

O-274-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2432764
BY PROACT INTERNATIONAL LIMITED
TO REGISTER THE TRADE MARKS**



IN CLASSES 9 and 42

AND

**THE OPPOSITION THERETO
UNDER NO 96167
BY
COSMIC SOLUTIONS LIMITED**

Trade Marks Act 1994

**In the matter of application 2432764
by Proact International Limited
to register the trade marks:**



**in classes 9 and 42
and the opposition thereto
under no 96167
by Cosmic Solutions Limited**

1. On 11 September 2006, Proact International Limited (which I will refer to as PIL) applied to register the above series trade mark for the following goods and services in classes 9 and 42 of the Nice Classification system¹:

Class 9: *Computer software (including downloaded computer software) for supply chain management; computer software for managing throughput of goods from manufacture to customer delivery.*

Class 42: *Computer software design services for supply chain management; computer software development services for supply chain management; consultancy, technical support and information services relating to supply chain management software; installation and maintenance of supply chain management software.*

2. Following publication of the application in the *Trade Marks Journal* on 9 November 2007, Cosmic Solutions Limited (which I will refer to as Cosmic) filed notice of opposition. Having withdrawn its ground of opposition under Section 5(4)(a) of the Trade Marks Act 1994 (the Act), Cosmic's sole ground of opposition remaining against all the goods and services of the application is brought under section 5(2)(b) of the (the Act), which states:

¹ 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).

“(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.”

To support this ground, LS relies upon all the goods and services of its earlier registered Community Trade Mark (CTM):

379354

PRO ACT

Class 9: *Computer programs.*

Class 35: *Business marketing analysis and sales analysis services.*

The CTM application was made on 5 November 1996 and it completed its registration process on 10 July 1998. Cosmic made a statement in its notice of opposition that it had use the mark in the United Kingdom in relation to the supply of computer programs namely business support software including but not limited to supply chain management software and the provision of business marketing analysis and sales analysis services.

3. PIL filed a counterstatement denying a likelihood of confusion and stating that it had been using the applied for mark for more than 15 years prior to the application date and that it was “seeking statutory protection for its extensive common law rights”. PIL puts Cosmic to proof of genuine use of the earlier mark in respect of the goods and services for which it is registered, since its registration process was completed more than five years prior to the publication date of the application. Section 6(A) of the Trade Marks Act 1994 (“the Act”) states:

“(1) This section applies where—

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

- (c) 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.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects—
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or
 - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

4. Both sides filed evidence. The matter came to be heard on 25 June 2010 when PIL was represented by Ms Jennifer Maddox of W.P. Thompson & Co, its trade mark representatives in this matter. Cosmic filed written submissions in lieu of attendance.

Evidence

5. Cosmic's evidence comprises a witness statement and exhibits from David Robert Wilkins, a director of Cosmic. He states that Cosmic has used the mark continuously since 1994 in relation to software and providing consultancy services including marketing and sales analysis services. He also states that he has concentrated upon showing use of the mark between 9 November 2002 and 9 November 2007, as proof of genuine use during the five year period ending upon the date of publication of the application is required. In fact, the five year period runs from 10 November 2002 to 9 November 2007, but nothing turns upon this.

6. Mr Wilkins states that the ProAct software is essentially a tool for analysing data for business planning which can be tailored to the needs of each customer. He says that the software can be put to numerous applications. Page 16 of his evidence (exhibit DRW2), is an extract from the "ProAct Manual 2002" says:

"Although originally designed as a Customer Profitability model, the generalised nature of ProAct's design widens the potential application area to include the following:

Sales/Marketing Information System
Customer Profitability
International Account Management
Forecasting/Planning
Account/Market Planning Workbench
Financial Modelling
Store Operations Modelling."

Mr Wilkins states that the software has always been supplied to customers on a disk or CD. He no longer has any actual CDs or cases from the five year period, but he exhibits at DRW1 copies of a label and a box cover as it has been supplied since 2003. Both show the mark as ProAct. The application areas listed are:

Profitability planning
Forecasting, both top-down and bottom-up
Financial planning
Promotional evaluation
Account planning
Export planning

Supply chain planning
EPOS data consolidation

7. Exhibit DRW4 shows a selection of an archived screenshots from Cosmic's website. Page 41, from 2006, says:

“ProAct is the ideal tool to develop multi-dimensional supply chain models...”

It goes on to list profitability planning, promotion evaluation, business planning, demand planning, despatch planning, account planning, account analysis, store analysis, EPOS consolidation, warehouse stock analysis and trade stocks analysis as applications for the software. Throughout the website printouts, which range from 2003 to 2007, the mark used on the software is ProAct.

8. Mr Wilkins states that throughout the five year period, Cosmic advertised the ProAct software in various publications, the most important of which is a publication called “Conspectus The IT report for directors and decision makers”. Exhibit DRW7 are copies of the front cover of the February 2003 report, priced at £15, subtitled “Data Warehousing, Business Intelligence and Analytics”; The March 2003 report (also £15), subtitled “Customer Relationship Management”; and the February 2005 report (£15), subtitled “Business Intelligence, Corporate & Business Performance Management”. Accompanying each front cover is a copy of an advertorial headed Cosmic Solutions, and subheaded according to the different software products offered by Cosmic: these are ProAct, CS Range Manager and CS ProMatch. The text relating to ProAct says:

“ProAct has been used for many years for business planning. Focusing on customer, channel and brand profitability. More recent modules include:

- Profitability planning.
- Forecasting.
- Financial planning.
- Promotional evaluation.
- Account planning
- Supply chain planning
- EPOS data consolidation

Cosmic says ProAct is tailored to meet client needs using functions such as:

- Flexible interfacing to build direct links to other internal and external data sources.
- Calculation functions used for forecasting, modelling and cost allocation techniques. These can be either simple or often multi-stage activity-based costing algorithms.

- Query and exception analysis, including drill-down and data mining functions.
- Scenario modelling, which allows tailoring of ‘what-if’ analyses to evaluate strategic and tactical alternatives.
- ProWeb reporting, which allows the distribution of outputs across the web.

Cosmic says ProAct is rapid to implement, compatible with all major ERP systems, easy to modify and match to particular planning processes.”

9. Exhibit DRW8 is a print dated 23 July 2009 from the Conspectus website which states that the publication has a UK registered readership of 22,500. DRW9 is a copy of an email exchange between Cosmic’s trade mark attorney and Graham Cantwell, an employee at National Computing Centre Ltd, the publisher of Conspectus. The exchange related to circulation figures of Conspectus during the five year period in issue (not the subject of a witness statement). These were given as between 20,000 and 25,000 recipients per issue.

10. Mr Wilkins states that Cosmic has exhibited at trade fairs and gives an example which occurred in 2003, where a Mr Vispi Birdi of Toms Confectionery, a ProAct customer, spoke at the annual Manufacturer Live exhibition about his company’s use of ProAct software. Other customers of ProAct software listed by Mr Wilkins are:

UK Company	Year
Bayer plc	2002-2004
Gillette	2002-2005
Holsten UK Ltd	2002
L’Oreal Golden UK Ltd	2007
Masterfoods UK Ltd	2002-2005
Pfizer Consumer Healthcare	2002-2007
Toms Confectionery	2002-2007

EU Company	Year
Masterfoods	2002-2007
Philip Morris	2002-2005
Unilever Netherlands	2006

Invoices at exhibit DRW11 show items listed as ProAct licences being sold to Pfizer in 2002. The 2003 Masterfoods invoice refers to “ProAct Annual Maintenance and Support” with licence support covering a charge for a site licence and twelve additional user licences. Turnover figures, particularised as to “the supply of ProAct software (and associated support services)” are:

Year	2002	2003	2004	2005	2006	2007
Turnover (£) (nearest 10,000)	100,000	130,000	120,000	70,000	50,000	30,000

11. Whereas the above turnover figures for the supply and support services for ProAct software decrease over the 2002-2007 period, the turnover figures for what Mr Wilkins describes as fairly large one-off ProAct Consultancy projects show an increase over the period. They are:

Year	2002	2003	2004	2005	2006	2007
Turnover (£) (nearest 10,000)	50,000	40,000	60,000	60,000	40,000	80,000

Mr Wilkins states that ProAct Consultancy services include marketing and sales analysis services and the projects were carried out using ProAct software and some 'bolt-ons'. He states that the projects were marketed to Cosmic's customers as ProAct projects. A project for Pfizer (in the UK) during 2002-2003 covered analysis of impact on sales, trade expenditure and profitability of the abolition of resale price maintenance for medicines and future marketing and sales strategy recommendation. A project in 2004 for Retail Impact Ltd analysed sales and marketing strategies in Sainsbury's stores. In 2005, a project for Pernod Ricard UK covered analysis of sales data in Co-operative stores to identify sales patterns in order to recommend product range and product display strategies appropriate to each group of stores with common sales patterns. A project for Gallagher Ireland Ltd between 2005 and 2007 consolidated data from multiple sources and analysed sales by type of customer to determine optimum stocking ranges. Invoices at exhibit DRW12 relating to these projects and for other customers refer to ProAct.

12. PIL's evidence

This was previously filed during the course of the application's examination process (in order for the application to proceed under the provisions of section 7 of the Act²) and has been adopted for the purposes of these proceedings. The evidence is in the form of a witness statement dated 4 July 2007 from Garth Parker, a director of PIL.

13. Mr Parker states that the mark has been in continuous use in the UK since January 1989 in relation to the appliedfor goods and services. He states that PIL develops, sells, installs and maintains supply chain management software. The

² Prior to the The Trade Marks (Relative Grounds) Order 2007 S.I. No. 1976.

goods and services are interlinked and it is not possible to separate turnover relating to the goods from that relating to the services. The following figures are given:

Year	Turnover (£)	Advertising (£)
2002	1,539,273	15,901
2003	1,267,808	13,806
2004	1,191,050	11,672
2005	1,534,765	16,652
2006	2,000,000	16,800

14. Mr Parker states that promotion of the goods and services takes place through monthly and quarterly direct mailings to customers; regular advertisements in “Automotive Logistics” and “PMP”, which are motor trade magazines distributed in the UK; a sales team of six people who visit prospective customers; promotion through third party logistics companies active in various industries; and word of mouth recommendations. Mr Parker attributes a significant amount of new business from this last category. He says that supply chain management software is a critical aspect of any manufacturing company’s IT and word of mouth is vital in obtaining referrals. Attached to Mr Parker’s statement are seven exhibits, which include the following:

- A PIL company brochure from 2001 which shows the words and the device applied for, but not together. Under “What we do”, a list appears: Supply Chain Execution (inbound logistics, outbound logistics, warehouse management, transport management, extending routing, device/systems integration, e-commerce, MIS); Dynamic Process Design, execution and control (prediction, resource allocation, task notification and execution, alerts and escalation, dynamic critical path projection, multiple enterprise, real-time process monitoring); Process Applications (project execution, supply chain execution, work execution, process execution). There are synopses of projects undertaken for global customers, including in the UK in February 1994, July 1996 and in April 2001.
- A newsletter from Summer 1991 where the mark appears as ProAct, featuring an article on the use of ProAct software in relation to delivery of Firestone tyres throughout the UK and an article on the use of ProAct by MacMillan Publishing in relation to delivery of 700,00 parcels per annum.
- An advertorial in the July/August 2005 issue of Conspectus. This is headed “ProAct International”. “Supply chain” appears as a sub-heading.

“Traditionally, companies have implemented ‘track and trace’ solutions and in doing so encountered the typical issues of integration and data exchange. In reality, visibility should be an

integrated by-product of their execution solutions, providing end-to-end tracking of the entire supply chain process and all associated events.”

- An advertorial from the “Automotive Logistics Buyers Guide 2006” where the mark appears as applied for. As the name of the publication would suggest, the textual context is supply chains and logistics in the motor trade: “Global, multi-modal supply chain management; transportation planning and capacity management; accrual of complex cost and revenue, charging, matching and invoicing; movement of both components and finished vehicles; integrated multi-site, multi-owner, RF or paper-based warehousing, assembly and inventory control”.
- A PIL brochure from 1999 which says:

“ProAct solutions span the total supply chain, from global sourcing, through consignment and container tracking, national warehousing (both multi-client and multi-location), trunking and depot network management, traffic management, home delivery and returns management).

Among the customers listed under Proact Projects are Argos, Comet, Exxon, General Motors, Guinness, the Home Office and Pedigree Petfoods.

- An advertorial in “Automotive Logistics” from 2006 where the mark appears as filed:

“ProAct International has been at the forefront of unique and innovative supply chain solutions for almost 20 years. With an emphasis on the automotive market, our solutions are deployed globally and manage the complex supply chains of major international manufacturers.”

15. Mr Parker states that the ProAct supply chain execution tool requires a high degree of customisation and is configured to meet the needs of individual companies by way of a high degree of interaction with PIL.

16. Mr Parker’s final statement is that PIL has received no objection to its use of PROACT at any time since the mark was adopted. In answer to this, Cosmic filed a second witness statement by Mr Wilkins. He exhibits a ‘cease and desist’ letter dated 26 May 2000 from Cosmic to PIL (DRW13). He states that further correspondence between the parties over the course of the following year included an opposition by Cosmic to a CTM application filed by PIL. At DRW14 are what Mr Wilkins states are the final three letters that concluded the dispute. The first is from PIL, dated 5 June 2001, to the Office for Harmonization in the Internal Market withdrawing its CTM application. The second is from Cosmic to

PIL on 8 June 2001 asking if PIL has decided not “to use the word ProAct in a trade mark sense”. The final letter is from PIL to Cosmic stating the PIL has “decided not to use the word ProAct in a Trade Mark sense so that they are not interested in continued use under licence.” No objection to the filing of this evidence by Cosmic has been raised by PIL. It is not clear what is meant by the contents and not an agreement which can have an effect on the section 5(2)(b) ground.

Decision

17. In addition to section 6A of the Act, section 100 states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

To rely upon its earlier trade mark, Cosmic has to prove that it has made genuine use of the trade mark in suit, or that there are proper reasons for non-use, in the relevant period. The relevant period is the five years prior to and ending on the date of publication of the application, i.e. from 10 November 2002 to 9 November 2007, as per section 6A(3) of the Act.

18. The leading authorities on genuine use are *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *La Mer Technology Inc. v Laboratoires Goemar SA* [2004] FSR 38, both from the European Court of Justice (ECJ). The following legal principles can be derived from these cases.

- i) ‘Genuine use’ means actual use of the mark in relation to goods or services which are already marketed, or about to be marketed, for the purpose of creating or preserving a market for those goods/services and which guarantees their origin to consumers or end users (*Ansul*, paragraphs 36 and 37);
- ii) Such use must be external and by the trade mark proprietor or by a third party with authority to use the trade mark (*Ansul*, paragraph 37);
- iii) Genuine use does not include token use for the sole purpose of preserving the rights conferred by the registration (*Ansul*, paragraph 36);
- iv) All the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account, in particular whether the use is warranted in the economic sector concerned to maintain or create a share in the market; including the nature of the goods or services, the characteristics of the market, the sale and frequency of use of the mark and whether the mark has been used for marketing all or some of the goods or services (*Ansul*, paragraph 38 and *La Mer*, paragraphs 22-23);

v) The use need not have been quantitatively significant for it to be deemed genuine: there is no *de minimis* rule (*Ansul*, paragraph 39 and *La Mer*, paragraphs 21, 24 and 25).

19. Under Section 6A(4) of the Act, use of a mark “includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.” The mark used by Cosmic in their evidence is ProAct. The mark which is registered is PRO ACT. Ms Maddox submitted that the mark as registered alludes to ‘professional act’ whereas ProAct is suggestive of acting in a proactive manner. She submitted that the difference in meaning would affect the distinctive character of the mark, which would mean there had been no genuine use of the registered mark. Cosmic’s written submissions say:

“It is well established that word marks are considered used as registered where the typeface is different. Further, since changing the letter size or changing between lower and upper case is customary when using word marks it is well established that such use is also considered to be of the mark as registered.”

I would dispute the above submission: it depends on the facts of the case, such as the typefaces involved. I was not directed to any authorities relating to use of variant marks.

20. In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25, the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. Lord Walker of Gestingthorpe said:

“43...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the enquiry is, do they alter the distinctive character of the mark as registered?”

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

“ Bare ruin'd choirs, where late the sweet birds sang”

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of “

whose eyes?— registrar or ordinary consumer?” is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the “ visual, aural and conceptual” qualities of a mark and make a “ global appreciation” of its likely impact on the average consumer, who:

“ normally perceives a mark as a whole and does not proceed to analyse its various details.”

The quotations are from para.[26] of the judgment of the Court of Justice in Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV [1999] E.C.R. I-3819 ; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

21. In *REMUS Trade Mark*, O/061//08, Mr Richard Arnold QC, sitting as the appointed person, considered a trade mark used with an additional element. Repeating what he had said in *NIRVANA Trade Mark*, O/262/06, he posed the following questions regarding whether variant use constitutes an acceptable variant:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

22. The registered trade mark consists of PRO and ACT as separate elements. Neither is more dominant or more distinctive than the other: the distinctive character of the registered mark resides in its totality. The use is of ProAct. The differences between what is registered and what has been used are that (i) the registration is in capital letters while in the used mark the ‘ro’ and ‘ct’ are in lower case and (ii) the space between the two elements is missing in use. However, the retention of the capital A still has the effect of separating the PRO and ACT elements. ‘Proact’ is not a dictionary word so there is no obvious step from proact to proactive as there may be between react and reactive. The combination of these factors leads me to conclude that use of ProAct is use in a form differing in elements which do not alter the distinctive character of the mark registered as PRO ACT.

23. Class 9

The turnover figures (which have been separated from turnover in relation to class 35) while not substantial in the field of computer software are not quantitatively insignificant either. The evidence shows that there has been steady trade since 1994 in the UK and within Europe by Cosmic, with consistent advertising in a publication in which the applicant also advertises. Cosmic's customers include, for example, Gillette in the UK, Pfizer in the UK and Dublin, and Masterfoods in Belgium and Unilever in the Netherlands³. Although there were no direct concessions by PIL regarding the amount of trade, there were also no submissions that the quantity of trade was insufficient to maintain the registration and in fact Ms Maddox suggested a reduction of the class 9 specification based on Cosmic's evidence. The contested point by Ms Maddox was the nature of the software which had been sold, bearing in mind the registration is for 'computer software', undefined as to purpose. I am satisfied that Cosmic has shown a sufficient quantity of use during the relevant period of a mark which in a form which is acceptable within the constraints of section 6A(4) of the Act. In relation to the specific types of software in the evidence, the scale and frequency of use would appear to be warranted in the business software market place. The question is whether Cosmic is entitled to rely upon the full width of its class 9 specification in its opposition to PIL's application.

24. There is an established body of case law which deals with the task of framing a fair specification. Mr Justice Arnold (as he now is) in his judgments as The Appointed Person in *Nirvana Trade Mark* and *Extreme Trade Mark O/161/07* comprehensively examined the analogous case law under section 46(5) of the Act. His conclusion in *Nirvana* was that:

“(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at[30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording:

³ Cosmic's evidence spans three EU jurisdictions. The Fourth Board of Appeal of the Office for Harmonization in the Internal Market (OHIM) stated in *ILG Ltd v Crunch Fitness International Inc* [2008] ETMR 17: “11 The relevant period is October 1998 to October 2003. Use in one country of the Community, such as Italy, is sufficient (Joint Statements by the Council and the Commission entered in the Minutes of the Council meeting at which the CTMR was adopted, No.B.10, OH OHIM 1996, 607, 613), provided that is it [sic.] genuine...”.

MINERVA at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

In his later judgment in *Extreme*, Mr Arnold referred to the General Court's judgments in *Reckitt Benckiser (España) SL v OHIM (ALADIN)* [2005] ECR II-2861⁴ *Mundipharma AG v OHIM*, Case T-256/04, noting that paragraph 29 of *Mundipharma* indicates that the matter is to be approached from the consumer's perspective:

⁴ "45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

“29. The Court notes in this respect that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services.”

Referring to the English authorities quoted in *Nirvana*, he said:

“[54] The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used....”

55. To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI’s interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch), [2004] FSR 19 is to be preferred to the slightly less generous approach of Pumfrey J in *DaimlerChrysler AG v Alavi* [2001] RPC 42.”

25. Professor Ruth Annand, sitting as the appointed person in a coincidentally named *EXTREME* Trade Mark appeal O/217/10, noted that:

“13. The current law on part cancellation for non-use was succinctly summarised by Mr. Geoffrey Hobbs QC sitting as a deputy judge of the High Court in *Daimler AG v. Sany Group Co Ltd* [2009] EWHC 1003 (Ch), paragraph 9:

“The required degree of precision [with which the goods/services of the registration in suit may need to be redefined] has not yet been authoritatively defined by the European Court of Justice (it was touched upon obliquely in Case C418/02 *Praktiker Bau-und Heimwerkermärkte* [2005] ECR I-5873 at paragraphs 49 to 52). In three decisions of the Court of First Instance (Case T-256/04 *Mundipharma AG v. OHIM* [2007] ECR II-449; Case T-483/04 *Armour Pharmaceutical Co v. OHIM* [2006] ECR II-4109; Case T-126/03 *Reckitt Benckiser (España) SL v. OHIM* [2005] ECR II-2861) it has been indicated that the outcome should be a

specification expressed in wording which covers no independent sub-category or sub-categories of goods other than the one(s) within which the relevant trade mark can be taken to have been used. In the most recent of these decisions (Case T-256/04 *Mundipharma AG* at paragraphs 27 to 36) it was emphasised that the chosen wording should reflect the purpose and intended use of the relevant goods. I have previously expressed the view that the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify (*WISI Trade Mark* [2006] RPC 13, p. 580 at paragraphs 11 to 18; *DATASPHERE Trade Mark* [2006] RPC 23, p. 590 at paragraphs 19 to 25). That appears to me to be consistent with the case law in England (analysed by Mr. Richard Arnold QC sitting as the Appointed Person in *NIRVANA Trade Mark* (BL O/262/06) at paragraphs 36 to 59) and also with the case law of the Court of First Instance. However it is possible, that the case law in England may not fully accord with the case law of the Court of First Instance, as noted in the decision of Mr. Richard Arnold QC sitting as the Appointed Person in *EXTREME Trade Mark (Pan World Brands Ltd v. Tripp Ltd* [2008] RPC 2, p. 21 at paragraphs 51 to 56; see also Bently and Sherman *Intellectual Property Law* 3rd Edn (2009) pp 906, 907) ...”

....

15. In *NIRVANA*, Mr. Arnold identified that the main difference between the approaches of the English courts and the General Court was that the former based a fair description of the use that had taken place on the perception of the average consumer whereas the latter provided no clear yardstick for determining when a sub-category of products cannot be further divided. To my mind, a danger with the category/subcategory approach is that invites sub-division according to the product(s) concerned. A tribunal may be seduced into equating a fair description with actual use shown.”
26. I must therefore approach Cosmic’s evidence from the standpoint of what is a fair description of the use from the average consumer’s view of the purpose of the goods, applying any appropriate sub-categorisation as long as it is not overly specific and unduly restrictive.
27. Cosmic’s registration in class 9 is ‘computer programs’. It was common ground between the parties that this is equivalent to ‘computer software’. The latter term in class 9 specifications (as a standalone and unqualified term) was the subject of judicial comment in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [195] FSR 850. Laddie J said:

“The defendant argues that on its present wording, the plaintiff's registration creates a monopoly in the mark (and confusingly similar marks) when used on an enormous and enormously diffuse range of products, including products in which the plaintiff can have no legitimate interest. In the course of argument I put to Mr Silverleaf that the registration of a mark for “computer software” would cover any set of recorded digital instructions used to control any type of computer. It would cover not just the plaintiff's type of products but games software, accounting software, software for designing genealogical tables, software used in the medical diagnostic field, software used for controlling the computers in satellites and the software used in the computers running the London Underground system. I think that in the end he accepted that some of these were so far removed from what his client marketed and had an interest in that perhaps a restriction on the scope of the registration to exclude some of the more esoteric products might be desirable. In any event, whether that was accepted or not, in my view there is a strong argument that a registration of a mark simply for “computer software” will normally be too wide. 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. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods.”

28. Ms Maddox categorised Cosmic's software at the hearing as a 'management analysis tool', its purpose being to analyse sales, pricing and other aspects of a business to improve profitability. She submitted that a description of Cosmic's goods might be 'computer software for business planning, forecasting and evaluation'. Ms Maddox selected this term from page 70 of Cosmic's evidence (a *Conspectus* advertorial in exhibit DRW7). In the full context of that exhibit, the term appears as:

“All Cosmic's products are designed to have flexible interfacing, allowing integration with other systems, and modelling scenario options. The products cover a range of business planning, forecasting and evaluation areas....ProAct is a multi-dimensional database that can model complex profitability and planning calculations; it is tailored to the individual requirements of each client. Analyses are produced using integrated

reports, graphs and 'what-if' scenarios. Modules exist to perform profitability and supply chain planning, as well as promotional evaluation and business forecasting."

29. At paragraph 16 of its written submissions Cosmic says:

"The applications to which the Opponent's computer software may be put includes supply chain analysis"

and at paragraph 18 Cosmic submits:

"The PRO ACT software is a sophisticated tool for analysing business data for businesses in (primarily) the Fast Moving Consumer Goods (FMCG) sector. The purpose of analysing data for such businesses is to better understand the operation of the business, enabling better choices to be made and ultimately to increase profitability."

At paragraph 22, Cosmic submits that it has clearly demonstrated use of its mark in relation to the goods and services for which is registered. It goes on to say:

"23 In the alternative, if the Opponent's use is found not to be sufficient to support the goods 'computer programs' in the context of these opposition proceedings then it is certainly sufficient to support the goods, "computer programs for business purposes."

30. *Mercury* means that for the purposes of this opposition, Cosmic cannot rely on 'computer programs' at large because it has not demonstrated use on a sufficiently wide variety of software. The evidence shows that ProAct can be used for modelling business scenarios, business planning, forecasting, evaluation, demand planning, despatch planning, warehouse stock analysis, supply chain planning including multi-dimensional supply chain modelling, profitability planning, financial modelling, analysing sales data, EPOS data consolidation and so on. The evidence shows that ProAct is flexible and allows integration with other systems. The list of applications is not exhaustive: individual set-ups are designed with individual customer needs in mind. In relation to supply chain planning, Ms Maddox sought at the hearing to draw a distinction between supply chain *planning* (Cosmic) and 'supply chain *management* (PIL). She submitted that the latter concerns movement of goods (logistics) whereas the evidence submitted by Cosmic shows that it is a tool to analyse whether a company is getting materials on time, whether it is getting the goods out to the distributor on time rather than managing the actual movement of the goods. I will say more about this later, but to reflect the distinction (if there is one) in the manner suggested by Ms Maddox would be pernickety, in the light of the fair description jurisprudence I have cited. The average consumer would describe the goods as 'supply chain software'. I have reached the conclusion that to restrict the goods to the various terms found in the evidence, which are

non-exhaustive, would be arbitrary and would run the risk of “equating a fair description with actual use shown.” Consequently, **a fair description of the goods in class 9 is “computer programs for business purposes”**.

31. Class 35

Cosmic seeks to rely upon its services in class 35: *Business marketing analysis and sales analysis services*. The evidence describes the provision of large one-off projects carried out using ProAct software and marketed to customers as ProAct projects. The projects for Pfizer, Sainsbury’s, Pernod Rickard and Gallagher covered sales and marketing analysis, projection and recommendations. There are no details as to how many projects were undertaken in the relevant period, so it could be that the turnover in 2003 relates to the Pfizer project and that few projects have been carried out, but those that have been carried out have been for very large corporations. The projects were external. I bear in mind that there is no *de minimis* rule in relation to quantity of sales. Taking all the evidence in the round, I consider that the commercial exploitation of the mark has been real and that Cosmic is entitled to rely upon its class 35 specification as registered.

Decision

32. The leading authorities which guide me in this ground are from the Court of Justice of the European Union (ECJ): *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, *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 for 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*.

Average consumer and the purchasing process

33. Cosmic's evidence shows that its goods and services involve significant investment and are the subject of a certain amount of bespoke alteration according to the consumer's requirements. Purchase of software to enable

analysis of business data including forecasting and supply chain analysis and management software will be a considered purchase based on research. The average consumer's encounter with the mark is liable primarily to be visual, but may literally involve an aural aspect: 'word of mouth recommendations' (as PIL's evidence shows).

Comparison of goods

34. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the ECJ 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 purpose⁵ and their method of use and whether they are in competition with each other or are complementary.

The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services were:

- (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, taking into account how goods/services are classified in trade.

⁵ The earlier incorrect translation of 'Verwendungszweck' in the English version of the judgment has now been corrected.

35. The goods and services to be compared are:

Earlier mark	Application
<p><i>computer programs for business purposes</i></p> <p><i>Business marketing analysis and sales analysis services</i></p>	<p><i>Computer software (including downloaded computer software) for supply chain management; computer software for managing throughput of goods from manufacture to customer delivery</i></p> <p><i>Computer software design services for supply chain management; computer software development services for supply chain management; consultancy, technical support and information services relating to supply chain management software; installation and maintenance of supply chain management software.</i></p>

36. As referred to above, Ms Maddox submitted that supply chain planning software was entirely different to supply chain management software. Ms Maddox said that supply chain planning software is for analysing whether materials are getting out on time: it is for making recommendations, not for actually ensuring that goods are moving. PIL’s software is to control and manage the movement of goods through the supply chain, essentially logistics. Ms Maddox submitted that the two types of software are not substitutes for each other; she placed great importance on the difference created by the words ‘planning’ and ‘management’. However, I cannot see that supply chain planning could not encompass logistics – which have to be planned. Despite the absence in Cosmic’s evidence of references to the logistics side of supply chain planning, Cosmic’s software cannot be confined to the narrow meaning Ms Maddox submits, which would be contrary to the fair description jurisprudence. The specification it is entitled to rely upon is ‘computer programs for business purposes’. This encompasses PIL’s class 9 goods and so both parties’ goods are identical.


37. Cosmic submits that PIL’s class 42 services are similar to its computer programs, submitting that it is commonplace that an entity offering any of the class 42 services in the application will also offer the software itself: “the rendering of such services will automatically result in the creation of computer software.” Both parties have shown the provision of class 42 computer consultancy services in their evidence (although Cosmic does not have class 42 in its registration). Ms Maddox referred at the hearing to PIL’s design of the

software, which is their customisation of it; the development services, again part of the customisation; and the consultancy technical support and information. She submitted that it is very difficult to separate the goods from the services because they are all linked. The class 42 services in PIL's application are both complementary and in competition with computer software for business purposes, which includes supply chain software. A prospective purchaser may purchase the design, maintenance and consultancy services with a view to buying a bespoke software product. Alternatively, an off the shelf software product may be bought instead of going through the consultancy, maintenance and design process. The users will be the same and the purpose of the software is defined by the service designing it. There is a high degree of similarity between PIL's services in class 42 and Cosmic's 'computer programs for business purposes'.

38. Cosmic's services are *business marketing analysis and sales analysis*. A comparison between these services and computer programs and computer services which are limited to supply chain management does not yield as strong a result for Cosmic as the comparison between its class 9 goods and the application, as above. Cosmic's services do not share the same purpose as PIL's services; they are not in competition and the one is not complementary to the other (in the sense of being indispensable). There is no similarity between them. If computer software for supply chain management may be of use in business marketing and sales analysis, it does not make it similar to the service which uses it: computer software is used in nearly all sectors (*Commercy AG v OHIM* Case T-316/07). Cosmic's evidence is tolerable support for its claim to have used its mark on business analysis services and it has demonstrated use on the software which includes supply chain analysis functionality. Allowing for the possibility that business marketing and sales analysis services may include a supply chain element and may be provided by an undertaking that also provides supply chain management software (as with Cosmic), there is a low degree of similarity between Cosmic's services in class 35 and PIL's class 9 goods.

Comparison of trade marks

39. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, 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. The marks to be compared are:

Earlier mark	Application
<p style="text-align: center;">PRO ACT</p>	

39. The registered trade mark consists of PRO and ACT as separate elements of equal length. Neither is more dominant or more distinctive than the other: the distinctive character of the registered mark resides in its totality. PIL's marks consist of PROACT, with the P and A of greater height than the remainder of the capital letters. One side of the A extends below the line of the other letters. The four marks in the series all have the word INTERNATIONAL beneath the 'PROA' part of PROACT; this element is proportionately subservient to PROACT. Two of the marks contain LTD beneath the C of PROACT: this element is so proportionately small as to be negligible within the overall impression. All four marks in the series contain the device to the left of the words. The device is the same height as the combination of the word elements and is reminiscent of the game solitaire. It is an arbitrary or invented device and is distinctive. The word PROACT is distinctive and highly prominent. By virtue of its size, it is the dominant element. International is smaller and commonplace in trade marks; it does not have a distinctive or dominant position in the marks.

40. Cosmic submits that the PROACT element in PIL's mark is identical to its own mark. This cannot be the case, visually at least, owing to the arrangement of the letters in PIL's mark. Ms Maddox submitted that the marks are not similar because of the presence of the "very strong logo element."

41. Cosmic's mark is composed of two elements. However, a separation of PIL's PRO and ACT elements has also been achieved by the enlargement of the P and A in its PROACT element (in the same way as in Cosmic's own use of its registered mark). This makes the dominant PROACT elements in the parties' marks very similar. The device element in PIL's mark is not integrated with any of the word elements; it is an independent part of the mark. Taking this into account and the relatively small parts played by INTERNATIONAL and LTD, there is a good deal of visual similarity between the marks. Even if there would be a pause in speech between PRO and ACT, any pause would be relatively

indistinct given the open vowel sounds of the O and A. Notwithstanding the additional INTERNATIONAL and LTD elements in the application, the prominence and the shared characteristics of the PRO ACT elements give rise to a good deal of aural similarity between the marks.

42. The single point of similarity between the marks is the PRO ACT/PROACT element. I have referred to the split appearance of the marks into PRO and ACT elements. Both parties refer to an allusion to 'proactive'; however 'proact' is not a dictionary word so there is no obvious step from proact to proactive (in contrast, for example to react and reactive). PRO and ACT are distinct elements in both marks (to a greater extent in Cosmic's). PRO and ACT, separately or juxtaposed, do not appear to create a meaning unless one reads into them 'pro(fessional) act', which is a bit stretched. Without meaning, there is no conceptual similarity between the marks; if there is a 'professional act' concept, then both marks share it.

43. Bearing in mind my findings in relation to visual and aural similarity, my overall conclusion (making the comparison on a visual, aural and conceptual basis) is that there is a substantial degree of similarity between the marks.

Likelihood of confusion

44. Ms Maddox argued that both parties had been offering their respective goods and services in the UK for a considerable length of time and that there had been no confusion between them because of the differences between the marks and between the nature of the software. She reiterated what PIL stated in its counterstatement:

“The Applicant has been using the applied for mark for more than 15 years prior to the application date and is seeking statutory protection for its extensive common law rights.”

Ms Maddox submitted that obtaining registered rights would not harm Cosmic in any way as PIL would be getting what it was entitled to at common law. She proposed that there would be no confusion between the products in the future given the lack of confusion in the past.

45. Absence of confusion has been the subject of judicial comment and a registry tribunal practice notice, TPN 4/2009. It does not help PIL to state that there has been no confusion; there is also no proof that there hasn't been confusion. If the consumer is completely confused, he or she will not know it. There must be evidence to suggest that the relevant public has shown that it distinguishes between the undertakings' goods and services. PIL's evidence is centred on the motor trade, Cosmic's on the fast moving goods sector; there may, hitherto, have been no overlap in the parties' target markets. Peaceful coexistence may have depended upon such a marketplace status quo which has

now been disrupted by PIL “seeking statutory protection for its extensive common law rights”. PIL’s previous attempt to register a CTM appears to have resulted in a complaint from Cosmic, suggesting that if there has been peaceful co-existence, it is disrupted each time PIL attempts to gain a trade mark registration, which puts its ‘rights’ on an entirely different footing. There is no automatic entitlement to a registration simply because a mark has been used.

46. A factor in the global comparison is a consideration of the distinctive character of the Cosmic’s trade mark because the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion⁶. Cosmic’s evidence of use is not on a large enough scale to say that its inherent distinctive character, which is on a reasonably high level (but not the highest), has been enhanced through use.

47. I should guard against dissecting the marks so as to distort the average consumer’s perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. Even if the imperfect picture which the average consumer has of PIL’s mark includes a recollection of the device, I consider that the overall recollection of PIL’s mark will be dominated by the PROACT element.

48. According to the interdependency principle (*Canon*), a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services, and vice versa. The position here is that the goods of both marks are identical and the class 9 goods of Cosmic and the class 42 services of PIL are highly similar. This close proximity is not offset by a lesser degree of similarity between the marks; on the contrary, there is a substantial degree of similarity between the marks. There is a likelihood that the average consumer’s recollection of the distinctive and dominant PROACT elements will mean that there is an expectation that the goods and services are derived from the same source. The presence of INTERNATIONAL, LTD and the device do not rebalance matters in PIL’s favour. **The opposition succeeds against all of PIL’s goods and services.**

Costs

49. Cosmic has been successful and is entitled to an award of costs on the following basis:

Preparing a statement and considering the other side’s statement:	£200
Official fee:	£200

⁶ *Sabel BV v Puma AG* [1998] RPC 199.

Evidence and considering the other side's evidence:	£800
Written submissions:	£200
Total:	£1400

50. I order Proact International Limited to pay Cosmic Solutions Limited the sum of £1400. 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 30 day of July 2010

**Judi Pike
For the Registrar,
the Comptroller-General**