

O-290-14

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS
IN THE MATTER OF TRADE MARK APPLICATION 2624099
BY iROSTRUM
TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS IN
CLASSES 9, 35, 42 & 45:**

**iRostrum
&
i-Rostrum**

AND

OPPOSITIONS 103991 & 104178 BY ROSTRVM SOLUTIONS LIMITED

The background and the pleadings

1) The series of two trade marks the subject of this dispute were filed by i-Rostrum (the “applicant”) on 11 June 2012 and published in the Trade Marks Journal on 27 July 2012. The series of marks are: **iRostrum & i-Rostrum**. Following publication, but before the opposition was filed, the goods and services for which registration is sought were limited to:

Class 9: Computer software providing online auction platforms with support tools for the administration of online auctions.

Class 35: Online Auctions.

Class 42: Computer software services for the development and customisation of online auction platforms and online auction administrative tools.

Class 45: Licensing of computer software providing online auction platforms with support tools for the administration of online auctions.

2) The registration of the applicant’s mark is opposed by Rostrvm Solutions Limited (the “opponent”). It filed two oppositions, one based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying on UK registration 1554081, the other based on a well-known mark under section 56(1) of the Act, the claim being that there is a likelihood of confusion with its well-known mark **ROSTRVM**; this represents another claim under section 5(2)(b). The second opposition was also pleaded under rule 25(2) of the Trade Marks Rules 2008 on the basis that the amendment to the applicant’s specification (as described above) conflicts with the opponent’s “use and reputation”. The pleading under rule 25(2) was misconceived as it contained no inherent objection to the specification amendment itself. The opponent was advised of this by the tribunal, following which it decided to delete the claim. The details of UK registration 1554081 are as follows:

ROSTRVM

Computers, computer programs; computer software; computer apparatus and instruments; software for telecommunications; data processing apparatus and instruments; parts and fittings for all the aforesaid goods; all included in Class 9.

Filed on 18 November 1993 and completed its registration process on 18 November 1994.

3) Given the filing date of the opponent’s mark, it constitutes an earlier mark as defined by section 6 of the Act. The earlier mark completed its registration

process more than five years prior to the publication of the applicant's mark, the consequence of which is that the proof of use provisions set out in section 6A of the Act are applicable. The opponent made a statement of use that its mark has been used in respect of all of the goods for which it is registered.

4) The claimed well-known mark is for the word **Rostrvm**. In addition to the UK, the opponent claims to have used it in Turkey, Ireland, Sweden, Holland, Germany, France and Belgium in relation to computer products and associated services.

5) The applicant filed counterstatements denying the claims. It put the opponent to proof of use. The two sets of proceedings were consolidated. Both sides filed evidence and written submissions. The matter was heard before me on 13 May 2014 at which the applicant was represented by Mr Chris Hall, of counsel, instructed by Stobbs; the opponent was represented by Ms Ashton Chantrielle, also of counsel, instructed by Chancery Trade Marks.

The evidence

Witness statement of Simon Richard Wellings dated 16 September 2013

6) Mr Wellings is the opponent's managing director. He explains that the opponent "designs, develops, sells and supports software applications for the call centre and back office process management and reporting markets". The business started in 1986 as a division of Intercom Data Services, but trading under the name of Rostrvm. Since 2002, following a management buy-out, it has operated as a limited company. Customers have included Aston Villa Football Club, Brookson, Affinion, Autonet Insurance, Vodafone, Axa Plc, Aviva Plc, Cambridge University Press, EDF Energy and Nottingham County Council. All these customers have been sold the "Rostrvm suite" with the mark prominently displayed on packaging, correspondence, license documents etc. Various invoices and other materials are provided which shown ROSTRVM in use. The invoices are for software products or professional services (e.g. installation and training, presumably relating to the software).

7) It is stated that in 1993 various Rostrvm products were launched including Rostrvm CallManager, Rostrvm Call Director, Rostrvm AdVisor and Rostrvm SuperVisor. A number of customers who took the products in 1993 are identified. It is in this year that the opponent's earlier mark was filed. It is stated that the mark has been used for all of its goods during the proof of use period. It is stated that the opponent has sold software modules and support systems under the mark. Exhibit SW03 is said to support all of this. It consists of various web prints and case studies. A list of UK towns and cities where the goods have been sold is provided in Exhibit SW04, copies of advertisements in Exhibit SW5, and a print of a sample online promotional campaign in Exhibit SW06. Various conferences have been attended and are detailed. Website statistics are provided. For

example, in 2010 the website received 20,590 visitors. Two Google search reports are provided, one for Rostrvm and one for i-Rostrum which Mr Wellings believes shows the closeness of the marks.

8) Mr Wellings' evidence runs to 69 pages with all his exhibits. I do not consider it necessary to go into the evidence in more detail at this stage, not least because at the hearing it was accepted by Mr Hall that genuine use had been established, albeit, in his view, only in relation to a subset of computer software. I will therefore come back to the evidence when dealing with this point and any other issues that may arise.

Witness statement of Sally Ann Shupke dated 28 June 2013

9) Ms Shupke works for Chancery Trade Marks, the opponent's representatives in this matter. She gives some submissions which I bear in mind but will not summarise here. She gives some of the same information as Mr Wellings. Her evidence also includes a number of case studies about the use of Rostrvm by certain of the opponent's clients. Again, for the reasons given above, I will not detail this further here.

Witness statement of Claire Sugden dated 30 January 2014

10) Ms Sugden works for Stobbs, the applicant's representatives in this matter. She provides four exhibits which include a flyer, web prints and case studies relating to the applicant's i-Rostrum mark. None can be placed before the relevant date. No evidence is given about the scale of use. The most one can take from the evidence is as an indication of the nature of the goods provided. Put simply, i-Rostrum is an online auction platform that auction houses can procure to run online auctions. Related software is also provided. One of the key features is that the branding of the auction house itself is still the most visible sign when the product is being used, although, it is "powered by i-Rostrum".

Second witness statement of Mr Wellings dated 18 March 2014

11) In his second witness statement, Mr Wellings provides further detail about the use made of the earlier mark. The evidence stems from a number of criticisms made in the applicant's submissions. For the reasons already given, I will not detail all of this here. I note that in response to the criticism that the opponent sells only "software applications for the call centre and back office process management and reporting", Mr Wellings responds:

"This is incorrect as our business relates also to the provision of software applications together with all of the goods for which the trade mark is registered. The goods of the trade mark application fall in, at least, "computer software" and "computer programs" together with the

supporting services of advice, consultancy, assistance with installation of the software and associated IT support.”

The section 5(2)(b) opposition on the basis of UK registration 1554081

12) Both oppositions are founded on section 5(2)(b) of the Act, but I will start with the one based on earlier mark 1554081. This mark is subject to the proof of use provisions set out in section 6A of the Act.

The proof of use provisions

13) The use conditions are set out in Section 6A of the Act as follows:

“(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered [.....]”

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [.....]

(5) “In relation to a Community trade mark [.....], any reference in subsection (3) [.....] to the United Kingdom shall be construed as a reference to the European Community”.

14) Section 100 is also relevant; it reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and *Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-

2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is

appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

16) The relevant period in which the earlier mark must have been genuinely used is 28 July 2007 to 27 July 2012. However, as I have already stated, the applicant now accepts that the earlier mark has been put to genuine use in the relevant period, but disputes that it has been put to genuine use in relation to all of the goods for which it is registered. I must therefore decide on what goods, as a matter of fact, the earlier mark has been used in relation to, and then decide upon a fair specification that reflects such use. Of course, it is not possible to go wider than the goods for which the mark is registered. Consequently, the claimed use in relation to “associated services” is not relevant because the earlier mark is not registered for those services. In relation to a fair specification, I must be mindful that the resulting specification should not be pernickety¹ and it is necessary to consider how the relevant public is likely to describe the goods². The General Court (“GC”) in *Reckitt Benckiser (España), SL v OHIM* Case T-126/03 held:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in

¹ See *Animal Trade Mark* [2004] FSR 19.

² See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.

that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

17) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods concerned."

18) The earlier mark is registered for:

Computers, computer programs; computer software; computer apparatus and instruments; software for telecommunications; data processing apparatus and instruments; parts and fittings for all the aforesaid goods; all included in Class 9.

19) It is clear from the evidence that what the opponent provides under its mark are computer programmes/software products for particular purposes. There is no use in relation to hardware of any sort. The software is in a particular field. It is for use in a call/contact centre environment. The primary roles of the suite of programs in relation to which the mark is used is for handling inbound and outbound calls, providing scripts for operators, providing statistical reports etc. However, Ms Chantrielle was keen to stress that the mark is also used for certain back-office functions. One example that was highlighted to me was in Exhibit SW06 (page 65 of 69) of Mr Wellings' evidence. This is a print from the opponent's website which carries the text "Simplifying your existing call centre and back office processes so that they play well together". Four icons with

accompanying text are set out at the bottom of the page: Inbound contact, outbound contact, desktop optimization and managing performance. In relation to desktop optimization, the accompanying text reads “our tools for call centre agents and back office teams support business processes and cleanup messy desktops”. I also note from the same page of this exhibit a further print which contains the text “our contact management software brings together call centre technology and back office IT resources...”. This quote demonstrates that despite the software bringing together call centre technology and back office IT resources, the opponents stills calls it “contact management” software. This seems to me to reflect the commercial reality of the situation. Any back-office functionality is not sold as a standalone product that could be used by a business outside of the call/contact centre environment. The software is call/contact management software with some added functionality. That is what the mark has been used in relation to.

20) In terms of a fair specification, Ms Chantrielle’s primary submission was that the opponent ought to be able to retain the specification (in so far as programs and software is concerned) without limitation of any sort. I reject this submission. This would be far too broad a specification to reflect the use made. This is a clear case where appropriate sub-categorization is appropriate. This point was pressed strongly by Mr Hall, who relied on the decision of Floyd J in *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] EWHC 35 (Ch):

“39 The unrestricted specification is of enormously wide scope. The Hearing Officer wisely reminded himself of what Laddie J. had said about wide specifications for computer software in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] F.S.R. 850 . Laddie J. considered that:

“... there is a strong argument that a registration of a mark simply for ‘computer software’ will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls the computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism

applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

40 That was a case decided under the Trade Marks Act 1938 , but, like Laddie J., I see no reason why the views there stated should not apply under the Act.

41 The Hearing Officer, having concluded at para.20 of his decision that “ *the only goods for which use has been shown is computer software for travel and accommodation reservations* ”, added that:

“... the software is used in a clearly defined and specific field. A field in which there is clearly a category of specific software targeted at a specific market”

42 Mr Malynicz challenges those findings. He took me on a tour of three of the items of software marketed by GI: Focalpoint, Viewpoint and Viewpoint Maps. The purpose of doing so was to show me that the functionality of the software extended beyond travel and accommodation reservations.

43 As to some of this “extra” functionality, I was not satisfied that the wording chosen by the Hearing Officer did in fact exclude it. For example Mr Malynicz submitted that the booking of car hire would be outside the restricted specification. He also submitted that booking coach tours would not be covered. These were not good points. In context, booking of car hire and tours would be within the definition “travel reservation”. Other aspects of the extra functionality are less controversial. For example he drew my attention to the existence of calendars, scratch pads, document management software and calculators which were made available as part of the complete package. However there was no evidence before the Hearing Officer that any of this extra functionality was sold or offered for sale independently of the core travel and accommodation reservation system.

44 The EU submitted that each of the elements of extra functionality was part of a system for travel and accommodation reservations, and was therefore covered by the Hearing Officer’s restrictions. They also made various criticisms of the documents relied upon by GI, as being either outside the relevant period or not strictly tied to the United Kingdom.

45 In *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2002] EWCA Civ 1828; [2003] R.P.C. 32 , Aldous L.J. described the task of the court in setting the correct specification of goods in the following way:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2) adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement to be applied by the court has adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that the proprietor has made of his mark. Thus the court should inform itself of the nature of the trade and then decide how the notional consumer would describe such use.”

46 In *H Young (Operations) Ltd v Medici Ltd (Animal Trade Mark)* [2003] EWHC 1589 (Ch); [2004] F.S.R. 19, Jacob J. (as he then was) explained why public perception was relevant:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been used for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) ‘three-holed razor blades imported from Venezuela’ is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say ‘razor blades’ or just ‘razors’. Thus the ‘fair description’ is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (‘the umbra’) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (‘the penumbra’). A lot depends on the nature of the goods -- of a specialist or are they more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgement as to the appropriate specification having regard to the use which has been made.”

47 It is clear from reading the Hearing Officer’s decision as a whole that he was aware that not every aspect of the Galileo system was exclusively

directed to the actual process of making travel and accommodation reservations. For example he was aware of Viewpoint Maps. It seems to me that the core question on which he had to decide was whether “computer software for travel and accommodation reservations” was a fair description of the use which the proprietor had proved, notwithstanding that aspects of the functionality of the software package could be used for tasks which were not themselves the making of reservations. The making of reservations was undoubtedly the core function of everything which the proprietor sold. All the extra functionality was ancillary to that purpose.

48 It is true that in a technical sense one could say that GI was selling software for calendars and for document management. But the Hearing Officer was entitled to come to the conclusion that this is not how the average consumer would have perceived the use. He was plainly entitled to come to the conclusion that this description “reflects the circumstances of the particular trade and the way that the public would perceive the use”. Nor is there anything “pernickety”, nor any element of “Venezuelan razor blades” about such a restriction. The average consumer does not see the sale of a car as a sale of climate control systems or computers or satellite navigation systems, although cars are now often sold with such built-in functionality. These are plainly questions on which different Hearing Officers or different judges may arrive at different views. I am wholly unpersuaded that the Hearing Officer erred by not extending the specification to cover expressly the extra functionality relied on by GI. The limitation which the Hearing Officer arrived at was, in my judgment, clearly a value judgment which he was entitled to reach.”

21) The relevant public would not describe the use made as being in relation to computer software generally, so some form of further qualification is needed. On this, Ms Chantrielle argued that a fair specification should reflect both the call/contact centre functionality and, also, as a separate term, the back-office management functionality. Mr Hall argued that a fair specification should be centered upon the call centre functionality as this the core of what the opponent does.

22) I am closer to the position of Mr Hall than that of Ms Chantrielle. As I have already said, the back-office functionality is simply an add-on to the call centre software. Such use is not really creating or establishing a market in relation to back-office software. The relevant public would not characterise the use made without referring to the call centre aspect. The goods should be limited accordingly, although, I will permit a reference to the back-office functionality, but only as part of the call centre software. I consider the following to represent a fair specification of the use made:

Call/contact centre management computer programs and software, including call/contact centre management computer programs with back-office management functionality; all included in Class 9.

Likelihood of confusion – legislation and case law

23) Section 5(2)(b) of the Act states that:

“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) The CJEU has issued a number of judgments which provide guiding principles relevant to this ground. 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 cases¹:

"(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."

The average consumer

25) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can, of course, vary depending on what is involved.

26) Both sides goods cover computer software for use in particular fields, but in both cases the fields are ones where the average consumer will be in the business world. The goods are likely to represent an important choice and do not strike me as something that will be purchased on a regular basis. I consider a good deal of care and consideration will go into the purchasing process. The same applies to the services for which the applicant seeks registration. The goods and services will be the subject of perusal via websites, brochures etc so the visual aspects of the marks are important. I do not, however, ignore the aural aspects completely as the marks may be referred to over the telephone for example.

Comparison of the marks

27) 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:

Applicant's marks	Opponent's mark
iRostrum & i-Rostrum	ROSTRVM

28) The opponent's mark has only one element to consider, the word ROSTRVM. In relation to the applicant's mark(s), this will be seen as a combination of the letter I and the word ROSTRUM. The letter I is commonly used in relation to goods and services with some form of Internet capacity, so I think it clear that the dominant part of the applicant's mark(s) will be the ROSTRUM element. I will, though, continue to bear in mind the whole mark comparison that must be made.

29) From a conceptual perspective, I-Rostrum/iRostrum will be perceived as the known English word ROSTRUM preceded by the letter I. Rostrum is a word that has some allusive meaning in relation to the goods and services of the mark because an auctioneer stands behind a rostrum when an auction is taking place. In relation to ROSTRVM, this word, as a matter of fact, has no meaning, or at least none which has been presented to the tribunal. Average consumers will often approximate a word to something that they know. However, in relation to the goods for which the earlier mark is to be considered (call/contact centre software) I do not consider that many will make such an approximation (to the word ROSTRUM); this, therefore, creates a conceptual difference. Mr Hall accepted that some average consumers may make an approximation (which I consider to mean that the concepts are highly similar), however, this, as I have said, would not be the majority view. I reject Mr Hall's further submission that a conceptual difference is created by the "cool" impact of the applicant's mark against the "antiquated" impact of ROSTRVM; this is too analytical an approach for the average consumer to adopt.

30) From a visual perspective, the marks are of similar (although not identical) length, and they share the letters R-O-S-T-R-M at the end. This sequence of common letters is broken with the penultimate letter, but as Ms Chantrielle submitted, the letters V and U look quite similar to each other. There is of course the additional letter I at the beginning of the applied for mark(s) which must be borne in mind. Nevertheless, I consider the marks to be visually highly similar.

31) From an aural perspective, the applicant's mark(s) will be articulated as EYE-ROST-RUM or EYE-ROS-TRUM. The opponent's mark is a difficult one to articulate because of the unusual construction of RVM at the end of the mark. However, because it is constructed as a word, I think the average consumer will give it a go. They are likely to give the mark a Scandinavian/East European articulation, some something like ROST-VRHUM or ROS-VRHUM – variations on a theme are also likely. It is also possible that some average consumers will approximate it to the word ROSTRUM and will therefore pronounce it in that way. Despite there being three syllables rather than two, I still consider the applicant's mark to be aurally similar to a high degree.

The distinctiveness of the earlier mark

32) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). As a made up word the earlier mark is highly distinctive from an inherent perspective. Even for average consumers who approximate the word to ROSTRUM, the mark is still reasonably high in distinctiveness as there is no allusive or suggestive relationship between this word and the goods for which the mark is to be considered and, furthermore, the misspelling adds further distinctive character.

33) The mark has also been used. However, whilst the use has been fairly longstanding, and whilst the case studies provided demonstrates that the opponent has some high profile clients, no advertising or turnover figures have been provided for the tribunal to gauge the significance of its use in the relevant market. Consequently, I do not consider it appropriate to hold that the mark's distinctive character has been materially enhanced from its already reasonably high level.

Comparison of goods/services

34) When making the comparison, all relevant factors relating to the goods/services in the 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.”

35) 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.”

36) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v 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 (PiraNAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

37) In relation to complementarity, I also bear in mind the 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 to rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted.

It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

38) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”³ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁴. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

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

39) Looking firstly in class 9, the applicant seeks registration for:

Computer software providing online auction platforms with support tools for the administration of online auctions.

40) The opponent’s mark is to be considered in respect of:

Call/contact centre management computer programs and software, including call/contact centre management computer programs with back-office management functionality; all included in Class 9.

³ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁴ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

41) There is a point of similarity in that both sides goods are software products. However, I agree with Mr Hall that this is where the similarity ends. The fields in which the goods operate are completely different. The purpose of the goods is completely different. The users of the goods are completely different. The methods of use, beyond the fact that they are used on a computer, are going to be different. The goods do not compete. The goods are not complementary. I note that the applicant's goods include "support tools for the administration of online auctions" and that the opponent's goods include "back-office management functionality", but both are tied to the core function of auction platforms on the one hand against call/contact centres on the other. I come to the view that any aspects of similarity are so superficial that the goods ought to be considered dissimilar. Even if I am wrong on that then the level of similarity between them must be wafer thin.

42) This finding is extended to the applied for services in classes 42 and 45 which contains the same restriction to the auction environment. In class 35 the applied for services are auction services. I struggle to see how one could even claim similarity in relation to this; Ms Chantrielle came up with little to persuade me otherwise. The services are not similar to the goods of the earlier mark.

Likelihood of confusion

43) 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.

44) The CJEU has stated that there can be no finding of a likelihood of confusion if the goods/services in question are not similar. See, for example, *Waterford Wedgwood plc v OHIM Case C-398/07*. My finding that the goods/services are not similar therefore means that this ground of opposition must fail. However, even if there is some similarity (my fall-back in relation to the applicant's goods and services in classes 9, 42 and 45 was that any similarity was wafer thin) then there would not, in my view, be a likelihood of confusion. Although a greater degree of similarity between the marks may off-set lesser degrees of similarity between the goods and services, in this case the degree of goods/service similarity is so low that this will not be operative. This is particularly so bearing in mind the more considered nature of the purchasing process and the fact that the applied for mark is in a field where the mark is suggestive; the net effect of all this is that the similarity between the marks will be put down to co-incidence and not economic connection. I would come to this view even if ROSTRVM were to be articulated as ROSTRUM. **There is no likelihood of confusion**

The section 5(2)(b) opposition based on a well-known mark claim

45) I will deal with this ground briefly. This is because there are a number of reasons why the claim must fail, as follows:

- i) It is difficult to see how this claim really takes the opponent any further forward. Ms Chantrielle referred to the associated services the opponent provided (no services are covered by the earlier mark), but these have the same call/contact centre basis as the goods of the earlier mark so the answer as to whether there exists a likelihood of confusion would be the same.
- ii) The evidence falls well short of establishing that the mark is well-known, analogous with my finding in relation to the distinctive character of the earlier mark.
- iii) A well-known mark must be a mark in a convention country, which is defined by the Act as excluding the UK. The only use provided is in the UK so it cannot be said to be a well known mark as defined by the Act.

46) Despite some of these reservations being put to Ms Chantrielle, she still pursued the claim. For the reasons given, the claim fails.

Costs

47) The applicant has been successful and is entitled to a contribution towards its costs. The award I make below, whilst still on the published scale, is at the higher end of the scale because the opponent filed two oppositions when only one was necessary and the second of those contained one misconceived ground and one ground that was unsubstantiated and flawed, but which was still pursued at the hearing. The applicant would have incurred additional costs in dealing with these matters, including the additional costs in having to file to separate counterstatements. My assessment of costs is as follows:

Preparing statements and considering the other side's statements
£450 x 2 = £900

Filing and considering evidence
£1100

Preparing for and attending the hearing
£800

Total
£2800

48) I hereby order Rostrvm Solutions Limited to pay I-Rostrum the above sum within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of July 2014

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *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).