

O-298-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS

2505873 AND 2505907

BY

GENEE WORLD LTD

TO REGISTER THE TRADE MARKS:

Genee Power Board

AND

Genee Slate

IN CLASS 9

AND

THE CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS 99048 AND 99046

BY

VIGLEN LIMITED

Trade Marks Act 1994

**In the matter of application nos 2505873 and 2505907
by Genee World Ltd
to register the trade marks:
Genee Power Board
and
Genee Slate
in class 9
and the consolidated oppositions thereto
under nos 99048 and 99046
by Viglen Limited**

1) On 7 January 2009 Genee World Ltd (World) made applications for the registration of the trade marks **Genee Power Board** and **Genee Slate**. Both applications were published, for opposition purposes, in the *Trade Marks Journal* on 6 February 2009. Subsequent to publication the specifications have been amended. The specification for Genee Power Board is now:

interactive whiteboards, none being computers, computer hardware or data processing equipment.

The specification for Genee Slate is now:

graphic tablets, none being computers, computer hardware or data processing equipment.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 6 May 2009 Viglen Limited (Viglen) filed notices of opposition against the registration of the two trade marks. Viglen bases its opposition on section 5(2)(b) of the Trade Marks Act 1994 (the Act). According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Viglen relies upon Community trade mark registration no 111013 of the trade mark **GENIE**. The application for the registration of the trade mark was made on 1 April 1996 and the registration process was completed on 4 May 1999. As the trade mark had been registered for more than five years at the date of the

publication of World's applications it is subject to proof of useⁱ. The trade mark is registered for the following goods:

computers.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Viglen claims that the goods of its registration and those of the applications of World are similar and that its trade mark and those of World are similar. Consequently there is a likelihood of confusion. Viglen claims to have used its trade mark on all of the goods for which it is registered in the five year period ending on the date of the publication of the applications, 6 February 2009.

4) World filed counterstatements. It requires Viglen to prove use of its earlier trade mark. It denies that its trade marks and that of Viglen are similar and also denies that the goods of its application are similar to those of Viglen's registration.

5) Both sides filed evidence.

6) A hearing was held on 9 August 2010. Viglen was represented by Mr James Setchell of Trade Mark Consultants Co. World was represented by Mr Eugene Pienaar of Revomark.

EVIDENCE

Evidence of Viglen

First witness statement of Mr Michael Edward Ray

7) Mr Ray is the finance director of Viglen. He states that Viglen specialises in the manufacture, sale and distribution of IT equipment and "ICT solutions" to schools, higher education establishments, public sector bodies, healthcare and emergency services. Mr Ray states the GENIE range of computers is the most important and profitable brand owned by Viglen.

8) Mr Ray states that the GENIE brand is continuously promoted within all of the catalogues and brochures of Viglen, as well as on its website.

9) Exhibited at MER1 are copies of catalogues for August 2008, October 2008 and March 2009 (the last outside the material period). The catalogues bear the title *Viglen Systems Catalogue*. Included in the catalogues is the GENIE range of personal computer packages. GENIE appears in both a stylised and non-stylised form. Included in the GENIE range, as shown in the catalogues

emanating from prior to the material date, are the GENIE Executive, the GENIE Ultra Small, the GENIE Pro and the GENIE Pro2.

10) Exhibited at MER2 are pages downloaded from viglen.co.uk on 16 December 2009 (outside the material period). The description of the GENIE Ultra range in the printouts advises that it is “a versatile PC to match the demands of modern classroom and admin computing”.

11) Mr Ray states that the approximate turnover under the GENIE brand during the period from January 2004 to November 2009 is as given in the table below.

Financial year (Sept – Sept)	Turnover £
2004	10,200,000
2005	13,700,000
2006	15,400,000
2007	18,000,000
2008	18,000,000
2009	21,900,000

The number of computers sold under the brand GENIE during the above period amounted to over 210,000 units.

12) Mr Ray states that at MER3 there are copies of invoices showing actual sales of computers under the GENIE name dating from February 2007 to date. Included in the exhibit are invoices from 7 May 2009 and 3 September 2009, so outside the material period, to Queen’s University Belfast and the University of Nottingham respectively. An invoice to Bristol University, dated 7 February 2007, is headed, under product/description, GENIES2, it is for £708.49 (excluding VAT). An invoice to Brunel University, dated 20 June 2007, is headed, under product/description, GENIES2, it is for £1,215 (excluding VAT). An invoice to Herefordshire Council IT Services, dated 5 October 2007, is headed, under product/description, GENIES2, it is for £614.92 (excluding VAT). An invoice to Cardiff University, dated 5 February 2008, is headed, under product/description, GENIES2, it is for £4,090 (excluding VAT). An invoice to Bristol University, dated 2 July 2008, is headed, under product/description, GENIES2, it is for £558.86 (excluding VAT). An invoice to ULT Projects Ltd, dated 2 October 2008, is headed, under product/description, GENIES2, it is for £49,293 (excluding VAT). An invoice to the University of Durham, dated 14 January 2009, is headed, under product/description, GENIES2, it is for £3,343.55 (excluding VAT). All of the invoices are on Viglen headed paper.

13) Exhibited at MER4 and MER5 are pages downloaded from the Internet on 16 December 2009:

- From bizwaremagic.com are pages related to HP Compaq Tablet PC. The contents include the following: “The HP Compaq Tablet PC TC 1100 is a very versatile little machine. It’s not really a true slate or a convertible – for it has a detachable keyboard. This is a big plus, if you want a convenient handy 3 pound slate to carry around for note taking, etc....Works perfectly as a slate, with a chunky comfortable pen...is a great slate pc”.
- From ruggedpcreview.com are pages headed *Rugged Slates*. The contents include the following: “Slate computers are full-function Windows machines without a keyboard. The entire computer is built into a slate-like enclosure that is as thin and handy as possible. Since they don’t have a physical keyboard, slates use passive or active pens for input.....Slate computers may use a passive digitizer that can be operated with a stylus or even a finger”.
- From venturebeat.com are pages relating to the HP DreamScreen tablet computer. The contents include the following: “These screens are hybrids of slate computers and digital photo displays.....They’re not full-fledged computers that run Microsoft’s Windows software...” The contents appear to emanate from the United States of America, the price of the product being quoted in dollars.
- From support.dell.com are pages relating to removing and replacing the power board of a Dell computer.
- From computerhope.com are pages dealing with the causes and cures for a computer having no power or not turning on. Included in the reasons for this occurrence is “Bad power supply, power button, and/or power board or inverter”.
- From skycomp.com (an Australian website) are pages giving the price of an Upsonic 750VA UPS with 5 Port Power Board.

14) Mr Ray states that Viglen specialises in the schools and educational IT solutions business and World operates in the same sector. He states that the goods of Viglen and those of World are sold through the same channels of trade and are likely to be sold as a full “ICT solution” and package to customers. Exhibited at MER6 are pages downloaded from the websites of Stone Computers of Staffordshire and RM Computers of Oxfordshire on 15 December 2009. Some of the pages from Stone are headed computers and computer equipment. In a box at page 77 interactive whiteboards are shown as being part of AV equipment, this box appears to be a part of a more general accessories and peripherals category. The other main categories are desktop computers, infrastructure solutions and laptop computers. A part of the Stone business is Compusys Advanced Systems, which provides AV solutions.

15) The online shop for RM categorises its products into the following: projectors and whiteboards, printers and scanners, software, PCs and notebooks and accessories. Interactive whiteboard pages are included in the exhibit, these pages come from the section for projectors and whiteboards. Also included in

the exhibit is a section from the website devoted to whiteboard alternatives, also from the projectors and whiteboards section. Included amongst these alternatives are the RM ClassPad RF+ and the Smart AirLiner, which are promoted as allowing the user to walk, talk and teach. A page devoted to the RM ClassPad RF+ is included in the exhibit, this refers to the availability of a spare USB dongle for use with the apparatus.

16) Viglen previously opposed the registration of the trade mark GENE WORLD in the United Kingdom. The application was subsequently withdrawn. Mr Ray exhibits a copy of the preliminary indication in relation to opposition no 96125. Subsequent to the withdrawal of the application Viglen obtained an award of costs against World. No cognisance can be taken of a preliminary indicationⁱⁱ.

17) Mr Ray states that World has been aware of Viglen's objection to the former's name GENE for a number of years, however, World continues to file trade mark applications which are clearly similar for similar/identical goods in class 9.

Evidence of World

Witness statement of Mr Ranjit Singh

18) Mr Singh has been the CEO of World since its incorporation on 28 September 2005.

19) Mr Singh states that World specialises in the manufacture, sale and distribution of presentation equipment and not computers or data processing equipment. He states that this equipment is distributed, inter alia, to corporations, training companies, schools and colleges. Exhibited at RS1 is World's product catalogue for 2010. The mission of World, according to the catalogue, is:

“Make our products interoperable with other ICT products. Be easy to operate so enabling the user to harness the huge benefits that can be gained from their use. Provide IT solutions that are suitable for the customer's specific requirements.”

20) The focus of World is:

“to strive to lead in the invention, development and manufacture of the industry's most elevate information technologies, including hardware such as Interactive Whiteboards, Digital Visualisers, Interactive Response Systems and a full range of Audio Visual products.”

21) Page 27 of the catalogue is devoted to the Genee Powerboard. This is described as a whiteboard. To use the product “[s]imply touch the Genee Power Board with the Genee pen and run all computer functions, such as opening files,

running digital video clips, or downloading free content from the Internet from the front of the class so there is need to return to your computer and lose the students' attention". At the bottom of the page the potential customer is advised that the product works with the Genee Slate, digital visualiser, speakers, projector and computer. The technical specification advises that the product has a USB port and that its software drivers are Windows 2000/XP.

22) Page 36 of the catalogue is devoted to the Genee Slate. The product wirelessly interacts with a whiteboard, PC or visualiser. Free software is included with the product, this software provides a library of clip art with over 2,000 images. The explanation of the product advises that up to 50 of the products can link to a PC or laptop.

23) Other products in the catalogue are the GENE VISION (a desktop visualiser), the GENE SCOPE (a portable digital microscope), the GENE PAD (an audience response system), IQ-PAD (an audience response system), PEBBLE (an audience response system), CLASS COMM (audience response software), CENSUS (audience response software), GENE PRO DIGITAL+ interactive whiteboard, WALL TALK (digital signage), SONICSHOCK 4 (a security alarm), GENE MULTILOCK (a security cable), GENE TOOLBAR (a presentation product) and GENE CLASSSCREEN (a combination of an LCD monitor and an interactive drawing tablet).

24) Mr Singh states that World has spent £702,000 promoting and advertising its products since September 2005. Market research was conducted for World by Futuresource in 2008. Mr Singh states that one of World's products, GENE VISION, had a market share of 43.1% in 2008, the largest market share in the industry. Exhibited at RS2 is a copy of the Futuresource report. The report is dated July 2009. It is entitled *Interactive Displays/ICT Products Market Snapshot on the Visualiser Market in the UK and Europe*. The report states that 11,000 visualisers were sold in the United Kingdom in 2008 and that 1 in 30 school classrooms have a visualiser. GENE VISION is described as the brand leader with 43.1% volume share. The price of visualisers ranges from £311 to £1,846; 62% of visualisers cost from £501 to £1,000.

25) Exhibited are RS3 are copies of World's promotional and marketing material. Page 61 shows, inter alia, the Genee Slate. The page is annotated May 2006 by hand (this particular promotional material includes a competition for predicting the results of England football matches in the 2006 World Cup in Germany). Page 71 shows the Genee Slate, the page is annotated October 2005 by hand. At pages 74 et seq are what appear to be hardcopies of slides for a presentation. The pages are headed *Product Presentation 2006/7*. On page 75 the following appears:

"The Company was set up to provide exciting, innovative and easy to use software, hardware and A.V. equipment that seamlessly integrates with

other solutions in both the classroom, presentation room and conference rooms.”

The presentation does not make reference to Genee Slate or Genee Power Board.

26) A CD ROM of promotional explanations of World’s products is included in the exhibit. The presentations cover CENSUS, CLASS COM, GENE E PAD, Genee Slate and GENE E VISION. The presentation in relation to Genee Slate simply refers to a slate. The gentleman explaining the apparatus advises that the user can programme the buttons on the screen as shortcuts to application software. He states that it allows remote control of a laptop and that the pen, with which the slate comes, takes the place of a mouse. He states that it allows the user to work on applications. He states “It comes with other nice software”.

27) Mr Singh states that the GENE E brand of products are the most profitable products of World. Mr Singh gives figures for turnover for GENE E products:

Year	Turnover £
2006	3,144,228.19
2007	3,383,430.65
2008	4,489,137.00
2009	4,338,314.78

Mr Singh states that approximately £1million of this turnover is “directly attributable” to Genee Slate and Genee Power Board.

28) Mr Singh also gives figures for World’s marketing and advertising expenditure:

Year	Advertising £	Exhibition £
2006	60,568.95	203,996.81
2007	28,839.16	135,247.42
2008	70,264.64	56,019.86
2009	67,206.46	80,536.95

29) Mr Singh states that the Genee Slate is a digitizer with no data processing capability. He states that such graphic tablets have been used since the early 1980s by designers and animators. He states that the products do not contain components inside them which can be found in computers. Mr Singh states that the Genee Slate is a device which is used to transfer data/information to a computer. He states that the device has no screen or data processing capability. At RS5 Mr Singh states that a detailed specification of the product is exhibited.

Page 96 consists of a page devoted to the Genee Slate. It can be seen from this exhibit that notes and annotations can be exported into various file formats, that it allows for live annotation over presentations, programs, documents and web pages and that it is available to all Microsoft Office programs, including PowerPoint, Excel and Word. The remaining pages relate to a wireless tablet, there is no mention of Genee or Slate. At page 99 the following appears:

“Wireless tablet is a 2.4G wireless solution table. Without complicated wireless software installation, just install tablet driver and plug our wireless receiver dongle to your PC and you use it freely any where. Moreover, Wireless tablet support Windows Vista™. If you do not want to use these extra hot key, volume adjustment and Macro Key function, you can even do not need to install any driver.”

The purchaser is advised that “Wireless Tablet is a Windows plug and Play device.”

30) Mr Singh states that the Genee Power Board is an interactive whiteboard using infra-red technology. He states that it is based on similar technology to the graphic tablet. Mr Singh states that an interactive whiteboard is a large interactive display/screen that connects to a computer and projector. A projector, he states, projects the computer’s desktop onto the board’s surface. It, therefore, just displays information/images onto a large surface/screen for presentation purposes. Mr Singh states that the product has no data processing capability. Exhibited at RS5 page 104 is a specification of the Genee Powerboard. The page advises that the product works perfectly with speakers, a projector, the Genee Slate, a laptop/PC and visualises. At page 105 there is a specification for various infra-red whiteboards.

31) Mr Singh says that the goods of the applications are “merely presentation tools and equipment”. He states that the target markets for respective goods of Viglen and World are different.

32) Mr Singh states that a power board is a component part of a computer, in relation to whiteboards it is not descriptive. He states that the trade channels that World uses are not similar to those used by Viglen. Mr Singh states that World has 5 main distributors:

- Bretford UK, which he describes as a distributor to the office and education markets. He states that it sells through resellers in both markets. Mr Singh states that products are sold as World products and not as packages. He states that it does not sell computers but products which are complementary “and therefore in keeping” with World products. Exhibited at RS7B pages 110-115 are pages from the Bretford website and pages showing World products being sold by Bretford. Bretford describes itself as a supplier of technology, education, presentation and

audio visual products. The World products shown are neither tablets nor whiteboards.

- Beta Distribution, Mr Singh states that the main activity of this undertaking is the distribution of facsimile transmission and printer machines to the “corporate market”. He states that Beta has no presence in the education market and that it sells via resellers. Exhibited at RS7B pages 117-120 are pages from the website showing World products, including the Genee Slate.
- Imago Group PLC, which is described by Mr Singh as a trade only organisation selling to resellers, mainly in the videoconferencing market. He states that Imago is in the corporate rather than the education market. Exhibited at RS7B page 127 is a page from the Imago website showing a World visualiser. Imago describe World as providing products for teachers, educators, presenters and corporates.
- Orchid Distribution Ltd, which Mr Singh describes as an education and corporate distributor selling World products to resellers in both markets. He states that it can “clearly be seen that the products are not sold as packages but separately”. Exhibited at RS7B pages 122, 124, 131, 134, 136, 137, 139, 142 and 143 are pages from the website of Orchid. Included in the pages is the Genee Slate, which is categorised as a peripheral product.
- Interactive Education Ltd. Exhibited at RS7B pages 123, 126, 128, 129, 132, 140, 144, 145. On pages 140 and 144 the Genee Slate is shown and on page 145 the Genee Powerboard is shown. The side menu of Interactive Education lists inter alia laptops and computers. The Genee Slate is categorised at an ICT accessory. The Genee Power Board is categorised as an interactive whiteboard.

33) Mr Singh, at RS7A, exhibits World’s customer list. He states that World has a vast array of customers in a variety of fields, not just education. Mr Singh states that RM is a customer of World and has sold products such as the GENE VISION. Mr Singh states that the products have been sold separately as presentation equipment and not as part of a package. He states that World has full control over who distributes its products and how they are distributed. He states that they have always been sold separately.

34) Mr Singh states that Viglen is a distributor of one of the products of World, the GENE VISION visualiser. Exhibited at RS8 are copies of 3 invoices from Interactive Education to Viglen. They are dated 11 August 2006, 31 July 2007 and 6 November 2007. They are for, respectively, 6, 16 and 11 GENE VISION 6100 products and for £3,120, £9,488 and £7,700 (ex VAT).

35) Mr Singh exhibits at RS9 a copy of a report produced by MirandaNet in relation to the use of the GENE VISION visualiser in schools. The “aim of the evaluation was to gauge the views of teacher and pupil users of its Genee Vision

Visualiser, and the ways in which it has impacted on their teaching, learning and work practice”.

Second witness statement of Mr Michael Edward Ray

36) Parts of Mr Ray’s witness statement are submission and a critique of the evidence of World, rather than evidence of fact. Consequently, they will not be summarised here. However, the comments are taken into account in reaching a decision in this case.

37) Mr Ray states that Viglen sells its GENIE range of computers within the public, business and personal sectors. He states that in the previous financial year Viglen sold over £10 million worth of stock outside of the educational sector.

38) Exhibited at MER8 are pages from Wikipedia in relation to tablet PCs. At page 7 of the exhibit there is a definition of slate computers, which are described as being tablet PCs without a dedicated keyboard. At page 11 there is a list of popular models of slate PCs. At page 19 et seq of the same exhibit are pages downloaded from plworld.wordpress.com on 13 May 2010 in relation to tablet computers. It is stated that Hewlett Packard is set to release its tablet, the Slate. At page 22 of the same exhibit there is a printout downloaded on 13 May 2010 which shows an HP Compaq tc1100 Tablet PC.

39) In relation to the purchase of World products by Viglen, Mr Ray states that the goods were purchased to satisfy express demands from clients. These were one-off sales and the sales people did not flag these to senior management at the time. He states that Viglen was never and is not a distributor of the goods of World. Mr Ray states that the one-off sales highlight that the goods of World would be sold as part of an overall package to clients including a full computer system and accessories.

Proof of use of earlier trade mark

40) At the hearing Mr Pienaar accepted that Viglen had proved use of its trade mark in respect of computers.

Average consumer, nature of purchasing decision and standard for likelihood of confusion

41) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”ⁱⁱⁱ. Computers, graphic tablets and interactive whiteboards are items of some cost. They are products which require consideration in the purchase in order to ascertain their technical qualities, including in their interaction with other components, whether that be computer peripherals, computer hardware or computer software. Consequently, the purchasing process will be a careful and educated one. The goods of the

applications will be bought normally for business or education purposes and so the purchaser will be particularly sophisticated. Computers will be bought by the same clientele as the goods of the application, however, they will also be bought by the public at large. All these factors will lessen the effects of imperfect recollection.

Comparison of trade marks

42) The trade marks to be compared are:

GENIE

**Genee Slate
Genee Power Board**

43) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{iv}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^v. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{vi}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{vii}.

44) There is no distinctive and dominant component in the trade mark of Viglen. It is a word that is well-known, at least aurally, through pantomimes and films. The distinctiveness rests in the trade mark in its entirety. Mr Pienaar submitted that Genee is an invented word and should be treated as such. Rather than being an invented word it is a misspelt word, it is genie misspelt. The evidence of World supports this proposition, as images of genies appear in its material eg on pages 60, 70 and 91 of RS3. Genie is a well-known word but not a word that is commonly read and written, so the average consumer will very possibly not be certain of the correct spelling of the word. Mr Pienaar submitted that Slate and Power Board are distinctive elements of World's trade mark as the goods of World were neither tablet computers nor components of computers and so the words are not being used generically. It is the case that the goods of the applications are neither power boards nor slates (being tablet computers). Tablet computers are known as slates and so it is not a great jump to a graphic tablet being viewed as a slate of another form by the average consumer. Graphic tablets are in the form of slates, if electronic ones. Even if slate were not directly descriptive of graphic tablets it is strongly allusive of them. Genee is neither descriptive nor allusive of the goods of either application. In relation to Genee Slate, owing to the strong allusiveness of Slate in relation to the goods and the position of Genee at the beginning of the trade mark, the dominant and

distinctive component of the trade mark is the Genee element. The goods of the Genee Power Board application are interactive whiteboards, ie boards that are powered. Consequently, even if Power Board is not directly descriptive it is strongly allusive of the goods. In relation to Genee Power Board, owing to the strong allusiveness of Power Board in relation to the goods and the position of Genee at the beginning of the trade mark, the dominant and distinctive component of the trade mark is the Genee element. The strong allusive nature of the ends of the trade marks combined with the distinctive Genee element at the beginning, is likely to lead the average consumer to view these as being particular types of Genee Products.

45) GENIE and Genee will be pronounced identically. Visually they are short words with one variation in the penultimate letter. Conceptually, they will be viewed as identical by the average consumer. The final elements of World's trade marks are alien to Viglen's trade mark and so visually, phonetically and conceptually different. Taking the trade marks of World as a whole, and bearing in mind the distinctive and dominant elements and the strongly allusive character of the final word(s) of World's trade marks, there is a high degree of similarity between the respective trade marks. In making this finding the judgment of the European Court of Justice (ECJ) in *Société des Produits Nestlé SA c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Case C-193/06 has been held firmly in mind^{viii}.

Comparison of goods

46) In "construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade^{ix}". Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^x. Consideration should be given as to how the average consumer would view the goods or services^{xi}. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods^{xii}. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{xiii}. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 the General Court (GC) explained when goods were complementary:

"82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for 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).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{xiv}.

47) The goods of the earlier registration are *computers*, the goods of the applications are *graphic tablets, none being computers, computer hardware or data processing equipment and interactive whiteboards, none being computers, computer hardware or data processing equipment*.

48) In his submissions Mr Pienaar made reference to the specific goods upon which World had used its trade mark and the specific manner in which it had marketed and sold these goods. The nature of the goods of World and their use is but an example, it cannot be used as a parameter to limit the consideration of the similarity of the goods. However, this does not preclude taking into account the evidence in relation to the specific goods where it can be considered not to be atypical. Mr Pienaar described the equipment of the applications as being audio visual equipment and considered that there is a clear demarcation line between such equipment and computers. Taking into account that computers are widely used for audio visual functions it is not possible to concur that there is clear blue water between audio visual equipment and computers. Of course, this case concerns specific products, not audio visual equipment at large.

49) Mr Pienaar accepted that the respective goods are complementary in that computers are indispensable to the use of *graphic tablets* and *interactive whiteboards*. However, he did not accept that this complementarity would lead customers to believe that the responsibility for the goods of the applications and the earlier registration lies with the same undertaking. Owing to what he considered the fundamental differences between the goods, he did not consider that this would occur.

50) Mr Pienaar emphasised that the goods of World have no memory, have no computing ability and have no data storage. Of course, this begs the question as to whether other graphic tablets and interactive whiteboards will have such functions and capacities. The exclusions preclude the goods from being *computers, computer hardware or data processing equipment* but do not preclude the goods from having memory.

51) The catalogue description of the Genee Power Board includes the following:

“[s]imply touch the Genee Power Board with the Genee pen and run all computer functions, such as opening files, running digital video clips, or downloading free content from the Internet from the front of the class so there is need to return to your computer and lose the students’ attention”.

There is no claim that such functionality is atypical of interactive whiteboards, The catalogue description of the Genee Slate advises that, inter alia, it interacts with PCs and allows the user to use the PC while on the move in an office or classroom. The graphic tablet allows the user to access all of his or her files and it comes with software. Page 36 of the catalogue is devoted to the GENE E SLATE. The product wirelessly interacts with a whiteboard, PC or visualiser. Free software is included with the product, this software provides a library of clip art with over 2,000 images. The explanation of the product advises that up to 50 of the products can link to a PC or laptop.

52) Mr Pienaar emphasised that although the goods of the applications and those of the registrations are sold by the same suppliers, they are in completely different categorisations; computers and audio visual equipment being discrete areas of business. The evidence supports the view that goods of the applications will be categorised as audio visual equipment whilst the goods of the registration will be categorised as computing equipment.

53) Computers, to the average consumer, are more than just the central processing unit. The natural meaning will encompass laptops and PCs, the latter including keyboards, mice and monitors. Laptops come with monitors, keyboards and pads or buttons to act as mice. Laptops and PCs may also have touch screens. Computers are more than computational devices. They are entertainment centres and are, inter alia, commonly used for presentations, lectures and lessons, where they take on the rôle of audio visual apparatus through running applications such as PowerPoint®.

54) The goods of the applications and those of the earlier registration are all fundamentally electronic goods and so have the same nature at a general level. There is vast array of electronic goods and so the goods having a similar nature is not in itself determinative. The goods of the application can be used to control computers, to run the application software and to access the Internet. Consequently, the nature of the respective goods has more than a notional similarity.

55) Computers have a very wide variety of functions but one of their standard functions is as audio visual tools. Consequently, they can serve the same purpose as the goods of the applications. A sequetor of this is that the goods of the applications and computers will have the same end users, persons who wish to give presentations and lessons.

56) The goods of the applications and those of the earlier registration are not fungible, they are not in competition.

57) Taking all the above factors it is considered that there is a degree of similarity between the goods of the applications and computers.

Likelihood of conclusion

58) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xv}. In this case the trade marks are similar to a high degree whilst there is only a degree of similarity between the goods.

59) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xvi}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xvii}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xviii}. GENIE is neither descriptive, nor allusive of computers. As a dictionary word it has a meaning that can act as a hook. GENIE enjoys a reasonable degree of inherent distinctiveness. There has been no claim to enhanced distinctiveness through use.

60) World has referred to the absence of confusion in the market place. There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

In this case the GENIE trade mark, from the evidence, has always been clearly identified with the products of Viglen; whilst the trade marks of World have always been identified with Genee World. Consequently, the use of all the trade marks has been within specific parameters and confines and so the lack of confusion tells one nothing as to the position if the trade marks were used without reference to the undertakings from which they emanate.

61) World also looked to how it uses its trade marks and how Viglen uses its trade mark, effectively supporting the position that the lack of confusion is neither determinative nor indicative of the position as to likelihood of confusion. The

current marketing undertaken by the parties is not relevant to the issues to be determined, as the GC stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

62) It is readily accepted that the purchasing decision in relation to the goods will be careful and considered, however, this is counterbalanced by the high degree of similarity between the trade marks. A careful purchasing decision is not necessarily going to militate against confusion where there is a high degree of similarity between the trade marks.

63) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other

hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

In this case the purchasing decision is most likely to be made through accessing websites, catalogues and technical manuals and so visual similarity is of greater importance than aural similarity. However, in this case the degrees of visual, aural and conceptual similarity are all effectively the same.

64) In *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* Case C-120/04 the ECJ stated:

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

In this case GENE in the trade marks of World is both dominant and distinctive and clearly has an independent distinctive rôle.

65) The average consumer will consider that the goods of World and those of Viglen come from the same economic undertaking, or a linked economic undertaking owing to the GENIE/Genée presence, the relationship between the goods and their similarities. Consequently, there is a likelihood of confusion in relation to both of the trade marks of World and the applications are to be refused.

Costs

66) Mr Pienaar submitted that the hearing was held at the request of Viglen and that it had added considerably to the cost of the proceedings. He considered that as World had not requested a hearing, it should be compensated for having to attend the hearing. World did not have to attend the hearing, it could have relied upon written submissions. More importantly, rule 63 of The Trade Marks Rules 2008 gives the parties a right to hearing. To sanction a party for exercising a right would be a de facto curtailment of the right. Consequently, no compensation will be given to World for its attending the hearing.

67) Viglen having been successful is entitled to a contribution towards its costs. Costs are awarded on the following basis:

Opposition fee x 2:	£400
Preparing statements and considering the statements of World:	£300
Preparing evidence and considering the evidence of World:	£1000
Preparing for and attending the hearing:	£300
Total:	£2,000

I order Genee World Ltd to pay Viglen Limited the sum of £2,000. This sum is to 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 this 19th day of August 2010

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Section 6A of the Act reads:

“(1) This section applies where –

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- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (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, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (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, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“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.”

ⁱⁱ *esure Insurance Limited v Direct Line Insurance plc* [2007] EWHC 1557 (Ch) Lindsay:

“17. As a subsidiary argument, esure argues before me that the Hearing Officer was wrong to reject the Registrar's preliminary view in the way that he did. Mr Hobbs, drawing attention to the Rules to which I have referred and also to Article 6 ECHR, argues that the Hearing Officer was right in doing as he did. I have no doubt but that the Hearing Officer was right to do as he did. The Registrar's view was arrived at before there was any evidence on either side, before there was any argument on either side and in a context in which it could not be regarded as a decision against the interests of either side without the prospective loser being given an opportunity to be heard, an opportunity which was not given. So far from it being an error of principle to fail to take the Registrar's preliminary view into account, it would, in my judgment, have been a serious error of principle for it to have been taken into account.”

iii *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

iv *Sabel BV v Puma AG* [1998] RPC 199.

v *Sabel BV v Puma AG* [1998] RPC 199.

vi *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

vii *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

viii “35 En particulier, la Cour a jugé à cet égard que, dans le cadre de l'examen de l'existence d'un risque de confusion, l'appréciation de la similitude entre deux marques ne peut se limiter à prendre en considération uniquement un composant d'une marque complexe et à le comparer avec une autre marque. Il y a lieu, au contraire, d'opérer la comparaison en examinant les marques en cause considérées chacune dans son ensemble (voir, en ce sens, ordonnance Matratzen Concord/OHMI, précitée, point 32, ainsi que arrêts précités Medion, point 29, et OHMI/Shaker, point 41).

41 Certes, au point 50 de l'arrêt attaqué, le Tribunal a examiné l'importance de l'élément figuratif propre à la marque demandée par rapport à son élément verbal. Toutefois, ayant constaté que cet élément figuratif n'est pas dominant par rapport à l'élément verbal, en ce sens que son intensité est égale ou inférieure à l'élément verbal et que ce dernier ne saurait donc être considéré comme subsidiaire ou négligeable, il a estimé pouvoir conclure à l'existence d'une similitude visuelle entre les signes en cause sur le seul fondement de la similitude des éléments verbaux, sans examiner, à ce stade ultime de son appréciation sur ce point, l'impression d'ensemble résultant, pour la marque demandée, de la combinaison d'un élément verbal et d'un élément figuratif.

42 Il est vrai que, selon la jurisprudence, l'impression d'ensemble produite dans la mémoire du public pertinent par une marque complexe peut, dans certaines circonstances, être dominée par un ou plusieurs de ses composants (voir, en ce sens, ordonnance Matratzen Concord/OHMI, précitée, point 32, et arrêts précités Medion, point 29, ainsi que OHMI/Shaker, point 41).

43 Toutefois, ainsi que la Cour l'a déjà jugé, ce n'est que si tous les autres composants de la marque sont négligeables que l'appréciation de la similitude pourra se faire sur la seule base de l'élément dominant (arrêt OHMI/Shaker, précité, point 42). Tel pourrait notamment être le cas, ainsi que le Tribunal l'a relevé au point 47 de l'arrêt attaqué, lorsqu'un composant d'une marque complexe est susceptible de dominer à lui seul l'image de cette marque que le public pertinent garde en mémoire, de telle sorte que le ou les autres composants de cette marque est ou sont négligeables dans l'impression d'ensemble produite par celle-ci.

46 Il en résulte que l'appréciation opérée par le Tribunal repose, aux points 48 à 50 de l'arrêt attaqué, sur la présomption selon laquelle, lorsqu'une marque complexe est composée à la fois

d'un élément verbal et d'un élément figuratif, et que ce dernier est d'une intensité égale ou inférieure au premier, l'appréciation de la similitude visuelle des signes en cause peut être établie sur la seule base de la similitude des éléments verbaux, de sorte que, à intensité égale, ce sont uniquement ces derniers qui déterminent la similitude visuelle desdits signes.

47 Il s'ensuit que le Tribunal, en n'ayant pas apprécié la similitude visuelle des signes en cause sur la base de l'impression d'ensemble produite par ceux-ci, a méconnu l'article 8, paragraphe 1, sous b), du règlement n° 40/94 et que, partant, les points 48 à 50 de l'arrêt attaqué sont, à cet égard, entachés d'une erreur de droit."

^{ix} *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^x *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{xi} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

"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 is to be applied by the court having 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 a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use"

^{xii} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{xiii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{xiv} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

(a) The respective uses of the respective goods or services;
(b) The respective users of the respective goods or services;
(c) The physical nature of the goods or acts of service;
(d) The respective trade channels through which the goods or services reach the market;
(e) In the case of self-serve consumer items, where in practice they are 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."

^{xv} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{xvi} *Sabel BV v Puma AG* [1998] RPC 199.

^{xvii} *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

^{xviii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.