

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2153285
BY WANTEK SOLUTIONS LIMITED (PREVIOUSLY SYZYGY
TELECOMMUNICATIONS LIMITED) TO REGISTER A SERIES OF MARKS
IN CLASSES 9, 35 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 48859
BY SYZYGY LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2153285
by Wantek Solutions Limited (previously Syzygy
Telecommunications Limited) to register a series of marks
in Classes 9, 35 and 42**

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**IN THE MATTER OF Opposition thereto under No 48859
by Syzygy Limited**

DECISION

1. On 11 December 1997 Syzygy Telecommunications Limited applied to register the following series of two marks:



2. The specification of goods and services reads:

Class: 09

Computer programs, software, magnetic media, tapes, discs, CD-ROMS, but none of the aforesaid goods relating to syzygy.

Class: 35

Advertising, marketing and promotional services.

Class: 42

Software writing, computer programming, licensing services, information technology consultancy services, but none of the aforesaid services relating to syzygy.

3. The application is numbered 2153285.

4. On 29 July 1998 Syzygy Limited filed notice of opposition to this application. There are two grounds of opposition under Section 5(4) and Section 3(6) of the Act. The opponents

rely on the fact that they have used the mark SYZYGY over a number of years on goods and services encompassing those specified in the application under attack. They also suggest that the applicant was aware of their reputation. It is the latter which is said to give rise to the Section 3(6) ground. It is clear from the generality of the Section 5(4) claim and the thrust of the opponents' evidence and submissions in relation thereto that the main ground of opposition relates to a claim in relation to the law of passing off (that is Section 5(4)(a)). There is also a reference to Section 5(4)(b) but I cannot see any basis for the latter.

5. The applicants filed a counterstatement denying the Section 5(4) ground. In relation to the Section 3(6) ground they make no admissions and put the opponents to strict proof.

6. Both sides ask for an award of costs in their favour.

7. Only the opponents filed evidence. Neither side has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Section 5(4)(a) reads:

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

8. The conventional test for determining whether the opponents have succeeded under this section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents' goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicants are goods of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

9. The very full guidance given in the *WILD CHILD* case by Mr Hobbs by reference also to Halsbury's Laws of England can be found at pages 460 and 461 of that decision.

10. The opponents have filed an affidavit by John F W Hunt, their Chief Executive, a position he has held since the company was incorporated on 13 July 1994. Prior to that he was involved in directing consumer marketing strategy at a large multinational corporation. He has been involved in various aspects of the multimedia industry for over 15 years.

11. The applicants have neither filed counter evidence of their own or challenged Mr Hunt's claims. I do not think I need do more than provide a brief overview of the main points to emerge from the evidence. These are as follows:

- the company provides strategic, creative and technological consulting and development services for all digital media. The core activities include strategic research and consultation, design, development and construction of websites, content origination, copy-writing, website hosting, promotion, advertising, software authoring, graphic design, audio and video editing, database engineering and authoring and production of CD-ROMs
- turnover figures are quoted for the years 1995 to 1998. In terms of the relevant period turnover rose from £116,000 (1995) to just over £1 million (1997)
- the goods and services are provided under the SYZYGY mark
- the company has been retained to design and develop Internet websites for various prestigious clients including BP, Siemens, Mars, Barclays Bank, Procter & Gamble, Boots and J Walter Thompson. To this end, the company works closely with external technology and telecommunications partners as well as client IT departments. In addition, Syzygy Limited has formed strategic partnerships with other companies such as WPP Group and Ogilvy & Mather.
- the creation of these websites has generated media attention in a number of print and online publications, including the Daily Telegraph, the Electronic Telegraph, Internet Magazine, Advertising Age, Design Week, Revolution, Campaign Interactive, Internet Informer and New Media Age
- the company has been the recipient of several industry awards for its websites.

12. A number of exhibits are supplied in support of the above as follows:

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| JFWH1 | - | copies of correspondence from prospective clients in response to initial approaches |
| JFWH2 | - | a company profile of SYZYGY. The particular document exhibited is a 1997 edition. An earlier version was produced in early 1996. |
| JFWH3 | - | sample company letterheads etc |

- JFWH4 - photocopies of two promotional CD-ROMs produced for a client company. I note that the SYZYGY name is prominent
- JFWH5 - copies of invoices from internet service providers in respect of providing mail forwarding, web hosting and web forwarding services for the period 1995 to 1996
- JFWH6 - printouts from the company's own website
- JFWH7 - printouts of websites designed for a number of clients (BP Amoco, J Walter Thompson, Mars, Siemens and the V & A Museum)
- JFWH8 - printouts from the UK net awards website as well as photocopies of award certificates. Some of this material is dated 1997 which puts it in the relevant period. There is also 1998 award material. Whether the latter is in respect of the previous years' work is not clear.

13. As a result of all this I have little doubt that the opponents have built a significant reputation in a relatively short period of time (bearing in mind also my comments below on the nature of their sign). The Company Profile document for 1997 (containing as it does material from 1996 and 1997) is relevant in terms of the material date for these proceedings. It confirms that in just three years trading the company has built an impressive client list. A list of these clients (most of them household names) can be found on page 5 of the document. Allied to the public recognition that is evident from the many awards received this suggests a high level of awareness amongst the relevant public (which I take to be in the main corporate clients). As this evidence is unchallenged I do not consider that further analysis is necessary for me to conclude that the opponents have established their claim to reputation/goodwill in the mark/sign SYZYGY as at the material date.

14. Turning to the second leg of the passing off test, that is misrepresentation, I should record that the unusual choice of name derives from, or rather is, an astronomical term meaning an alignment of planetary bodies (hence also, I think, the exclusions from the applicants' specifications to overcome a descriptiveness objection). Mr Hunt says that he chose the mark "to refer to the alignment of the three core skills of strategy, creativity and technology which we offer to our clients". I doubt whether the meaning of the word or the reason for its adoption would be immediately apparent to many people. The point is that in the context of the goods and services in relation to which it is used it is a fanciful mark. The twin consequences of that are that it will readily be seen as distinctive of the opponents and that misrepresentation will more readily be inferred (in comparison to an opponent who has adopted a prima facie weakly distinctive mark where small differences may serve to distinguish). The applicants' specification of goods is cast in fairly broad terms and, as they have filed no evidence, I have no means of knowing precisely what their intentions are. On a

fair reading of their specification I consider that there could be a substantial measure of overlap with the opponents' area of activity. I have little hesitation, therefore, in concluding that if the applicants were to use their mark misrepresentation would be an inevitable consequence.

14. In *Mecklermedia Corporation v D C Congress Gesellschaft mbH*, 1997 FSR 627 Mr Justice Jacob said:

"Now in some cases one does indeed need separate proof of damage. This is particularly so, for example, if the fields of activity of the parties are wildly different (*e.g. Stringfellow v McCain Foods (G.B.) Ltd* [1984] R.P.C. 501. CA, nightclub and chips). But in other cases the court is entitled to infer damage, including particularly damage by way of dilution of the plaintiff's goodwill."

15. It seems to me that in the circumstances of the case before me damage, in terms of potential loss of trade or reputation, can be inferred. The result is that I find the Section 5(4)(a) ground to be made out.

16. I do not propose to deal formally with the Section 3(6) ground. I note that the applicants chose not to admit it rather than deny it but equally the opponents have advanced no evidence that would enable me to take a reasoned view of the matter.

17. The opposition has succeeded under Section 5(4)(a).

18. The opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £535. 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 2ND day of May 2001

**M REYNOLDS
For the Registrar
the Comptroller-General**