

O-405-03

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2279989
IN THE NAME OF SITEHELPDESK.COM LIMITED**

AND

**IN THE MATTER OF
OPPOSITION THERETO UNDER NO. 90061
BY NETDESK CORPORATION**

**Trade Marks Act 1994
In the matter of application No 2279989
in the name of Sitehelpdesk.com Limited**

And

**In the matter of opposition thereto
under No. 90061
by Netdesk Corporation**

BACKGROUND

1. On 6 September 2001, Sitehelpdesk.com Limited applied to register SITENETDESK as a trade mark in Class 9 in respect of:

Computer software (including software downloadable from the Internet), computer programs, data processing apparatus and instruments; parts and fittings for all the aforesaid goods; all included in Class 9.

2. On 7 February 2002, Netdesk Corporation filed notice of opposition to the application, the grounds on which the opposition is based being as follows:

1. Under Section 5(2)(b) because the mark applied for is a similar mark to the opponents' earlier mark and is sought to be registered for identical or similar goods to those covered by the earlier mark such that there exists a likelihood of confusion.

3. The earlier mark relied upon by the opponents is as follows:

Number	Mark	Class	Specification
CTM 1105873	NETDESK	9	Software for data management.
		41	Educational services.
		42	Consulting services for computer software and computer hardware.

4. The applicants filed a counterstatement in which they deny the ground on which the opposition is based. Both sides ask that an award of costs be made in their favour.

5. Neither side filed evidence in these proceedings. Neither party took up the offer of an oral hearing, preferring instead to have the matter determined from the papers.

Decision

6. The opposition is made on one ground, Section 5(2)(b). That section reads as follows:

5.-(2) A trade mark shall not be registered if because

(a) ...

(a) 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.

7. An earlier trade mark is defined in Section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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,

8. Before dealing with the substantive case, I need to address a point raised by the applicants in their Counterstatement. They refer to a trade mark in the ownership of a third party, for the identical mark NETDESK (and NETDESK-P and NETDESK-C), that is registered in respect of computer software, a description of goods that includes the goods identical to Class 9, and arguably similar to the services of Class 42 of the opponents' earlier mark. They point out that this registration pre-dates the earlier Community Trade Mark relied upon by the opponents, asserting that as a consequence, the opponents' earlier mark is not validly registered.

9. Article 95(1) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark states:

Article 95 : Presumption of validity Defence as to the merits

1. The Community trade mark courts shall treat the Community trade mark as valid unless its validity is put in issue by the defendant with a counterclaim for revocation or for a declaration of invalidity.

10. From this it seems quite clear that unless there is a successful challenge to the validity of the opponents' CTM registration, it stands as valid, and constitutes an earlier trade mark within the meaning of Section 6(1)(a). But whatever, in my view, what I have to consider under Section 5(2) is whether the mark applied for should be prevented from proceeding to registration because of a likelihood of confusion with the opponents' earlier trade mark. I can see nothing that suggests I should have regard to other registrations, nor have I been directed to any authority in support of such a proposition. The existence of other registrations is no

more than Astate of the register@evidence, which, in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 Mr Justice Jacob commented:

A It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence."

11. I can see no merit in this line of the applicants= argument, and it is dismissed accordingly. Having disposed of this point, I turn to consider the substantive ground under Section 5(2)(b). In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (h) further, 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; *Marca Mode CV v Adidas AG*,

- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

12. Class 9 of the opponents' earlier mark covers 'Software for data management'. The corresponding class of the application lists 'computer software' with no limitation to its function, purpose or whatever. Clearly, this description includes the self-same software as in the opponents' registration, so in that respect at least, there must be identical goods involved. It does not, however, follow that all software should be regarded as being either the same or similar to the opponents' software for 'data management'. In the *Mercury Trade Mark* case [1995] FSR 850, Mr Justice Laddie was critical of allowing the wide term 'computer software', without it being restricted to a particular area of use, e.g. flight simulators, optical text reading or factory design software, saying:

In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs.

13. Although the opponents' software is limited to performing a particular function, the purpose is not specialised to the extent that it would only be of interest to a specific group of consumers, or come from a niche supplier, and I must assume that notionally, both parties' goods share the same channels of trade, from manufacturer to retailer, and also the same consumer. But in any event, the applicants' computer software is not limited in any way and at least in respect of software for the same purpose as the opponents', must notionally be identical in all respects. Computer software and the 'computer services' covered by Class 42 of the opponents' earlier mark should be considered to be either similar, or closely allied. I do not, however, consider the 'educational services' specified in Class 41 of the opponents' earlier mark to be similar to the applicants' software.

14. Computer software can be expensive, particularly if written to order, which in itself would give rise to a certain degree of circumspection in its purchase. But what, I believe, makes the purchase of software a very considered act, and I would say that this also applies to computer consultancy, is that it is a technical and/or specialised item or service, obtained to perform or fulfil a specific function, usually by a well informed and knowledgeable consumer, or otherwise, by one that will be cautious and enquiring prior to the purchase.

15. The mark applied for consists of the word SITENETDESK as one word in upper case. This clearly encompasses the whole of the opponents' NETDESK mark, and if only to that extent they must have some similarity. The case law states that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, but qualifies this by saying that the distinctiveness and dominance of individual components should have some bearing. The difference between the marks is that the word SITE is at the beginning of the mark applied for, and if there is a dominant component (if only by virtue of its positioning) it is this element. However, it is an ordinary English word that I note could have relevance to at least some of the respective computer goods or services, for example, as a reference to a location on the Internet, although it has not been put to me that it has any

particular meaning. The remaining portion of the mark is composed of what I would say are two, discernable elements; NET and DESK, both of which I know to individually, have relevant meanings, although I do not know whether they sit together to create a sensible whole.

Again, it has not been put to me that they do and I must therefore proceed on the basis that both the opponents and the applicants' marks form a distinctive combination.

16. In some circumstances, taking a mark of one trader and attaching an ordinary English word, even if distinctive, to form a cohesive whole, may result in the acquired element (the other trader's mark) losing some, most or even all of its individual significance. However, attaching an element, such as a house mark or some word having descriptive relevance to another trader's mark may not avoid the finding that they are still similar. A significant part of the applicants' mark is identical to the opponents' earlier mark. The word SITE does not run naturally into the NET syllable, nor create the cohesive whole that would mask the fact that it is followed by NETDESK. It is composed of three discernable elements, with three strong consonants making the whole mark an awkward combination for the tongue, and when spoken is likely to be broken into distinct elements, SITE-NET-DESK. Insofar as the consumer will gather some conceptual message from the respective marks, I believe that it will be the same, or at least, very similar.

17. There is no evidence that the opponents have been using the trade mark NETDESK, and as such I do not see how I can conclude that it is a mark used to such an extent that it is deserving of a wider protection than it would otherwise have been afforded.

18. On a global appreciation of all of the circumstances, I consider that a consumer familiar with the mark NETDESK, on seeing SITENETDESK, will be led into wrongly believing that the respective goods/services come from the same or economically linked undertakings, and there is a likelihood of confusion. Accordingly, the objection under Section 5(2)(b) succeeds.

19. The opposition having been successful, the opponents are entitled to an award of costs. I order the applicants to pay the opponents the sum of , 350 as a contribution towards their costs. This sum 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 22nd day of December 2003

**Mike Foley
for the Registrar
the Comptroller General**