

O-135-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2543559
BY MANAGEMYIP LIMITED
TO REGISTER THE TRADE MARK
ManagemyIP
IN CLASSES 9, 28 & 35**

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER No. 103113 BY
MYIP LIMITED**

BACKGROUND

1) On 31 March 2010 MANAGEMYP Limited (hereinafter the applicant) applied to register the trade mark ManageMyIP in respect of the specification shown below:

In Class 9: Computer games, in particular related to education.

In Class 28: Games, including electronic games, relating especially to aspects of business

In Class 35: Market research services; organisation and conducting of exhibitions for commercial or advertising purposes; organising of business support groups or communities including via a global computer network or the Internet or mobile telephony; business partnering and referrals; organising of business community functions.

2) The application was examined and accepted, and subsequently published for opposition purposes on 16 December 2011 in Trade Marks Journal No.6918.

3) On 16 March 2012, myIP Limited (the opponent), filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the registered proprietor of the following trade marks:

Mark	Number	Date of filing and registration date	Class	Specification
myIP	2521765	21.07.2009 / 27.11.2009	9	Intellectual property management software; database applications for managing intellectual property assets.
			42	Design, maintenance, and updating of computer software and databases relating to intellectual property and intellectual property management; technical support services relating to intellectual property, intellectual property management, intellectual property software and intellectual property databases; information, advisory and consultancy services relating to intellectual property software and intellectual property databases.
			45	Information, advisory and consultancy services relating to intellectual property and intellectual property management.
myIP	M1029237	IC of 21/7/09 (UK) Designation date: 18/1/10	9	Intellectual property management software; database applications for managing intellectual property assets.
			42	Design, maintenance, and updating of computer software and databases relating to intellectual property and intellectual property management; technical support services relating to intellectual property, intellectual property management, intellectual property software and intellectual

				property databases; information, advisory and consultancy services relating to intellectual property software and intellectual property databases.
			45	Information, advisory and consultancy services relating to intellectual property and intellectual property management.

b) The opponent relies upon its two marks above in relation to its grounds of opposition under Sections 5(2)(b) and 5(3). The opponent states that the goods and services are identical and/or similar. It also contends that the mark applied for is similar to its marks such that the average consumer would be confused as to origin of the goods and services. Use of the mark in suit would take unfair advantage of the opponent's marks and also lead to dilution of the distinctiveness of its marks. Further, it could lead to the opponent's marks being tarnished were the goods and services offered under the mark in suit not be of the standard usually applicable to those of the opponent.

c) The opponent contends that it has used the sign "myIP" since at least 2002 and has reputation and goodwill in the goods and services for which it is registered. The marks and goods and services of the two parties are identical/similar and would lead to misrepresentation and offend against Section 5(4)(a).

4) On 7 June 2012, the applicant filed a counterstatement which basically denied the opponent's contentions. It states that the opponent's marks, by usage of upper and lower case, makes the marks into two word marks with the word "my" being the first person-possessive and the abbreviation for Intellectual Property. It will be seen as such, and therefore the term IP has no distinctiveness for any of the goods or services for which the opponent's marks are registered. The first person possessive as a prefix is common for the types of goods and services for which the opponent's marks are registered and as such lack distinctiveness and verge on descriptive marks. The applicant also points out that the IPO Registry also uses the term "myip" in order to inform the general public on all aspects of Intellectual Property.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard, but both parties provided written submissions which I shall refer to as and when required in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 13 August 2012, by Jeremy Mark Kirkpatrick the Managing Director of the opponent, a position he has held since its incorporation in 2002. He states that his company sells software and services relating to the management of intellectual property. In addition to bespoke products he states the company also releases new versions of its package software approximately every year. The software can be used to manage all types of intellectual property from registered items such as trade marks, patents and designs to unregistered property such as copyright, unregistered rights, knowhow and trade secrets. The software includes

contracts, customer relations management, start ups, spin outs and also reminders for important actions. He states that his company runs a user group which meets annually as well as an on-line forum for clients to pose questions and allow other clients to contribute. He states that his company provides advice and consultancy to its customers in relation to management of their IP portfolios and also offers report writing, data load, training and maintenance services. He states that the software is not specific to any industry or sector and as such they have clients in local and national government, numerous private sector companies in all sectors including IP managers, as well as customers overseas. He also states that his company now employs four people and also uses IT contractors.

7) Mr Kirkpatrick states that he met Ms Mitchell the principle of the applicant company, prior to its formation. At the time Ms Mitchell was representing Highbury Ltd, and a possible collaboration was discussed, although it did not occur. At exhibit JMK2 Mr Kirkpatrick provides a copy of a software evaluation agreement, which allowed Highbury Ltd to evaluate the software provided by the opponent so that Highbury could determine whether to negotiate with the opponent regarding licensing its product. He provides the following turnover and promotion figures for the goods and services for which the opponent's marks are registered. The figures relate to sales in the UK/EU:

Year	Turnover £	Promotion £
2003	55,000	1,500
2004	29,000	3,000
2005	64,000	5,000
2006	80,000	5,000
2007	91,500	5,000
2008	143,000	8,000
2009	70,000	5,000

8) Mr Kirkpatrick states that his company attends various trade shows/ conferences. He lists a number in Europe, which he estimates cost between £1000 - £2000 per conference. At other conferences the company has paid others to represent them. He states that the above promotional figures do not include the cost of the annual user group meeting which costs approximately £3000-4000 per annum. At exhibit JMK3 he provides a sample of invoices which show sales of software and licences, and also some installation and training to a number of addresses in the UK.

APPLICANT'S EVIDENCE

9) The applicant filed a witness statement, dated 7 October 2012, by Christi Mitchell the founding director of the applicant company a position she has held since its inception in October 2009. She states that in addition she is also a director of Highbury Ltd. She provides background information on Highbury and her own business contacts. She points out that the agreement signed with the opponent was on behalf of a company in New Zealand, and the intention was to sell the software of the opponent in that country, however sales were not forthcoming and so it was abandoned. She states:

“9. It was some three years later, with much water under the bridge, and nothing to do with the software that we had tried to sell, that the ManageMyIP project was conceived. Most businesses can ill afford to ignore technology, and specifically web technology, to further their ends. A web-based product to promote the recognition of IP assets, their valuation, and information on and tools for IP protection, is quite a distinct product from the IP/patent portfolio management software of myIP which we had briefly used in 2005/6, and was a natural extension of the activities and direction of Highbury Ltd.”

APPLICANT’S EVIDENCE IN REPLY.

10) The applicant filed a second witness statement by Mr Kirkpatrick, dated 12 December 2012. He points out that the invoices he previously provided were only a sample.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

12) I shall first consider the ground of opposition under Section 5(2)(a) of the Act which reads:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b),

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

13) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

14) The opponent is relying upon its trade marks 2521765 which was filed on 21 July 2009 and registered on 27 November 2009 and International mark 1029237 which has

an IC date of 21/7/09 (UK) and a Designation date of 18/1/10. They are both clearly earlier trade marks and because of the interplay between the date the application was advertised and the dates of registration they are not subject to the proof of use requirements set out in Section 6A of the Act.

15) 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 (MEDION) 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). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Distinctive character of the opponent's earlier trade marks

16) To my mind, as the opponent has singularly failed to show that it has a reputation in the marks it is relying upon. The evidence provided is underwhelming at best. The opponent has provided figures relating to turnover and marketing, however whilst I do not know the actual size of the relevant market, it is likely to be of significant size and spread within the UK given the number of businesses etc who generate IP. Therefore, to my mind, the figures provided seem modest and given the breadth of the specification do not amount to enough to achieve a reputation, sufficient to allow the opponent to benefit from an enhanced reputation. However, the opponent's marks are registered and must be regarded as having a degree of distinctiveness, but in my opinion this must be very low given the fact that the goods and services for which they are registered concern intellectual property (IP) belonging to the individual/company purchasing the goods or services.

The average consumer and the nature of the purchasing process

17) I must now determine the average consumer for the goods and services of the opponent. The opponent contends that "the market for these goods and services is not the mainstream so would not be directed at the general public". I am willing to accept that the average consumer for the opponent's goods and services will be businesses of all shapes and sizes. In purchasing the goods and services they will be careful to ensure that the goods and services will achieve what the purchaser wants and will be compatible with the existing systems they use.

Comparison of goods and services

18) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively

endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods 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 are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

19) In *Gerard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs (OHIM))* case T-133/05 the GC said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM-Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the earlier trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM-Petit Liberto (Fifties)*[2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

20) The question of complementary goods/services has been considered by the CFI in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the CFI stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057 ; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757 , paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000 , paragraph 48).”

21) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

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

22) I also take on board that the class in which the goods are placed is relevant in determining the nature of the goods (see *Altenic Ltd’s Trade Mark Application* [2002] RPC 34. Goods in one class cannot be identical to those in another, although they may be similar to a high degree.

23) For ease of reference the competing goods and services are reproduced below. As the specification for both of the opponent’s marks are identical I shall only carry out one comparison test.

Applicant’s goods and services	Opponent’s goods and services
In Class 9: Computer games, in particular related to education.	In Class 9: Intellectual property management software; database applications for managing intellectual property assets.
In Class 28: Games, including electronic games, relating especially to aspects of business.	In Class 42: Design, maintenance, and updating of computer software and databases relating to intellectual property and intellectual property management; technical support services relating to intellectual property, intellectual property management, intellectual property software and intellectual property databases; information, advisory and consultancy services relating to intellectual property software and intellectual property databases.
In Class 35: Market research services; organisation and conducting of exhibitions for commercial or advertising purposes; organising of business support groups or communities including via a global computer network or the Internet or mobile telephony; business partnering and referrals; organising of business community functions.	In Class 45: Information, advisory and consultancy services relating to intellectual property and intellectual property management.

24) The opponent contends:

“5. As mentioned above, the “computer games” in Class 9 of the application are not definitively limited due to the use of “in particular”, therefore the comparison is between computer games in general and the software goods and services relating

to intellectual property and intellectual property management of the registrations. Computer games are ultimately a piece of software which is created and maintained.

6. The goods listed in class 28 are broad enough to encompass intellectual property ownership and management which is an “aspect of business” given that intellectual property is an intangible asset of business.

7. The services in class 35 are broad enough to encompass the goods and services of the earlier registrations. For example, the “organisation and conducting of exhibitions for commercial or advertising purposes” is not limited to a specific topic and therefore, the exhibitions could have intellectual property ownership and management as their focus, likewise the “organising of business community functions” and “organising of business support groups or communities including via a global computer network or the Internet or mobile telephony”. Services in Class 45 of the earlier registrations namely, information, advice and consultancy relating to intellectual property and intellectual property management may involve liaising between parties to secure for example, licensing arrangements and thus could be said to involve “business partnering and referrals” as listed in the application.”

25) The applicant’s goods in classes 9 and 28 are both clearly stated as electronic/computer games relating to education and business. The opponent’s logic, and I use the word in its widest possible context, is that because computer games are comprised of software they are similar to its goods in class 9 which are software/databases for managing intellectual property. I reject the opponent’s contentions. By any rational test the goods of the applicant are completely dissimilar to any of the opponent’s goods or services.

26) The contentions of the opponent regarding the services applied for in class 35 are similarly specious. The fact that the applicant may organise exhibitions to do with intellectual property does not make those services similar to the opponent’s services simply because they are in respect of IP. To adopt this contention would mean that whatever the services registered if the subject matter were the same they would be regarded as similar. I would refer the opponent to the comments of the learned judge in *Avnet* (see above).

27) The fact that I find the goods and services applied for to be dissimilar to those of the opponent’s earlier marks is the end of the issue, but for the sake of completeness I shall carry on with the test.

Comparison of trade marks

28) The trade marks to be compared are as follows:

Applicant’s mark	Opponent’s marks
ManageMyIP	myIP

29) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

30) Clearly the applicant's mark encompasses the whole of the opponent's mark and there is obviously a reasonable degree of visual, aural and conceptual similarity, even though there are differences, such as the word "manage" at the beginning of the mark.

Likelihood of confusion

31) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services and vice versa. Although the trade marks are very similar, that similarity rests in an element which is, at best, of very low distinctiveness and the goods and services of the two parties are dissimilar, there is no likelihood of consumers being confused into believing that the goods and services provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (a) therefore fails.**

32) I now turn to consider the ground of opposition under Section 5(3) of the Act which states:

"5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

33) The relevant principles can be gleaned from the case law of the Court of Justice of the European Union. In particular, cases *General Motors Corp v Yplon SA* [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 and *L'Oreal SA and others v Bellure NV and others* - Case C-487/07. These cases show that:

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel*, paragraph 51.
- (c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
- (d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42
- (e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; *Intel*, paragraph 57.
- (f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68: whether this is the case must also be assessed globally, taking account of all the relevant factors; *Intel*, paragraph 79.
- (g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel*, paragraphs 76 and 77.
- (h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.
- (i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by

the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal*, paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; *L'Oreal*, paragraph 41.

34) The onus is upon an opponent to prove that its earlier trade marks enjoy a reputation or public recognition and it needs to furnish the evidence to support this claim. In the instant case the opponent filed evidence which it contended showed that it had reputation in its earlier marks for, broadly speaking, services surrounding the management of intellectual property. At paragraph 16 above I set out my concerns with the evidence provided and came to the conclusion that the opponent had not shown reputation in its mark for any goods or service. Thus the opponent falls at the first hurdle, and the opposition under Section 5(3) fails.

35) Lastly I turn to the ground of opposition under Section 5(4)(a) of the Trade Marks Act 1994 which reads:

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

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

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

36) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven*

Warnink BV v. J. Townsend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

„The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

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

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

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

„To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

37) I also note the comments of Pumfrey J in *South Cone Incorporated v JackBessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

38) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

“Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

39) First I must determine the date at which the opponent's claim is to be assessed; this is known as the material date, which is 31 March 2010. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

40) Earlier in this decision I found that use of the marks in suit, actual or on a fair and notional basis would not result in confusion with the opponent's marks. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

CONCLUSION

41) The opposition has failed under all three grounds.

COSTS

42) The applicant has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering the other sides' evidence	£800

TOTAL	£1100
-------	-------

43) I order myIP Limited to pay MANAGEMYIP Limited the sum of £1100. 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 21st day of March 2013

**George W Salthouse
For the Registrar,
the Comptroller-General**