

O-493-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3024934 BY
DESIRE2LEARN INCORPORATED**

TO REGISTER:

INSIGHTS

**AS A TRADE MARK
IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000090 BY
THE INSIGHTS GROUP LIMITED**

BACKGROUND

1. On 4 October 2013, Desire2Learn Incorporated (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application, which claimed an International Convention priority date of 8 April 2013 (from Canada), was published for opposition purposes on 3 January 2014, for the following goods and services:

Class 9 - Computer software in the field of online educational courses and learning management; computer software, namely, computer programs and program platforms for creating, conducting, providing, and analyzing electronic learning online data, content and course material for use online; computer programs and platforms for creating and providing electronic learning online data, content and course material for use online over global information networks; computer programs for establishing and administering educational online courses of instruction, including programs for use and analysis in the development of course syllabus, course materials, and course content; computer programs and platforms for use in conducting online communications between course administrators, teachers and students; computer programs and platforms for use in enabling and facilitating online payment for electronic learning programs; computer programs and platforms for use in self enrollment and registration for and in online electronic learning courses of instruction; computer programs and platforms for use in student assessment, student evaluation and student review of grade results in completed online electronic learning courses of instruction; computer programs and platforms for use in comparative statistics of student achievement.

Class 41 - Educational services, namely, conducting online exhibitions and displays and interactive exhibits in the field of computer programming, and electronic learning programs and platforms.

2. The application is opposed by The Insights Group Limited (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the goods and services in the application, is based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon the goods and services shown below in the following Community Trade Mark (“CTM”) registration:

CTM no. 7120661 for the trade mark: **Insights** which was applied for on 1 August 2008 (claiming an International Convention priority date of 2 May 2008 from the USA) and for which the registration process was completed on 5 January 2012:

Class 9 - Electronic publications; computer software in the field of individual, team and organisational development and HR consulting.

Class 16 - ...instructional and teaching materials.

Class 41 - Organisation and arranging of seminars, workshops, training sessions, conferences and symposiums, congresses and colloquiums; educational information; educational services; publication of books and texts; all of the aforementioned in the field of people (but not personal relationship) and organisational development; arranging training courses; training and seminars for personnel and business assessment, consultancy and development; presentation skills training; team building training; career consultancy; training service in relation to conflict and stress management; sales training.

3. In its Notice of Opposition, the opponent states:

Identity/Similarity of the Marks

The mark applied for is identical to the opponent's earlier mark. In accordance with the judgment in the LTJ Diffusion SA v Sadas Vertbaudet SA case, C-291/00, a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer. Accordingly, the fact that the opponent's earlier mark is registered in upper and lower case, namely as "Insights" and the mark applied for appears in upper case only, namely as "INSIGHTS", the differences between the marks are so small that they are likely to go unnoticed by the average consumer, especially given that both marks could be used in either formats.

Although the opponent also comments upon what it considers to be the identity/similarity in the competing goods and services, for reasons which will shortly become obvious, there is no need for me to comment upon this aspect of the opponent's case at this point in my decision.

4. On 14 May 2014, the applicant filed a Form TM21B to amend its specification of goods and services. It requested that class 41 be deleted from the application and that class 9 be amended to read:

Computer software in the field of online educational courses and learning management, namely, software for enabling educational institutions to collect, analyze, predict, visualize and report on educational outcomes and interactions.

5. The opponent having confirmed that the above amendments did not dispose of its opposition, the applicant filed a counterstatement, in which it stated:

1. The Applicant admits the existence of the Opponent's earlier registration CTM 7120661 INSIGHTS but makes no admissions as to its validity.
2. The application in suit has been amended. The application is now in respect of class 9 only and for a very specific specification reading:

"Computer software in the field of online educational courses and learning management, namely, software for enabling educational institutions to collect, analyze, predict, visualize and report on educational outcomes and interactions".

3. The Applicant admits that the applied-for mark is identical to the Opponent's earlier mark.
4. The Applicant denies that the goods remaining in the application are similar to ANY goods and services in the earlier registration in classes 9, 16 and 41 as claimed in Q12 of the notice of opposition.
5. The Applicant's computer software is highly specialised and has limited application since it is a tool for eg. universities and colleges to collect and process data on educational outcomes eg. examinations and continual assessment in educational courses. The applicant's computer software is not educational in nature. It does not teach or instruct. It is a piece of analytical and data management software.
6. All claims made in the notice of opposition are denied unless expressly admitted.

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. In an official letter dated 27 June 2014, the Tribunal allowed the parties until 11 July 2014 to seek leave to file evidence and/or to request to be heard; a period expiring on 28 July 2014 was allowed for the parties to file written submissions. Following a request from the applicant for additional time, the Tribunal, in an official letter of 23 July 2014, extended the period allowed for the parties to request leave/ask to be heard/file written submissions to 28 July and 11 August 2014 respectively. On 28 July 2014, the applicant wrote to the Tribunal seeking leave to file evidence in support of its application. The operative part of that letter reads:

Computer software in class 9 is a very tricky area where comparison of goods and services is involved, as the breadth of software types and the very different nature of software and its applications means that software used in practically all commercial areas are combined under one class heading and described in the Nice Classification "List of Classes, With Explanatory Notes" as "all computer programs and software regardless of recording media or means of dissemination, that is, software recorded on magnetic media or downloaded from a remote computer network".

The Registrar cannot possibly have an all encompassing knowledge about computer software (unlike for say clothing or motor cars) so it is appropriate that evidence is filed which will assist in understanding the computer software in respect of which registration is sought.

The evidence the Applicant wishes to file will be a Witness Statement by an Officer of the company giving information about the computer software sold under the trade mark INSIGHTS namely, the nature and function of the software, the nature of the relationship between vendor and purchaser and the nature of the purchasing decision. These all have a bearing on the issue of similarity of goods and services. The statement will be only a few pages long and may be accompanied by a modest number of exhibits.

Having the evidence will enable the Registrar to make a decision on fact rather than supposition. It is the writer's experience that this kind of additional information greatly assists the Registrar in the decision-making process and that it is appreciated.

8. On 11 August 2014, the applicant filed written submissions. In an official letter dated 13 August 2014, the Tribunal issued a preliminary view to allow the applicant to file the evidence described above giving it a period of 14 days to do so and copy it to the opponent. On 26 August 2014, the applicant filed two witness statements and amended written submissions. In an official letter dated 4 September 2014, the Tribunal, inter alia, acknowledged the applicant's evidence and allowed the opponent until 9 September 2014 i.e. 14 days from the receipt by it of the applicant's evidence, to object to the preliminary view and request a hearing, to seek leave to file evidence of its own or to do nothing. As the opponent did not respond to that letter, in a further official letter dated 26 September 2014, the Tribunal allowed the parties until 10 October to file any written submissions they considered appropriate; on 10 October 2014, the opponent filed written submissions.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. As indicated above, both parties filed written submissions, which I will refer to, as necessary, below.

The applicant's evidence

10. In its letter of 28 July 2014, the applicant sought leave to file evidence. Its letter explained the reason why leave was being sought (see above) and the nature of the evidence it wished to file i.e.

“...a witness statement by an officer of the company giving information about the computer software sold under the trade mark...The statement will only be a few pages long and may be accompanied by a modest number of exhibits.”

It is on the basis of this request that leave was granted. However, when the applicant’s evidence was received, it consisted not only a statement of “an officer of the company” i.e. Mr Auger’s evidence (see below) but also a witness statement from Rigel Kate Moss McGrath, a trade mark attorney at WP Thompson, the applicant’s professional representatives; her statement is accompanied by two exhibits running to some 25 pages. The purpose of this statement is described as:

“3. I have been asked by the applicant to research the extent to which third parties use the word INSIGHTS as part of, or as a trade mark in the UK...”

11. Although this evidence was admitted into the proceedings, the applicant’s request to file evidence was very specific and (as far as I am aware) no leave has ever been sought by the applicant to file evidence of the type filed by Ms Moss McGrath. Notwithstanding the fact that the opponent has answered this evidence in its written submissions, as no leave has been sought by the applicant for this additional evidence, I do not intend to take the witness statement of Ms Moss McGrath (or any submissions from either party which flow from it) into account in reaching a decision; I will, however, comment upon it again when I consider costs.

12. The statement for which leave was sought and granted and which is taken into account, is from Jeremy Auger, the applicant’s Chief Strategy Officer. Mr Auger states:

“3. I have been asked to make this statement in support of my company’s application to register INSIGHTS as a trade mark in the United Kingdom, to provide specific details of the nature, purpose and characteristics of my company’s INSIGHTS software, in order that it may be fully and correctly compared to the goods for which the trade mark owned by the opponent is registered.

5. The INSIGHTS computer software developed by my company collects and analyses “learning” data generated by academic institutions, for the purpose of predicting and supporting the progress and performance of its students and improving the learning environment by way of personalised student learning and course improvements. The software provides operators with data access and risk forecasting, predictive modelling, optimisation and strategic functions in order to provide institutions with valuable analysis of aspects of learning such as content consumption, learning behaviours and student interaction.

6. INSIGHTS software is used by academic institutions not only to assess the academic progress of students, but also to identify potential problems or issues such as under-engagement, performance risk, social isolation, and/or the like.

7. INSIGHTS software is not used alone, but as part of a suite of an Integrated Learning Platform offered by my company.

8. My company can sell the INSIGHTS software via re-sellers, but also uses direct sales staff and consultants to sell direct to academic institutions. In fact, *typically* my company responds to tender requests from institutions.

9. Access to the software is provided to the Institutions by way of term licenses. The licence pricing structure can be based on a “per user basis” or a “fixed fee basis”, both being negotiable. The number of users in any given institution usually ranges between 100-10,000 but could be unlimited. In addition to the licence fee there are consultancy fees and installation fees associated with the INSIGHTS product.”

13. Exhibit JA1 consists of what Mr Auger explains are screen shots from the INSIGHTS software (which were used in presentations made in the UK by the applicant in December 2013 and March 2014), demonstrating the manner in which the software can be used by operators to capture data.

DECISION

14. The opposition is based upon sections 5(1) and 5(2)(a) of the Act, which reads as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

(b)...

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

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

16. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As the opponent’s earlier trade mark had not been registered for more than five years when the application for registration was published, it is not subject to proof of use, as per section 6A of the Act. As a consequence, the opponent is entitled to rely upon all of the goods and services for which its earlier trade mark is registered, although, in this case, it limits the basis of its opposition to those goods and services referred to in paragraph 2 above.

Comparison of trade marks

17. As the opponent pointed out in its Notice of Opposition, in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

18. In its counterstatement, the applicant admits that the competing trade marks are identical. As the application is for the trade mark INSIGHTS in upper case and the opponent’s earlier trade mark is for the same word albeit in title case, that is, on the basis of the guidance in *Sadas*, a sensible concession with which I agree.

Comparison of goods and services

19. The competing goods and services are as follows:

Opponent’s goods and services	Applicant’s goods
<p>Class 9 - Electronic publications; computer software in the field of individual, team and organisational development and HR consulting.</p> <p>Class 16 - ...instructional and teaching materials.</p> <p>Class 41 - Organisation and arranging of seminars, workshops, training sessions, conferences and symposiums, congresses and colloquiums; educational information; educational services; publication of books and texts; all of the aforementioned in the field of people (but not personal relationship) and organisational development; arranging</p>	<p>Class 9 - Computer software in the field of online educational courses and learning management, namely, software for enabling educational institutions to collect, analyze, predict, visualize and report on educational outcomes and interactions.</p>

training courses; training and seminars for personnel and business assessment, consultancy and development; presentation skills training; team building training; career consultancy; training service in relation to conflict and stress management; sales training.	
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20. In its submissions, the opponent states:

“7...When looking at the specification of goods in class 9 of the earlier mark as drafted, it is clear that computer software refers both to the field of individual, team and organisational development and to the field of HR consulting.

8. The computer software designated by the marks in conflict is identical since the applicant's software is fully included in the opponent's software. Providing educational courses and learning management is included in providing personal and organizational development. Also, enabling institutions to analyse data and report on educational outcomes forms part of individual, team and organisational development. This is because individual, team and organizational development includes educational development. It is impossible to exclude educational development from personal development...

9. In the alternative, the similarities between the applicant and the opponent's software are obvious. Both sets of goods are software for use in relation to the development/education of individuals.

10. The witness statement of Mr Auger supports the claims of the opponent. Mr Auger states at paragraph 5 that the purpose of the software is to predict and support the progress and performance of students and improve their learning environment. Therefore, the purpose of the software of the applicant is to monitor the development of students. This is the same purpose as that of the software of the opponent. Essentially, they both help users to get the best out of the people to whom the software is targeted by monitoring their performance, progress and development.”

Insofar as it services in class 41 are concerned, the opponent states:

“12. The services in class 41 of the opponent's trade mark are similar to the goods in class 9 of the applicant. The specification of services covers, inter alia, “educational information; educational services”. The opponent's (sic) goods in class 9 are for use in the field of education and therefore they are similar to the educational information and educational services of the opponent.”

21. In its written submissions, the applicant states the following in relation to the clash between the competing software in class 9:

“11. The earlier computer software has been limited to a very specific area of HR use. It is clearly intended for HR departments to assess staff development

and progress within companies and organizations from a personnel point of view.

12. The applicant's software is not a product for HR departments within companies and organizations. Rather it is a data management tool for recording and managing the grades and exam results achieved by students on particular educational courses. It is sold to educational institutions which run courses to which students subscribe. It is most particularly not an HR product and would not be sold to HR departments for personnel monitoring. Therefore the respective products have a different purpose – one monitors personnel development within an HR context and the other provides a record of student outcomes on educational courses..."

In relation to the clash between its software and the opponent's services in class 41, the applicant states:

"15. Class 41 specifically covers educational services of one type or another. The educational services in the opponent's earlier registration are limited by the term "in the field of people (but not personal relationship) and organisational development". This is clearly a reference to education in HR and is a teaching/instruction service. The applicant's product is data management software. It is not a teaching tool. It does not teach and is not used in the process of teaching. Thus, not only are the goods not identical but there is no similarity because of the nature of the computer software and its intrinsic functionality. Educational services which focus on people and organizational development are two steps away from the applicant's computer software. Not only is the applicant's software not a service but it is not a product which could be used for the purposes of educating."

22. The use of the word "namely" in the applicant's specification must be approached, as indicated in the Trade Mark Registry's classification guidance, on the following basis:

"Note that specifications including "namely" should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above "dairy products namely cheese and butter" would only be interpreted as meaning "cheese and butter" and not "dairy products" at large. This is consistent with the definitions provided in Collins English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are"."

Thus, the applicant's specification must be interpreted as:

"Software for enabling educational institutions to collect, analyze, predict, visualize and report on educational outcomes and interactions."

23. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

24. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

25. In my view, the applicant's argument proceeds on a false assumption i.e. that the opponent's computer software "has been limited to a very specific area of HR use" and is, as a consequence, "clearly intended for HR departments to assess staff development and progress within companies and organizations from a personnel point of view." Rather, the opponent's specification in class 9 must be interpreted, as the opponent suggests, as referring both to the "field of individual, team and organisational development" **and** to the field of "HR consulting" (my emphasis). Computer software for use in the field of individual, team and organizational development is, in my view, broad enough to include within its scope computer software to enable an educational establishment to monitor educational outcomes and interactions. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court ("GC") stated:

"29 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)."

26. As the applicant's computer software is included, in my view, within the broader category of computer software as specified in the opponent's earlier trade mark, the competing goods must, on the principles outlined in *Meric*, be regarded as identical.

As the applicant admits that the competing trade marks are identical, **the requirements of section 5(1) of the Act are satisfied and the opposition succeeds accordingly.**

27. However, what if it is felt that I have interpreted the opponent's specification too broadly? In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary', and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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

28. When one considers, inter alia, the users and intended purpose of both the applicant's software and (at least) the following of the opponent's services "educational information... all of the aforementioned in the field of people (but not personal relationship) and organisational development", there is, in my view, a clear symbiotic relationship which results in a high degree of similarity between the applicant's software and (at least) the opponent's services mentioned. Given the identity in the trade marks, and irrespective of the nature and traits of the average consumer or the inherent distinctive character the earlier trade mark possess, it would, in my view, inevitably result in a likelihood of direct confusion and **the opposition also succeeds under section 5(2)(a) of the Act.**

Overall conclusion

29. **The opposition based upon both sections 5(1) and 5(2)(a) of the Act succeed and, subject to any successful appeal, the application will be refused.**

Costs

30. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but keeping in mind that the opponent provided written submissions in relation to evidence provided by the applicant for which leave was never granted, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£100
Written submissions:	£300
Total:	£600

31. I order Desire2Learn Incorporated to pay to The Insights Group Limited the sum of **£600**. 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 November 2014

C J BOWEN
For the Registrar
The Comptroller-General