologies* was a passing off case where the evidence showed invoices to two customers totalling €939 and €2291 for around 40,000 paper cups. There was evidence in that case that the UK market in paper cups was approximately 2.5 billion paper cups per year and only limited evidence of advertising in the UK. Mr Mitcheson found at [37] to [40] of his decision that the evidence “fell well short of what [...] would have been necessary to establish sufficient goodwill to maintain a claim of passing off”. He added:

“41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that

it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods".

Evidence

61. The evidence in support of the claim to goodwill is provided by Nigel Bayley. His evidence is that he founded GSJ in 2006 "to launch a UK subscription website that provided access to genealogical records, named TheGenealogist". He says that this website is one of the top genealogy websites in the country and that it regularly features on television, such as on the programme "Who Do You Think You Are?".¹²

62. "TreeView" was designed by Mr Nigel Bayley's son as a web application for users of GSJ's website to build and store their family tree online.¹³ The evidence is that "TreeView's main purpose is as a way of introducing new users to our website and to provide an added benefit to subscribing".¹⁴ A newsletter dated November 2007 announces "an exciting new project from S&N that allows users to manage their family tree online", open to anyone with an account at TheGenealogist and available at <http://tree.thegenealogist.co.uk>.¹⁵ A similar article appears in *Family Tree* magazine in January 2008, detailing "the brand new online tree facility from S&N Genealogy Supplies".¹⁶

63. In 2010, the software was rewritten.¹⁷ A review from *Family History Monthly* indicates that it is available for free at www.thegenealogist.co.uk/tree, and that the previous version has been available through the site for many years.¹⁸ The article includes screenshots from the application which show the words "TreeView". Logos are also visible, both in the screenshots and at the end of the article, but they are not the logos relied upon. One of the same logos, along with the words "TreeView", is visible on a print dated 2010 from

¹² N. Bayley, §2.

¹³ Ibid.

¹⁴ N. Bayley§5.

¹⁵ NJB2.

¹⁶ NJB1.

¹⁷ N. Bayley, §3.

¹⁸ NJB3.

www.treeview.co.uk obtained from the WayBack Machine internet archive.¹⁹ Further updates to the software are publicised in 2012 (on TheGenealogist, “our free online tree building program”) and 2016 (the ‘Discover your Ancestors’ website).²⁰

64. A free mobile app using the name TreeView has been available since 2014, which appears to have much the same family-tree-building functions as the desktop site. This is reported in the GENES blog.²¹

65. TreeView software for Windows and Mac has been sold independently of the website version since 2016, also reported in the GENES blog.²² It is said to allow users to sync details with treeview.co.uk and thegenealogist.co.uk. The packaging bears the following figurative sign:



66. Turnover figures for this software are provided for the years 2016 to 2018, as shown below (later figures are provided but are irrelevant as they postdate the relevant date):²³

2016: £ [REDACTED]

2017: £ [REDACTED]

2018: £ [REDACTED]

67. Advertising spend for 2016 was £ [REDACTED] and in both 2017 and 2018 was £ [REDACTED].²⁴ Examples of advertising for the software and application in *Family Tree*

¹⁹ NJB4.

²⁰ NJB5; N. Bayley §3 and NJB8.

²¹ N. Bayley, §2, NJB6.

²² N. Bayley, §3, NJB7.

²³ N. Bayley, §5.

²⁴ N. Bayley, §6.

magazine, which is dated 2016 and 2017, are shown.²⁵ Development spend from 2009 is also given.²⁶

68. 201,845 online trees appear to be stored on TreeView online, which is rather more than the number of unique users (the unique user numbers are subject to an order for confidentiality).²⁷ Android and iOS downloads total 157,400, there being 236 and 23 ratings for the applications, respectively; only 43 reviews have been given for the software, of which four are in evidence.²⁸ However, apart from two reviews which were posted 3 and 4 years ago (the evidence was accessed on 8 January 2021), none of this information appears to relate to the position at the relevant date.

Discussion

69. There is no evidence at all that GSJ, or any other connected entity, conducted a business in providing computer design, development and consultancy services to others. I accept that GSJ ran a genealogy website from 2007. I also accept that there has been some use of “TreeView” in relation to software provided through TheGenealogist website from 2007 and in relation to mobile applications from 2014. However, there is nothing to suggest that “TreeView” has been used in respect of genealogy research services (i.e. those services provided to others): it appears to be, in its various forms, software which allows users to construct and view their family tree. I accept that the longstanding presence of the software on TheGenealogist may be part of the attractive force for customers, even if it is offered at no extra charge: particularly effective software or its ability to interact with other websites may well induce customers to choose GSJ’s services rather than those of others. There is, however, no evidence of any turnover, save as discussed below, before the relevant date: such evidence as there is of user numbers, turnover and downloads is all dated 2021.

²⁵ NJB11.

²⁶ N. Bayley, §6.

²⁷ N. Bayley, §4.

²⁸ Ibid.; NJB10.

70. There were some sales of “TreeView” family tree software as a standalone product (i.e. not downloadable/online software or software as a service) from 2016, though it is not clear how much of the 2018 turnover relates to the period before the relevant date. The figures are higher than in *Stannard v Reay*, even allowing for inflation, and *Smart Planet Technologies* but are significantly lower than those at the relevant date in *Lumos*. The software appears to have retailed at about £40, equating to around [REDACTED] separate packages in 2016, declining thereafter; there are no invoices or other details to assist with customer numbers. The only advertising or promotional material is three advertisements from *Family Tree* magazine (2016 and 2017), a GENES blog article quoting a press release and an article on the “Discover your Ancestors” website. I accept that the obvious place for advertising software for family trees is in special interest magazines, particularly in the early days of such a business. There is, however, no evidence to show how large the distribution for such magazines, or indeed the readership of the websites, was at the relevant date. The impact of three advertisements over a two-year period and two web articles is unlikely to have been significant. Further, both of the website articles/blogs are written by the same contributor. The fact that the software’s existence has not been picked up and reported more widely, even in the genealogy sector, points towards limited impact.

71. It is also important for me to consider the distinctiveness of the sign. There is no class of names to which goodwill cannot attach as a matter of law but, as is apparent from *Smart Planet Technologies*, the less inherently distinctive a sign, the more use will be required to educate the relevant public that the sign designates a particular trader’s goods. Unlike in *Lumos*, the sign at issue is not highly distinctive; on the contrary, I have already found that “TREEVIEW” is descriptive of software which organises or presents information in hierarchical lists. In the case of software for genealogy, the information is family tree information rather than, for example, business data. “TreeView” is descriptive of the intended purpose of the goods, i.e. to show a family tree. That conclusion finds supports in GSJ’s own evidence, which is that the choice of name “was due to the number of different types of views of family trees the online builder could display”.²⁹ The figurative sign used (i.e. that shown at paragraph 65, above), is not markedly more distinctive, as

²⁹ N. Bayley, §2.

the stylisation of the letters is slight and the outline of half a tree and the leaf device replacing the dot of the “i” both reinforce the word’s meaning and are subordinate to the word. Inherently, this sign is weakly distinctive at best. The small level of sales and limited advertising and promotion will not, in my view, have resulted in either sign acquiring any additional distinctiveness. On balance, my view is that the modest sales and limited distinctiveness of the signs had not resulted at the relevant date in a goodwill sufficient to warrant protection under the law of passing off.

72. There is a further issue which I should address, though as my above findings dispose of the invalidation under this ground, I will do so relatively briefly. The Trade Marks (Relative Grounds) Order 2007 stipulates that in order for a party to bring an application for invalidity under s. 47(2)(b), it must be the proprietor of the earlier right. It is not made explicit in the evidence who owns the goodwill in relation to the various goods and services claimed. The evidence filed on behalf of GSJ is that “TreeView” software is sold through GSJ’s “sister company” S&N Genealogy Supplies (“S&N”). Whilst it is entirely possible for goodwill to be owned by an entity other than the business actually trading in the goods, here there is no explanation of how goodwill generated by S&N in relation to the standalone software would come to vest in GSJ. It therefore appears that GSJ is not the owner of the goodwill generated by S&N’s business in software and that it has no standing to bring the opposition under s. 5(4)(a).

73. How the signs have been used in practice may result in a different conclusion. In *Oertli v Bowman* [1959] RPC 1 HL, the plaintiffs had granted a licence, later revoked, to the defendants to sell electric food mixers. The plaintiffs brought an action for passing off. Lord Reid encapsulated the factors relevant to the question of ownership of goodwill at [7]:

“Bowman made and marketed the Turmix machines without the appellants [plaintiffs] having controlled or having had any power to control the manufacture, distribution or sale of the machines, and without there having been any notice of any kind to purchasers that the appellants had any connection with the machines”.

74. This passage is considered in *Wadlow on the Law of Passing Off*, 6th ed., as follows:

“3-294 There are two distinct, and not necessarily consistent, standards in this passage. One is to ask who is in fact most responsible for the character or quality of the goods; the other is to ask who is perceived by the public as being responsible. The latter is (perhaps surprisingly) the more important, but it does not provide a complete answer to the problem because in many cases the relevant public is not concerned with identifying or distinguishing between the various parties who may be associated with the goods. If so, actual control provides a less decisive test, but one which does yield a definite answer.

3-295 To expand, the following questions are relevant as to who owns the goodwill in respect of a particular line of goods, or, mutatis mutandis, a business for the provision of services: (1) Are the goods bought on the strength of the reputation of an identifiable trader? (2) Who does the public perceive as responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory? (3) Who is most responsible in fact for the character or quality of the goods? (4) What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? For example, goodwill is more likely to belong to the manufacturer if the goods are distributed through more than one dealer, either at once or in succession. If more than one manufacturer supplies goods to a dealer and they are indistinguishable, the dealer is more likely to own the goodwill”.

75. Insofar as the non-downloadable software package is concerned, it is available from www.treeview.co.uk. This software does not appear to be available elsewhere, including on TheGenealogist website. The only print from www.treeview.co.uk sheds no light on the entity responsible for the goods. As late as 2016, the GENES blog post quotes a press release from S&N “concerning its TreeView software package (www.treeview.co.uk)”. I bear in mind that the premium software includes a subscription to TheGenealogist but that alone does not indicate to the relevant public that GSJ is responsible for the goods, as the subscription could be a simple marketing deal for the benefit of both companies.

76. I keep in mind that there had been longstanding use of related software on TheGenealogist by the relevant date. However, the picture relating to this software is mixed. The articles from 2010, 2012 and 2014 concerning online software and the mobile app, as well as the 2016 “Discover your Ancestors” article, make no mention of S&N. TheGenealogist is referenced in all of the articles, in some cases being identified as the place of first release of the goods and on occasion being asserted as the owner of the online software/mobile application (e.g. NJB5, NJB8). Screenshots of “TreeView” on TheGenealogist website from 2010 do not appear to indicate that the goods/services are licensed in any way.³⁰ Yet there is some evidence that S&N advertised the original TreeView software as its own in its 2007 newsletter. The 2008 report describes the downloadable/online software as S&N’s product and the GENES blog from 2016 identifies S&N as the producer of TreeView software package. Neither GSJ nor S&N appears to be referred to on either TheGenealogist or treeview.co.uk websites. As far as I can tell, neither GSJ nor S&N has a particular reputation which is relied on by the purchasing public. The public is likely to perceive whoever stands behind TheGenealogist website as responsible for the goods and services which feature there. However, judging from the 2016 comments in the GENES blog, S&N does not appear to have abdicated responsibility for the online software and is responsible in fact. The online software does not appear to be available in multiple fora, nor is there any evidence that TheGenealogist offers other types of named software (or any other goods). In relation to the online software, the goodwill is most likely to rest with GSJ, as the operator of TheGenealogist website. However, in relation to the standalone software (which is the only product for which any revenue is shown), it is available only through www.treeview.co.uk. There is no evidence showing it marketed through TheGenealogist and its sales are made by S&N. I do not consider that the documentary evidence is sufficient to disturb my primary conclusion that any goodwill connected with the “TreeView” software package is owned not by GSJ but by S&N.

77. The application for invalidation based upon s. 5(4)(a) is dismissed.

³⁰ NJB3.

Conclusions on the application for invalidation

78. The application is upheld for those goods and services indicated at paragraph 44, above. It is rejected for the remainder of the goods and services.

Opposition against trade mark application number 3388422

Section 5(2)(a)

79. Section 5(2)(a) of the Act is 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 earlier trade mark is protected, [...] there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

80. The following principles, which are relevant to the assessment of the likelihood of confusion, are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of trade marks

81. It is accepted that the marks are identical.

Comparison of goods and services

82. Identity was conceded in the counterstatement between “computer software” and “application software”, though GSJ points out that all of its goods are limited to the field of genealogy. As the earlier mark may only be relied upon for the goods and services which have survived the application for invalidation, however, the comparison must be based on the goods and services which remain in issue. The goods and services to be compared are, therefore:

Earlier goods and services	Contested goods
<p><u>Class 9:</u> Software drivers; Software for diagnostics and troubleshooting; Software for embedding online advertising on websites; Software for the processing of business transactions; Computer game software; Computer software for use in computer access control; Computer software to automate data warehousing; Internet access software; Simulation software for use in digital computers.</p> <p><u>Class 42:</u> Advisory services relating to man-machine interfaces for computer software; Computer hardware design;</p>	<p><u>Class 9:</u> Computer software; Application software; web application and server software; all relating to genealogy.</p>

<p>Consultancy and advice on computer hardware; Design and development of computer software for supply chain management; Design and development of computer software for use with medical technology; Design of software for processing and distribution of multimedia contents; Design services relating to virtual reality software; Development and testing of computing methods and algorithms; Development of computer software for logistics, supply chain management and e-business portals; Providing online non-downloadable software for use in supply chain management; Rental of computer hardware.</p>	
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83. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

84. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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 respectively 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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

85. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“12. [...] 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”.

86. A further relevant factor is whether there is a complementary relationship between the respective goods and/or services. It was explained by the CJEU in *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. The same applies by analogy to services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2009:428, the GC stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

Computer software; web server software; all relating to genealogy

87. The earlier specification includes a number of software goods. It could be argued that the fact that all of the goods are software necessarily means that there should be a finding of similarity because they all have the same nature, all software being a set of instructions to enable a computer to perform a specific task. However, if that approach were adopted, trade marks owners would be able to enforce their trade mark against others in radically different fields, where there is no commercial overlap. That cannot be right.

88. As I understand it, web servers are computer software which acts as an interface between a user’s computer or browser and web pages. Given that the contested goods are limited to genealogy-related server software, it appears that the server software at issue would interact with a user’s software to respond to queries concerning genealogy-related websites and databases.

89. It seems to me that the closest term in the earlier specification is “internet access software”. In my view, there are two ways to construe this term. It may be software employed by or provided by internet providers in order to enable users to connect their devices to the internet, or it may be software which controls or restricts user access to websites. The purpose of these is different from that of a server, which is simply to process requests from the client computer and to respond to requests from, for example, a web browser. Although the respective goods could be used by both the general public and sector professionals, it does not appear to me that there is a meaningful overlap in users, given in particular the specific nature and purpose of the contested goods. Their method of use will differ and channels of trade are unlikely to intersect. Nor is there either a competitive or a complementary relationship between the goods. These goods are not similar.

90. As far as the remaining earlier goods are concerned, even where there is an overlap in users, this is likely to be at a very superficial level. I accept that, for example, “software for diagnostics and troubleshooting” could be used to determine whether there are faults in web server software related to genealogy. However, it would only be in cases where there was a problem with the server software that one might deploy diagnostic software: the goods are not important for one another’s typical use and one would not routinely be required to use diagnostic/troubleshooting software in order to use software for genealogy. Further, the technical knowledge required to develop server software for genealogy on the one hand and diagnostic/troubleshooting software on the other strikes me as distant enough that the user is unlikely to think that the same or connected undertakings are responsible for the respective goods. There is no other obvious point of similarity. These goods are not similar.

Computer software; application software; web application software; all relating to genealogy

91. I cannot see any meaningful overlap in purpose between any of the earlier goods and services and the above terms, other than the very superficial similarity that they are all intended to make computers perform certain tasks. The contested goods have as their

purpose enabling genealogical research, which would include software for constructing family trees as well as, for example, programmes which enable the searching of historical records. The purposes of the earlier goods are various but there is none that strikes me as similar to that of software for genealogy. Users will not overlap save at a very general level. The method of use of the goods will be different and there is no competitive relationship. I do not consider that any of the goods are complementary, the same reasoning applying here as above in relation to diagnostic/troubleshooting software. There is no similarity between the various types of software in the earlier mark and the contested goods.

92. It does not seem to me that Mr Powell would be in a stronger position based on his “software drivers”. These goods are, as I understand it, code for connecting a computer and a peripheral device, such as a mouse or printer. There does not appear to be any overlap, other than for nature and users, both of which are at too general a level to result in similarity. Nor would the services in class 42 improve Mr Powell’s position, as not only do they differ in purpose and method of use but they are also different in nature. There is no obvious complementary or competitive relationship, nor is it likely that channels of trade or users would overlap to a material degree.

93. In order for there to be confusion, there must be a degree of similarity between the goods.³¹ As the goods and services at issue are not similar, the opposition under s. 5(2)(a) must fail.

Conclusion

94. Trade mark registration number 3327595 is invalid and deemed never to have been made, except in relation to the goods and services shown below for which it remains registered:

Class 9: Software drivers; Software for diagnostics and troubleshooting; Software for embedding online advertising on websites; Software for the processing of business transactions; Computer game software; Computer software for use in

³¹ See, for example, *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

computer access control; Computer software to automate data warehousing; Internet access software; Simulation software for use in digital computers.

Class 42: Advisory services relating to man-machine interfaces for computer software; Computer hardware design; Consultancy and advice on computer hardware; Design and development of computer software for supply chain management; Design and development of computer software for use with medical technology; Design of software for processing and distribution of multimedia contents; Design services relating to virtual reality software; Development and testing of computing methods and algorithms; Development of computer software for logistics, supply chain management and e-business portals; Providing online non-downloadable software for use in supply chain management; Rental of computer hardware.

95. The opposition against trade mark application number 3388422 has failed. The mark will proceed to registration for all of the goods and services in its specification.

Costs

96. Both parties have achieved a measure of success in the invalidation; GSJ has successfully defended against the opposition in full. I consider that GSJ is entitled to an award. When making the award, I bear in mind the degree of success overall, and the light evidence and submissions filed in this case. I award costs to GSJ as follows:

Considering the notice of opposition and filing the counterstatement:	£200
Filing evidence and submissions:	£300
Total:	£500

97. I order Simon Powell to pay Genealogy Supplies (Jersey) Limited the sum of **£500**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of October 2021

Heather Harrison

For the Registrar

The Comptroller-General