

O-312-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2536131
BY IMDMS LTD TO REGISTER THE TRADE MARKS**

IMPACT
Impact

AS A SERIES OF TWO

IN CLASSES 9, 16, 25, 35, 38, 40 AND 42.

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 100618
BY ALPHA IMPACT LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2536131
By IMDMS Ltd to register the trade marks**

IMPACT
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**IN THE MATTER OF opposition thereto under No 100618 by Alpha Impact
Ltd**

BACKGROUND AND PLEADINGS

1. On 11th January 2010, IMDMS Ltd (hereafter, "IMDMS") of 7 Charfleets Farm Way, Canvey Island, Essex SS8 0PA applied to register the marks 'IMPACT' and 'Impact' as a series of two and for various classes of goods and services.
2. The application was allocated number 2536131 and was published in the Trade Marks Journal on 19th March 2010, and on 16th June 2010 Alpha Impact Ltd (hereafter, "Alpha") of 3-5 London Road, Rainham, Kent ME8 7RG lodged an opposition against the following services:

Class 35

Advertising; public relations services; business management; business administration; office functions; advertising and marketing services; promotion services; market surveys; analysis of advertising response and market research; compilation of information into computer databases; systemization of information into computer databases; compilation, monitoring, storage, management, analysis, evaluation and retrieval of commercial and business information, data and statistics relating to search engine optimisation, web advertising and web traffic analysis; preparation of commercial and business statistics; provision of commercial and business information, data and statistics; statistical modelling for business and commercial purposes; strategic planning for business and commerce; business marketing research; business project management; the bringing together, for the benefit of others, of computers, electronic apparatus and instruments and computer software relating to search engine optimisation, web advertising and web traffic analysis, enabling customers to conveniently view and purchase those goods from an Internet web site; on-line advertising on a computer network; providing commercial and business information directory services for a wide variety

of topics, and referrals to web sites that provide a wide variety of information, products and services, in the form of an on-line commercial and business directory, all via a global computer network; advertising and business information services all provided on-line from a computer database or the Internet; data processing services; database management; creating indexes of information received from users of global computer networks for others; production of marketing, promotional and advertising matter and materials; social media marketing and advertising; email marketing services; affiliate marketing services; organizing content of business and advertising information provided over a global computer network and storing and disseminating advertising information for others; brand creation services; brand development services; consultancy, information and advisory services relating to all of the aforesaid services.

Class 38:

Chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting; advisory, consultancy and information relating to the above.

Class 42

Development of software solutions for Internet providers and Internet users; providing search engines for the Internet; design, drawing and commissioned writing for the compilation of web pages on the Internet; technical support services relating to computer networks and the Internet; Internet advice services relating to all the aforesaid services; computer research, development, advisory and consultancy services; compilation of scientific information; documentary research relating to information storage, computer system analysis, documentary research relating to information retrieval and services for the provision of technological information; computer helpline services; computer hardware and software support services; computer information services; database design and development; reconstitution of databases; support and consultation services for managing databases; evaluations, assessments and research in the fields of science and technology; design, development, installation, updating and maintenance of software; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; hosting the web-sites of others; providing search engines for obtaining data via communications networks; design services; application development for mobile / handheld devices; creation of social networking applications; providing databases and directories via communications networks for obtaining technical data; application service provider (ASP) services featuring software for use in connection with online database services; providing users of electronic communications networks with means of identifying, locating, grouping, distributing, and managing data; providing computer databases; corporate

identity services; branding consultancy services; artwork design, information, advisory and consultancy services relating to all of the aforesaid services.

- Alpha opposed on the sole basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), citing the following earlier mark:

Mark. Filing and registration dates	Services relied upon under section 5(2)(b)
<p>CTM 4169793</p> <p>Alpha Impact</p> <p>14th December 2004</p> <p>11th June 2008</p>	<p>Class 35: Employment agencies, recruitment of employees and temporary employees; advertising; business consultancy in the pharmaceutical, medical, dental and veterinary fields; management and compilation of computer databases in the pharmaceutical, medical, dental and veterinary fields; retailing of pharmaceutical, medical and veterinary products, except radio advertising.</p> <p>Class 38: Telecommunications, except radio services.</p> <p>Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.</p>

- In its pleadings, Alpha say the respective trade marks are visually, aurally and conceptually highly similar. The trade mark under opposition is contained within the earlier trade mark. The respective services are identical or highly similar to those of the earlier registration. Taking into account a global assessment there is a likelihood of confusion.
- IMDMS filed a counterstatement denying the likelihood of confusion. However, it admits the respective marks are similar and further admits that some of the services are identical or similar, *but* does not admit that all services are *equally* similar to those of Alpha and moreover, asserts that other remaining services are neither identical nor similar. I have not at this

point recorded its precise claims regarding similarity of services since these have been displaced by later-filed submissions which I have taken to be definitive.

6. In summary, and notwithstanding its concessions, IMDMS denies there will be any likelihood of confusion since, in its view, there is only a low degree of similarity between the respective marks, in particular the opponent's mark conveys a different visual, aural and conceptual impression. This, when factored in with the degree of similarity between the respective services, which in most cases is not high, will not lead to any likelihood of confusion.
7. IMDMS also relies on the fact that it, and its predecessor in title, have traded continuously under, and by reference to the mark 'IMPACT' in respect of many of the services for which registration is sought, without a single instance of confusion between the applicant and opponent.
8. Evidence was filed by both parties, which insofar as it is factually relevant, I shall summarise below. Both parties filed submissions which I shall also take into account below. No hearing was requested by either party either and so I give my decision based upon a careful reading of the papers.

Applicant's evidence in chief

9. This takes the form of a witness statement dated 16th December 2010 from Mr James Coates, a director of IMDMS.
10. He says the applicant was incorporated in October 2006 when he was appointed as a director. Prior to that he was running a business providing design, marketing and advertising services, including: logo design, brochure design, stationery design, website design, advertising design, search engine optimisation, pay per click marketing, web hosting, domain name registration and other promotional merchandise and clothing, under and by reference to the names: "IMPACT", and/or "IMPACT MEDIA", and/or "IMPACT MEDIA DESIGN".
11. Before the company's incorporation and his appointment as director, he says he was involved with the business since 2003 and has used the mark 'IMPACT' or the variants described in the above paragraph. Since that time 'IMPACT' has been used both in online and offline publications, ranging from regional publications to full nationwide presence. From the initial launch of the company, he says the business phones have always been answered with the words, "Good morning, IMPACT" or "Good afternoon, IMPACT", even right up to the time of writing the witness statement.

12. Exhibit 1 is an example of one of the first business cards showing the word 'IMPACT' in bold, underneath which are the words "Media design". The website www.impactmediadesign.co.uk also appears on the card.
13. Exhibit 2 shows a directory advertisement in the YELLOW PAGES for Essex, placed around 2005. Similar adverts were used online in YELL.COM. The advert contain the words: "*Fresh ideas.... With Impact*" ; "Your one stop multimedia website.....www.i-m-d.co.uk". Also the heavily stylised letters 'IMD' with accompanying words, "Impact Media Design" appear on the advert. A reproduction of the advert appears below:



14. Exhibit 3 shows one of the early marketing tools used to promote the company's services and this is a company website showing the same 'IMD' logo as appears in the advert at Exhibit 2. The details on the website show the company is engaged in web site design solutions, including: hosting, domain name registration, search engine optimisation, pay per click marketing and related services. This site was publically accessible from the end of 2004 onwards.
15. Exhibit 4 is a VAT registration certificate from March 2006 showing the trade classification of the company, being "advertising".
16. Exhibit 5 shows the company's current website which uses the predominant colours, green and black. The name 'IMPACT MEDIA DESIGN' appears at the top; the word, 'IMPACT', above the words, 'MEDIA DESIGN'. The company describes itself as: designing logos, creating websites, making adverts, producing copy and much more. It is based at Studio 7 in Canvey Island. It designs for print, as well as online, and further describes itself as,

“small but with dedication and commitment”. The website is dated 2010. A reproduction of the current logo design appears below:



17. Exhibit 6 shows a sponsored webpage which was placed throughout one of NEWSQUEST'S network of online newspaper websites. This was to promote 'THE ESSEX AND SOUTHEND BUSINESS AWARDS' which the company sponsored in 2008. This advertisement shows the same 'IMD' logo and words "Impact Media Design" as in Exhibits 2 and 3, shortened to 'Impact' in the accompanying text.
18. Exhibit 7 is a newspaper scan from a newspaper dated September 2008 called 'THE ECHO' (I assume, covering Southend in Essex), showing details of the sponsors of 'THE SOUTHEND BUSINESS AWARDS', including IMPACT MEDIA DESIGN. The familiar stylised letters 'IMD' are used alongside "IMPACT MEDIA DESIGN MULTIMEDIA SOLUTIONS". The website www.impactbranding.co.uk is mentioned.
19. Exhibit 8 shows POWERPOINT slides which were used to promote the applicant's services and displayed at 'THE ESSEX AND SOUTHEND BUSINESS AWARDS' to over 1,000 business owners/employees. The slides contain the more recent logo contained in Exhibit 5. The website www.weareimpact.co.uk is referred to and there are examples of logos designed by the company, including for: Council of Mortgage Lenders; OAK dental group; BONDFIRE Protection and others.
20. Exhibit 9 shows an advertising package taken out with the company's local football club, Canvey Island FC. The company sponsor the club and are responsible for the club's website. There are also ground advertisements.
21. Exhibit 10 shows the websites of various clients, including: JET Tyres Ltd; Canvey Island Town Council; Council of Mortgage Lenders; Grout's the Bakers; Word of Mouth Dentistry; Opus Sterling, executive search consultants; ramseymoore estate agents; The Rubettes musical group; Seeker recruitment and Unfold consulting who operate in the hospitality sector. In all these examples, Impact Media Design is credited for website design.
22. Exhibit 11 shows more examples of promotional activities, such as: a sponsored golf day, a football tournament and various promotional items such

as mugs, coasters, balloons, brochures and mouse mats. In most examples, the company logo is the more recent version referred to in Exhibits 5 and 8.

23. Mr Coates ends by saying that in 7 years trading there have been no instances of confusion as between his company and the opponent.

Opponent's evidence in reply.

24. This takes the form of a witness statement dated 16th February 2011 from Mr Sean Johnson, principal shareholder of the opponent.

25. He says his company was incorporated on 27th November 2002 and has used the mark 'ALPHA IMPACT' ever since. He notes that one of the main activities of the applicant is in the recruitment sector and one of his company's activities is the advertising of job vacancies on behalf of clients. Hundreds of such adverts were placed in online and printed media before Mr Coates's company started trading under the 'IMPACT' mark in 2003.

26. He further notes, by way only of critique of the applicant's evidence, that the majority of Mr Coates's exhibits refer to the mark 'IMPACT MEDIA DESIGN' and do not show 'IMPACT' in use on its own. In any event, he says most of Mr Coates's exhibits also post date of application of his company's mark, being 14th December 2004.

DECISION

Section 5(2)(b)

27. The opposition is founded solely upon Section 5(2) (b) of the Act. This reads:

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

(a).....

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

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

28. Alpha's mark has a filing date of 14th December 2004 and date of registration of 11th June 2008. It is plainly an 'earlier mark' in accordance with section 6 of the Act. Moreover, given that its date of registration is within 5 years of the publication of the application, it is not subject to proof of use requirements.

29. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 (“*Medion*”) and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(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 and nature of the purchase

30. The average end consumer for both parties' services, in a notional sense, will be other businesses. These businesses will be in the market for both general business services such as: advertising, PR, business management or recruitment, but also more specific services to do with computer and software solutions.

31. Both parties will, accordingly, draw their customers from the same 'pool'.

32. These other businesses will purchase such services with a high degree of circumspection and often on recommendation and established, successful relationships.

33. I will need to factor these observations into my overall analysis of likelihood of confusion.

Comparison of marks

34. The case law makes it clear I must undertake a full comparison (taking account of visual, phonetic and conceptual similarities and dissimilarities), from the perspective of the average consumer. Marks need to be considered in their totalities and overall impression (see authority (k) above in para 29), taking account of distinctive and dominant elements.

Visual comparison

35. Alpha's mark comprises two words, 'ALPHA' and 'IMPACT', in that order. IMDMS's mark is a single word, 'Impact'. In the first version of the series it is in capital letters and in the second, a combination of upper and lower case.

Both parties' marks are in plain script without any stylisation. The word 'impact' is common to both marks. Taking the similarities and dissimilarities into account I find the respective marks share a moderate degree of visual similarity.

Phonetic comparison

36. Alpha's mark will be enunciated "ALFA IM-PACT". IMDMS'S mark will be enunciated simply "IM-PACT". Taking the similarities and dissimilarities into account I find that the respective marks share a moderate degree of phonetic similarity.

Conceptual comparison

37. By conceptual similarity, it is meant 'semantic' conceptual similarity. IMDMS's position is that there is no conceptual similarity at all as the words 'ALPHA IMPACT' comprise an unusual juxtaposition of ordinary English words, conveying a different conceptual impression to the word 'IMPACT' alone. It says the word 'ALPHA' is equally dominant and distinctive as the second word 'IMPACT'.
38. In contrast, Alpha's position is that because of the grammatical structure of its mark, "extra emphasis" is placed on the second word, 'IMPACT', with the first word, 'ALPHA', suggesting that the "IMPACT" of the goods/service is: "first class", "high quality" or "impressive", or any of the other "commonly understood meanings" (as Alpha puts it), attached to the word 'ALPHA'.
39. In effect, both parties acknowledge the words 'ALPHA' and 'IMPACT' are ordinary English words, although they disagree as to the consequence of that.
40. Whilst I believe the word 'IMPACT' will have a commonly understood meaning in English, I am not convinced the word 'ALPHA' will be understood in the same sense. Beyond likely, and simple, *recognition* as the first letter of the Greek alphabet, it is unlikely the word 'alpha' will impart any particular *meaning* in the eyes of the average UK consumer, and it would be dangerous to impute any such meaning. A dictionary definition of the word, 'ALPHA', is as follows:

noun

1. the first letter of the Greek alphabet (α , α), transliterated as 'a'. ■[as modifier] denoting the first of a series of items or categories, e.g. forms of a chemical compound: *the α and β chains of haemoglobin*. ■ (Brit.) a first-class mark given for an examination paper or piece of school or college work: *he had been awarded alpha double plus*. ■[as modifier] denoting the dominant animal or person in a particular group: *Turner soon proved to be*

the alpha male. ■short for **alpha test.** ■ (**Alpha**) [followed by Latin genitive] (*Astronomy*) the first (typically the brightest) star in a constellation: *Alpha Orionis.* ■[as modifier] relating to alpha decay or alpha particles: *an alpha emitter.*

2. a code word representing the letter A, used in radio communication.¹

41. None of these definitions of 'ALPHA', with the possible exception of, "a first class mark given for an examination", resonates with the meanings of 'ALPHA' which Alpha say the average consumer will impute, namely that it will mean "first class", "high quality" or "impressive". I am thus *not* persuaded by Alpha's submission that, as a two-word combination, ALPHA IMPACT, it is the second word, 'IMPACT' which is, in grammatical effect, the *operative* word; that is, the word upon which 'extra emphasis' is put. In other words, to the average consumer, the word 'alpha' in the combination does not serve, adjectivally, to define or describe a particular 'type' of 'impact'.
42. Although the words, separately, may have a meaning, or at least in the case of 'alpha' be *recognised*; taken *together*, they confer no clear semantic concept. This grammatical analysis means that both words have independence one from the other. This is not to say that, *in trade mark terms*, the words are equally dominant, or that each word is equally distinctive, but they are linguistically *independent*, and to the average UK consumer the two words 'ALPHA IMPACT', do not 'hang together' in a recognisable and comprehensible way, such as in, for example, the words 'HUGE IMPACT'. There is no such recognisable 'thing' as an, "ALPHA IMPACT".
43. The absence of clear semantic meaning in the word combination 'ALPHA IMPACT', and the fact that IMDMS's mark comprises the commonly-understood word, 'IMPACT', alone, undermine IMDMS's argument that the respective marks are conceptually different. Whilst the respective marks can be said *not* to be conceptually *identical*, there must be a degree of semantic conceptual similarity, by virtue of the shared word, 'IMPACT'. 'IMPACT' is a normal, everyday word, readily comprehended (as distinct from merely *recognised*, like 'Alpha'), and taking account its linguistic 'independence' from ALPHA, I find that the respective marks share, at least, a moderate degree of conceptual similarity.

Overall similarity of marks

44. I need to bring my individual findings above into an overall assessment of similarity of marks bearing in mind their distinctive and dominant elements.

¹ "alpha *noun*" *Oxford Dictionary of English*. Edited by Angus Stevenson. Oxford University Press, 2010. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 13 May 2011 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t140.e0021440>>

45. Whilst I have found that, in the earlier mark, 'ALPHA' and 'IMPACT' have independence in a linguistic sense, it does not follow that both are equally dominant or distinctive in a trade mark sense. The word 'IMPACT' is a known English word, having a somewhat laudatory connotation – 'to make an impact'. 'Alpha', on the other hand may, as I have said, be recognised as the first letter of the Greek alphabet but would convey no specific *meaning*. It is on that basis I consider the word, 'ALPHA', to be the more distinctive (in a trade mark sense) of the two words, *but*, and crucially, that the word 'IMPACT' nevertheless has at least an average level of distinctiveness.
46. Bearing in mind, in particular, my conceptual analysis, based on the grammatical independence of the words 'ALPHA' and 'IMPACT', I find that, overall, the respective marks can be said to share a moderate level of similarity.

Comparison of the services

47. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the 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 method of use and whether they are in competition with each other or are complementary.'

48. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.
49. It is important to recognise that even though the factual evidence on similarity is non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC, sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary.
50. I should also mention a further case in terms of the application of legal principle, and that is the European Court of First Instance ("CFI") in *Gérard*

*Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("Meric")*² Case T-133/05, where, at para 29, it is stated:

"In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

51. I should finally mention that in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 ("Avnet"), Jacob J cautioned against giving too wide a construction to specifications for services covering a vast range of activities and that they should be confined to the substance, as it were, of the core of possible meanings attributable to the rather general phrase.
52. In its submissions, Alpha 'groups' the services into sub-sets for ease of comparison (but does not concede any of IMDMS's services are not similar to its own), whilst IMDMS divides its services into those it considers dissimilar and those it considers have a degree of similarity (whether 'low', 'medium' or 'high'). Even for those services it concedes have some degree of similarity, it nevertheless denies overall likelihood of confusion. IMDMS's position, in its final submission, contrasts, or at least is far more exact, in terms of conceding specific degrees of similarity, than the position it adopted in its counterstatement, as briefly mentioned above at para 5.
53. The task of assessing similarity of services has not been made easier by the differing approaches taken by the parties and the sheer length of IMDMS's specification in particular. I have approached the task against the background of the case law cited above and, in the end, I believe IMDMS's specification naturally divides into certain groupings³, though not necessarily exactly as Alpha has submitted.

² See also the discussion in, eg BL O/269/04 *Galileo*, before the appointed person, re the fact that 'identity' does not mean 'co-extensive'.

³ The principle of grouping goods and services has been endorsed in, eg Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau*.

54. The relevant services to be compared are:

Alpha's services	IMDMS's services
<p>Class 35: Employment agencies, recruitment of employees and temporary employees; advertising; business consultancy in the pharmaceutical, medical, dental and veterinary fields; management and compilation of computer databases in the pharmaceutical, medical, dental and veterinary fields; retailing of pharmaceutical, medical and veterinary products, except radio advertising.</p>	<p>Class 35 Advertising; public relations services; business management; business administration; office functions; advertising and marketing services; promotion services; market surveys; analysis of advertising response and market research; compilation of information into computer databases; systemization of information into computer databases; compilation, monitoring, storage, management, analysis, evaluation and retrieval of commercial and business information, data and statistics relating to search engine optimisation, web advertising and web traffic analysis; preparation of commercial and business statistics; provision of commercial and business information, data and statistics; statistical modelling for business and commercial purposes; strategic planning for business and commerce; business marketing research; business project management; the bringing together, for the benefit of others, of computers, electronic apparatus and instruments and computer software relating to search engine optimisation, web advertising and web traffic analysis, enabling customers to conveniently view and purchase those goods from an Internet web site; on-line advertising on a computer network; providing commercial and business information directory services for a wide variety of topics, and referrals to web sites that provide a wide variety of information, products and services, in the form of an on-line commercial and business directory, all via a global computer network; advertising and business information services all provided on-line from a computer database or the Internet; data processing services; database management; creating indexes of information received from users of global computer networks for others; production of marketing, promotional and advertising matter and materials; social media marketing and advertising; email marketing services; affiliate marketing services;</p>

<p>Class 38: Telecommunications, except radio services.</p> <p>Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.</p>	<p>organizing content of business and advertising information provided over a global computer network and storing and disseminating advertising information for others; brand creation services; brand development services; consultancy, information and advisory services relating to all of the aforesaid services.</p> <p>Class 38: Chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting; advisory, consultancy and information relating to the above.</p> <p>Class 42 Development of software solutions for Internet providers and Internet users; providing search engines for the Internet; design, drawing and commissioned writing for the compilation of web pages on the Internet; technical support services relating to computer networks and the Internet; Internet advice services relating to all the aforesaid services; computer research, development, advisory and consultancy services; compilation of scientific information; documentary research relating to information storage, computer system analysis, documentary research relating to information retrieval and services for the provision of technological information; computer helpline services; computer hardware and software support services; computer information services; database design and development; reconstitution of databases; support and consultation services for managing databases; evaluations, assessments and research in the fields of science and technology; design, development, installation, updating and maintenance of software; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; hosting the web-sites of others; providing search engines for obtaining data via communications networks; design services; application development for mobile / handheld devices; creation of social networking applications; providing databases and directories via communications networks for</p>
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	obtaining technical data; application service provider (ASP) services featuring software for use in connection with online database services; providing users of electronic communications networks with means of identifying, locating, grouping, distributing, and managing data; providing computer databases; corporate identity services; branding consultancy services; artwork design, information, advisory and consultancy services relating to all of the aforesaid services.
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Class 35

55. It is conceded by IMDMS that its, “advertising”, “advertising and marketing services” and “promotion services” are all identical to “advertising” in Alpha’s specification. Bearing in mind IMDMS’s concession, and under the approach clearly mandated in the *Meric* case quoted above, (and also consistent with the approach taken by OHIM in its oppositions (see, eg B 1 666 570)), it is self evident that “advertising” is part and parcel of “marketing”, as well as “promotional” activity. This renders the following services in IMDMS’s specification also identical to advertising : “online advertising on a computer network”; “advertising and business information services all provided online from a computer database or the internet”; “production of marketing, promotional and advertising matter and materials”; “social media marketing and advertising”; “email marketing services” and “affiliate marketing activities”. It does not matter how and in what form the marketing or advertising takes place, it is still “advertising”. I am not, however, convinced that “market surveys”; “business marketing research” and “market research”, and even “analysis of advertising response”, are identical to “advertising”. It is one thing to say that “advertising” is part and parcel of “marketing”, but the research and data upon which a campaign may be run is not necessarily provided by the same undertaking. There is of course some degree of complementarity; without the necessary raw data and research, advertisers will not know how to run campaigns or whether they are successful. Taking account of all the relevant factors I find that: “market surveys”; “business marketing research” and “market research”, and “analysis of advertising response” are all highly similar to “advertising”.

56. As far as “public relations services” (“PR”)” are concerned, these can have a slightly different slant and intended purpose to “advertising” as such. Despite that, both are concerned with ‘image’, whether it concerns people, services or products. That said, being concerned with ‘image’ is placing the question of similarity at perhaps too high a level of generality and it is entirely conceivable that PR companies do not also engage in advertising. On that basis, I find

that “public relations services” are highly similar, but not identical, to “advertising”.

57. “Brand creation services” and “brand development services” are also highly similar to “advertising”. Advertising is the means by which brands are projected, in order to achieve sales and growth. It seems more probable than not that companies and agencies offering “advertising” will also be concerned with a client’s brand and the image it wishes to project; the advertising aspect being integral to the brand services. The channels of trade are therefore likely to be the same and the end consumers also the same.
58. As far as “business management” in IMDMS’s specification is concerned, this is plainly a broad term. Alpha has “business consultancy in the pharmaceutical, medical, dental and veterinary fields”. The fact that Alpha’s term is framed with specific regard to a particular sector does not, according to *Meric*, render it dissimilar to the broader term adopted by IMDMS. On the contrary. In the circumstances, I regard ‘management’ and ‘consultancy’ to be, in essence, the same. In the real market place I think it likely that the word ‘consultancy’ (a term which would include ‘projects’) would have more recognition and usage than ‘management’, which is inherently vaguer, but in essence, they are the same; namely a business service offered to other businesses to facilitate better performance or growth within a clearly defined area, or in general terms. This renders the following services in IMDMS’s specification identical to Alpha’s sector related consultancy: “business management”; “business project management”; “strategic planning for business and commerce” and “consultancy, information and advisory services relating to all the aforesaid services.”.
59. IMDMS also has “business administration” and “office functions”. I have hesitated over these terms as they suggest to me something more operational and practical than ‘consultancy’, which is suggestive of arm’s length advice. In other words, I see the terms used by IMDMS as covering companies that offer other companies common services such as: HR, payroll, secretarial and facilities management; that is, non-core services. Consultancies would not necessarily offer that kind of service but instead *advise* other businesses. In the circumstances I do not consider these services to be similar or if similar, only to a small degree.
60. My next ‘grouping’ in Class 35 relates to the more narrow and focussed database and computer based ‘information’ related and retrieval services. Alpha has, “management and compilation of computer databases in the pharmaceutical, medical, dental and veterinary fields”. It is important in this context to note that Alpha has the broad term ‘management’ in its term, and so its scope is not just that of compiling databases, but also that of ongoing monitoring and wider management on behalf, it is assumed, of other businesses. In accordance with *Meric*, the fact that Alpha’s term is framed

with regard to a specific sector does not render it dissimilar to broader terms adopted by IMDMS. Thus, under this approach, the following IMDMS services are identical to Alpha's sector-specific term: "compilation of information into computer databases"; "systemization of information into computer databases"; "database management"; "compilation, monitoring, storage, management, analysis, evaluation, and retrieval of commercial and business information, data and statistics relating to search engine optimisation, web advertising and web traffic analysis"; "preparation of commercial and business statistics"; "provision of commercial and business information, data and statistics"; "statistical modelling for business and commercial purposes"; "data processing services"; "database management", "creating indexes of information received from users of global computer networks for others" and "organising content of business and advertising information provided over a global computer network and storing and disseminating advertising information for others." Having said that, the term 'management and compilation' in Alpha's specification is unlikely, confining the words to their core meaning as required by *Avnet*, to include within their scope the provision of a stand alone 'information' service such as a 'directory' service, accessible to the wider public rather than just businesses. With that in mind, I find that, "providing commercial and business information directory services for a wide variety of topics, and referrals to web sites that provide a wide variety of information, products and services, in the form of an online commercial and business directory, all via a global computer network" is a service which is only similar to Alpha's term.

61. Next, Alpha has, "retailing of pharmaceutical, medical and veterinary products, except radio advertising". IMDMS's retailing services are specified using the term, "the bringing together, for the benefit of others, of computers, electronic apparatus and instruments and computer software relating to search engine optimisation, web advertising and web traffic analysis, enabling customers to conveniently view and purchase those goods from an internet web site." I do not believe the respective retail specifications are similar; the one goes to medical and pharmaceutical products such as may be sold in BOOTS, SUPERDRUG or other smaller chemists and the other to retail operations such as may be offered by, eg PC WORLD or others. The intended purpose of the respective retail operations is not the same and neither, with the possible exception of electronic apparatus having a medical application, such as eg Tens machines, are the products being sold. Taking all factors into account I find the respective retail services not similar to each other or if they are similar, particularly in terms of the nature of retailing in general, then they are only similar to a low degree.

Class 38

62. Alpha says, “telecommunications, except radio services” are identical or similar to all the services specified in IMDMS’s Class 38 specification. It does not say why. IMDMS says that only, “radio and television broadcasting” are highly similar. The other services have a low degree of similarity as they have a different intended purpose, different distribution channels and are not complementary. “Telecommunications” is another very broad term, suggestive, in trade, of the provision of broadcasting, wireless and telephony services of the kind that, eg BT, SKY, BBC and mobile phone providers may provide.
63. On that basis, I think it likely the average consumer may also see such companies as providing services like, ‘chat room’, ‘e-mail’ and ‘portal services’, such is the complementarity (and convergence these days) between the provision of the primary ‘broadcasting’ service, and the provision of related ‘niche’ services. To take the commercial broadcaster SKY for example; not only is it a television broadcaster but it also provides telephony, internet access and related services such as e-mail. On that basis, whilst one may argue that the nature and intended purpose of ‘telecommunications’ is ostensibly different to that of, ‘chat room services’ or ‘portal services’, the practical reality these days is of multi- service provision, distribution through the same channels and to the same end user. In my view this is a recognisable pattern in trade; ‘chat room services’, ‘portal services’ and ‘e-mail services’ offered under the names BT, BBC or SKY are apt to be linked to those main providers, not because they are existing major players but because of the related and complementary nature of the services.
64. Taking this forward, I do however consider that certain services in IMDMS’s Class 38 specification are ‘closer’ to Alpha’s specification. “Television broadcasting” is identical to “telecommunications”. “Radio broadcasting” is highly similar to, “telecommunications, except radio”, even though radio is expressly excluded. Given the convergence these days I note, as in the above paragraph, that broadcasters such as SKY also broadcast radio alongside TV channels. As far as the other services are concerned: “chat room services”, “portal services”, “e-mail services”, “providing user access to the internet”, and “advisory, consultancy and information related to the above”, for the reasons outlined in the paragraph above, I consider these to be highly similar to Alpha’s “telecommunications, except radio”.

Class 42.

65. Alpha’ specification is very broad in this class, including such terms as, “scientific and technological services and research and design relating thereto”, “industrial analysis and research services” and “design and development of computer hardware and software”.

66. Taking “design and development of computer hardware and software” first, I consider the following services to be identical in IMDMS’s specification: “development of software solutions for internet providers and internet users”, “providing search engines for the internet”, “design, drawing and commissioned writing for the compilation of web pages on the internet”, “database design and development”, “creating and maintaining web sites” “providing search engines for obtaining data via communications networks”, “design services” (on the *Meric* principle), “application development for mobile/handheld devices”, “creation of social networking applications” and “application service provider (ASP) services featuring software for use in connection with online database services”. All of these services would appear to involve “design and development of computer software and hardware” and thus, restricting the scope of Alpha’ specification to its core meaning, as required by *Avnet*, a finding of identity is justified .

67. In contrast: “technical support services relating to computer networks and the internet”, “Internet advice services relating to all the aforesaid services”, “computer research, development, advisory and consultancy services”, “computer helpline services”, “computer hardware and software support services”, “computer information services”, “reconstitution of databases”, “support and consultation services for managing databases”, “design, development, installation, updating and maintenance of software”, “information relating to computer hardware or software provided online from a global computer network or the internet”, “hosting the web-sites of others”, “providing databases and directories via communications networks for obtaining technical data”, “providing users of electronic communications networks with means of identifying, locating, grouping, distributing and managing data”, and “providing computer databases”, would all appear to be services which do not necessarily involve the development of hardware or software *as such* but instead, provide information, support and advice around *existing* hardware and software. “Hosting the web-sites of others” especially, is a service which does not necessarily involve hardware and software development. In the circumstances however, the services listed here would all fall within the term, “technological services and research and design relating thereto”, and thus be identical to such services. Alternatively, they would be similar to, “design and development of computer hardware and software”.

68. “Compilation of scientific information”, “documentary research relating to information storage, computer system analysis, documentary research relating to information retrieval and services for the provision of technological information” and “evaluations, assessments and research in the field of science and technology “ are all identical to, “scientific and technological services and research and design relating thereto”.

69. That leaves the following: “corporate identity services”, “branding consultancy services” and “artwork design, information, advisory and consultancy services relating to all of the aforesaid services”.
70. It is questionable that “corporate identity services and “branding consultancy services” appear in the correct class, but assuming they are correctly classified, I regard them as highly similar to “advertising” in Alpha’s Class 35 specification for the reasons given at para 57 above, and notwithstanding that the services appear in different classes.
71. As far as “artwork design” services are concerned, these may well be stand alone services which have little obvious synergy with the other class 42 services. The most that can be said is that, perhaps, such services may complement, and are provided as part and parcel of ‘advertising services’ in class 35. At best then, I find that “artwork design” has a low level of similarity to “advertising”
72. Finally, there are, “information, advisory and consultancy services relating to all the aforesaid services”. Grammatically, the “aforesaid services” relate only to “artwork design” on the basis that a semi-colon separates “artwork design.....” from all the preceding services and only a comma separates “information, advisory and consultancy services relating to all the aforesaid services” from “artwork design”. Had IMDMS intended that the “information, advisory and consultancy services” relate to all the preceding services, they would have separated them off from “artwork design” with a semi-colon. On that basis, the same finding as far “artwork design” is applied to, “information, advisory and consultancy services relating to all the aforesaid services” in that they have a low level of similarity to ‘advertising’, being unlikely to possess independent economic existence from “artwork services”. If, contrary to my grammatical interpretation and as a contingency, “information, advisory and consultancy services relating to all the aforesaid services” was intended to relate to all the services listed in class 42 then the individual findings already made against each of services would apply also to “information, advisory and consultancy services”.

73. It would help if I brought my findings together in a table:

Class 35

IMDMS	Alpha
advertising; advertising and marketing services; promotion services; advertising and business information services all provided on-line from a computer database or the Internet; production of	Identical to: “advertising”

marketing, promotional and advertising matter and materials; social media marketing and advertising; email marketing services; affiliate marketing services.	
market surveys; business marketing research; analysis of advertising response and market research	Highly similar to: “advertising”
public relations services	Highly similar to: “advertising”
brand creation services; brand development services	Highly similar to: “advertising”
business management; business project management; strategic planning for business and commerce; consultancy information and advisory services relating to all the aforesaid services	Identical to: “business consultancy in the pharmaceutical, medical, dental and veterinary fields”
business administration; office functions	Not similar, or if similar ,only to a low degree
“compilation of information into computer databases”; “systemization of information into computer databases”; “database management”; “compilation, monitoring, storage, management, analysis, evaluation, and retrieval of commercial and business information, data and statistics relating to search engine optimisation, web advertising and web traffic analysis”; “preparation of commercial and business statistics”; “provision of commercial and business information, data and statistics”; “statistical modelling for business and commercial purposes”; “data processing services”; “creating indexes of information received from users of global computer networks for others”; “organising content of business and advertising information provided over a global computer network and storing and disseminating advertising information for others.”	Identical to: “management and compilation of databases in the pharmaceutical, medical, dental and veterinary fields”
“providing commercial and business information directory services for a wide variety of topics, and referrals to web sites that provide a wide variety of information,	Similar to: “management and compilation of databases in the pharmaceutical, medical, dental and veterinary fields”

products and services, in the form of an online commercial and business directory, all via a global computer network”;	
“the bringing together, for the benefit of others, of computers, electronic apparatus and instruments and computer software relating to search engine optimisation, web advertising and web traffic analysis, enabling customers to conveniently view and purchase those goods from an internet web site.”	Not similar, or similar only to a low degree, to: “retailing of pharmaceutical, medical and veterinary products, except radio advertising”

Class 38

IMDMS	Alpha
“television broadcasting	Identical to: “telecommunications except radio”
“radio broadcasting	Highly similar to: “telecommunications except radio”
“chat room services”; “portal services”; “e-mail services”; “providing user access to the internet”; “advisory, consultancy and information related to the above”	Highly similar to “telecommunications, except radio”

Class 42

IMDMS	Alpha
”development of software solutions for internet providers and internet users”, “providing search engines for the internet”, “design, drawing and commissioned writing for the compilation of web pages on the internet”, “providing search engines for obtaining data via communications networks”, “design services”, “application development for mobile/handheld devices”, “creation of social networking applications”, “design, development, installation, updating and maintenance of software”, “application service provider (ASP) services featuring software for use	Identical to: “design and development of computer hardware and software”

<p>in connection with online database services”, ,“artwork design, information, advisory and consultancy services relating to all the aforesaid services”</p>	
<p>“technical support services relating to computer networks and the internet”, “Internet advice services relating to all the aforesaid services”, “computer research, development, advisory and consultancy services”, “computer helpline services”, “computer hardware and software support services”, “computer information services”, “database design and development”, “reconstitution of databases”, “support and consultation services for managing databases”, “information relating to computer hardware or software provided online from a global computer network or the internet”, “creating and maintaining web sites”, “hosting web-sites of others”, “providing databases and directories via communications networks for obtaining technical data”, “providing users of electronic communications networks with means of identifying, locating, grouping, distributing and managing data”, and “providing computer databases”</p>	<p>Identical to : “technological services and research and design relating thereto” or, alternatively, they would be similar to, “design and development of computer hardware and software”.</p>
<p>“compilation of scientific information”, “documentary research relating to information storage, computer system analysis, documentary research relating to information retrieval and services for the provision of technological information”, “evaluations, assessments and research in the field of science and technology”, “artwork design, information, advisory and consultancy services relating to all the aforesaid services”</p>	<p>Identical to: “scientific and technological services and research and design relating thereto”</p>
<p>“corporate identity services”, “branding consultancy services”,</p>	<p>Highly similar to: “advertising” in Class 35</p>
<p>“artwork design”,</p>	<p>Low degree of similarity to “advertising”</p>
<p>“information, advisory and consultancy services relating to all the aforesaid services”</p>	<p>Low degree of similarity to “advertising”, or finding to reflect the individual findings on each service</p>

Likelihood of confusion

74. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK being the prime example.
75. The earlier mark comprises two words, ALPHA IMPACT. As I have already said in my assessment of similarity of marks the two words are, linguistically speaking, independent of each other. That said, in trade mark terms, ALPHA is the dominant, distinctive word. The word 'IMPACT' has laudatory connotation and has a readily comprehensible meaning. Nevertheless, it still has at least an average degree of distinctiveness. Given its independence, its average level of distinctiveness and the fact it is not submerged or otherwise rendered de minimis in the combination of the two words, I must take account of the guidance provided in the case law (see in particular section (f) of para 29 above which refers to the *Medion* case).
76. I am aware, of course, that in the *Medion* case, the Court were considering the situation where there is an independently distinctive element in a *later* mark which is common to the earlier mark. In this situation it is an independently and averagely distinctive element which is in the *earlier* mark. At the same time, and in this particular case, I need to give due recognition to the principle in *Medion*. It does not mean of course that likelihood of confusion automatically follows once there is a shared, and averagely distinctive, independent element. It is however a factor in the overall global assessment of likelihood of confusion.
77. At this point I need to remind myself of my other various findings and factors and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.
78. I have found that the respective services are identical, highly-similar, similar to a low degree or not similar at all. I have made observations on the respective average consumers, namely that they are also identical and I have found the purchasing process to involve considered purchasing. Finally, I have found the respective marks to share a moderate degree of similarity. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in one parties favour, it inevitably wins. All factors must be weighed in the evaluation of likelihood of confusion.

79. Nonetheless, in all the circumstances **I find there is a likelihood of confusion in this case for all services that are identical or highly similar. For those services found to be only ‘similar’ or ‘similar only to a low degree’ or ‘not similar’ the opposition fails. For the avoidance of doubt, as regards the, “information, advisory and consultancy services relating to all the aforesaid services” in class 42 and in light of my contingency observation, the opposition succeeds except in relation to “artwork design”.**

80. This finding reflects expressly the *Medion* principle to which I have referred, given the independent nature of the word ‘IMPACT’. Of course, I recognise that in *Medion* the relevant goods/services were identical and not merely highly similar, but this cannot mean that the *Medion* case precludes a finding of likelihood of confusion against goods/services that are only highly similar.

81. At this point I need to consider the argument put by IMDMS to the effect that the absence of actual confusion prior to the date of filing and during which IMDMS’s mark was in use is a factor mitigating against likelihood of confusion.

82. Whilst it is well established that evidence of what is often referred as “parallel trading” may be a relevant factor, such evidence needs to establish that the respective marks have actually been put to use in the same market (as opposed to the notional use which is normally considered), without the consumer being confused regarding economic origin. If such evidence is forthcoming this can inform the tribunal’s decision. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace, however, this should be tempered by a number of decisions which express caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paras 42 to 45.) In the first of the above cases 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.”

83. In the circumstances, the evidence does not establish that the respective marks have been put to use in the *same* market circumstances. Although not a factor in my assessment of likelihood of confusion, which is necessarily a notional assessment based on the marks applied for and registered and their specifications; in the real market place, plainly IMDMS are a design company and Alpha is a recruitment agency.

84. Taken in the round, although IMDMS can lay claim to a presence on the internet over a period, the scale of their operation is not large by any means and appears to be centred around Essex and Southend in particular. Furthermore, it is clear from the evidence that the mark in use by IMDMS has varied over the years, often incorporating the words 'MEDIA' and/or 'DESIGN' and sometimes presented as just the stylised letters, 'IMD'. The fact that the phones for example are answered with the word "IMPACT" is natural, aural abbreviation and should not be taken to be indicative of every way, including in advertising, the company has presented itself or is known. The company has also used a variety of website addresses. The different variant uses, two of which I have reproduced, by IMDMS, together with its localised focus and the different areas of the parties' *actual* activity inevitably all militate against any 'parallel use' argument. In consequence, I do not find this to be a factor which would disturb my overall finding of likelihood of confusion as at para 79.

Costs

85. Alpha has been largely successful in its opposition. Accordingly, it is entitled to a contribution towards its costs and neither party sought costs off the normal scale. In the circumstances I award Alpha Impact Ltd the sum of £1,000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

1. Statutory fee for filing opposition - £200
2. Considering counterstatement- £ 200
3. Evidence - £300
4. Filing written submissions - £300

Total £1,000

86. I order IMDMS Ltd to pay Alpha Impact Ltd the sum of £1,000. The sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 06 day of September 2011

**Edward Smith
For the Registrar,
the Comptroller-General**