

O-336-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2600308A  
BY  
GARDNER DC SOLUTIONS  
TO REGISTER THE TRADE MARK

**IMODULUS**

IN CLASSES 9, 37 AND 42

AND

THE OPPOSITION THERETO  
UNDER NO 103259  
BY  
MODULUS MANAGEMENT CONSULTANCY LIMITED

## BACKGROUND

1. On 4 November 2011, Gardner DC Solutions (hereafter the applicant), applied to register the above trade mark in classes 9, 37 and 42 of the Nice Classification system, as follows:<sup>1</sup>

### **Class 9**

Computer software and computer hardware; apparatus for data storage; CRM, CAM, CAD, estimating, stock control, tracking and bar coding software; software including building services solutions, data storage solutions, duct work, piping, electrical and equipment libraries; estimating software including customised cost reports; digitised software interfaces; software including bar code, printing, tracking, monitoring and reporting software for every stage of the production process, and order tracking from production to delivery.

### **Class 37**

Repair, servicing and maintenance services.

### **Class 42**

Provision of technical support and professional consultation services relating to the design, manufacture, production and supply of data storage vault solutions, data storage and associated machines, machinery, plant and software including via telephone and remotely; development of systems for the storage of data.

2. Following publication of the application on 27 January 2012, Modulus Management Consultancy Limited (hereafter the opponent) filed notice of opposition against the application.

3. The ground of opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4. The opposition is directed at all of the applicant's goods and services in classes 9, 37 and 42. The opponent relies upon the mark, goods and services shown below:

<b>Mark details</b>	<b>Goods and services relied upon</b>
CTM: 8139073 Mark: <b>MODULUS</b> Filed: 5 March 2009 Registered: 22 November 2009	<b>Class 35:</b> Business management services; business administration services; stock control services; stock pricing services; business pricing services; business services relating to the operation and management of call centers; data capture services; data maintenance services; data processing services; information and advisory services relating to all of the foregoing. <b>Class 42:</b> Computer software programming services; design of software; updating of software; installation of software; maintenance of software design and development of data processing systems; data security services; information and advisory services relating to all of the foregoing.

<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

5. On 7 August 2012, the applicant filed a counter statement. It denies the grounds on which the opposition is based.

6. The opponent's mark is an earlier mark not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.<sup>2</sup>

7. Both parties filed evidence. The opponent filed submissions in lieu of attendance at a hearing. Neither party requested a hearing, both content for a decision to be made from the papers on file.

## **EVIDENCE**

### **The opponent's evidence in chief**

8. The opponent's evidence consists of a witness statement by Sally Cooper, a trade mark attorney. It is dated 21 January 2013. It is accompanied by four pages which are not presented as exhibits.

9. The first two pages are a print of the opponent's mark, taken from the trade mark register on 19 October 2012. Ms Cooper has supplied the print to show that the opponent had not 'opted in' for notifications of other similar marks.

10. The third page shows a screen print of a google search result page which was returned following a search for 'gardner dc solutions imodulus'; the corner of the screen shows the date 19 October 2012. The fourth page is a print taken from the applicant company's website [www.gardner-dcs.com](http://www.gardner-dcs.com). The print appears to be taken of the 'homepage' and states, "Welcome to Gardner Data Centre Solutions, The home of the truly scalable & modular Data Centre 'iMODULUS'."

11. In her witness statement, Ms Cooper says of these two pages:

*"At today's date, the Applicant continues to use the form "iMODULUS" to advertise and sell its goods and services."*

### **The applicant's evidence in chief**

12. The applicant's evidence consists of a witness statement by Stephen Legge, the Managing Director of Gardner DC Solutions Limited. It is dated 20 March 2013. It is accompanied by three exhibits.

13. Exhibit SL1 consists of eleven pages which Mr Legge describes as:

*"2...designer drawings showing the data storage buildings and construction".*

14. The drawing show a series of large constructions, all of which have visible framework. The drawings are not dated and do not show the mark at all.

15. Exhibit SL2 consists of pages from the opponent company's website and two pages from the applicant company's website. The pages were accessed on 19 March 2013. The

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

first two pages are taken from www.modulus-ltd.org. The first does not show the mark, 'MODULUS' at all. It is a list of products which include, inter alia, 'stand alone PC systems', 'stock control', 'web solutions', 'systems consultancy'.

16. The second page of the exhibit shows the following:



17. The remaining two pages show 'Scalable Data Centre Solutions' available from the applicant company's website.

18. Mr Legge submits that the opponent company:

*"3...state their main market is automotive after-sales, an area which is neither complementary nor in competition with that where we offer our goods".*

19. Exhibit SL3 is a copy of the examination report for the applicant mark, which is dated 20 November 2011. Mr Legge states:

*"4...As can be seen, no earlier marks are cited."*

20. That concludes my summary of the evidence.

### **Preliminary points**

21. In her submissions on behalf of the opponent, under the heading 'B: Procedural', Ms Cooper states:

*"No part of the Counterstatement or of the Statement of Stephen Legge supplies information concerning the extent (if any) of use of the mark applied for prior to November 2011 being the date of Application."*

22. There is no requirement for the applicant to provide use of its mark. The applicant has five years from the date of registration in which to use its mark. This is the reason that an opponent relying on an earlier mark must, if requested, only prove use only where the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication of the application.

### **DECISION**

21. Section 5(2)(b) of the Act reads as follows:

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

## **Relevant case law**

22. In his decision in *La Chemise Lacoste SA v Baker Street clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

## **CJEU cases**

*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; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

## **The principles**

“(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 the nature of the purchasing act**

23. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of services at issue. The attention paid is likely to vary depending on price and, to some extent, the nature of the services and the frequency of the purchase.

24. The parties’ specifications cover a wide range of goods and services that can be aimed at an ordinary member of the public and/or to a more specialised commercial customer. In the case of a consumer seeking, for example, a data storage vault solution, there is likely to be a high level of attention paid to the purchase and considerable discussion prior to entering into the purchasing act. Such a purchase will be made by a business and will be very expensive and will require considerable planning. In contrast a member of the general public purchasing computer software is likely to pay a lower level of attention. That said, the purchasing act for all of the respective goods and services will be at least well considered as the average consumer, whether an individual or a commercial undertaking, will take note of, inter alia, the type of product or service, the cost, its capabilities, etc.

**Comparison of goods and services**

25. The goods and services to be compared are as follows:

<b>The opponent’s services</b>	<b>The applicant’s goods and services</b>
	<p><b>Class 9</b>            Computer software and computer hardware; apparatus for data storage; CRM, CAM, CAD, estimating, stock control, tracking and bar coding software; software including building services solutions, data storage solutions, duct work, piping, electrical and equipment libraries; estimating software including customised cost reports; digitised software interfaces; software including bar code, printing, tracking,</p>

	monitoring and reporting software for every stage of the production process, and order tracking from production to delivery.
<p><b>Class 35</b> Business management services; business administration services; business consultancy services relating to vehicles and vehicle sales and vehicle after-sales; vehicle fleet management services; stock control services; stock pricing services; business pricing services; business services relating to the operation and management of call centers; data capture services; data maintenance services; data processing services; information and advisory services relating to all of the foregoing.</p>	
	<p><b>Class 37</b> Repair, servicing and maintenance services.</p>
<p><b>Class 42</b> Computer software programming services; design of software; updating of software; installation of software; maintenance of software; design and development of data processing systems; data security services; information and advisory services relating to all of the foregoing.</p>	<p><b>Class 42</b> Provision of technical support and professional consultation services relating to the design, manufacture, production and supply of data storage vault solutions, data storage and associated machines, machinery, plant and software including via telephone and remotely; development of systems for the storage of data.</p>

26. Whilst the parties have made a number of comments about their respective areas of trade and its effect on the likelihood of confusion, in making a comparison between both parties' goods and services I must consider the opponent's specification as registered, since it is not subject to proof of use. This must be compared with the applicant's specification as it appears in the application.

27. I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

"67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed."

28. I am also mindful of the findings of the Court of First Instance (now General Court) in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-414/05:

"71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are

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

29. In comparing the goods and services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM)*, Case T-133/05, which while referring to goods is equally applicable in principle when considering the parties’ respective services:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

30. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

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

31. I also bear in mind the decision in *El Corte Inglés v OHIM* Case T-420/03, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685).”



32. I also take note of the case of *Les Éditions Albert René V OHIM T-336/03*, where it was held:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

33. Additionally, there is the guidance provided in *Avnet Incorporated v Isoact Limited* - [1998] F.S.R. 16 (HC):

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

34. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... 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."

35. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark BL O-399-10* (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

36. In its submissions filed in lieu of a hearing, the opponent states:

*“Proper analysis accordingly points to:*

*the parties both operating in the business-to-business sector and dealing with actual and potential customers through websites*

*the parties being in competition (rather than their business endeavours being complementary)*

*the parties both being involved in offering software / software systems / dedicated software solutions*

...On degree of similarity:

*“computer hardware and computer software” is similar to all of the ‘software’ services of the earlier mark and to “design and development of data processing systems”.*

*“apparatus for data storage is similar to “design and development of data processing systems” and “data capture services” and “data maintenance services” and “data processing services” and “data security services”.*

*“CRM, CAM, CAD, estimating, stock control, tracking and bar coding software” is similar to all the “software’ services of the earlier mark and to “stock control services” and “stock pricing services” and business pricing services” and is encompassed by “business management services” and “business administration services”.*

*“software including building services solutions, data storage solutions, duct work, piping, electrical and equipment libraries” is similar to all of the “software” services of the earlier mark and “design and development of data processing systems” and “data security services” and “data capture services” and “data maintenance services” and “data processing services” and is encompassed by “business management services” and “business administration services”.*

*“estimating software including customised cost reports” is similar to all of the “software” services of the earlier mark and to “stock control services” and “stock pricing services” and “business pricing services” and is encompassed by “business management services” and “business administration services”.*

*“digitised software interfaces” is similar to all of the “software” services of the earlier mark.*

*“software including bar code, printing, tracking, monitoring and reporting software for every stage of the production process and order tracking from production to delivery” is similar to all of the “software” services of the earlier mark and to “stock control services” and “data processing services” and is encompassed by “business management services” and “business administration services”.*

*“repair, servicing and maintenance services” is similar to the “information and advisory” services that support all of the services of the earlier mark and to “updating of software” and “maintenance of software”.*

*“provision of technical support and professional consultation services relating to the design, manufacture, production and supply of data storage vault solutions, data storage and associated machines, machinery, plant and software including via telephone and remotely” is similar to the “information and advisory” services that support all of the services of the earlier mark and to “business services relating to the operation and management of call centres” and “data capture services” and “data maintenance services” and “data processing services” and “data security services” and is encompassed by “business management services” and “business administration services”.*

*“development of systems for the storage of data” is similar to “design and development of data processing systems” and to all of the “software” services of the earlier mark.”*

### **The applicant’s services in class 42**

37. The term ‘development of systems for the storage of data’ in the application is clearly identical to ‘development of data processing systems’ in the opponent’s specification.

38. The applicant’s specification also includes, ‘provision of technical support and professional consultation services relating to the design, manufacture, production and supply of data storage vault solutions, data storage and associated machines, machinery, plant and software including via telephone and remotely’. This is essentially a technical support and consultation service in respect of data storage solutions and associated apparatus. The opponent’s specification includes the development of data processing systems and the associated information and advisory services. In my view these services are identical as both provide support and advice in the field of developing/designing data storage solutions.

### **The applicant’s goods in class 9**

39. The applicant’s class 9 goods are computer software and computer hardware at large and computer software and hardware for carrying out a range of activities. In class 42 the opponent has software programming and design of software. Dealing first with the applicant’s computer software, software is the end result of a software design and/or programming service. Such a relationship, which is complementary, is likely to be one where the average consumer regards the same undertaking as being the provider of both the goods and the services. Consequently, I find the applicant’s computer software to share a reasonable degree of similarity with the opponent’s software programming and design services.

40. The applicant’s specification also includes computer hardware in class 9. The opponent’s specification includes the development of systems for the storage of data. In my view such systems will include the software and associated hardware for the storage of such data. As I have discussed above, the average consumer is likely to regard the same undertaking as being the provider of the goods and services given their symbiotic relationship. I find there to be a reasonable degree of similarity between the applicant’s hardware and the opponent’s services in class 42.

### **The applicant’s services in class 37**

41. ‘Repair, servicing and maintenance services’ of the type that are included in the application include the repair and maintenance of computer hardware. The opponent has a registration for ‘maintenance of software’ in class 42. Both parties’ services are repair/maintenance services. Both will be used to repair an element of a computer or computer system, consequently the users are the same and the uses similar. There may be a difference in the service delivery in the sense that computer hardware is likely to require physical repair, whereas the software may require repair by a programmer and be carried out online through an update. However, both services may be provided by the same undertaking. In my experience a business offering computer repair is able to replace/repair a hard drive or reprogram faulty software in order to correct the running of a pc or laptop. There is a close relationship between the services as computers require

functional hardware and software in order to operate. Taking all of these factors into account, I find there to be a reasonable degree of similarity between these services.

### Comparison of marks

42. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
IMODULUS	MODULUS

43. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>3</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

44. In its submissions the opponent states:

*"The letter 'I' at the beginning of a word may be taken as an abbreviation for "interactive" or "intelligent".*

45. The opponent draws my attention to Stephen Legge's statement, in particular pages 3 and 4 of exhibit SL2, which refers to:

*"Gardner's iMODULUS truly scalable Modular Data Centre Solution..."*

46. And further submits:

*"a) that 'I' at the beginning of IMODULUS was, indeed, intended as an abbreviation for "interactive" or "intelligent", and*

*b) that the dominant and distinctive part of IMODULUS is, in fact, MODULUS."*

47. In making this comparison I must compare the applicant's mark as applied for and the opponent's mark as registered. The opponent's mark consists of the single word 'MODULUS', the applicant's consists of the single word 'IMODULUS'. Both are presented in plain block capitals. No part of either word is stylised or emphasised in any way. Consequently, the marks do not possess any distinctive or dominant elements: the distinctiveness of each mark lies in the mark as a whole.

### Visual and aural similarities

48. I have described the competing trade marks above. Both contain the letters "M, O, D, U, L, U, S. The opponent's mark will be pronounced MOD-YOU-LUS. The average consumer will pronounce the applicant's marks as EYE-MOD-YOU-LUS or IM-OD-YOU-LUS.

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<sup>3</sup> *Sabel v Puma AG, para.23*

49. In terms of the letters making up the marks the only difference between them is the letter “l” which appears at the beginning of the applicant’s mark. There is a general rule that the average consumer tends to place most importance on the start of a word<sup>4</sup>, but it is exactly that - a general rule, which can be mitigated depending on the circumstances of the case<sup>5</sup>. In this case, the fact that the applicant’s mark contains the additional ‘l’ at the beginning, is not sufficient to reduce the degree of similarity where both marks contain the letter string MODULUS and which is all of, or all but one of, the letters making up the mark.

50. Consequently, I find there to be a high degree of visual similarity and aural similarity between the parties’ marks.

### **Conceptual similarities**

51. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>6</sup> The assessment must be made from the point of view of the average consumer.

52. In its submissions the opponent states:

*“MODULUS is a word of the English language but not a word in everyday use.*

*It rarely (maybe never) appears on its own outside of a scientific context and has a high degree of distinctiveness in the context of use as a trade mark.”*

53. The Collins English Dictionary defines MODULUS in the following terms:

“1. Physics: a coefficient expressing a specified property of a specified substance. See bulk modulus, modulus of rigidity, Young's modulus.

2. Maths: another name for the absolute value (sense 2) of a complex number.

3. Maths: the number by which a logarithm to one base is multiplied to give the corresponding logarithm to another base.

4. Maths: an integer that can be divided exactly into the difference between two other integers: *7 is a modulus of 25 and 11*. See also congruence (2).

[C16: from Latin, diminutive of *modus* measure].<sup>7</sup>”

54. The average consumer cannot be assumed to know the meaning of everything. I am guided on this point by the *Chorkee* case (BL O-048-08), in which Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

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<sup>4</sup> *Les Editions Albert Rene v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM) Case T-336/03*

<sup>5</sup> *Castellani SpA v OHIM, T-146/06 and Spa Monopole, campagne fermiere de Spa SA/NV v OHIM, T-438/07*

<sup>6</sup> *This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIM [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.*

<sup>7</sup> *In Collins English Dictionary. Retrieved from <http://www.credoreference.com/entry/hcengdict/modulus>, accessed 5 August 2013.*

“36....By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

55. Similarly in this case, the meaning of the word MODULUS can be established very quickly, however, given the scientific nature of the word and the fact that it is not a common word in frequent use, I am not able to take judicial notice of the fact that the average consumer for the goods and services at issue would know its meaning. In my view the average consumer would consider the word ‘MODULUS’ to be an invented word.

56. As far as I am aware, the applicant’s mark, ‘IMODULUS’, is not a word which could be found in a dictionary. In light of my comments above, it is clear that the average consumer will consider this to be an invented word.

57. Taking all of these factors into account, I find the parties’ marks to be conceptually neutral.

### **Distinctive character of the earlier mark**

58. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been used as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

59. Having found that the opponent’s earlier mark will be considered an invented word by the average consumer, it follows that the word has no particular meaning in respect of the goods and services at issue. Consequently, I find the opponent’s mark to have a high degree of inherent distinctive character.

60. None of the evidence provided by the opponent allows any assessment of the use made of its mark, so I am unable to conclude whether the distinctive character has been increased through its use.

## Likelihood of confusion

61. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the average consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>8</sup> I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.

62. I have found the marks to be visually and aurally highly similar and conceptually neutral. I have found there to be a high level of inherent distinctive character in the earlier mark.

63. Given the nature of the parties' goods and services I have identified that the average consumer will include any members of the general public purchasing software and will also include business to business purchases buying expensive data storage solutions. The level of attention paid will vary from reasonable to very high depending upon the nature of the goods and services. I have found that some of the goods and services are identical, some are highly similar and some similar to a reasonable degree.

64. Taking all of these factors into account, and bearing in mind the concept of imperfect recollection, the similarity of the marks is such that in the context of identical or similar goods and services (even those where similarity is at a reasonable level) there will, in my view, be direct confusion (where one mark is mistaken for the other). Even if I am wrong in this, the similarity between the parties' marks is such that there will be indirect confusion (where the average consumer believes the respective services originate from the same or a linked undertaking).

## CONCLUSION

**65. The opposition succeeds.**

## COSTS

66. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and that minimal evidence and written submissions in lieu of a hearing were filed. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£200
Filing evidence and considering the other side's evidence	£200
Written submissions	£200
Official fee:	£200
<b>Total</b>	<b>£800</b>

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<sup>8</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27.

67. I order Gardner DC Solutions Limited to pay Modulus Management Consultancy Limited the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19th day of August 2013**

**Ms Al Skilton  
For the Registrar,**