O-522-14

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION 3011727
IN THE NAME OF WNS GLOBAL SERVICES (UK) LIMITED
OF THE FOLLOWING TRADE MARK IN CLASS 9:

PROGENIE

AND

AN APPLICATION FOR INVALIDITY (NO. 500272) BY O2 HOLDINGS LIMITED

Background and pleadings

1. This dispute concerns trade mark registration 3011727 which consists of the mark **PROGENIE** and which was filed by WNS Global Services (UK) Limited ("the proprietor") on 27 June 2013. The mark was entered on the register on 4 October 2013. The mark is registered in respect of the following class 9 goods:

> Application software; Interface software; Computer programmes; Computer interfaces; Application software; Computer software [programmes]; Data processing software.

2. O2 Holdings Limited ("the applicant") requests the invalidation of the above registration on a ground under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"); this ground is relevant in invalidation proceedings on account of the provisions of section 47(2) of the Act. The applicant relies on two trade marks[1], both of which consist of the word **GENIE**. The two marks cover a range of goods and services, I will detail later those upon which the applicant primarily relies. Both marks have dates of filing prior to the applied for mark and, thus, constitute earlier marks in these proceedings. Furthermore, the earlier marks completed their registration procedures within the five year period preceding the date of the application for invalidity so meaning that there is no requirement to establish that the earlier marks have been genuinely used; the earlier marks may be relied upon for all of the goods and services for which they are registered. It should be noted that the applicant originally relied on the same earlier marks as the basis for a claim under section 5(3) of the Act but, as it filed no evidence, the claim was struck out.

3. The applicant filed a counterstatement denying the claims made. Its statement in defence includes the following comments:

- The comparison cannot be made on the basis of GENIE alone, the whole of the marks must be compared.
- That the proprietor's mark is used with a logo and will be used with the name of the proprietor, so providing more distinguishing power.
- PROGENIE is used for a product which facilitates the viewing of websites. There is no conceptual similarity between this usage and the earlier marks.
- That the goods are not similar.
- The earlier marks cover a broad range of goods which do not specifically include computer programs.
- The PROGENIE product is a plug-in used in various platforms and the applicant has not provided evidence showing that they use the mark on anything similar.
- The proprietor's goods are "highly specialized and industrial specific". They are not over the counter goods. This lessens the likelihood of confusion.

4. Neither side filed evidence. The proprietor filed written submissions, mirroring, essentially, what was stated in its counterstatement. A hearing then took place

[1] UK registration 2587310 and Community Trade Mark ("CTM") registration 10113009

before me on 17 October 2014, with the applicant represented by Mr Julius Stobbs of Stobbs; the proprietor was represented by Mr Michael Ellis of Ellis IP Limited.

Decision

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

> "5.-(2) A trade mark shall not be registered if because –
> ..
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

6. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

> (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
>
> (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
>
> (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
>
> (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
>
> (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
>
> (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods/services

7. When making a comparison, all relevant factors relating to the goods/services should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include*, inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

8. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

> "(a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

9. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensible for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

> "It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi* v *OHIM – Sissi Rossi* (*SISSI ROSSI*) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi* v *OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam* v *OHIM – Propamsa* (*PAM PLUVIAL*) [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés* v *OHIM – Bolaños Sabri* (*PiraÑAM diseño original Juan Bolaños*) [2007] ECR I-0000, paragraph 48)."

10. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* were he warned against applying too rigid a test:

> "20. In my judgment, the reference to "legal definition" suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*."

11. I also bear in mind the principle that derives from the judgment of the General Court in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 – "*Meric*") in that, when comparing goods/services, if a term clearly falls within the ambit of a term in the competing specification then identical goods/services must be considered to be in play.

12. The proprietor's mark is registered in respect of:

> Application software; Interface software; Computer programmes; Computer interfaces; Application software; Computer software [programmes]; Data processing software.

.

13. No fall back specification was advanced by the proprietor prior to the hearing, not even in its skeleton argument. This is so regardless of the fact that in its counterstatement it indicated that its product "facilitates the viewing of websites across various platforms" and is "essentially a plug-in to be used in various platforms/interfaces". At the end of the evidence stage of the proceedings, the tribunal wrote to both sides on 1 August 2014 asking them, essentially, whether a hearing was required to deal with the substantive matter (the alternative being that a decision could be made from the papers). In this letter the following text appears in bold print:

> **"The decision in relation to this case will be made on the basis of the evidence and/or submissions now accepted into the proceedings. The Hearing Officer will decide the case on the specification currently before him or her. If, however, the registered proprietor considers it has a fall-back position in the form of a limited specification, it should make this clear to the Hearing Officer (i.e. a limited specification should not be submitted for the first time at any appeal hearing). This will not represent a binding restriction of the specification and no inference will be made, by the Hearing Officer, if such a limitation is, or is not, offered."**

14. Despite all this, Mr Ellis, during the course of the hearing, made an explicit request to amend the term "computer software [programmes]" to read:

> Computer software [programmes] for web-analytic plug-ins.

15. Mr Stobbs was not impressed with the limitation being put in during the course of the hearing. I was not impressed either. However, despite Mr Stobbs' submission that the amendment ought not be allowed, I do not consider I have the power to refuse the amendment. In a similar way that an applicant can amend its goods and services under section 39 of the Act, the proprietor of a mark has the right to surrender a registered mark in respect of some or all of its goods/services (section 45(1) refers). It is not as though a decision had yet been reached in these proceedings in which case I would have been *funtus* in terms of doing anything about the decision. Neither is it the case that this is just a fall-back, the request was to amend the term. Therefore, I consider duty bound to consider the matter on the basis of the specification as amended. I must, though, guard against any prejudice that may be faced by the applicant for being ambushed at the hearing. I will go through the proprietor's terms one by one:

16. *Application software* – In its skeleton argument the proprietor provided some computing dictionary references[2] which demonstrate that application software is, essentially, software that performs a particular task and which is executed by the system or operating software of a computer (or computing device). Examples include spreadsheets and word processing applications. There are, of course, huge numbers of examples that could be listed. Mr Ellis argued that this was distinct from the only item of software included in the specification of the earlier marks, namely: "driver

[2] Although not filed in evidence, I was prepared to consider them because they are the sort of references a hearing officer is entitled to refer to when reaching a decision.

software for telecommunications networks and for telecommunication apparatus", the term which Mr Stobbs initially focused upon. Mr Ellis considered this to be akin to system software and which runs in the background without being noticed by the user. Whilst I agree that there is a distinction and that these goods are not identical, the term application software is so broad that it encompasses application software which facilitates or assists the user in relation to telecommunication network devices. Therefore, whilst the exact purpose is different, they could both operate in conjunction with the same devices and could be provided to the same users in the same way (on a CD for example). The user may install the application and run it from time to time (for example, to see the network status or to amend settings) whilst the driver will be installed to drive the device, but this still introduces some complementarity. From this perspective, the goods are similar to a reasonably high degree.

17. *Interface software* – Mr Ellis submitted that this term covered things such as plug-ins, which work in conjunction with application software to provide extra functionality, an example was given of *Java*. Whilst this may be so, the term is another broad one and will cover any type of software which interfaces not only with other application software, but also software which interfaces with hardware, including telecommunication network devices. As such, and for similar reasons as above, I consider there to be a reasonably high degree of similarity between these goods and "driver software for telecommunications networks and for telecommunication apparatus" of the earlier marks.

18. *Computer programmes* – Mr Ellis accepted that these goods were to be considered as identical to the driver software in the specifications of the earlier marks.

19. *Computer interfaces* – Mr Ellis argued that these goods were types of software. To the extent that they are then the same finding applies as per interface software above. However, an interface could also be a computer device which links (or interfaces) with something else. This would in my view be covered by the earlier marks "data processing equipment" which is broad enough to cover the registered term (to the extent that the interface could be used in a data processing environment). The goods are therefore identical (or else similar to a very high degree) from the perspective that these are hardware computer interfaces.

20. *Data processing software* – Mr Ellis accepted that this covered a broad range of purposes and he did not really dispute that the goods of the earlier mark were included within it. I find that the goods are identical (with "driver software for telecommunications networks and for telecommunication apparatus"). Even if this were not so, Mr Stobbs also highlighted that the earlier mark covers data processing equipment; as such, equipment and software which are both aimed at data processing functions, even though the nature may be different, means that there is a high level of similarity in terms of purpose, channels of trade, users etc.

21. *Computer software [programmes] for web-analytic plug-ins* – This is the term that Mr Ellis amended at the hearing. He accepted that without amendment the term was a broad one and that it would have been treated as per computer programmes above. However, one is now faced with a specific type of software. Mr Stobbs still felt

that there was some similarity between these goods and his goods (the drivers) on the basis that all these sorts of software could be used on similar devices etc and the responsibly for them would be put down to the same or an economically linked undertaken. He also referred to there being some similarity with data processing equipment. I am not overly persuaded by these arguments as they fail to reflect the true purpose of the (amended) goods. However, Mr Stobbs also highlighted that the earlier marks covers computer programming at large. He argued that a consumer could choose between obtaining something for web analytic purposes (including plug-ins) either off-the-shelf, or, alternatively, something more bespoke from the provider of a computer programming service. I think there is some force in this. It is common practice for businesses in particular to make such an election depending on the exact requirements they need in a software solution. I consider there to be a reasonable degree of similarity. Mr Stobbs mentioned other services also, such as various web services such as creating and hosting websites, telecommunications services etc, but I do not consider that they put the applicant in any better position.

Average consumer and the purchasing act

22. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.* In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

23. The average consumer in this case could be a member of the public or a business. In respect of the amended term, it is more pertinent to consider a business user. I consider at least a reasonable degree of care and attention will be used. If the services of a computer programmer were to be used then a higher degree of care and attention will be used. The visual impact of the marks will likely take on more importance as the goods/services will most often be encountered on websites, in computer stores, in brochures etc, although, I will not ignore the aural impact of the marks completely.

Distinctive character of the earlier trade mark(s)

24. The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s), based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma*

AG, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

25. From an inherent perspective, the word GENIE has no obvious descriptive or even allusive connotations for the goods/services relied upon. It could be said that a GENIE is a magical being and so the mark has a laudatory connotation, however, I think that this view would only be taken after a high degree of analysis which the average consumer would not ordinarily deploy. I consider the earlier mark to have at least a reasonable degree of inherent distinctive character. Mr Ellis did attempt to provide evidence in his skeleton argument of other undertakings using the word GENIE in their names, by way of an extract from a business directory. I rejected the filing of this "evidence" as there was no good reason why it could not have been provided earlier and, in any event, its usefulness was limited as the actual use in the course of trade (as opposed to just listings) was not set out and little could be taken from it in terms of the impact upon the average consumer. No use of the earlier marks has been presented so there is no evidence that the distinctive character of the earlier marks has been enhanced.

Comparison of marks

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

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by

means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

Proprietor's mark	Applicant's mark
PROGENIE	**GENIE**

28. In terms of the overall impression of the proprietor's mark, although it is presented as one word, the average consumer will appreciate that it is composed of the words PRO and GENIE, albeit conjoined. Mr Ellis submitted that it would be read through as one word (as a play on the word PROGENY) and not seen in the way I have just described. Mr Stobbs argued to the contrary, highlighting that in the applicant's actual use (as outlined in its counterstatement) emphasis is given to the separation of the words. I agree with Mr Stobbs' view because the average consumer is more likely to focus on and see words they know as opposed to over-analysing the mark and making an approximation to another word. In any event, notional and fair use of the PROGENIE mark word include use in upper and lower case that would put the point to bed. Finally, I note that in the applicant's counterstatement it appears to accept the point as it states "Progenie comprises of two dominant components "PRO" and "GENIE". The blend of meaning and significance of this combination is that the word PRO is qualifying the word GENIE, a word indicative of a magical being. The overall impression of the applicant's marks will be based upon its single component, the word GENIE per se.

29. From a visual perspective, the proprietor's mark is noticeably longer than the earlier mark(s) as it has the additional letters/word PRO at the beginning. However, they do share the letters/word GENIE which creates an inevitable degree of similarity. I consider there to be a reasonable, but not high degree of visual similarity. The same assessment follows through to the aural comparison as the GENIE element will be pronounced in the same way, but there is a difference on account of the additional articulation of the word PRO in the proprietor's mark. Conceptually, both marks make reference to a genie, a mythical/magical being, although, in the proprietor's mark the word is qualified by PRO which is most likely, as Mr Stobbs submitted, to be seen as an abbreviation of the word PROFESSIONAL. Both marks making reference to a genie gives a reasonably high degree of conceptual similarity.

Likelihood of confusion

30. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment

of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG,* paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

31. In relation to the goods I have found to be identical, highly similar and similar to a reasonably high degree, I conclude that there is a likelihood of confusion. This is particularly so when one bears in mind that the word PRO is an essentially descriptive element which, when imperfect recollection is borne in mind, means that the PRO element may be forgotten about because the most memorable part of the respective marks is the word GENIE. Even if the marks were more perfectly recalled and the PRO element not overlooked then one must also bear in mind indirect confusion which Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 described thus:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

32. The addition of the word PRO to the word GENIE falls squarely in the second category identified above, the competing mark being seen as, effectively, the PRO version of the GENIE product. In relation to the term amended at the hearing, I have found there to be a reasonable degree of similarity with computer programming. Even here I consider there to be a least a likelihood of indirect confusion on a similar

basis to that above. **The application for invalidation succeeds in full and the registration, in accordance with section 47(6), is deemed never to have been made.**

Costs

33. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Fee for application - £200

Attending the hearing - £500

***Total* - £1000**

34. I therefore order WNS Global Services (UK) Limited to pay O2 Holdings Limied the sum of £1000. The above 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 10th day of December 2014

Oliver Morris
For the Registrar,
The Comptroller-General