

**O-523-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3140908 BY  
ATHENIAN IT DEVELOPMENTS LTD  
TO REGISTER:**

**Athena Evaluate**

**AS A TRADE MARK IN CLASSES 9, 38 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 406768 BY METRON TECHNOLOGY LIMITED**

## BACKGROUND & PLEADINGS

1. On 16 December 2015, Athenian IT Developments Ltd (“the applicant”) applied to register the trade mark **Athena Evaluate** for the goods and services shown in paragraph 21 below. The application was published for opposition purposes on 11 March 2016.

2. On 13 June 2016, the application was opposed in full by Metron Technology Limited (“the opponent”). The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3), the opponent relies upon the following United Kingdom and European Union Trade Mark (“EUTM”) registrations:

UK no. 1318913 for the trade mark **ATHENE** which was applied for on 14 August 1987 and entered in the register on 5 February 1993. It is registered for the following goods in class 9:

Computer programs; tapes and discs, all for the magnetic or optical recording of data; semi-conductor integrated circuits; printed circuit boards; computers; electronic data processing, display, print out and storage apparatus; telecommunications apparatus; installations comprising all of the aforesaid goods; parts and fittings for all the aforesaid goods; all included in Class 9; but not including audio visual teaching apparatus or sound or visual recording, reproducing and transmitting apparatus or goods of the same description as these excluded goods.

EUTM no. 2566404 for the trade mark **ATHENE** which was applied for on 6 February 2002 and entered in the register on 10 July 2003. It is registered for the following goods and services:

**Class 9** - Computer programmes; tapes and disks; all for the magnetic or optical recording of data; semiconductor integrated circuits; printed circuit boards; computers; electronic data processing, display, print out and storage apparatus; telecommunications apparatus; installations comprising all of the aforesaid goods; parts and fittings for all the aforesaid goods all included in Class 9 but not including audio visual and teaching apparatus for sound or visual recording, reproducing and transmitting apparatus or goods of the same description and these excluded goods.

**Class 16** - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; brochures, manuals; instruction and user manuals.

**Class 42** - Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

3. In relation to its objection based upon section 5(3) of the Act, in addition to its claim that “the relevant public will believe that [the competing trade marks] are used by the same undertaking or think that there is an economic connection between the users of the trade marks”, the opponent states:

“19...use of the applicant’s mark would take unfair advantage on the opponent, whereby, upon entering the market, they would be able to immediately benefit from the reputation built up by the opponent without the equivalent investment of resources, effort and time.

20. The opponent submits that their software product offered under the opponent's marks may be offered for sale alongside the software product offered under the applicant's mark. It is therefore highly likely that consumers will be confused by the similarity of the marks and purchase the applicant's product rather than the opponent's product. This would unfairly detract business away from the opponent.

21. The applicant's mark covers goods and services which are identical or highly similar to those covered by the opponent's marks. The opponent has no control over the applicant's offer of these goods and services and should the applicant, for instance, offer lower quality goods and services this will inevitably affect the opponent's reputation in its marks.

22. The opponent believes that by allowing registration and use of the applicant's mark, the opponent's marks will lose their distinctiveness and their ability to signify origin will be weakened..."

4. Finally, in relation to its objection based upon section 5(4)(a) of the Act, the opponent states that the word ATHENE has been used throughout the United Kingdom since 1986 in relation to "software; design and development of computer hardware and software." It further states:

"25. Registration and use by the applicant of the applicant's mark would amount to a misrepresentation and would be likely to cause confusion on the part of the public that the goods and services provided under the applicant's mark, and the business behind it, is associated or connected with that of the opponent or their brand or that the goods and services provided under the applicant's mark emanate from the opponent, which is not the case.

26. The opponent submits that this will cause damage to the opponent, for instance through the diversion of sales."

5. The applicant filed a counterstatement in which the basis of the opposition is denied. It explains that it has six trade marks already registered (all of which it states begin with the word “Athena”) and that it has “had no oppositions nor any evidence of confusion with any other trade marks.” In its counterstatement, the applicant put the opponent to proof of use. It stated that it sought proof of use in relation to: “computer software for use in the professional services sector.” The tribunal responded to that request in a letter dated 17 October 2016. The tribunal stated:

“You have asked the opponent to provide proof of use of [as above]. However, you are asked to specify precisely what goods and/or services that are covered by the opponent’s earlier marks you wish them to provide proof of use.

...If you chose not to amend the counterstatement the registrar may move to strike out any grounds which are not adequately particularised.”

6. A period expiring on 7 November 2016 was allowed for the applicant to clarify its position. As the applicant did not respond to that request, in an official letter dated 28 November 2016, it was allowed “a further final period of 7 days” from the date of that letter to reply i.e. by 5 December 2016. In an official letter dated 21 December 2016, the tribunal wrote to the applicant again. In that letter it stated:

“As we have not received a response to our letters, and as the registry considers the term “computer software for use in the professional services sector” to be too vague, the Form TM8 and counterstatement will be admitted into the proceedings with your request that the opponent provide proof of use disregarded. A copy of the form has been sent to the opponent.”

7. In these proceedings, the opponent is represented by Foot Anstey LLP; the applicant represented itself. Both parties filed evidence with the opponent also filing written submissions during the course of the evidence rounds. Although neither party asked to

be heard both elected to file written submission in lieu of attendance at a hearing; I will refer to these submissions, as necessary, later in this decision.

## **DECISION**

8. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act which read as follows:

“5 (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.

(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 European Union trade mark or international trade mark (EU) in the European Union) 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.

(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.”

9. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As these earlier trade marks had been registered for more than five years at the date when the application was published, they are, in principle, subject to proof of use, as per section 6A of the Act. In its Notice of Opposition, the opponent indicated that its earlier trade marks had been used upon all the goods and services for which they are registered and upon which it relied. The circumstances surrounding the applicant’s request for proof of use is explained above. The consequence of the applicant failing to respond to the tribunal’s letters of 17 October and 28 November 2016 is that, as the tribunal pointed out in its letter of 21 December 2016, its request for proof of use is to be disregarded. The opponent can, as a consequence, rely upon all the goods and services it has identified without having to make good its claim to have used its trade marks upon these goods and services.

## Opponent's evidence

11. The opponent's evidence is provided by Andrew Smith in a witness statement accompanied by exhibit AS1 (consisting of 129 pages). Mr Smith is one of the opponent's directors; he has held that position since 1999.

12. I begin by noting that the applicant did not challenge any aspect of the opponent's evidence. Rather, in, inter alia, an email dated 29 April 2017, its managing director, Neil Renfrew, responded to the filing of the opponent's evidence stating:

“...I've no doubt that Merton has been using the “Athene” trade mark for some time and I wish them success with it.”

13. In view of that admission it is not, I think, necessary for me to produce as detailed an evidence summary as might otherwise have been necessary. With that in mind, Mr Smith explains that the opponent specialises:

“6...“in the development and supply of software products and related support and training. Primarily, the opponent produces automated products in relation to capacity management, but we also provide goods and services to support IT systems management, cloud capacity management, server performance and capacity management software.”

The opponent's software and associated services is, he states, provided to “customers worldwide including the USA, Japan and South Africa”. The opponent's customers include Aegon, Sainsbury's, Nestle and EE.

14. With that background established, the main points emerging from Mr Smith's evidence are, in my view, as follows:



- The ATHENE brand was first used in 1986 when Athene Software Limited, a wholly owned subsidiary of the opponent, was registered;
- Between 1 April 1993 and 31 March 2017, the opponent's sales figures in relation to the ATHENE brand amounted to some £54m. Although Mr Smith explains that evidence in this respect is provided at pages 1 to 12 of exhibit AS1, given the international scope of the opponent's business, it is not immediately apparent to me what percentage of these sales figures relate to the United Kingdom;
- In 1987, the opponent launched its first product under the ATHENE brand i.e. capacity management software;
- Further "products and solutions" sold under the ATHENE brand were introduced in August 1987, February 2013, August 2016 and February and March 2017;
- The opponent's "annual turnover" between 2012 and 2016 (including turnover relating to the ATHENE brand) amounted to some £9.7m (once again, it is not clear to me what percentage of these sales relate to the United Kingdom);
- The opponent or its subsidiary Athene Software Limited own five domain names (the first of which was registered "before 1996") and all of which contain the word athene either as a separate element, for example, athene-software.co.uk or with another word, for example, metronathene.co.uk;
- Webpages from metron-athene.com (which Mr Smith describes as the "primary domain") downloaded on 10 April 2017 are exhibited with athene® appearing on many of the pages provided;
- In the period January 2015 to January 2017, the opponent's primary domain received 39,633 visitors with 162,887 pages viewed;

- Since 2005, the opponent has spent a little under £1.9m on advertising and marketing the ATHENE brand;
- Between 1 January 2014 and 1 January 2017, the opponent “has invested funds in the use of Google AdWords” and on promoting the brand on LinkedIn;
- The opponent and its trade marks have featured in the following publications: IBM Global Solutions Directory (website), Gartner Data Center (website), VirtualizationAdmin.com (website) and IBM Webinar Events (website);
- The opponent and its ATHENE brand have appeared in reports, reviews, supplements and articles;
- In February 2008, the ATHENE brand and products were discussed in a Butler Group review. Mr Smith explains that the Butler Group are “a leading provider of information technology analysis and advice” and the review would have been seen “primarily by IT company analysts”;
- In January 2015, the ATHENE brand was featured in a Gartner Market Guide which Mr Smith explains “would have been seen by prospective clients looking to purchase capacity management software”;
- The ATHENE trade mark has and continues to be used on: job adverts, order forms, leaflets and flyers, pop up stands and posters, email signatures and email addresses;
- The ATHENE brand is “active on social media” and features on LinkedIn (with 765 followers at 6 April 2017) and Twitter (with 882 followers at 6 April 2017);
- The opponent is a silver partner of the Oracle Partnership and has been nominated for and awarded “numerous awards for the ATHENE brand and products”. For example, the Microsoft Partner Network Silver Award for independent Software vendor (2012), the Microsoft Partner Network Silver Award

for Application Development (2014), also in 2014, the opponent was nominated for a Virtualization Management and Optimization Reader's Choice Award by VirtualizationReview.com;

- In 2017, the opponent was nominated for a UK Enterprise award and a Technology Innovator Award.

### **Applicant's evidence**

15. This consists of a witness statement from Mr Renfrew (mentioned above). Mr Renfrew explains that the applicant was incorporated in April 2010 and specialises in "providing information technology services and products primarily to large law firms." He states that the applicant is the owner of six UK trade marks, all of which are registered in classes 9, 38 and 42 and all of which consist of two words i.e. ATHENA DOMINUS, ATHENA PRAXIS and ATHENA PORTICO (all filed in May 2012), ATHENA QUANTUM (filed in June 2015) and Athena Auditorium and Athena Atrium (both filed in December 2015). Full details of these trade marks appear in the Annex to this decision.

16. Mr Renfrew states that none of these trade marks were subject to opposition and that he was not aware of the opponent before the opposition was filed. He adds:

"9. [He] is not aware of or has seen any evidence of any confusion between any of the applicant's currently registered trade marks...and the opponent's trade mark Athene®".

And:

"13. There is and has been no evidence of any confusion between any of the applicant's trade marks and the opponent's trade mark Athene® over the last five years.

14. If the opposition is based on the likelihood of confusion then no evidence has been presented to back this up.

15. A Google search for the word “Athene” followed by a Google search for the term “Athena Dominus” testifies to the absence of confusion (although this is not presented as evidence since Google searches are, by nature, dynamic and therefore subject to change).”

17. That concludes my summary of the evidence filed, to the extent I consider it necessary.

18. I shall deal first with the objection based upon section 5(2)(b) of the Act.

### **Section 5(2)(b) – case law**

19. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles:**

(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 or 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;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also 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 of that mark;

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

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

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

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

**The opponent’s strongest case**

20. The opponent relies upon two earlier trade marks both of which are registered for the identical word i.e. ATHENE. As the specifications in class 9 are identical and as the EUTM also contains goods in class 16 and services in class 42, it is the EUTM which offers the opponent its strongest case and it is upon the basis of this trade mark that I shall conduct the comparison.

**Comparison of goods and services**

21. The competing goods and services are as follows:

<b>The opponent’s goods and services – EUTM no.2566404</b>	<b>The applicant’s goods and services</b>
<p><b>Class 9</b> - Computer programmes; tapes and disks; all for the magnetic or optical recording of data; semiconductor integrated circuits; printed circuit boards; computers; electronic data processing, display, print out and storage apparatus; telecommunications apparatus; installations comprising all of the aforesaid goods; parts and fittings for all the aforesaid goods all included in Class 9 but not including audio visual and teaching apparatus for sound or visual recording, reproducing and transmitting apparatus or</p>	<p><b>Class 9</b> - Software, application software and software platforms and interfaces for use in relation to business services, business planning, business pricing, business project management, process management, business management, business monitoring, business reporting, software integration, software management, software access management, data, information and database management, business intelligence, data extraction, monitoring,</p>

<p>goods of the same description and these excluded goods.</p> <p><b>Class 16</b> - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; brochures, manuals; instruction and user manuals.</p> <p><b>Class 42</b> - Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.</p>	<p>management and presentation; downloadable publications and reports; databases.</p> <p><b>Class 38</b> - Telecommunications; electronic mail services; computer aided transmission of messages and images; providing access to databases; providing user access to a global computer network; providing internet portals, on-line chat rooms, on-line forums and electronic bulletin boards for transmission of messages among users; communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; services for internet users to upload, post, display, tag, and electronically transmit data, on-line publications and documentation and information; advice and information relating to all the aforesaid services.</p> <p><b>Class 42</b> - Information technology services; software, application software, software platform, computer interface and Intranet design, development, installation, integration, maintenance, repair and support services; integration of computer systems and networks; software</p>
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	engineering; providing temporary use of non-downloadable computer software in relation to business services, business planning, business pricing, business project management, process management, business management, business monitoring, business reporting, software integration, software management, software access management, data, information and database management, business intelligence, data extraction, monitoring, management and presentation; hosting services and software as a service and rental of software; design and development of information technology systems, applications and processes; information, advice and consultancy in relation to all the aforesaid services.
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22. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“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 purpose and their method of use and whether they are in competition with each other or are complementary”.



The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This enquiry 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 or services in the same or different sectors.

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...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”.

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

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

“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 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).”

In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated:

“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.”

In *Separode Trade Mark* BL O-399-10, the Appointed Person stated:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that

the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

23. In its submissions, the opponent submits:

“9...that [the applicant’s goods in class 9] are identical to the goods covered by [its] marks with the exception of “downloadable publications and reports” which is highly similar to the goods covered by [its] marks. That is so from the perspective of the nature of the goods, their method of consumption by the average consumer, and the distribution and sales channels of the goods.”

24. In relation to the applicant’s services in class 38, the opponent submits:

“12...the contested services are similar to the services covered by [its] marks. There is a clear link between the goods covered in class 9 of [its trade marks] and the applicant’s services in class 38, as consumers would use the goods in class 9 for telecommunication and communication purposes.”

25. Finally, in relation to the applicant’s services in class 42, the opponent submits:

“15...the contested services are identical or highly similar to [its services in class 42]. IT companies commonly provide software and computer design services and therefore these goods and services are complementary.”

26. In its submissions, the applicant states:

“4. Both marks relate to pieces of computer software and that is true. However, as far as can be ascertained on the internet, they perform different functions and are aimed at different users in different business sectors. Any similarity is a consequence of the need to “categorise” the goods and related services for

registration purposes. The goods and services are obviously not identical. They are not even similar. If they were, it is likely that [the opponent] would be taking action against [the applicant] on copyright grounds!”

27. As the applicant’s request for proof of use was struck-out for lack of particularisation, it was not necessary for the opponent to provide evidence of the use it had made of its earlier trade marks. In those circumstances, the applicant’s reference to the actual goods and services upon which the opponent may use its trade mark is not relevant. It is the wording of the specifications as they appear on the Trade Marks Register that matters and it is upon that basis that I am required to conduct the comparison.

### **Class 9**

28. The applicant’s specification in this class consists of three categories of goods i.e. (i) “software, application software and software platforms and interfaces” for use in a range of essentially business related activities, (ii) “downloadable publication and reports” and (iii) “databases”. The opponent’s specification in this class includes, inter alia, “computer programmes” (which would include all of the goods in the applicant’s specification in category (i)) and “electronic data processing, display, print out and storage apparatus” (which would include the applicant’s goods in category (iii)). Insofar as the goods in category (ii) of the application are concerned, the opponent’s specification in class 16 includes, inter alia “brochures, manuals, instruction and user manuals”. As these include the same goods as those in category (ii) of the applicant’s specification (but in a different format), they are, in my view, similar to a high degree.

### **Class 38**

29. The applicant’s services in this class are all, broadly speaking, telecommunication services of one kind or another and advice and information relating to such services. Whilst the opponent’s earlier trade mark is not registered in this class, its class 9

specification includes “telecommunication apparatus”. As the case law above explains, goods may be regarded as complementary to one another when:

“...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”.

30. Although that was in the context of a comparison of goods, as the case law further explains, the purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings.

31. As the applicant’s telecommunication services would be unable to function without the opponent’s telecommunication apparatus, clearly one is important for the use of the other. As to whether the average consumer may think that the responsibility for the goods and services I have mentioned come from the same or connected undertakings, absent submissions to the contrary, my own experience (as a member of the general public) informs me that it is not unusual to find, for example, undertakings providing both telecommunication apparatus (routers for example) and telecommunication services (broadband services for example), and who also, unsurprisingly, provide advice and information in relation to such goods and services. Absent submissions to the contrary, I find there is a complementary relationship between the goods and services I have identified, leading in turn, to at least medium degree of similarity between them.

## **Class 42**

32. The applicant’s specification in this class includes “information technology services” and “design and development of information technology systems, applications and processes” which would encompass the opponent’s “design and development of computer hardware and software” in the same class; such services are identical on the

*Meric* principle. The applicant's "software, application software, software platform, computer interface and Intranet design" and "software engineering" is synonymous with the opponent's "design and development of computer hardware and software" and is also identical.

33. The opponent's specification in class 9 includes "Computer programmes", "computers" and "electronic data processing, display, print out and storage apparatus", whereas the applicant's specification in class 42 includes:

"software, application software, software platform, computer interface and Intranet design", "development, installation, integration, maintenance, repair and support services;", "integration of computer systems and networks", "providing temporary use of non-downloadable computer software in relation to business services, business planning, business pricing, business project management, process management, business management, business monitoring, business reporting, software integration, software management, software access management, data, information and database management, business intelligence, data extraction, monitoring, management and presentation", "hosting services and software as a service and rental of software" and "information, advice and consultancy in relation to all the aforesaid services."

34. In my view, the average consumer will be extremely familiar with the established pattern of trade in which undertakings engaged in a trade in computer software and hardware will routinely provide the "complementary services" (as defined in the case law) I have identified in the paragraph above. This, in my view, results in at least a medium degree of similarity between the opponent's goods in class 9 and the applicant's services I have identified.

## **The average consumer and the nature of the purchasing act**

35. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

36. The average consumer of the goods and services at issue in these proceedings will be both members of the general public and business users buying on behalf of a commercial undertaking with both visual and aural considerations featuring in the selection process. As many of the goods and services at issue are more likely than not to be obtained by self-selection from (where appropriate) a bricks-and-mortar retail outlet or from the equivalent pages of a catalogue or website, visual considerations are likely to dominate the selection process, although not to the extent that aural considerations (in the form of word-of-mouth recommendations and oral requests to sales assistants both in person and by telephone) can be discounted.

37. As to the degree of care the average consumer will display when selecting the goods and services at issue, I note that the cost and importance of many of the goods and services at issue will vary considerably. Contrast, for example, a member of the



general public selecting many of the goods in class 16 (and paying a fairly low degree of attention during that process) with a business user wishing to engage a company to provide IT related development, maintenance and support services. As the latter services are likely to be of considerable importance to the well-being of a commercial undertaking and as any purchasing decisions made in relation to such services is likely to involve not insignificant financial outlay (and may also involve, for example, meetings with potential suppliers), I would expect the average business user to pay a fairly high degree of attention to the selection of many of the goods and services at issue. I will return to this point later in this decision when I consider the likelihood of confusion.

### **Comparison of trade marks**

38. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

39. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
ATHENE	Athena Evaluate

40. The opponent's trade mark consists of the six letter word ATHENE presented in block capital letters. That is the overall impression it will convey and where its distinctiveness lies.

41. The applicant's trade mark consists of two words. The first six letter word in the applicant's trade mark is presented in title case. The second word (also presented in title case) and its meaning (i.e. inter alia, to "appraise" – collinsdictionary.com refers) will be well-known to the average consumer. In its submissions filed during the evidence rounds, the opponent states that it is clear that:

"7...the dominant element of the applicant's mark is "Athena" with the additional word "Evaluate" connoting part of the intended purpose of the products or services to be offered under that dominant mark..."

42. Although consisting of two words both of which will contribute to the overall impression the applicant's trade mark conveys, when considered in relation to the goods and services for which registration is sought, the word "Evaluate" has, in my view, very little if any distinctive character. It will, as a consequence, have a low relative weight in the overall impression conveyed. Rather, it is the first distinctive word in the applicant's trade mark i.e. "Athena" which will dominate the overall impression conveyed.

43. When compared from a visual standpoint, both trade marks either consist of or contain a word consisting of six letters and in which the first five letters are identical. Notwithstanding the different case in which the words are presented (notional and fair use of the opponent's trade mark would, inter alia, include use in title case i.e. as

“Athene”) and the presence of the word “Evaluate” in the applicant’s trade mark, there remains, in my view, a fairly high degree of visual similarity between them.

44. Turning to the aural comparison, the first word in the applicant’s trade mark and the opponent’s trade mark consist of three syllables. Given the descriptive nature of the word “Evaluate” it is, in my view, highly likely that the applicant’s trade mark will be referred to by the word “Athena” alone; in those circumstances, the competing trade marks are aurally highly similar. However, even if I am wrong in that regard and the applicant’s trade mark is articulated in full, as the word “Athena” would be articulated first, there remains a fairly high degree of aural similarity between the competing trade marks.

45. Finally, the conceptual comparison. In its submissions filed during the evidence rounds the opponent states:

“7...Athena is the later Romanisation (i.e. the rendering into Latin as a matter of language and in into Roman culture) of the existing Greek name for the god Athene; the goddess of wisdom, skill in the arts, etc.”

46. Although I am aware that in Greek religion and mythology Athene/Athena are alternative names for the same goddess, I have no evidence as to how familiar the average consumer will be with these meanings. If they are familiar with these meanings (and as the word “Evaluate” does nothing to either alter the concept conveyed by the word Athena or create a new concept), the competing trade marks are conceptually identical. If, however, they are unfamiliar with these meanings, the competing trade marks are, insofar as it is relevant, conceptually neutral.

### **Distinctive character of the earlier trade mark**

47. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by

reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

48. As the opponent's earlier trade mark is neither descriptive of nor non-distinctive for the goods and services upon which it relies, it is, absent use, possessed of a high degree of inherent distinctive character. In its submissions filed in lieu of a hearing, the opponent states:

“19...the opponent's marks have an enhanced degree of distinctiveness as a consequence of the use the opponent has made of the marks...”

49. As I mentioned above, not only does the applicant not challenge the opponent's evidence, its managing director, Mr Renfrew, sensibly accepts that it has used the earlier trade mark upon which it relies. Although during the course of my review of the opponent's evidence I explained that I was uncertain what percentage of its sales figures related to the United Kingdom, the unchallenged evidence indicates that the opponent has used its earlier trade mark for some 28 years prior to the filing of the application and that use has been, broadly speaking, in the field of capacity management software and related services. Based in Somerset, it is not, in my view, unreasonable for me to infer that, inter alia, a not insignificant portion of the sales of £54m, visitors to its primary domain and amount spent on advertising (that relate to the period prior to the filing of the application) also relate to the United Kingdom. That, together, with the articles in which the opponent's earlier trade mark has featured and the nominations and awards it has received, point to it having acquired an enhanced degree of distinctive character by virtue of the use that has been made of it. However,

even if I am wrong in this regard, for reasons which will shortly become obvious, it does not matter.

### **Likelihood of confusion**

50. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the applicant's goods in class 9 are identical to some of the opponent's goods in class 9 and highly similar to some of the opponent's goods in class 16;
- the applicant's services in class 38 are similar to the opponent's goods in class 9 to at least a medium degree;
- the applicant's services in class 42 are either identical to some of the opponent's services in class 42 or similar to some of the opponent's goods in class 9 to at least a medium degree;
- the average consumer of the goods and services at issue is either a member of the general public or a business user;

- such an average consumer will select the goods and services at issue using a mixture of visual and aural means (with visual considerations likely to dominate) whilst paying a degree of attention varying from fairly low to fairly high;
- the overall impression conveyed by the opponent's trade mark and its distinctiveness lies in the single word of which it is composed;
- the word "Athena" will dominate the overall impression the applicant's trade mark conveys;
- the competing trade marks are visually similar to a fairly high degree, aurally similar to at least a fairly high degree and, if not conceptually neutral, conceptually identical;
- the opponent's earlier trade mark is possessed of a high degree of inherent distinctive which, in relation to some goods and services, has been enhanced by the use made of it.

51. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods and services down to the responsible undertakings being the same or related.

52. In reaching a conclusion, I shall proceed on the basis most favourable to the applicant i.e. that (i) the average consumer will pay a high degree of attention during the selection process (making them less prone to the effects of imperfect recollection), (ii) the competing trade marks are conceptually neutral, and (iii) that the inherent distinctiveness of the opponent's trade mark has not been enhanced by the use that has been made of it.

53. However, even approaching the matter on that basis, as the competing goods and services are similar to at least a medium degree and the competing trade marks visually

and aurally similar to a fairly high degree, it will, in my view, inevitably lead to a likelihood of direct confusion. If the competing trade marks are conceptualised as I mentioned above (i.e. as the name of a goddess) the outcome is even more pronounced. That being the case, the opposition succeeds in full.

54. In reaching that conclusion, I have not overlooked Mr Renfrew's comments regarding (i) the absence of evidence of confusion between the competing trade marks and (ii) the applicant's registrations shown in the Annex to this decision. Neither assist the applicant. The first, for the reasons explained by Kitchen L.J. in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, when he stated:

"80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."

55. The comments of Millett L.J. in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 are also relevant, when he stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

56. As to the applicant's registrations, all were applied for after both of the earlier trade marks upon which the opponent relies. The fact that the opponent has not taken action against those registrations is a matter for them.

## **Conclusion**

**57. The opposition based upon section 5(2)(b) of the Act has been successful in full and, subject to any successful appeal, the application will be refused.**

## **The grounds based upon sections 5(3) and 5(4)(a) of the Act**

58. Having reached a very clear conclusion under section 5(2)(b) of the Act, in the interests of procedural economy I see no need to consider the additional grounds upon which the opponent relies.

## **Costs**

59. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced prior to 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Using the TPN mentioned as a guide, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and considering the applicant's counterstatement:	£200
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Preparing evidence and considering the applicant's evidence:	£500
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Written submissions:	£300
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Official fee:	£200
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**Total:**

**£1200**

60. I order Athenian IT Developments Ltd to pay to Metron Technology Limited the sum of **£1200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 18<sup>th</sup> day of October 2017**

**C J BOWEN**

**For the Registrar**

**The applicant's trade marks (paragraph 15 refers).**

UK nos. 2623077, 2623071 and 2623079 for the trade marks **ATHENA DOMINUS**, **ATHENA PRAXIS** and **ATHENA PORTICO** all of which were applied for on 30 May 2012, entered in the register on 16 November 2012 and which stand registered for the following goods and services:

**Class 9** - Computer and application software relating to business process and knowledge management; Intranet servers.

**Class 38** - Internet and intranet portal services; electronic mail services; computer aided transmission of messages and images; providing access to databases; providing user access to a global computer network; providing Internet portals, on-line chat rooms, on-line forums and electronic bulletin boards for transmission of messages among users; information, advice and consultancy in relation to all the aforesaid services.

**Class 42** - Computer software design, development, installation, integration, maintenance and repair; Intranet design, development and maintenance; providing temporary use of non-downloadable computer software; information, advice and consultancy in relation to all the aforesaid services.

UK no. 3113179 for the trade mark **ATHENA QUANTUM** which was applied for on 14 June 2015 and entered in the register on 20 November 2015 and which is registered for the goods and services shown below:

**Class 9** - Software, application software and software platforms and interfaces for use in relation to business services, process management, business management, business monitoring, business reporting, software integration, software management, software access management, data, information and database management, business intelligence, data extraction, monitoring, management and presentation; downloadable publications and reports; databases.

**Class 38** - Telecommunications; electronic mail services; computer aided transmission of messages and images; providing access to databases; providing user access to a global computer network; providing internet portals, on-line chat rooms, on-line forums and electronic bulletin boards for transmission of messages among users; communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; services for internet users to upload, post, display, tag, and

electronically transmit data, on-line publications and documentation and information; advice and information relating to all the aforesaid services.

**Class 42** - Information technology services; software, application software, software platform, computer interface and Intranet design, development, installation, integration, maintenance, repair and support services; integration of computer systems and networks; software engineering; providing temporary use of non-downloadable computer software in relation to ; hosting services and software as a service and rental of software; design and development of information technology systems, applications and processes; information, advice and consultancy in relation to all the aforesaid services.

UK no. 3140909 for the trade mark **Athena Atrium** which was applied for on 16 December 2015, entered in the register on 18 March 2016 and which is registered for the goods and services shown below:

**Class 9** - Software, application software and software platforms and interfaces for use in relation to business services, process management, business management, business monitoring, business reporting, software integration, software management, software access management, data, information and database management, business intelligence, data extraction, monitoring, management and presentation; downloadable publications and reports; databases.

**Class 38** - Telecommunications; electronic mail services; computer aided transmission of messages and images; providing access to databases; providing user access to a global computer network; providing internet portals, on-line chat rooms, on-line forums and electronic bulletin boards for transmission of messages among users; communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; services for internet users to upload, post, display, tag, and electronically transmit data, on-line publications and documentation and information; advice and information relating to all the aforesaid services.

**Class 42** - Information technology services; software, application software, software platform, computer interface and Intranet design, development, installation, integration, maintenance, repair and support services; integration of computer systems and networks; software engineering; providing temporary use of non-downloadable computer software in relation to business services, process management, business management, business monitoring, business reporting, software integration, software management, software access management, data, information and database management, business intelligence, data extraction, monitoring, management and presentation; hosting services and software as a service and rental of software; design and development of information technology systems, applications and processes; information, advice and consultancy in relation to all the aforesaid services.

UK no. 3140907 for the trade mark **Athena Auditorium** which was applied for on 16 December 2015, entered in the register on 18 March 2016 and which is registered for the goods and services shown below:

**Class 9** - Software, application software and software platforms and interfaces for use in relation to business services, data governance, data analysis, data auditing and reporting, process management, business management, business monitoring, business reporting, software integration, software management, software access management, data, information and database management, business intelligence, data extraction, monitoring, management and presentation; downloadable publications and reports; databases.

**Class 38** - Telecommunications; electronic mail services; computer aided transmission of messages and images; providing access to databases; providing user access to a global computer network; providing internet portals, on-line chat rooms, on-line forums and electronic bulletin boards for transmission of messages among users; communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; services for internet users to upload, post, display, tag, and electronically transmit data, on-line publications and documentation and information; advice and information relating to all the aforesaid services.

**Class 42** - Information technology services; software, application software, software platform, computer interface and Intranet design, development, installation, integration, maintenance, repair and support services; integration of computer systems and networks; software engineering; providing temporary use of non-downloadable computer software in relation to business services, data governance, data analysis, data auditing and reporting, process management, business management, business monitoring, business reporting, software integration, software management, software access management, data, information and database management, business intelligence, data extraction, monitoring, management and presentation; hosting services and software as a service and rental of software; design and development of information technology systems, applications and processes; information, advice and consultancy in relation to all the aforesaid services.