

O-069-14

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION BY NOWCOMM LIMITED
UNDER NO 2462401A FOR THE TRADE MARK**



AND

**IN THE MATTER OF OPPOSITION NO. 98043 THERETO
BY NOW WIRELESS LTD**

THE BACKGROUND AND THE PLEADINGS

1) On 24 July 2007 Nowcomm Limited (“the Applicant”) filed application no. 2462401 to register the following mark for certain goods in Class 9:



Following correspondence with the Registry, application no. 2462401A for this mark was published on 24 July 2008 for the following goods and services:

Class 9: Computers, computer hardware, modems, data-processing apparatus, computer hardware for support management. Surveillance hardware systems; electromagnetic door locks and remotely controlled door locks.

Class 37: Installation of hardware systems.

Class 42: Computer advisory, consultancy and design services.

The application was published in the Trade Marks Journal on 4 July 2008.

2) Now Wireless Limited (“the Opponent”) opposes the registration of the mark on grounds under sections 5(2)(b) and 5(4)(a) of the Trade Mark Act 1994 (“the Act”).

For the purposes of its claims under section 5(2)(b) the Opponent initially relied on:

- UK trade mark application no. **2389521**, filed on 15 April 2005
- Community trade mark (“CTM”) application no. **4650156**, filed on 20 September 2005 with a priority date of 15 April 2005 (claimed from UK application no. 2389521).

NOWWIRELESS

The original specification of this mark, which the Opponent attached to form TM7, covered a number of goods and services in classes 9, 35, 38 and 42. In the witness statement of 20 November 2009 which Mr Richard McLoughlin submitted for the Applicant he pointed out that the specification as at 2 November 2009 contained amendments of which the Applicant had not been advised. These amendments consist of a number of deletions and limitations. They are shown in the current specification which the Opponent attached to its submissions of 18 December 2012, requesting that the opposition continue with respect to the amended specification. The Applicant was already aware of these amendments at the time it submitted its first witness statement, and I shall make my assessment on the basis of this amended specification, which is as follows:

Class 9: Computer software, firmware, hardware and peripheral equipment, namely, servers, firewalls, VPN gateways, routers, modems, LAN access

points, wireless access points, wireless systems, instant hotspots, cardbus adapters, pci adapters, USB network adapters, voice over Internet equipment, VPN, wireless connectivity, digital security, SMS, MMA, WAP, email systems, instant messaging, security hardware and software, CCTV cameras and CCTV recording equipment, monitors and sensors; computer networking equipment, for emergency services, government organizations, corporations and educational establishments; computer security apparatus, instruments and software; wireless computer security apparatus, instruments and software; wireless telecommunications apparatus and equipment; wireless gateways; MMS, SMS and WAP gateways; data encryption apparatus; mobile broadband and position location apparatus and instruments; wireless networks; firewalls, wireless firewalls; virtual private networks; variable message signs and ticket machines; telecommunications apparatus and equipment for emergency services, law enforcement, security, public transport, traffic control systems and public CCTV; mobile telephones, mobile telephone cases, fascias, for emergency services, government organizations, corporations and educational establishments, Operator logos; wireless security apparatus and instruments; parts, fittings and accessories for all the aforesaid goods.

Class 35: Processing and storage of data and information.

Class 38: Provision of advice and information relating to communications, broadcasting and networking services; Internet television and radio broadcasting services; telecommunication services; wireless telecommunication services; transmission and broadcast of publications, text, signals, software, information, data, code, sounds and images; broadcasting and communications by telephone, line, cable, wire or fibre; broadcasting and transmission of text, messages, information, sound, images and data; provision of SMS, MMS and instant messaging services; general packet radio services (GPRS); interactive video text services; message and text message sending; dissemination of information over the internet and by mobile telephone; computer-aided transmission of messages and images to mobile telephones; interactive communication and telecommunication services; interactive mobile telephone, telephone, facsimile, Internet, television and television text services; communications by telegram, telex, telephones, mobile, wireless telecommunications, network services and computer terminal, video, wire, satellite, microwave or cable; communications services provided to businesses, institutions and public bodies for the broadcasting and transmission of information by electronic means, broadcasting and transmission via communication and computer networks and broadcasting and transmission of digital information; electronic mail services; transmission and reception of data and of information; satellite communication services; communications by and/or between computers and computer terminal; computer aided transmission of information, messages, text, sound, images, data and radio and television programmes; transmission of on-line computerised information; provision of access to worldwide web facilities and structures; communications services for the provisions of access to information, text, sound, images and data via communications and computer networks; telecommunication access services for access to a communications

or computer network; digital communications services; wireless communications services; provision of user access to a global computer network; provision of access to databases; leasing and rental services in connection with telecommunications apparatus and equipment; provision to businesses, institutions and public bodies of advice and information relating to computer gateway services, computer services for accessing communications for computer networks, computer services for accessing entertainment, education, information and data wirelessly or via telephone, line, cable, wire or fibre; computer services for accessing and retrieving information, messages, text, sound, images and data via a computer or computer network; computer services for provision of information on-line from a computer database or computer network.

Class 42: Computer services, namely, computer consultancy services and installation, maintenance and repair of computer software for networks; computer firewall and data security services; design and development of computer networks; design and development of virtual private networks; information services relating to the development of computer networks; installation and maintenance of computer software; computer services for interactive communications and broadcasting; rental of computer software and computer apparatus; provision of information relating to computers, computer software, firmware, hardware and peripheral equipment; provision of advice and information relating to all the aforesaid services.

3) The above mark constitutes an “earlier trade mark” for the purposes of section 5(2)(b), subject to its being registered; since it has not yet been registered, section 6A is not relevant, and the Opponent is not required to prove use of its mark.

4) For the purposes of its claim under section 5(4)(a) the Opponent relies on the following sign:

NOWWIRELESS

The Opponent claims that it has significant goodwill in relation to this sign, saying that it has been part of a group of companies which have been trading under the sign NOW since as early as 1989, and that against the background of that existing reputation the sign NOWWIRELESS was first launched over the financial year 1999/2000, the range of goods and services marketed under the sign including:

Servers, firewalls, VPN gateways, routers, modems, LAN access points, wireless access points, instant hotspots, cardbus adapters, pci adapters, USB network adapters, voice over internet equipment, computer software to enable VPN and wireless connectivity, security, SMS, MMS, WAP and instant messaging, and the installation, repair and maintenance of the aforesaid.

5) The Applicant filed a counterstatement, denying the grounds of opposition.

UK trade mark application 2389521 was subsequently successfully opposed and refused registration, leaving CTM application no. 4650156 for the following mark as the sole earlier trade mark relied on under section 5(2)(b). In April 2010 the

Opponent requested that these proceedings be suspended pending the outcome of opposition proceedings at OHIM against CTM application no. 4650156. On 26 October 2012 the parties were informed of the Registrar's preliminary view that in view of the long delay in resolving the outcome of the earlier CTM proceedings the Registrar should issue a decision on the 5(4)(a) ground and a provisional decision on the 5(2) ground. This was accepted by the parties. During 2013 proceedings were delayed by extensions of time for submissions and the granting of leave to the Applicant to file further evidence.

THE EVIDENCE

6) The Opponent's evidence consists of three witness statements of Mr Brian Jackson, dated 17 July 2009, 27 February 2010 and 30 August 2013 respectively. I shall refer to them respectively as Mr Jackson's first, second and third witness statements. The Applicant's evidence consists of two witness statements of Mr Richard McLoughlin, dated 24 November 2009 and 12 July 2013 respectively. I shall refer to them respectively as Mr McLoughlin's first and second witness statements

7) In his first witness statement Mr Jackson states that he is the managing director of the Opponent, which is a member of a group of companies, including Now Distribution Ltd and Now (International) Ltd, the names of which begin with the word NOW. Through these companies, he says, use of the mark NOW can be traced back to 8 December 1989, when Now Distribution Ltd originally changed its name to Now Distribution (UK) Ltd. He further states that his company uses a range of trade marks in which the word NOW is followed by an element describing the goods and services provided under the mark (e.g. NOWGPRS for goods and services involving GPRS technology, NOWSMS for SMS services, etc.).

8) Mr Jackson describes the Opponent as a leading supplier of wireless technology (having over 1,000 customers worldwide, including resellers in the UK and Europe) and of installations and developments. He attaches as **Exhibit BJ2** a list of the Opponent's customers, listed by country, to show, he says, the wide area in which the marks NOWWIRELESS, NOWSMS, NOWMMS, NOWWAP and NOWGPRS are used. The list itself contains no indication as how, where or when which marks were used vis-à-vis which customers. In particular, I have no information as to what period of time the list relates to and whether it includes customers supplied after the relevant date of 24 July 2007. No turnover or invoiced figures are given. It has three (unheaded) columns, consisting of a four digit number (which may be a product code – this is not explained, and no key is provided), a name (clearly that of the customer) and a country. It is 22 pages long, with 50 entries per page. However, many customers appear more than once, and names may not always be used completely consistently. The first page of UK entries, for example, consists mostly of entries for Anite telecoms, Anite Telecom Ltd and Anite Telecoms Ltd. The UK accounts for 4 pages, out of a total of 22. Discounting repeated customer entries, the UK pages account for just over 100 customers. The remaining 18 pages cover customers in 85 countries. A further complication is that, despite its length, the list does not appear to be complete. None of the local authorities featured in the "case studies" in **Exhibit BJ10**, for example, appears on the list – though several appear in invoices issued before the relevant date in **Exhibit BJ3**. These factors make it very difficult to

draw any firm conclusions from this list as to how, when and in what volumes business was done with which customer.

9) Mr Jackson states that the Opponent supplies a wide range of goods and services under the mark NOWWIRELESS, including servers, firewalls, VPN gateways, routers, modems, LAN access points, wireless access points, instant hotspots, cardbus adapters, pci adapters, USB network adapters, voice over internet equipment and computer software to enable VPN and wireless connectivity, security, SMS, MMS, WAP and instant messaging. It also supplies hardware and software including CCTV cameras, recording equipment, monitors and sensors and provides consultancy, design and development services. **Exhibit BJ3** comprises a bundle of invoices to show sales of these goods and services between 2004 and 2009. The reproduction quality of many of these invoices is so poor as to make large parts of them illegible or only barely legible with difficulty. One (shown on page 2 and dated 02/04/2004) is issued by NOW IP Ltd. The rest are all issued by the Opponent under its corporate name: Now Wireless Ltd. They are dated from 2004 to 2009, i.e. some date from after the relevant date. They show a range of goods and services supplied with UK VAT to UK customers, so, though currency is not explicitly specified, prices are obviously in pounds. Neither the name "Now Wireless" nor the mark NOWWIRELESS is used in the description of the goods and services in any of the invoices. The following terms can be made out, respectively, in the descriptions on some of them: *NowSMS Server* (this appears on 13 invoices, net unit price varying from 416.50 to 1,256.60), *Now Wap Proxy ...* (this appears on 5 invoices, net unit price varying from 430.50 to 6,000.00), *Now SMS Annual Upgrade Agreement* (appears on one invoice to Manx Telecom, net unit price 999.00), *Now WAP Annual Upgrade Agreement* (appears on one invoice to Manx Telecom), net unit price 2,250), *NowSMS 50 messages/second Lease Purchase* (appears on one invoice, unit price 1,500). None of the invoices issued to local authorities appear to bear NOW-prefixed product descriptions; they bear technical descriptions consistent with the supply of goods and services of the kind described above. The average invoice sum seems to be about 6,000.00, though the total net invoice sum for 11 "Mesh Node" products to Suffolk County Council was 14,190.00 and Kent County Council was invoiced 65,302.00 net for "Wireless Communications Equipment for Traffic Signa [sic] in accordance with tender 20 June 06".

10) Mr Jackson says that "NOW products" are currently used by councils to create wireless communication systems that cover entire cities and other areas, such systems being currently deployed in relation to traffic light systems, CCTV cameras, emergency services communications equipment, automatic number plate recognition, variable messaging signs (VMS), real time information services and on bus stops. He states that his company currently has such installations and systems in place to do these jobs variously in Suffolk, Edinburgh, Bradford, St Helens, Kent, Glasgow Nottingham, Dunfermline, Coventry, Fife, Hertfordshire, Lowestoft and Bristol. He says that the most common use of "NOW products" has been in relation to replacement traffic light system installations by local councils. Typical customers of the Opponent are stated by Mr Jackson to include local authorities, the emergency services, telecommunications companies, government bodies, corporations and schools. Examples are given, and Mr Jackson says that all these goods and services are provided under the trade mark NOWWIRELESS. However, Mr McLoughlin in his first witness statement, having provided evidence of applications

filed by the Opponent for CTMs which do not contain the word NOW, observes that the copy invoices attached by Mr Jackson include items sold and supplied by the Opponent by reference to marks other than NOWWIRELESS, NOWSMS, NOWMMS, NOWWAP and NOWGPRS. In his second witness statement Mr Jackson replies that in referring to “NOW products” he means products sold and marketed by the Opponent under its name; this includes goods sold under the Opponent’s CTMs MESH DUST and MESH4G. However, he says, “It remains that the turnover represents a significant trade in NOW marked goods and services. Further, all goods and services to which these two Community Trade Marks are applied are sold by Now Wireless Limited”.

11) In his first witness statement Mr McLoughlin added up the invoices for 2005 and 2006 in the Opponent’s **Exhibit BJ3**, drawing the inference that the Opponent had sold goods and services to purchasers in the UK to a value of less than £100,000 in 2005, and less than £55,000 in 2006, and that the relevant figures could be lower if goods/services that are “NOW products” but are not NOWWIRELESS, NOWSMS, NOWMMS, NOWWAP or NOWGPRS are excluded. In his second witness statement Mr Jackson says these inferences should be disregarded, as the invoices in question do not cover all the Opponent’s activities during this period. He states that they are provided as examples of invoices issued during this period “in order to establish use of the mark”, and do not show all sales under the mark or all invoices issued over the period. However, no break-down of figures is provided to show what sales were made to UK customers by reference to particular NOW-prefixed marks.

12) **Exhibit BJ4** comprises a series of print-outs from the Applicant’s website, demonstrating its work in relation to Southern Cross Healthcare, Derby City Council, West Lindsey District Council, and schools in Bradford. Mr Jackson argues that this shows that the Opponent’s and Applicant’s respective customer bases are very closely linked, and that this increases the likelihood that use of the mark in suit will cause confusion. **Exhibit BJ5** consists of a print-out from the Applicant’s website stating the Applicant can provide a complete wireless network for both businesses and an entire metropolitan area through wi-fi hotspots around the city using its equipment. Mr Jackson says this is similar to the way the Opponent would deploy a city-wide wireless network under its NOWWIRELESS mark. The page also mentions connecting CCTV cameras wirelessly, which Mr Jackson says is exactly what the Opponent does under the name NOWWIRELESS.

13) 4 Mr Jackson provides the following turnover figures for goods and services which he describes as sold under the mark NOWWIRELESS:

| Company | Year | £ Turnover |
|-------------------|-----------|------------|
| Now International | 1999/2000 | 525,009 |
| | 2000/2001 | 1,151,241 |
| | 2001/2002 | 601,182 |
| | 2002/2003 | 787,939 |
| Now Wireless | 2002/2003 | 222,213 |

| | |
|-----------|-----------|
| 2003/2004 | 1,122,579 |
| 2004/2005 | 1,178,561 |
| 2005/2006 | 1,101,604 |
| 2006/2007 | 1,452,000 |
| 2007/2008 | 1,640,000 |

No further break-down of the above figures, in terms of specific goods and/or services or location of customer, is provided.

14) In response to criticism in Mr McLoughlin’s first witness statement Mr Jackson attaches to his second witness statement as **Exhibit BJ12** print-outs of the profit and loss accounts of Now International Limited from 2001 to 2003 and Now Wireless Limited (formerly Now IP Ltd) from 2002 to 2008, to confirm the accuracy of these turnover figures.

15) Mr Jackson states that the Opponent advertises the goods and services supplied under the NOWWIRELESS, NOWSMS, NOWMMS, NOWGPRS and NOWWAP marks and estimates that it spends approximately £50,000 per year on doing so, with much of that expense being incurred through attending exhibitions which normally cost in the region of £8000-£10,000 each. **Exhibit BJ6** consists of a DVD containing copies of presentations used at exhibitions; it also contains two files marked “Now Distribution Exhib 2002.[1/2]”, which comprise photographs of a stand bearing the name NOW DISTRIBUTION. I cannot see the mark NOWWIRELESS anywhere in these photographs. The presentation slides from 2001 contain references to “Now Distribution”, “Now international”, and “Now Wireless”. The word NOW appears at the top left-hand corner of one set of slides, as follows:



“NOW Wireless” appears on one slide in connection with “Wireless solutions for Telcos and ISPs” and “Consultancy for implementation of wireless solutions”. On another slide (bearing the above mark and another mark incorporating “Infinite.com”) Now Distribution is described as the sales channel of Infinite UK, distributing Infinite products and related products to authorised resellers. The presentations from 2004 onwards deal with such matters as wireless communication systems in relation to traffic light systems, real time information services on bus stops, etc. They contain some references to NOW Wireless (“Who is NOW Wireless?”; “NOW Wireless customers”; “Most mobile phone companies, operators and phone manufacturers worldwide use our MMS and SMS servers. Over 200 Telco customers”), and the slides themselves bear one or other of the following signs:



The Opponent’s Mesh4G mark plays a prominent role in the presentations. In several of them the Mesh4G mark appears prominently at the top right of each slide, the sign which I have shown on the right above appearing in smaller form on the bottom left. The presentation from 2006 is headed “Mesh4G Products”, and consists of a series of slides with images of products. However, the products themselves either do not bear a visible mark, or bear an indecipherable mark, as shown below,

which does not appear to correspond to any of the Opponent's marks or signs mentioned in these proceedings:



Mr Jackson sets out a list of 28 exhibitions at which his company has exhibited between October 2000 and April 2007. Some of those listed appear to have taken place in the UK, some abroad, and the location of others is not specified. Mr Jackson says that the exhibitions he lists are the main ones attended by buyers from the telecommunications industry and from local authorities, emergency rescue services and gas, water and electricity providers. He estimates that these exhibitions attract upwards of 15,000 people.

16) Mr Jackson says he established the domain name now.co.uk in 1996 with nowwireless.co.uk and nowwireless.com being registered in 2001, and that there **Exhibit BJ7** consists of copies of a WHOIS query confirming these details. **Exhibit BJ8** contains a copy of the webpage www.nowwireless.com, which Mr Jackson states was first active on 2 October 2003. The mark NOWWIRELESS and the word NOW are shown prominently. In his second witness statement Mr Jackson states that "NOW WIRELESS websites are part of the promotional effort to raise awareness and provide details of all the products and services my company offers. Goods and services are not sold directly online". He says www.nowwireless.co.uk, which receives around 21,000 hits a week, resolves to the website www.nowwireless.com, which receives 507,000 hits a week. However, I have no information as to how many hits were being received before the relevant date, and whether they were received from the UK or abroad.

17) In **Exhibit BJ9** Mr Jackson exhibits a selection of photocopies of press cuttings and advertisements, including a press cutting from the *Daily News* of ITS 11 October 2006 referring to the urban traffic control system for Coventry, and containing the statement "Peek (with Now Wireless) will provide the UTC system, control room and communication system". Pages 1-7 come from a publication "PCDealer" of August 1998 and refer to Mr Jackson and Now Distribution. The article on pages 8-10 is from *ITS* of May 2006 and refers to Peek Traffic winning a contract to provide Glasgow with a traffic control system. It explains that Glasgow City Council asked Peek Traffic to see if a wireless technology solution would be workable: "There were two commercial solutions on the table One is the Mesh Radio system, a Motorola product which is being sold in this country by NOW Wireless" Pages 11 and 12 show advertisements for the Opponent's Mesh4G wireless technology. They are respectively marked "ITS Solutions" May and October 2006. They are headed "Mesh4G™ 4th Generation Metropolitan Wireless", and the nowwireless.com sign appears at the bottom right. Page 13, which is marked "TEC – October 2006", is very similar. Page 14 is marked "Snapgear¹ Leaflet 2006", advertises the wireless security products available from the Opponent, and informs the reader that "Now Wireless is a leading UK supplier of wireless infrastructure projects for 2G, 2.5G, 3G and 4G". The nowwireless.com sign appears at the bottom right. Page 15 is from *ITS Daily News* of October 2005 and makes a single reference to "Now Wireless"

¹ It seems that Snapgear is a third party mark – cf. Paragraph 18.

working with another company to upgrade the urban traffic system in Coventry. Pages 16 and 17 are advertisements for Now Wireless from *Government Business* of April 2009 (after the relevant date). No details are provided to show whether or where any of these publications are distributed, circulation figures, or who the readership might have been.

18) Mr Jackson indicates that the Opponent issues newsletters and mail shots to potential customers in local authorities and the emergency services. At **Exhibit BJ10** he exhibits a document headed "Mesh4G™ Wireless Cities". Mr Jackson gives no explanation of how or where it is used or distributed. A small note at the end of the document reads "published 26 October 2007". It explains that "Now Wireless was established in 1989 and is a distributor and supplier of wireless and internet technologies to government, councils, resellers, retailers, operators, internet service providers and other enterprises". It gives a number of "Case Studies" concerning work done for local authorities, which include the following statements: "NOW Wireless was asked by Portsmouth City Council in 2002 to find a secure wireless network system"; "Having met with Jacobs Batbie at a conference in the beginning of last year NOW Wireless were asked to be involved with a number of projects aimed at reducing revenue costs for Kent County Council. "In 2005 we were contacted by Faber Maunsell to help find a way to significantly reduce Suffolk County Council's capital and revenue costs for their traffic light network in Lowestoft"; "In September 2005 NOW Wireless was asked by Hampshire Fire and Rescue Service to provide a reliable fireground wireless communications solution at the scene of major accidents. "This trial confirms that the Mesh4G™ communications system answers our problems of getting good, reliable data to and from the fire ground" says Paul Turner, Senior Communications Engineer for Hampshire Fire and Rescue Service."

19) At **Exhibit BJ11** are copies of a selection of newsletters "in use between 2005 and 2007". No further information is provided about when and to whom these may have been sent; the printouts provided were issued by email to various members of staff at Mr Jacksons' companies. Some are apparently drafts. They are headed "NOW News" and explain that "Now Wireless is a value-added distributor specialising in secure communications and messaging technology". They contain many references to products supplied under third party trademarks (Lancom, Snapgear, etc.) plus references like the following: "Welcome to our April 2005 newsletter. We are pleased to announce we are organising a FREE RESELLER TRAINING course for May. The May training will provide an overview of our new Wireless Security and Mesh4G ranges, as featured below..... The NOW Wireless Security (WS) series is a range of multi role Wireless Access Points and router products encompassing solutions for home, small business and major corporate users. For example the WS/21 "Matrix" Multi-Role VPN Gateway". Items in the range are referred to simply by the letters WS with a number. The February 2005 newsletter contains the following: "We are also launching a bundle version of our successful SMS and MMS messaging product, NowSMSthe NowSMS SMS/MMS Gateway is an SMS and MMS Content Delivery Solution ...Now SMS users can send text and images to a mobile phone as easily as sending email".

20) In Mr McLoughlin's first witness statement he submits that the Opponent's evidence does not establish a reputation in the UK for goods/services sold under the

mark NOWWWIRELESS or other NOW marks, and that it is relevant that the Opponent has not referred to any instance of confusion arising since the Applicant commenced trading on 1 November 2005.

21) The Applicant was given leave to file additional evidence, which was provided in Mr McLoughlin's second witness statement. He submits that "The prefix "now" is a generic term that has been used as such in a variety of sectors and applications which commenced at or about the same time that the opponent changed its corporate name to Now Wireless Limited". He exhibits evidence of use of the word "now" in advertising campaigns by Vodafone "(Make the most of Now)" and Cisco ("The Cisco Power of the Network. Now"), the launch in the UK of a broadband service marketed as NOW Broadband and NOW wireless Broadband, the marketing by PCCW Media Ltd of a device known as the "Now Player", and the launch by the broadcaster Sky of an on demand service in the UK called "Now TV". He also refers to a recently launched service from Google – "Google Now" – which he understands to provide access to data over wireless connection via devices such as lap tops, smart phones and tablets, and to oppositions to the registration of NOW WIRELESS both at OHIM and in the UK by EMI (IP) Ltd and Starbucks (HK) Limited.

22) According to the Opponent's evidence in reply, given in Mr Jackson's third witness statement, some of the third party uses of NOW described in Mr McLoughlin's evidence post-dated the date of application for the mark in suit. I deal with this and other points addressed by Mr Jackson in my assessment in paragraphs 40 to 43.

SECTION 5(2)(b)

23) Section 5(2)(b) of the Act reads:

5(2) A trade mark shall not be registered if because –

... (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

24) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union ("CJEU") in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 ("*Canon*"), *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of the relevant goods and services

25) In making an assessment of the similarity of the services, all relevant factors relating to the services in the respective specifications should be taken into account.

In *Canon Kabushiki Kaisha v. Metro- Goldwyn-Mayer* 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.”

26) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

27) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

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

28) I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE*, where he warned against applying too rigid a test with regard to complementarity.

29) When comparing the respective services, if a term clearly falls within the ambit of a term in the competing specification then identical services must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*) even if there are other goods within the broader term that are not identical.

30) It is settled law that in assessing whether there is a likelihood of confusion I must make my comparison on the basis of notional and fair use over the whole range of services covered by the Applicant's application and (since the earlier mark is not subject to proof of use) the Opponent's respective specification. It is the inherent nature of the services of the specification which I have to consider, rather than current marketing strategy (see *Devinlec Développement Innovation Leclerc SA v OHIM Case T- 147/03*). I am required to consider the likelihood of confusion "in all the circumstances in which the mark applied for might be used if it were to be registered" (See Case C-533/06, *O2 Holdings v Hutchison 3G UK* at paragraph 66).

31) I will make the comparison with reference to the Applicant's goods.

Class 9: *Computers, computer hardware, modems, data-processing apparatus, computer hardware for support management. Surveillance hardware systems; electromagnetic door locks and remotely controlled door locks.*

32) The Applicant's *computer hardware* is identical with the Opponent's *computer hardware. Computers, modems, data-processing apparatus, computer hardware for support management* also fall within the ambit of *computer hardware*, and are therefore identical under the guidance in *Meric*. Similarly, the Applicant's *surveillance hardware systems, electromagnetic door locks and remotely controlled door locks* are covered by the Opponent's *security hardware and CCTV cameras and CCTV recording equipment, monitors and sensors*, and are therefore identical.

Class 37: *Installation of hardware systems.*

33) The *installation of hardware systems* will cover installation of *computer hardware*. There is a close connection between *computer hardware* in class 9 of the opponent's specification and the *installation of hardware systems* 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. There is a strong overlap between the users and the uses and purpose served by the respective goods and service. They may be supplied by the same supplier. There is a reasonable degree of similarity between them. There is also a high degree of similarity of nature, purpose and complementarity (in the sense explained above) between *installation of hardware systems* and *installation, maintenance and repair of computer software for networks* and *installation and maintenance of computer software* in the opponent's class 42 specification.

Class 42: *Computer advisory, consultancy and design services.*

Computer advisory, consultancy and design services

34) The Opponent's specification for class 42 services is:

Computer services, namely, computer consultancy services and installation, maintenance and repair of computer software for networks; computer firewall and data security services; design and development of computer networks; design and development of virtual private networks; information services relating to the development of computer networks; installation and maintenance of computer software; computer services for interactive communications and broadcasting; rental of computer software and computer apparatus; provision of information relating to computers, computer software, firmware, hardware and peripheral equipment; provision of advice and information relating to all the aforesaid services.

The Opponent's *computer services, namely computer consultancy services* falls within the ambit of *computer consultancy services*. *Design and development of computer networks* falls within *computer design services*. The Opponent's provision of advice and information relating to all the aforesaid services is covered by *computer advisory services*. The services are identical.

The average consumer and the purchasing process

35) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

36) Both the Applicant's and the Opponent's specifications encompass a range of goods and services of a very technical nature. Some of the Applicant's goods and services, such as *computers, modems* or *computer advisory services* might be of interest to the general public as well as to business and other users. Even where bought by the public, however, they will be considered purchases. Other goods and services of the Applicant's specification, such as *surveillance hardware systems* and *computer design services* are aimed primarily at businesses and other organisations rather than the general public. If bought by private individuals they will be very considered purchases. Similarly, while it is conceivable that some goods and services of the Opponent's specification might be purchased by private individuals, it is clear that they are aimed primarily at a professional public of businesses and other organisations, and this is reinforced in some instances by limitations, for example: *computer networking equipment for emergency services, law enforcement, security, public transport, traffic control systems and public CCTV; computer services, namely computer consultancy services and installation, maintenance and repair of computer software for networks*. There is likely to be a considerable bespoke element to many of these services, and an element of technical suitability of goods for intended use, with the result that they will be bought after technical discussions to ensure they are

fit for purpose. I find that customers will pay a high level of attention when selecting the goods/services at issue.

The distinctiveness of the earlier mark

37) The degree of distinctiveness of the Applicant's mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). Account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* C-342/97 at paragraph 23).

38) In paragraph 21 I have summarised evidence provided in the second witness statement of Mr McLoughlin regarding use by third parties, both in a nominative sense and in advertising slogans, of the word NOW in the broadcasting, media and telecommunications sectors.

39) In his witness statement in reply Mr Jackson says that NOW TV was launched in 2012, after the filing date of the application for the mark in suit, and that the Opponent has an "informal relationship with the representatives of British Sky Broadcasting in respect to their trade mark NOW TV, in which it is understood that the respective parties are not in the same business area". He states that the Opponent has a coexistence agreement with EMI (IP) Ltd, which is involved in the dissemination of music content, and that oppositions from Starbucks have yet to be resolved. I am content to discount the evidence in these cases on the basis that the Opponent has been in dispute with the relevant third parties and/or has entered into agreements with them.

40) Mr Jackson states that NOW BROADBAND and NOW WIRELESS BROADBAND is a 4G wireless broadband service, and 4G wireless broadband was not active in the UK when the mark in suit was filed; it is targeted at domestic users and, while the company intends also to target businesses, they are not involved in launching city-wide networks for facilitating public services. He states that the use of NOWPLAYER in **Exhibit RM4** originates from a website connected to a Hong Kong website. He exhibits a print-out to show that it is targeted at Chinese-speaking Hong Kong residents, and says the mark concerns an application for viewing television content. He further states that GOOGLE NOW was not, to his knowledge, in existence when the mark in suit was applied for, and Google is not engaged in the Opponent's field of industry.

41) I accept that uses made by third parties dating from after the date of application of the mark in suit will not themselves have affected consumer perceptions at that time. I also accept that use targeted at consumers in Hong Kong will not have affected consumer perceptions within the UK.

42) I agree that the word “now” is not being used nominatively in the Vodafone and Cisco advertising copy and slogans in **Exhibits RM1 and RM2**. Nevertheless, I do find that they illustrate an aspect of the use of the word “now” in the context of telecommunications and wireless networks. The Cisco advertising campaign referenced in **Exhibit RM2** in particular shows the word “now” being given prominence and emphasis in association with these fields. The copy text is headed (in capitals) “THIS IS THE POWER OF THE NETWORK. It is followed by the word-sentence “now.”, written in lower case, but on the next line and in letters much larger than those on the preceding line, so as to give the word special prominence and emphasis. The copy reads:

“Networks are all around us. They are in our walls, in the air. At schools, hotels, hospitals, even coffee shops. Always there, always on. They have the power to change the way we work, live, play and learn. This power exists today, in our routers, in our switches. In the networks that connect students to teachers, customers to corporations, ideas to people. People who understand the powerful difference between having a network and being networked. People who are tapping this power to revolutionize their organizations. To become more competitive, agile, profitable, productive, mobile, collaborative, global, and secure.

This is the power of the network. Now.”

This demonstrates that those wishing to promote goods and services in these fields find it attractive to associate them with the “immediate” and “up-to-date” meanings of the word “now”. The advertisement is clearly addressed, at least in part, to a professional consumer. I consider that it is also clearly expected that immediacy and the quality of being up-to-date are characteristics which the consumer will recognize and value. I note that in *Starbucks (HK) Ltd v British Sky Broadcasting Group PLC* [2012] EWHC 3074 (Ch) Arnold J held that a mark consisting of the word NOW could not be inherently distinctive of television and other telecommunication services, because it would be understood by the average consumer as a description of a characteristic of the service, namely its instant, immediate nature.

43) According to the *Shorter Oxford Dictionary* (5th ed, 2002), the meanings of “now” include “immediately”, “at once”, “at the present time or moment”, “of the present time”, “modern” and “up-to-date”. In the rapidly evolving and converging world of computer and telecommunication technology consumers will consider it important that products in the Opponent’s class 9 and services in the Opponent’s classes 38, 45 and 32 should reflect the latest developments and be “up to the minute”. Speed and immediacy of delivery in use and action will also be a desired characteristic of these goods and services. The word “now” will be perceived by the relevant public as descriptive of these characteristics; as such it is not an inherently distinctive element of the Opponent’s mark.

44) The significance of wireless communication and networks, both in the use of computers and computer-related products and in telecommunication generally, is now very great. In its submissions the Opponent described the suffix WIRELESS as being descriptive, commonly used in the technology and communication industries, and bestowing little or no distinctive character on the mark formed. Both NOW and WIRELESS are deficient in inherent distinctiveness. Any inherent distinctive character in the mark must therefore lie in combining these words. I therefore find that NOWWIRELESS as a whole has only a low degree of inherent distinctive character for the goods and services at issue.

45) Any acquired distinctiveness of the Opponent's mark can only arise through the actual use made of the mark NOWWIRELESS by the Opponent in relation to services at issue under section 5(2)(b), and will depend on how that mark has been used in the period before the mark in suit was applied for. The acquired distinctiveness must be in relation to goods or services of the Opponent which are at least similar to those of the Applicant.

46) The first problem is that the mark does not seem to have been used exactly as registered. Guidance on the test to be applied in deciding whether an acceptable variant is being used was provided in the decision of the Appointed Person in *Nirvana Trade Mark* - BL O/262/06:

"The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

47) Looking at the marks shown in paragraph 15, I consider that the consumer will regard the double dotted arrow device simply as a jointly affixed sign. I consider that the difference between now.wireless and NOWWIRELESS would probably go unnoticed by the consumer. "nowwireless.com" will be seen as a website address. Now Wireless and NOW Wireless plainly differ from NOWWIRELESS, but I do not consider that they alter the distinctive character of the mark.

48) However, there are further problems. From the promotional material and newsletters provided in evidence by the Opponent it is clear that the Opponent supplies goods under marks different from the earlier mark in these proceedings. The Opponent's Mesh4G mark, for example, plays a prominent role in presentations explaining the goods and services available from the Opponent in terms of wireless networking systems. A similar pattern can be seen in some advertisements. A presentation from 2006 is devoted entirely to Mesh4G products. The "case studies" document at **Exhibit BJ10** is headed "Mesh4G™ Wireless Cities". Mr Jackson says that the Opponent issues newsletters and mailshots to potential customers in local authorities and emergency services. I am not sure whether the "NOW News" newsletter in **Exhibit BJ11** is included in these, but references to "free reseller sales training", "our latest trade price list", all prices being "trade prices" and "Now

Wireless” being “a value-added distributor” make it clear that it is largely targeted at resellers of the Opponent’s products. The earlier mark is not used directly in relation to any product in these proceedings. Many of the opponent’s products are sold under third party brands, or by reference to other marks and sub-brands of the Opponent. (Mesh4G, NowSMS, etc.).

49) The “case studies” document in **Exhibit BJ10** explains that “Now Wireless was established in 1989 and is a distributor and supplier of wireless and internet technologies to government, councils, resellers, retailers, operators, internet service providers and other enterprises” – though the document is entitled “Mesh4G™ Wireless Cities”.

50) On the evidence of the newsletters and promotional materials the following inferences seem reasonable. 1. “Resellers” will see “Now Wireless” as the name of a distributor of branded products, many of which it sells under third party marks and some of which it sells under its own marks – none of which, however, is NOWWIRELESS or a variant of it. 2. Resellers will be informed that certain marks and sub-brands used by the distributor Now Wireless to describe certain of its product lines are in fact its “own brand” products. 3. Resellers will be aware that the distributor Now Wireless is not responsible for the quality of branded third party goods distributed by it. 4. In addition to distributing goods to resellers, the Opponent has done business with local authorities, emergency services, telecommunication companies, etc, providing for installation and supply of hardware for wireless network services. It has done so under the name Now Wireless. I have no breakdown of the turnover figures supplied by Mr Jackson showing what proportion of these figures relate to goods sold by reference to third party marks, what proportion are sold to resellers and what proportion consist of direct business with end customers such as local authorities, emergency services and telecommunication companies.

51) It is not clear whether the customer list filed as **Exhibit BJ2** represents the position at the date of application for the mark in suit or at the date it was filed. In any case, for the reasons I have explained in paragraph 8, it is very difficult to draw firm conclusions from this list as to how, where, when and in what volumes business was done with which customer. I have no figures to show how much of the Opponent’s turnover (as shown in the figures given in paragraph 13) is achieved through sales to customers situated abroad, and how much to those situated in the UK. However, the list in **Exhibit BJ2** seems to indicate at least that a significant part of the Opponent’s turnover is achieved abroad, and the list of exhibitions I have described in paragraph 15 also tends to point that way. As regards distinctiveness acquired through use, it is the UK market which is most significant, because it is here that confusion with a national mark will be measured. Moreover, though the total turnover figures given by the Opponent are not insignificant, it is difficult to judge their impact in what must be a very large UK market for the goods and services in question without evidence of market share. In the light of all these considerations I am unable to conclude that a significant proportion of consumers for the relevant goods and services in the UK would recognise the Opponent’s earlier mark in these proceedings as indicating the Opponent as their source. I therefore find that the Opponent has not shown that the earlier mark had acquired a materially enhanced level of distinctiveness in the UK as a result of the use of the marks before the date of application for the mark in suit.

52) Even if I am wrong in finding that the mark NOWWIRELESS as a whole had not acquired an enhanced distinctive character by the relevant date, this does not necessarily mean that NOW had become a distinctive element of the mark. Even if NOWWIRELESS as a whole had achieved average distinctiveness by the relevant date, it does not follow that NOW alone was distinctive as a result of use of NOWWIRELESS. I find that the use shown of NOWWIRELESS does not establish this. The use of other NOW marks by the Opponent is irrelevant under section 5(2)(b), because the Opponent's ground under this section is based only on the registered mark NOWWIRELESS.

Comparison of the marks

53) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are shown below.

| The Opponent's Mark | The Applicant's Mark |
|---------------------|--|
| NOWWIRELESS |  |

54) The relevant public will perceive the words NOW and WIRELESS and the abbreviation COMM (which will be understood to stand for “communication(s)”) as descriptive. Both marks are presented without any break between the word NOW and the remainder of the mark, but each breaks naturally into its component parts. This is emphasised in the Applicant's mark by the use of different colours. The first O in the Applicant's mark is figuratively presented, but the mark is still clearly and easily readable as NOWCOMM. None of the component word/abbreviation parts of either mark are inherently distinctive. This applies to the word/abbreviation components of the Applicant's mark, though the stylisation adds some distinctiveness to the mark as a whole. Consumers tend to pay more attention to the first part of a word mark, and the figurative O in the Applicant's mark may reinforce this somewhat, but the latter part of both marks continues to play a material role, so that I think that the distinctive character of both marks remain fairly balanced, NOW not being markedly dominant in either case.

55) The Opponent's mark consists of eleven letters, and the Applicant's of seven, the first three being the same. The Applicant's mark is divided by the use of two quite sober colours and the O is figuratively represented by a swirl device, but remains clearly readable as the letter O. There is not more than an average degree of visual similarity

56) The Opponent's mark has three syllables and the Applicant's only two. Both marks begin with NOW. The remaining parts of the mark are dissimilar. There is not more than a low degree of aural similarity.

57) The marks share the conceptual element of NOW. "Wireless" and "Communication(s)" (for which COMM stands) provide some conceptual difference, though communications includes wireless communications and both are commonly used in the area of telecommunications and computer technology. There is a reasonable degree of overall conceptual similarity.

Likelihood of confusion

58) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

59) I have found that none of the component parts of either mark are inherently distinctive, and that NOW is not markedly dominant in either case. I have found the earlier mark to be of low distinctiveness (though I bear in mind that weak distinctive character of an earlier trade mark does not preclude a likelihood of confusion²) and even if I am wrong about that, the element NOW alone has not acquired a distinctive character as a result of the use of NOWWIRELESS. I have found an average degree of visual similarity, a low degree of aural similarity and a reasonable degree of conceptual similarity between the marks. I have found that the goods and services of both specifications are largely aimed at professional business users. Even where bought by private individuals they will be considered purchases. There will be a considerable bespoke element to many of the services and the requirement of technical suitability of goods for intended use will mean they will be bought after technical discussions to ensure they are fit for purpose. In the light of all this, even bearing in mind that I have found goods and services to be identical, I do not find that there is a likelihood of confusion.

The opposition under section 5(2)(b) fails.

SECTION 5(4)(a)

60) The requirements for this ground of opposition can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

² *L'Oréal SA v OHIM – C-235/05 P*

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

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

61) This ground is completely separate from that under section 5(2)(b) and, as such requires separate analysis. Nevertheless, with two qualifications, which I discuss below, I fail to see how the Opponent can be in any better position. This is because, even if I accept that the Opponent has goodwill associated with the sign NOW WIRELESS, I have already found, given the nature of the respective marks (which are virtually the same in this analysis), and given the nature of the goods and services (which are, again, the same, in that the Opponent's goodwill associated with the mark NOW WIRELESS does not extend beyond the goods and services assessed under section 5(2)(b)), that there will be no likelihood of confusion.

62) The first qualification I would make is that in the Court of Appeal in *Marks and Spencer PLC v Interflora* (2012 EWCA (Cic) 1501) Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes amounted to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not necessarily mean that the average consumer is confused. For the avoidance of doubt, applying the appropriate test for misrepresentation, for the same reasons I found that the use of the Applicant's NOWCOMM mark would not create a likelihood of confusion with the Opponent's NOWWIRELESS registered mark, I find that it is unlikely that a substantial number of persons will believe that use of the NOWCOMM mark in relation to the goods and services of the Applicant's specification indicates a connection in the course of trade with the Opponent's Now Wireless business. I also bear in mind the principle that where a trade name is descriptive comparatively small differences in a competitor's trade name will suffice to avoid deception (*Office Cleaning services v Westminster Office Cleaning Association* [1946] 1 All ER 320 – "Office Cleaning").

63) The second point to address is that, in addition to the registered mark NOWWIRELESS, the Opponent claims goodwill in connection with a number of marks prefixed with the word NOW; it submits that consumers would assume that NOWCOMM was associated with this NOW-prefixed "family" of marks, NOW being the dominant and distinctive element of this "family". The word NOW has played a role in presentations between 2001 and 2007, as described in paragraph 15, and in newsletters as described in paragraph 19. On the evidence of the newsletters the NOW-prefixed marks used on the invoices described in paragraph 9 appear to be convenient sub-brands with which the Opponent describes certain of its "own brand" product lines, and some use of such sub-brands is shown in the invoices.

64) It is difficult to quantify the use which was made of the NOW-prefixed marks, as opposed to other marks of the Opponent or of third parties, in the period before the date of application for the mark in suit. The Opponent's customers consist of businesses such as corporations, telecommunications companies and resellers, and other organisations such as local authorities, government bodies, schools and

emergency services. The Opponent supplies these customers with goods and services relating to the installation and operation of wireless networks. I have no evidence on the size of this market, but it must be very large. Since I have found NOW to be descriptive, it is important to establish that the Opponent has made use of NOW-prefixed marks on a sufficient scale on the relevant market to give it a secondary meaning for consumers in that market. I am not satisfied that it has shown this. I do not consider the evidence establishes that NOW-prefixed marks had been used on the relevant market on a sufficient scale to render the descriptive word NOW distinctive. It seems that resellers and end customers of the Opponent will generally be aware that it supplies some goods under its own NOW-prefixed sub-brands. However, this customer base consists of professionals, and the purchasing process will be a considered one, involving a need to ensure technical suitability of goods for intended use and a bespoke element to many services. Any initial query in the mind of a potential purchaser as to whether the NOW in the Applicant's mark might indicate a connection with the Opponent will be resolved the course of that process, and the identity of the supplier clarified. As a result, I do not consider that those who come across NOW-prefixed marks of the Opponent would conclude that there is a trade connection with the Applicant on the basis of the NOW element in the Applicant's mark. The Opponent has therefore not established misrepresentation.

65) The opposition under section 5(4)(a) therefore also fails

OUTCOME

66) The opposition fails in its entirety.

COSTS

67) The Applicant has been successful, and is in principle entitled to a contribution towards its costs. On giving the Applicant leave to file late evidence, however, I noted that the Applicant's failure to file this evidence at the proper stage in these proceedings would cause the Opponent inconvenience and expense, and that I would make an appropriate order (which would be against the Applicant) at the end of the proceedings. The further evidence was not very lengthy or complicated, and the response was fairly straightforward. Under the circumstances, therefore, I consider that halving the costs I would otherwise have awarded is sufficient and proportionate, given that the Opponent lost. I therefore order Now Wireless Limited to pay Nowcomm Limited the sum of £650. This sum is calculated as follows:

| | |
|---|------|
| <i>Preparing a statement and considering the other side's statement</i> | £150 |
| <i>Preparing evidence and considering the other side's evidence.</i> | £500 |

68) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated 10th of February 2013

**Martin Boyle
For the Registrar,
The Comptroller-General**