

O-109-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2492135
BY HANDHELD SOFTWARE LTD TO REGISTER THE TRADE MARK**

mFormWizard

IN CLASS 9

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 98739
BY HYTEC LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2492135
By Handheld Software Ltd to register the trade mark**

mFormWizard

and

**IN THE MATTER OF Opposition thereto under No. 98739
by Hytec Ltd**

BACKGROUND

1. On 8th July 2008, Handheld Software Ltd (hereafter "Handheld") of Sirius House, Alderley Road, Chelford, SK11 9AP applied to the register the word mark, "mFormWizard", in Class 9 for:

"Forms design and forms development software".

2. The application was published on 14th November 2008 and on 13th February 2009 Hytec Ltd (hereafter "Hytec") of Cairns House, 10 Station Road, Teddington, Middlesex TW11 9AA lodged an opposition against all goods specified.
3. Hytec based its opposition on the following sections of the Trade Marks Act 1994 (hereafter "the Act"):

Section 3(1)(b) – Hytec say the mark is descriptive of the goods that the applicant wishes to provide, namely a form wizard for mobile devices. That is to say that the word 'wizard', to use Hytec's own words, "describes an interactive help utility that guides a user through a potentially complex task". In accordance with Registry Practice Amendment 9/02, the letter 'm' is 'commonly used as an abbreviation for 'mobile'', and finally the word 'form' is a 'document with marked spaces where information can be recorded in an organised way';

Section 3(1) (c) - for the reasons stated under section 3(1)(b) above;

Section 3(1)(d) - again for the reasons stated under section 3(1)(b) above, and on the basis that the words used have become customary in the current language or in the bona fide and established practices of the trade. As Hytec put it, "The ordinary

man on the street would probably be able to guess what 'mFormWizard' did, and certainly the IT professional would.”;

Section 5(2)(b) – on the basis of Hytec’s earlier mark, UK 2387798, the details of which are as follows:

Mark	Filing and registration dates	Goods relied upon in the opposition
Integral <i>m</i>Forms	24 th March 2005 and 3 rd March 2006	Class 9 Computer Software, (downloadable from website) tapes, compact discs.

Hytec say that registration of the application will give rise to likelihood of confusion on the basis that the two marks are similar, both use a combination of ‘m’ and ‘form’ together. Further, the similarity continues with the use of the capital ‘F’ next to the lower case ‘m’;

Section 5(3) – on the basis that the earlier mark has a reputation built up since at least 2003 and that registration of the application would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark;

Section 5(4)(a) – on the basis that the earlier mark, or a variant of it, had been in use since 2003 in relation to mobile computing software, either incorporated in physical format or downloadable from the web. It was, moreover, used in relation to training and implementation services and OLM MxSoft (Hytec’s former name) had domain names registered around the mark. Handheld’s use of the mark, the subject of the application, would constitute a misrepresentation of Hytec’s mark which would be actionable in ‘passing off’. Enclosed with the statement of case is a front sheet of a brochure from June 2004 which I have annexed at Annex A.

- Handheld filed a counterstatement denying all the grounds of the opposition. They say that:

in connection with section 3(1)(b), even a minimum degree of distinctiveness is sufficient to enable a mark to be registered. It is well established that a trade mark may be comprised of elements which allude to certain features, and that the combination of those elements may comply with linguistic rules, but this, of itself, would not justify a conclusion that a mark is devoid of distinctive

character, given that the average consumer perceives a mark as a whole without analysing individual elements. They also say that the description used by Hytec was taken from Handheld's own website but is not a description which is obvious from the mark itself and they also note that there are several 'wizard' marks already on the register;

in connection with section 3(1) (c), to be caught by this prohibition would depend upon there being a sufficiently 'clear and specific relationship' between the mark applied for and the goods to enable the relevant public to perceive immediately and without further thought, a description of the goods or one of their characteristics. In this case, Handheld say the mark is a neologism which, although comprised of elements which *individually* may be descriptive, when brought together would not make a descriptive totality;

in connection with section 3(1)(d), there is no evidence of use by third parties prior to the date of application;

in connection with section 5(2)(b), although the goods are identical, there would not be a likelihood of confusion since the marks must be compared as wholes bearing in mind their distinctive and dominant elements. In this case the designation 'mForms' is, say Handheld, according to Hytec both non-distinctive and descriptive, and on that basis no proprietary interest in that designation can be claimed by Hytec. As the remaining elements in the respective marks, 'wizard' and 'integral' are very different then, overall, there can be no likelihood of confusion;

in connection with section 5(3), there is no basis for asserting any reputation in relation to the earlier mark, and neither is it stated exactly how the use of the application would take advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark; and finally

in connection with section 5(4)(a), the evidence of the brochure at Annex A does not establish use of the earlier mark as registered and even if it did, use of the application would not constitute a misrepresentation of the earlier mark for the reasons given in connection with the claim under section 5(2)(b).

5. Hytec were invited to file evidence to substantiate their grounds of opposition but declined, saying in their letter of 31st July 2009 that they had no further evidence to add beyond the content of their statement of case summarised above. The registry responded in a letter dated 6th August 2009, saying that the grounds under section 3, sections 5(3) and

5(4)(a), would all be struck out in the absence of evidence, leaving only the ground under section 5(2)(b). This, said the registry, was in accordance with rule 20(3) of the Trade Marks Rules 2008 (hereafter "TMR").

6. Despite this, Hytec has filed no evidence and nor has Handheld. Both parties were invited to file submissions but neither party has nor have they requested a hearing. The matter thus falls to be decided on the basis of the papers on file.

DECISION

7. Firstly, to reaffirm the scope of the matters to be decided. Rule 20 (2) and (3) of the TMR provides:

"(2) Where—

(a) the opposition is based on an earlier trade mark of a kind falling within section 6(1)(c); or

(b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2); or

(c) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant,

the person opposing the registration ("the opposer") shall file evidence supporting the opposition

(3) Where the opposer files no evidence under paragraph (2), the opposer shall be deemed to have withdrawn the opposition to the registration to the extent that it is based on—

(a) the matters in paragraph (2)(a) or (b); or

(b) an earlier trade mark which has been registered and which is the subject of the statement of use referred to in paragraph (2)(c)."

8. Given the provisions of rule 20(2)(b) and (3) and the fact that the opposer has not filed any evidence, it must be deemed to have withdrawn all grounds of opposition except those in relation to section 5(2)(b). I have however given an account of the claims and counterclaims in relation to those other grounds as they may be relevant to my determination under section 5(2)(b).
9. The opposition is thus founded solely upon Section 5(2) (b) of the Act. This reads:

“(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,

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

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

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

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

11. With a filing date of 24th March 2005 and a registration date of 3rd March 2006, it is clear that under Section 6(1) of the Act, Hytec’s mark is an earlier trade mark. Further, as it completed its registration procedure less than five years before the publication of the contested mark (14th November 2008), it is not subject to the proof of use requirement set out in section 6A of the Act.

12. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law 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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does

not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

The average consumer and nature of purchase

13. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), it is important that I assess who the average consumer is for the goods at issue, and whether there is anything about the nature of transactions under the respective marks that may lead me to conclude that the average consumer is other than someone “deemed to be reasonably well informed and reasonably circumspect and observant” (see authority (b) in para 12 above).
14. The average consumer for the goods covered by Hytec’s earlier mark will be the general public as well as IT professionals. In purely linguistic terms, the fact that Hytec’s software is downloadable from a website is indicative perhaps that access is wide. As for Handheld’s goods, these have more of a specialised ‘feel’ about them. It is difficult to imagine that the general public will become involved in specific ‘forms software’ or the development of the same. That said, it is possible that IT ‘administrators’, as distinct from ‘professionals’, may be a consumer for both parties’ products and so it would be dangerous to restrict the identity of either consumer to IT professionals. In my view, absent any evidence on the point, the average consumer for Handheld’s goods will be a specialised IT person or someone working as an administrator. Insofar as the average consumer for both parties’ products will be IT professionals or administrators, the identity of that consumer will necessarily overlap.
15. The goods concerned are specialised purchases. They are not everyday commodities and a degree of care will be taken in their selection, not least on the basis that the consumer will inevitably be keen to ensure that the correct software is purchased to ensure compatibility and functionality with any hardware.

Comparison of goods

16. I do not understand Handheld to be denying that the goods are identical, as stated in para (vii) of the counterstatement. Handheld’s goods are self-evidently identical to Hytec’s “[c]omputer software”.

Comparison of marks

17. The respective marks are as below:

Hytec's mark	Handheld's mark
Integral mForms	mFormWizard

18. The case law makes it clear that I must undertake a full comparison of both marks in their totalities and taking account of all differences and similarities. The comparison needs to focus on the visual, aural and conceptual identities of both marks.
19. In terms of visual appearance, Hytec's mark presents as a two word mark in a slightly stylised script. This is because there is a gap between the two words. The two words are, in the order, "Integral" and "mForms". Handheld's mark presents as a single word "mFormsWizard", without any stylisation. However, visually, the single word breaks down into distinct elements, taking into account the use of capital letters. I believe that there are three distinct elements:- 'm', 'Form' and 'Wizard'. Given the common element(s) in the respective marks, 'm' and 'Forms', (and also noting that the letter 'm' in lower case is followed by the word Forms, starting with a capital 'F' in both marks) I consider the marks to be visually similar to a more than moderate degree.
20. Aurally, Hytec's mark will be pronounced IN-TEG-RAL EM FORMS. Handheld's will be pronounced EM FORMS WIZ - ARD. Again, given the common element 'mForms', but also taking into account the dissimilarities in the non-common elements, I consider that the marks will be aurally similar to a more than moderate degree.
21. The question of conceptual similarity or dissimilarity hinges around the meaning, if any, of 'mForm(s)'. Hytec argued in relation to their section 3 ground that the letter 'm' is a common abbreviation for 'mobile'. This assertion is based upon Registry Practice Amendment 9/02. Hytec say the word 'form' is understood to be 'a document with marked spaces where information can be recorded in an organised way'. They also say that 'wizard' is commonly used to describe an interactive help utility that guides a user through a potentially difficult task. Handheld do not dispute that 'wizard' is not uncommon in the software industry; they say the term is used to describe an interactive utility used in the installation (or

uninstallation) of computer programs, “but not usually in the running of said programs”.

22. I do not understand Handheld to concede that the element ‘mForm(s)’ is either non- distinctive or descriptive, although it may be inferred from their specification that the word ‘Forms’ *solus* is non-distinctive or descriptive. The position Handheld adopt is to point out the illogicality in Hytec’s position of, on the one hand, claiming that ‘mForms’ is *entirely descriptive*, and at the same time saying that the respective marks are likely to be confused based upon a shared *proprietary* element, ‘mForms’. Plainly, if the only common element is entirely descriptive then there can be no likelihood of confusion as the remaining elements, ‘Integral’ and ‘Wizard’, are entirely different.
23. Given that Hytec has abandoned its section 3 ground without any evidence I cannot conclude that ‘mForms’ is descriptive or non-distinctive in relation to these goods. There simply is no evidence upon which to base such a conclusion, especially as this is a technical, specialised field. I believe it was for Hytec to make good their section 3 claim, based, not upon assertion or guidance notices published by the Registry intended to enable *prima facie* examination of marks, but instead (as we are now in an inter-partes dispute) convincing evidence. I do not believe the front page of the brochure annexed (which was not in any event submitted as formal evidence) can assist in determining this matter. Even if it had been filed as formal evidence, I do not believe I can conclude that use of the term ‘mForms’ is plainly descriptive use. The mere fact, for example, that the brochure page contains other dominant indicia would not exclude the possibility that “mForms” was also being used in a distinctive, trade mark manner. Further, the fact that “mForms” appears above the words “Software Overview” does not then mean that it can only be construed in a descriptive manner.
24. Proceeding then on the basis that the shared element, ‘mForms’, has at least the minimum level of distinctive character, the words ‘integral’ in Hytec’s mark and ‘Wizard’ in Handheld’s need to be examined as to their possible effect upon the perceptions of the average consumer.
25. The normal meaning of ‘integral’ is:

Integral (adjective)

1. necessary to make a whole complete; fundamental. • included as part of a whole. • having all the parts necessary to be complete.
2. (*Mathematics*) of or denoted by an integer or integers.¹

¹ integral *adj.*” *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 15 March 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e28824>>

The meaning of 'integral' is thus adjectival; necessary to make a whole complete, fundamental or included as part of a whole. Given this definition, when placed before the element 'mForms', whilst it may contribute to the overall impact of the mark, it will do so in a secondary and qualifying way.

26. 'Wizard' is a recognised term in the software field, as acknowledged by both parties, having the meaning given in para 21 above. Handheld's (very fine) point that a 'wizard' is used in the installation or deinstallation of a program rather than the running of a program does not, as I see it, detract from the consumers' perception on seeing the term used in relation to these goods. It will still be seen as descriptive of a characteristic of the goods, namely, those which have or otherwise utilise an interactive help utility.
27. Given my analysis above, the respective marks share the distinctive 'concept' of 'mForm(s)'; the other words, 'integral' and 'wizard', serve only a secondary, descriptive function around this 'distinctive concept'. The effect of those descriptive or adjectival words on the respective totalities needs however to be analysed. In respect of Hytec's mark, the 'concept' will be that the 'mForms', (whatever they are and assuming the term to be proprietary), are 'integral' or fundamental to the whole product. In the case of Handheld's mark, the 'concept' will be that the 'mForm' comes complete with, or otherwise utilises, a wizard. On that basis I conclude that the respective marks share some conceptual similarity.
28. Bringing the visual, aural and conceptual elements together, I find that overall there is a medium to high level of similarity as between the marks.

Use and distinctive character of the earlier trade mark

29. Before I bring my findings together in an overall assessment, I have to consider whether Hytec's mark has a particularly distinctive character, either arising from the inherent characteristics of the trade mark or because of the use made of it. In terms of its inherent distinctiveness I consider Hytec's mark only to have low to average distinctiveness. The term 'mForms' endows the mark as a whole with some distinctive character, but in the light of the adjectival word 'integral', and descriptive word 'forms', such distinctive character as the totality has, is on the low side.
30. Hytec say they have used their mark since 2003. There is no formal evidence of that use. The front page of the brochure is not formal evidence and it is questionable that it shows use of the mark as registered, given the presentation which plainly splits the 'integral' element (which is used with a prominent 'I' device) from the 'mForms' element. On

that basis I am unable to conclude that any inherent distinctiveness in Hytec's mark is enhanced through use.

Likelihood of confusion

31. The various findings I have arrived at above need now to be factored into an overall assessment of likelihood of confusion. I need to adopt a global approach, which takes into account 'imperfect recollection' on the part of the consumer, as advocated by the ECJ in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* It is also the case that the authorities, to which I have referred above in para 12 above, recognise two forms of confusion, direct and indirect. By direct confusion, it is meant that the average consumer is likely to mistake one mark for another, assuming imperfect recollection of course. By indirect, it is meant that although the average consumer will not necessarily mistake the respective marks directly; he or she may well nevertheless assume an association, in that goods sold under the mark the subject of the application derive from the same economic undertaking as the goods sold under the earlier mark.
32. I have decided the respective marks share a medium to high level of similarity. The respective goods are identical. The average consumers' are identical insofar as they may comprise IT professionals or administrators, and the earlier mark is of low distinctiveness. Taking account of my explanation of the difference between direct and indirect confusion in para 30 above, I have come to the conclusion that in this case there is a likelihood of indirect confusion.
33. In all the circumstances case then, I find that the opposition succeeds in its entirety.

Costs

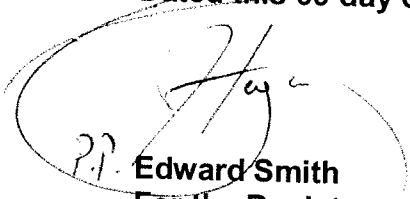
34. Hytec have succeeded in their opposition under section 5(2). Accordingly, it is entitled to a contribution towards its costs. I take account of the fact that that the decision has been reached without any evidence having been filed, without a hearing taking place and neither side were apparently legally represented. It is the Registrar's practice to award litigants in person at half the rate he awards them where a party has legal representation. In the circumstances I award Hytec the sum of £400 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

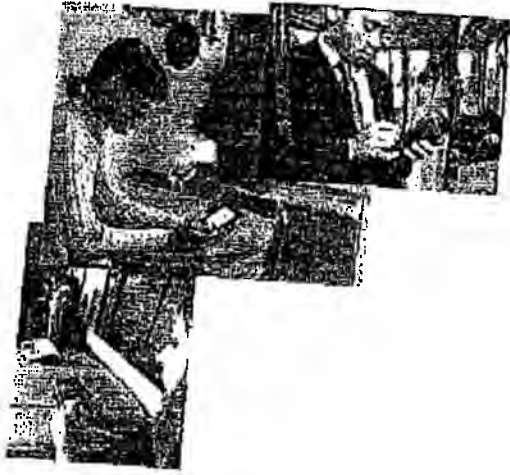
1. Filing Notice of Opposition - £ 200
2. Preparing a statement and considering counterstatement - £200

Total £400

35. I order Handheld Software Ltd to pay Hytec Ltd the sum of £400. The 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 09 day of April 2010


P.P. **Edward Smith**
For the Registrar,
the Comptroller-General



Integral

MOBILE DATA

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mForms

Software Overview

Version 1.0
Date: 9th June 2004

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