

O-180-17

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3154399
BY DATUM360 LIMITED
TO REGISTER THE TRADE MARK
KIT360
IN CLASS 42**

AND

**IN THE MATTER OF OPPOSITIONTHERETO
UNDER No. 406671 BY
KIT ELECTRONICS LIMITED**

BACKGROUND

1) On 11 March 2016, Datum360 Limited (hereinafter the applicant) applied to register the trade mark KIT360 in respect of the following services:

- Class 42: Engineering consultancy services; engineering project management services; software as a service; design and development of software for management of engineering information and data; provision and hosting of software for management of engineering information and data; hosting of databases; electronic storage services for cataloguing engineering data.

2) The application was examined and accepted, and subsequently published for opposition purposes on 1 April 2016 in Trade Marks Journal No.2016/014.

3) On 23 May 2016 Kit Electronics Limited (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
KIT	3041747	11.02.14 26.09.14	9	Electronic devices for data processing, for indicating the interaction of fields, for information processing, for the transmission of data between computers, for the transmission of data between microprocessors, for transmitting data, for telephone exchanges, for cards incorporating electronic chips; network protection devices (electronic); reading devices for cards incorporating electronic chips; Information storage devices (electric or electronic); interfaces for computers; computer memory devices.
			42	Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer system design.

a) The opponent contends that its mark and the mark applied for are very similar and that the services applied for are similar to the goods and services for which the earlier mark is registered. As such the mark in suit offends against Section 5(2)(b) of the Act.

4) On 25 July 2016 the applicant filed a counterstatement, basically denying that the marks are similar. The applicant requested proof of use.

5) Only the applicant filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Both sides provided written submissions which I shall refer to as and when necessary in my decision.

APPLICANT'S EVIDENCE

6) The applicant filed a witness statement, dated 28 November 2016, by Katie Goulding its Trade Mark Attorney. She provides the information from her own enquiries and also from information provided by the applicant. She states that the applicant creates, stores, manages and provides access to information for engineering business processes. This, she states, is based on the applicant's expertise in Engineering Information Management (EIM) especially in the Oil and Gas industries. She states that they support businesses to:

- Work out what engineering information is needed;
- Figure out the information sources;
- Define how that information will be sourced and from which part of the supply chain;
- Configure how businesses want to work with that information;
- Establish what technology is right for the business;
- Implement and interface selected systems, and
- Put the right level of information assurance in place.

7) Ms Goulding states that the applicant uses the mark PIM360 in respect of one of its information management solutions which provides web-based access to engineering data sets. It is intended to use the mark in suit in respect of part of the broader PIM360 solution, specifically supporting the aggregation of equipment standard information into one catalogue. She provides the following exhibits:

- KG1: Pages from the applicant’s website. Ms Goulding states that the mark in suit is intended to replace an existing mark CAT360. On its website the applicant states “CAT360 allows clients to utilise a catalogue of equipment information....”.
- KG2: Copies of the applicant’s UKIPO registrations for the marks Datum360, PIM360 & CLS360.
- KG3: A definition of the word “KIT” from the online Oxford dictionary which provides as one of its main definitions “set of articles or equipment needed for a specific purpose”.
- KG4 & 7: Copies of pages from internet sites which show that the word “kit” is used in connection with electronic devices; computer hardware; computer programming; and software developing; i.e. “a package of electrical components used to build an electronic device”; “computer hardware kit”; “A crimeware kit, also called an infection, exploit or DIY attack kit, is a programming tool that allows someone...”; “A software developer’s kit (SDK) is a set of programs used by a computer programmer to write application programs”.

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

DECISION

9) The only ground of opposition is under section 5(2)(b) which reads:

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

(a)

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

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

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

11) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. Given the interplay between the date that the opponent’s mark was registered (26 September 2014) and the date that the applicant’s mark was published (1 April 2016), the proof of use requirements do not bite.

12) When considering the issue under section 5(2)(b) I take into account the following principles which 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

13) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In

Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

14) I must consider the class 42 services of both parties, which broadly speaking, include technical services involving engineering, computer software and hardware. It seems apparent that these services will be provided to businesses rather than the general public. These businesses are likely, in my opinion, to select the services mainly by visual means, initially from an on-line search or advertisement. It seems clear that following an initial contact it is likely that a meeting may be required in order to understand the precise requirements of the client company and for the customer to ensure that the provider has the necessary expertise. I also must take into account aural issues as it is possible that word of mouth recommendations may play a part in the selection. Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the service required. However, to my mind, even when the service requirement is relatively straightforward the nature of the service is such that the average consumer will pay **a medium to high degree of attention to the selection of such services.**

Comparison of services

15) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

16) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

17) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (GC) 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”.

18) In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr

Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

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

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

20) The goods and services of the two parties are:

Applicant's services	Opponents' goods and services
	Class 9: Electronic devices for data processing, for indicating the interaction of fields, for information processing, for the transmission of data between computers, for the transmission of data between microprocessors, for transmitting data, for telephone exchanges, for cards incorporating electronic chips; network protection devices (electronic); reading devices for cards incorporating electronic chips; Information storage devices (electric or electronic); interfaces for computers; computer memory devices.
Class 42: Engineering consultancy services; engineering project management services; software as a service; design and development of software for management of engineering information and data; provision and hosting of software for management of engineering information and data;	Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer system design.

hosting of databases; electronic storage services for cataloguing engineering data.	
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21) The applicant accepts that its “design and development of software for management of engineering information and data” is identical to the opponent’s “design and development of computer hardware and software”. But it denies any of the other services are similar pointing out that its services relate to the engineering field and that the opponent’s claim that this is linked to technological services “is not enough for a finding of similarity given how vast the technology field is”. I disagree as the term “scientific and technological” in the opponent’s specification is not limited in any way. To my mind, the terms “Engineering consultancy services; engineering project management services” included in the applicant’s specification must be encompassed by the term “Scientific and technological services” within the opponent’s specification as engineering services must be regarded as scientific and technical. Lastly, I believe that the terms “software as a service; provision and hosting of software for management of engineering information and data; hosting of databases; electronic storage services for cataloguing engineering data” would be encompassed by the terms “Scientific and technological services; design and development of computer hardware and software” which encompass a vast array of services. **In conclusion I find that the class 42 services of the two parties are identical.**

Comparison of trade marks

22) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

23) It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponents' trade mark	Applicant's trade mark
KIT	KIT360

24) The applicant claims that its mark will not be split into its two parts "KIT" and "360" but does not state why it holds this belief. It points out that the word "kit" lacks distinctiveness for the goods and services of the opponent. It contends that the mark is of weak distinctive character. It points to the evidence it filed on this subject. It further contends that as the marks are short, differences are more easily perceived and given the average consumer being a specialist bringing a higher degree of attention the difference will be immediately noticed. It denies that the "360" element is laudatory and that the combination in its mark has no meaning for the services applied for by the applicant.

25) It is accepted that the marks share an identical start, with the entirety of the opponent's mark forming the first part of the applicant's mark. I do not accept that, in respect of the services of the two parties in class 42, that the word "KIT" has a particular meaning. Whilst both parties may design systems which require equipment or "kit" in order for them to function the service provider would not, necessarily, also provide said kit as part of its services. I also disagree with the applicant in its contention regarding whether the mark will be seen as two parts. To my mind, it is obviously two separate parts, despite being conjoined. The word "kit" is a standard well known English word and the combination of the two parts "kit" and "360" do not conspire to alter the perceived meaning of the first part. I believe that the "360" element will be seen as qualifying the first part in so far as it suggests that the "kit" will be all encompassing or comprehensive. **Visually, aurally and conceptually the marks are highly similar.**

Distinctive character of the earlier trade mark

26) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from

those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, 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 *Windsurfing Chiemsee*, paragraph 51).”

27) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

28) The opponent's mark consists of the well-known word KIT. Whilst in respect of its goods in class 9 it could be seen as descriptive this is not the case in respect of the class 42 services as these would not encompass the provision of equipment. **The mark is inherently distinctive to a medium degree. The opponent has not shown use of its mark and so it cannot benefit from enhanced distinctiveness.**

Likelihood of confusion

29) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the services is a business who will select the services by predominantly visual means, although not discounting aural considerations and that the degree of care and attention they pay will vary depending upon the cost of said services but they are likely to pay a medium to high degree of attention to the selection of such services.
- the marks of the two parties are similar to a high degree.
- the opponent's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the services of the applicant are identical to the opponent's services.

30) In view of the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the services applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in full.**

CONCLUSION

31) The opposition in relation to all the services applied for has been successful.

COSTS

32) As the opponent has been successful it is entitled to a contribution towards its costs. The opponent represented itself and completed the Registry's assessment form. It stated that it incurred expenses of £100 in filing the opposition and spent 19 hours dealing with the issues in the case. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley Q.C. sitting as the Appointed Person on appeal, observed that:

“It is correct to point out that the Registrar's practice on costs does not specifically relate to litigants in person but in my judgement it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR [Civil Procedure Rules]. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6 – (1) This rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

33) Parties which represent themselves are reimbursed at a rate of £18 per hour. In the instant case this provides a figure of £342 to which must be added the £100 cost of bringing the opposition. This is well within the restriction mentioned above.

34) I order Datum 360 Limited to pay KIT Electronics Limited the sum of £442. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of April 2017

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