

O-334-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2422005B
BY EVOLUTION SECURITY SYSTEMS LIMITED TO REGISTER A
TRADE MARK IN CLASSES 9, 37 & 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 96568 BY
EVOLUTION (ELECTRONIC SECURITY SYSYEMS) LIMITED**

BACKGROUND

1. On 17 May 2006, Evolution Security Systems Limited (the applicant) applied to register the following trade mark for a range of goods and services in classes: 9, 35, 37, 38, 41 and 42; the application was allocated trade mark No. 2422005.




Following examination, the application was divided and the part of the application allocated the suffix B was subsequently accepted and published for opposition purposes on 7 December 2007 in Trade Marks Journal No.6713 for the following goods and services:

Class 9: Computer software and hardware for security purposes; anti-virus software, software firewalls, spam and advertisement inhibiting software, access control equipment and software, authentication software, content filtering software, archiving software, Internet screening software, email and web browsing screening and control software, intrusion detection and prevention software, security and web application testing software, and encryption and decryption software; none of the aforesaid goods being for printing equipment or for the electroacoustic field; video recordings concerning IT security.

Class 37: Installation of computer hardware relating to IT security.

Class 42 - Leasing and rental of and consultancy and support relating to computer software and hardware for security purposes, including anti-virus software, software firewalls, spam and advertisement inhibiting software, access control equipment and software, authentication software, content filtering software, archiving software, Internet screening software, email and web browsing screening and control software, intrusion detection and prevention software, security and web application testing software, and encryption and decryption software; security services, Internet screening services including e-mail and web browsing screening services, intrusion detection and prevention services; computer and network security risk assessment; installation and configuration of computer hardware and security software; security and web application testing services, security policy design services, consultancy and support relating to security, access control and encryption.

2. On 6 March 2008, Evolution (Electronic Security Systems) Limited (the opponent) filed a notice of opposition. This consists of grounds based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act). In their Statement of Grounds they indicate that the opposition is based upon the following trade marks:

Trade Mark	No.	Application Date	Registration date	Goods and services
EVOLUTION	2214018	11.11.1999	11.08.2000	<p>9 - Electronic security system apparatus; closed circuit television apparatus; all for security purposes.</p> <p>37 - Installation, maintenance and repair services all relating to security equipment and/or apparatus.</p> <p>42 - Advice and design services all relating to the provision of security systems and services.</p>
 <p>The applicant claims the colours yellow, green and blue as an element of the mark.</p>	2203871	23.07.1999	31.03.2000	<p>9 - Electronic security system apparatus; closed circuit television apparatus; apparatus for recording, transmission and reproduction of sound and/or images.</p> <p>37 - Installation, maintenance and repair services, all relating to electronic and other security equipment and/or apparatus.</p> <p>42 - Advice and design services, all relating to the provision of electronic and other security systems and services, including installation and commissioning.</p>

They direct the opposition against the following goods and services in the application for registration:

Class 9: Computer software and hardware for security purposes; access control equipment and software, intrusion detection and prevention software; video recordings concerning IT security.

Class 42 - Leasing and rental of and consultancy and support relating to computer software and hardware for security purposes, access control equipment and software, intrusion detection and prevention software; security services; intrusion detection and prevention services, consultancy and support relating to security, access control and encryption.

3. On 19 June 2008 the applicant filed a counterstatement which consists, in essence, of a denial of the grounds upon which the opposition is based. I note that they say:

“The lack of similarity between the Registrations and the Application is evidenced by the fact that the Applicant’s mark has been in use in the United Kingdom on a substantial scale for some nine years without any objection by the Opponents and, to the Applicant’s knowledge, without any confusion occurring.”

4. Only the opponent filed evidence. While neither party asked to be heard, the opponent filed written submissions in lieu of a hearing which I will refer to as necessary below. After a careful consideration of all the material before me, I give this decision.

EVIDENCE

Opponent’s evidence-in-chief

5. This consists of a witness statement, dated 10 November 2008, from Richard Lambert the opponent’s Managing Director. Mr Lambert explains that the opponent has:

“..been using the registered trade mark since the trade mark was assigned to us in 1999.”

6. He states:

“The trade mark has been used, promoted and as a result, recognised in the industry for Access Control, Closed Circuit Television and Intrusion Detection Systems including installation maintenance and repair.”

7. He goes on to say:

“[the opponent] has clients in the IT field and provides systems for IT Managers to monitor their computer room by Access Control and CCTV.”

8. Attached to Mr Lambert’s statement (at RGL1) are eighteen exhibits, these are as follows:

1 – consists of what Mr Lambert describes as an “Evolution Maintenance Brochure” which he says was printed in 2000 and which I note bears a copyright date of 2000. Both trade marks shown in paragraph 2 are used;

2 – consists of what Mr Lambert describes as an “Evolution General Brochure” which he says was printed in 2007 and which I note bears a copyright date of 2008. Both trade marks shown in paragraph 2 are used;

3 – consists of what Mr Lambert describes as “an Evolution current letterhead”, which I take to mean the letterhead in use at the date of his statement i.e. November 2008. The trade mark the subject of registration No. 2203871 can be seen in the top right hand corner below which appears the words “(Electronic Security Systems) Ltd;

4 – consists of a copy of an invoice dated 6 February 2003 made out to the MRC Molecular Haematology Unit at the John Radcliffe hospital in Oxford in respect of: “Security, access control system maintenance, emergency call out facility and software support. For period 1st April 2003 to 31st March 2004” in the amount of £3,383.52. The invoice bears the trade mark in the form described in (3) above;

5 – consists of what Mr Lambert describes as a “drinks coaster/CD dating from 2001. The CD bears the trade mark in the form shown in (3) above, albeit with the word “Ltd” omitted;

6,7 & 8 – consist of copies of what Mr Lambert describes as “Quotes.” The letters are as follows:

(6) a letter to: Canary Wharf Contractors Ltd, Canary Wharf, London dated 28 November 2001 (for “the containment and interface for the car park barriers on levels 3 and 2”);

(7) a letter to EEP of West Wycombe dated 25 October 2002 (in respect of the intruder detection and CCTV systems for Alexander McQueen at 2-5 Old Bond Street, London);

(8) a letter to Tellings Golden Miller Group Plc of Hounslow dated 17 September 2008 (in respect of a vehicle number plate recognition system at their Bedfont Road premises);

All the letters bear the trade mark in the form described at (3) above;

9 – consists of copies of what Mr Lambert describes as “example trade mark protection letters from Evolution to competitors.” These letters are to: CSL (Communications) Limited of Harefield, dated 23 May 2001, Evolution Security Ltd of Colchester dated 12 July 2002 (and a letter to Companies House of 17 July 2002 in relation to the same company), and a letter to David Solomons drs@drsmarketing.co.uk dated 27 January 2003. All of the letters refer to “EVOLUTION” or the “EVOLUTION TRADE MARK”;

10 – consists of a copy of what Mr Lambert describes as an “Evolution General Brochure” which he says was printed in 2000 and which I note bears a copyright date of 2000. The brochure is very similar to that described at (2) above;

11 – consists of a copy of the German language version of the brochure mentioned in (10) above also from 2000;

12 – consists of a copy of the EvoView newsletter dated 2001 the back page of which Mr Lambert notes contains trade mark news;

13 /14 – consists of copies of case studies said to date from 2001 in connection with the New Cross Hospital in Wolverhampton and the Centre Commercial, Boulogne, Paris. Exhibit 13 bears the trade marks in the form shown in paragraph 2 above;

15/16 – consists of press releases dating from 28 March 2002 (in relation to the installation of security and surveillance equipment at the former Rolls Estate in Chancery Lane, London), and 10 April 2002 (in relation to the opponent being appointed as the European distributor for IDenticard security products). Both show the trade marks in use in the form shown in paragraph 2 above;

17 – consists of an example of a job advertisement said to date from 2001. While the publication is not identified, the advertisement bears the trade mark in the form registered under No. 2203871;

18 – consists of what Mr Lambert describes as “Awards and Qualification which have established the brand.” These are as follows:

extracts from The Sunday Times ARM Tech Track 100 published on 11 November 2001 which lists the top 100 fastest growing British unquoted technology companies based on sales growth. I note that Evolution Europe are listed at No. 93 with sales in 1998 and 2000 listed as £1,149,000 and £2,590,000 respectively. The article indicates that the company was established in 1996 and under the heading “comment” says: “Installs security systems for offices and university laboratories”:

a page which reads: “[the opponent]..are pleased to announce that they have won The Sunday Times 2001 Tech Track 100 ARM Award Presented on December 11th.”;

a certificate which reads: “Deloitte & Touche TECHNOLOGY FAST 50 2000/01, Deloitte & Touche Congratulate [the opponent], On achieving a ranking in the Eastern Region Technology Fast 50 Programme October 2000, Recognised as one of the fastest growing technology companies In The Eastern Region.”

a "Certificate of Quality & Service" dated 2 May 1997 indicating that [the opponent] has fulfilled the requirement for recognition by the Guild of Master Craftsmen;

a certificate dated 31 October 2000 indicating that the opponent was admitted to The British Security Industry Association Ltd as a Principal member;

a certificate dated 5 April 2004 indicating that the opponent "has been assessed and satisfies the requirement of the NSI NACOSS GOLD SCHEME with respect to the following scope: The Design, Installation and Maintenance of Electronic Security Systems including: Access Control, CCTV Systems, Intruder Alarms in accordance with the requirements of BS EN ISO 9001:2000 and NSI Quality Schedule SSQS 101."

9. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

10. Sections 5(1), 5(2)(a) and 5(2)(b) of the Act read as follows:

"5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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) 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."

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

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

(a) a registered trade mark, international trade mark (UK) or 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.”

12. In these proceedings the opponent is relying on the registered trade marks shown in paragraph 2 above, which have application dates of 23 July and 11 November 1999 respectively i.e. prior to that of the application for registration which was filed on 17 May 2006; as such, they qualify as earlier trade marks under the above provisions. The application for registration was published for opposition purposes on 7 December 2007 and the opponent’s trade marks were registered on 31 March and 11 August 2000 respectively. As a result, the opponent’s earlier trade marks are subject to The Trade Marks (Proof of Use, etc) Regulations 2004. I note that in their Notice of Opposition the opponent indicated that their trade marks had been used upon:

9 - Electronic security system apparatus; closed circuit television apparatus; all for security purposes.

37 - Installation, maintenance and repair services all relating to security equipment and/or apparatus.

42 - Advice and design services all relating to the provision of security systems and services.

13. However, I also note that for the purposes of these proceedings the opponent is only relying on the goods and services in classes 9 and 42 of their registrations. In their counterstatement the applicant asks the opponent to provide evidence of the use that they have made of their trade marks.

14. The relevant sections of the Proof of Use Regulations read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Proof of use

15. In reaching a conclusion on this point, I must apply the same factors I would if I were determining an application for revocation based on grounds of non-use; the relevant

period for present purposes is the five year period ending with the date of publication of the application for registration i.e. 8 December 2002 to 7 December 2007.

16. The leading authorities on the principles to be applied when determining whether there has been genuine use of a trade mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

17. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

18. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything

technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

19. Finally, the comments of the Court of First Instance in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

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

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration.

Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

20. It is clear from the case law mentioned above that for use to be considered genuine it must be neither token nor internal. While it must be use with a view to creating or preserving a share in the market concerned, it need not be quantitatively significant nor is it necessary to show that a significant market share has been achieved. The relevant period in which the opponent needs to prove use is, as mentioned above, 8 December 2002 to 7 December 2007.

21. In paragraphs 12 and 13 above, I noted the goods and services upon which the opponent say they have used their trade marks and the extent to which they rely upon those goods and services in these proceedings. In his statement Mr Lambert says that the trade marks have been used for:

"Access Control, Closed Circuit Television and Intrusion Detection Systems including installation maintenance and repair."

22. The evidence that the opponent has filed in support of their claim to use in the relevant period suffers from a number of defects, most notably that no turnover or promotional figures have been provided by Mr Lambert in his statement. That said, his unchallenged evidence indicates that the trade marks the subject of the opponent's registrations have been in use since at least 2000 (exhibit 1) and that they were still in use in 2008 (exhibit 2). From the documents provided as exhibit 18, one can discern that the opponent began trading in 1996 and in the period between 1998 and 2000 their sales increased from £1.1m to £2.6m. They also establish that in October 2000 they achieved a ranking in the Eastern Region Technology Fast 50 programme as one of the fastest growing technology companies in that area and that in November 2001 they were ranked in The Sunday Times' Tech Track top 100 British unquoted technology companies. In addition, there is the invoice dated 6 February 2003 (exhibit 4) and the quotes whose dates fall either before or after the relevant period i.e. 28 November 2001, 25 October 2002 and 17 September 2008 (exhibit 6). As the dates of all of these quotes are outside the relevant period they are of little assistance; in addition, there is no indication that they were accepted and the work undertaken. That said, I am prepared to accept that at the time that they were provided it was with a view to creating or preserving a share in the market concerned. I also note that in April 2004 the opponent was assessed under and satisfied the NSI NACOSS GOLD SCHEME.

23. Insofar as the nature of the opponent's business is concerned, I note that the evidence provided contains, *inter alia*, the following references:

"Electronic security systems service and maintenance" (exhibit 1);

“The Evolution group of companies are market leaders in electronic security systems providing integrated solutions to business and institutions across Europe. Since 1996 Evolution has installed and continues to maintain systems in most European countries.” (exhibit 2);

“With carefully chosen products selected for their quality, reliability and performance, Evolution can provide bespoke systems encompassing all aspects of electronic security...” (exhibit 2);

“Security, access control system maintenance, emergency call out facility and software support...” (exhibit 4);

“We will install exit loops for the roller shutter (provided by others)” (exhibit 6);

“..certified by our intruder alarm partners Absolute Security” (exhibit 7);

“We are proposing to install a Vista Dual camera..The Vista Lite software and hardware is to be installed....are to be recorded on a Vista Quantum4 four channel...” (exhibit 8);

“During 2000 Evolution developed formal distributor agreements with existing and new suppliers. These agreements mean keener pricing and direct support from the manufacturers, further enhancing Evolution’s ability to perform quickly and effectively. Evolution are now fully trained and authorised distributors for CCure, HID Proximity, Grosvenor, IdentiCard and Lenel access control products, Geutebruck and Sensormatic Robot CCTV and Controlware Video Surveillance over LAN...This portfolio of market leading product puts Evolution in prime position to meet any electronic security requirement with the best products at the best price.” (exhibit 12);

“The resulting combination of Geutebruck MultiScope II, BBV Telemetry Control and Controlware TCP/IP transmission..provided the answer without the need to install new cable or cameras at a competitive cost.” (exhibit 13);

“..After researching the market and demonstrating many samples Evolution finally specified Silent Witness domes and Vicon fully functional domes for installation....Following this process, the choice very quickly narrowed down to Geutebruck’s PC-based Multiscope II Digital CCTV system...Using Geutebruck’s Video Motion Detection software for internal cameras and Redwall detectors for the external cameras..” (exhibit 15).

24. Finally, I note that the opponent satisfied the requirement of the NSI NACOSS GOLD SCHEME with respect to the following “ The Design, Installation and Maintenance of Electronic Security Systems including: Access Control, CCTV Systems, Intruder Alarms...” (exhibit 18).

25. Having carefully reviewed the evidence, it appears to me that the nature of the opponent's business is providing advice on and then designing, installing, maintaining and repairing security systems. The hardware and software which comprise the system are, it appears from the evidence, provided by a range of other parties and are chosen by the opponent on the basis of their suitability for the job in hand. As far as I can tell, there is nothing in the evidence which suggests that they trade in electronic security systems and CCTV apparatus (i.e. with a view to creating or preserving a market for the goods themselves). In fact, as the quotations above appear to indicate, the evidence points to the opposite conclusion.

26. As I have already mentioned the opponent's evidence is far from perfect; however, it stands unchallenged. Taking the best view I can, I am prepared to accept that the evidence when considered in totality is sufficient for me to conclude that in the relevant period they have made genuine use of their EVOLUTION trade marks in the UK and that this use has been in relation to:

“Advice, design, installation, maintenance and repair services all relating to the provision of security systems and services”.

27. However, as I noted above, in these proceedings the opponent is not relying on their services in class 37. As no use has been shown in relation to the goods in class 9, it is only the:

“Advice and design services all relating to the provision of security systems and services”

in class 42 that I need to consider further. That of course is not an end of the matter, as I now need to decide (as per *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd*) what represents a fair specification. The above wording is identical to that contained in the opponent's class 42 specification in registration No. 2214018 and differs only slightly from the class 42 specification of registration No. 2203871. It was, in the opponent's view, an appropriate form of words to describe the services that they were either providing or intended to provide at the time the trade marks were applied for; a view I share based on the evidence provided. **In those circumstances and in the absence of any oral or written submissions to assist me, I consider that: “Advice and design services all relating to the provision of security systems and services” represents a fair specification and it is on the basis of this specification that I will conduct the comparison under sections 5(1), 5(2)(a) and 5(2)(b) of the Act.**

Sections 5(1) & 5(2)(a)

Case law

28. Both of these grounds require the respective parties' trade marks to be identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the ECJ said, in relation to what constitutes an identical trade mark:

“51 There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52 However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, [Case C-342/97 Lloyd Schuhfabrik Meyer \[1999\] E.C.R. I-3819](#) at para.[26]).

53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

29. I note that in their counterstatement the applicant denies that their trade mark is identical to either of the opponent’s earlier trade marks. Insofar as the respective trade marks themselves are concerned, the applicant says of the comparison with the first of the opponent’s trade marks:

“...They are manifestly different in that the mark of the application is in special script with a particular form of initial letter “e” and is in colour.”

30. In relation to the comparison with the second of the opponent’s trade marks they say:

“..They are manifestly different in that the mark of the Registration includes coloured design elements, and in that the mark of the application is in special script with a particular form of initial letter “e” and is in colour.”

Sections 5(1) and 5(2)(a) – comparison of trade marks

31. For the sake of convenience the trade marks to be compared are as follows:

Applicant's trade mark	Opponent's trade marks
	EVOLUTION
	

32. In reaching a conclusion, I have applied the test for identity outlined in paragraph 28 above. Having done so, I have concluded that the presence of the enlarged slightly stylised lower case letter “e” appearing in the applicant’s trade mark, when compared to the block capital presentation of the first of the opponent’s trade marks, and the differences created by the presentation of the word Evolution and the incorporation of a device element in the second of the opponent’s trade marks, are differences that are not so insignificant that they will go unnoticed by the average consumer. The differences in colour between that in which the applicant’s trade mark has been applied for, and for which the opponent have claimed as part of trade mark No. 2203871, are merely further points of difference supporting the same conclusion. **The opposition based on sections 5(1) and 5(2)(a) fail accordingly.**

Section 5(2)(b)

Case law

33. The European Court of Justice (ECJ) has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & 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* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing decision

34. 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.

35. From the evidence provided, it appears that the average consumer for the services on which the opponent's trade mark has been used has been a business user who requires advice and guidance on the design of a security system. In this regard, I note that in his witness statement Mr Lambert talks about the EVOLUTION trade mark being

“recognised in the industry.” That said, I can see no reason why the opponent’s services could not also be targeted at a member of the general public requiring, for example, advice on making their home more secure. While I have no evidence on the nature of the opposed goods and services, it appears to me that they too are capable of being targeted at both the business user and the general public.

36. Having determined who I consider the average consumer to be, I must now determine the nature of the purchasing decision. I have very little evidence as to how the respective goods and services are likely to be selected. Insofar as the opponent is concerned, the evidence does not really assist me in this regard. However, while I have already noted that the average consumer has been a business user, I pointed out that it could also be a member of the general public. Insofar as the first group is concerned, such an individual may have access to, for example, a list of approved service providers maintained by the business concerned. I also think that recommendations may come from contacts in other businesses, and that the opponent’s services may be selected having consulted appropriate trade publications, listing directories (such as Yellow Pages) or having conducted on-line enquiries. It appears to me that if the average consumer is considered to be a member of the general public, many of the same considerations will apply. However, trade publications and business contacts are likely to be replaced by specialist publications available to the general public (targeted at, for example, computing and home security) with oral recommendations more likely to come from family and friends.

37. While I have no evidence on how the opposed goods and services are likely to be selected and no information on their potential cost, as I have already concluded that the average consumer for their goods and services may be either a business user or a member of the general public, and given the nature of the goods and services under attack, it appears to me that many of the considerations I have identified in relation to the opponent’s services will also apply to the applicant’s goods and services.

38. Given those conclusions it is likely, in my view, to be the visual considerations that will be the most important, although oral recommendations from others will also I am sure play a part in the selection process (albeit I think a lesser part). Insofar as the opponent is concerned, the evidence provided suggests that (in the context of a business user) that once they have been identified as a potential provider and given what are likely to be the not insignificant sums involved, the average consumer is likely to view brochures, attend meetings and receive detailed quotations before any decision to proceed is taken. Some (but probably not all) of the same steps will apply if the average consumer is considered to be a member of the general public. I also think that many of the same considerations will apply to some if not all of the opposed goods and services.

39. As I mentioned above, if the average consumer is considered to a business user, it is possible that not insignificant sums will be in play; the same may not always be true if the average consumer is a member of the general public. Regardless, given the nature of the goods and services at issue and the need for the average consumer to ensure

that, for example, the security system they are considering meets all their needs or the security software is compatible with their existing hardware and will protect against the threats they wish to counter, it appears to me that they are likely to pay a high level of attention in the case of a business user and a reasonable but not as high a level of attention in the case of a member of the public.

40. In summary, it appears to me that while the evidence provided suggests that to date the average consumer of the services on which the opponent has proven use has been a business user, the services could also be targeted at the general public. In the absence of evidence, the applicant's opposed goods and services could also be targeted at both business users and the general public. For the purposes of comparison both groups are likely to rely on both visual and aural aspects of the respective trade marks and, given the nature of the goods and services at issue, are likely to pay a high (in the case of a business user) or reasonable (in the case of a member of the public) level of attention to their selection.

Section 5(2)(b)

Comparison of trade marks

41. The trade marks to be compared are shown in paragraph 31 above.

42. It is at this point that I must assess the degree of visual, aural and conceptual similarity between the competing trade marks, whilst keeping in mind their distinctive and dominant components. I note that in their counterstatement the applicant says:

“With regard to the ground under section 5(2)(b), it is denied that [the opponent's] marks and that of the Application are similar within the meaning of the section regard being had to the distinctiveness of the mark of the registration.”

43. Self evidently both parties' trade marks converge on the word EVOLUTION. The opponent's trade marks consist of either the word alone presented in upper case or the word presented with a capital letter E and accompanied by a device element for which the colours yellow, green and blue have been claimed as an element of the mark.

44. The applicant's trade mark consists, in my view, of the word EVOLUTION presented with an enlarged slightly stylised lower case letter “e”. While the presentation of the letter “e” appearing in the applicant's trade mark, the device element in the opponent's trade mark and the colours in which they are presented all contribute to their overall appearance, it is the word EVOLUTION that is, in my view, the distinctive and dominant element in all three trade marks; it is by this word that the competing trade marks will be referred to and remembered. **While I was unwilling to find the competing trade marks identical, I have no hesitation in finding them visually highly similar and aurally and conceptually identical.**

Comparison of goods and services

45. The goods and services to be compared are as follows:

The opposed goods and services	The opponent's services on which use has been proven and which can be taken into account
<p>Class 9: Computer software and hardware for security purposes; access control equipment and software, intrusion detection and prevention software; video recordings concerning IT security.</p> <p>Class 42 - Leasing and rental of and consultancy and support relating to computer software and hardware for security purposes, access control equipment and software, intrusion detection and prevention software; security services; intrusion detection and prevention services, consultancy and support relating to security, access control and encryption.</p>	<p>Class 42 - Advice and design services all relating to the provision of security systems and services.</p>

46. The leading authorities on how to determine similarity between goods and services are considered to be the *Canon* case (supra) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. 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 or services in the same or different sectors.

47. In reaching a conclusion on the degree of similarity in the respective services, I must also bear in mind the comments of Jacob J (as he then was) in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 when he said:

"... definitions of services are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes".

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."

48. I note that in their counterstatement the applicant says:

"With regard to the ground under section 5(2)(b), it is denied that the goods and services of [the opponent's registrations] (at least so far as use thereon is proved) and those of [the Application] are similar..."

49. Turning first to the applicant's opposed goods in class 9, be they software or hardware they are clearly all security related. Having reviewed the evidence provided by the opponent above, I concluded that while they have not made genuine use of their EVOLUTION trade marks in relation to the claimed goods in class 9, it is clear that the advice and design services on which they have proven use includes, as an integral component, advice on the selection of a range of security related hardware and software products provided by third parties such as: Vista, CCure, HID Proximity, Grosvenor, IdentiCard, Lenel, Geutebruck and Sensormatic.

50. While the physical nature of the applicant's goods in class 9 must differ from the services provided by the opponent in class 42, the uses to which their goods will be put and the area of trade in which the opponent provides advice and design services are likely to be the same i.e. they are all security related. In addition, the services are, in my view, likely to be regarded as complementary to the goods, in the sense that a trader in security related goods in class 9 would be expected to provide technical advice on those goods.

51. As the uses and users of both parties' goods and services are likely to be the same, and as the goods and services are complementary, the applicant's goods in class 9 and the services on which the opponent have proven use in class 42 are, in my view, similar to a high degree.

52. Turning now to the applicant's services in class 42 they include:

"consultancy and support relating to computer software and hardware for security purposes, access control equipment and software, intrusion detection and prevention software; security services; intrusion detection and prevention services, consultancy and support relating to security, access control and encryption".

53. Given my comments above regarding the nature of the opponent's use, and as all of the applicant's services are security related, the services identified above and those on which the opponent have proven use in class 42 are, in my view, either identical or similar to a high degree.

54. That leaves the:

"leasing and rental of computer software and hardware for security purposes, access control equipment and software, intrusion detection and prevention software".

55. As far as I can tell there is nothing in the opponent's evidence which suggests that they either rent or lease security hardware or software. However, it appears to me that the security advice which they provide is broad enough to include advice on, for example, other organisations who provide such leasing and rental services in the security sector.

56. As the uses and users of the respective services may well be the same, these remaining services in class 42 are, in my view, similar to the services on which the opponent have proven use in class 42 to at least a moderate degree.

Distinctive character of the opponent's EVOLUTION trade marks

57. I must also assess the distinctive character of the opponent's EVOLUTION trade marks in relation to the services for which they have been used and which can be taken into account. In their counterstatement the applicant says:

"..regard being had to the distinctiveness of the mark of the registration."

58. This is clearly a reference to the degree of distinctive character they consider the opponent's earlier trade marks enjoy. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or 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 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 mark to identify the goods or services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods

or services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. The word EVOLUTION is a well know dictionary word meaning, *inter alia*: “a gradual development, esp. to a more complex form”. As such, it is not, like an invented word, a trade mark possessed of the highest level of distinctive character.

59. While the meanings mentioned above arguably may allude to the fact that the opponent’s services are more developed than perhaps those of its competitors, this is at best an allusion and does nothing in my view to diminish the capacity of the trade marks to act as badges of origin. **Absent use, the opponent’s trade marks possess a reasonable degree of inherent distinctive character. While I have found above that the opponent has made genuine use of their trade marks in the relevant period, I drew attention to the defects in the evidence provided. These defects are such that I am not in a position to conclude that at the material date in these proceedings their use of their EVOLUTION trade marks had improved upon their inherent distinctive character to any material extent.**

Likelihood of confusion

60. 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 and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the EVOLUTION trade marks, as the more distinctive these trade marks are the greater the likelihood of confusion. The distinctive character of the EVOLUTION trade marks must be appraised by reference to the services on which the opponent has proven use and also by reference to the way they will be perceived by the average consumer. I must also keep in mind the average consumer for the goods and services and the nature of the purchasing process.

61. In summary, I have concluded that:

(i) the opponent has used their EVOLUTION trade marks in relation to: “Advice and design services all relating to the provision of security systems and services” and that this represents a fair specification (paragraph 27);

(ii) that the respective parties’ trade marks are not identical (paragraph 32);

(iii) the services at (i) are: similar to the applicant’s goods in class 9 to a high degree; are identical or similar to a high degree to the following services in class 42: “consultancy and support relating to computer software and hardware for security purposes, access control equipment and software, intrusion detection and prevention software; security services; intrusion detection and prevention services, consultancy and support relating to security, access control and encryption”, and similar to the following services in class 42 to at least a moderate degree: “leasing and rental of

computer software and hardware for security purposes, access control equipment and software, intrusion detection and prevention software (paragraphs 51, 53 and 56);

(iii) given the nature of the goods and services at issue both visual and aural aspects of the comparison are likely to play a part in the selection process (paragraph 38);

(iv) the average consumer will pay a high (in the case of a business user) or reasonable (in the case of a member of the general public) level of attention to the selection of the goods and services (paragraph 39);

(v) the respective trade marks are visually highly similar and aurally and conceptually identical (paragraph 44);

(vi) that the opponent's use of their EVOLUTION trade marks have not improved to any material extent upon the reasonable degree of inherent distinctive character the trade marks enjoy (paragraph 59).

62. I must now apply the global approach advocated to my findings to determine whether direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the goods and services would be assumed to come from economically linked undertakings) is likely to occur. Having done so, I have concluded that given the high degree of similarity/identity in the respective trade marks, the degree of similarity in the respective goods and services (which varies from identical to at least moderate), the nature of the purchasing process, the traits of the average consumer and the reasonable degree of inherent distinctive character the opponent's EVOLUTION trade marks enjoy, that confusion, be it direct or indirect, is likely to occur.

63. In summary, the partial opposition has been wholly successful and the application should be refused in respect of the opposed goods and services.

Costs

64. As the opponent has been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. In their written submissions provided by way of a letter from the opponent dated 27 August 2009 they say:

“We would however also like to add that defence of our Trade Mark has cost us £3,176.00 in legal fees so far, we have provided detailed and comprehensive evidence in defence on two occasions now, both to the Trade Marks Registry and to the Applicant and have received nothing from the Applicant justifying their Application.

We refer to our letter of 15th May 2009 and believe that it would be unfair on us to allow the Applicant further opportunity to waste more of our management time and continue to increase our costs without justification.....”

65. In their letter of 15 May 2009 the opponent say, *inter alia*:

“It is our view that the Applicant is merely seeking to delay the inevitable successful outcome of our opposition with the intention of wilfully increasing our costs.”

66. I note that the comment from the letter of 15 May 2009 was made in the context of a request by the applicant (approved by the Trade Marks Registry) for an extension of time of three months to file their evidence-in-chief; in the event no evidence was forthcoming.

67. Whilst I note the content of the bills from Blaser Mills solicitors to the opponent in connection with these proceedings (provided with the letter of 27 August), it is well established that awards of costs in Trade Marks Registry proceedings are not intended to compensate parties for the expense to which they may have been put. Rather, an award of costs is intended to represent only a contribution to that expense. Having reviewed the relevant papers I see nothing unusual in the conduct of these proceedings and consequently see no reason to depart from the scale mentioned in the TPN above. That being the case, I award costs to the opponent on the following basis:

Preparing a statement and considering the other side’s statement:	£300
Official fee:	£200
Preparing evidence and considering the other side’s evidence:	£500
Total:	£1000

68. I order Evolution Security Systems Limited to pay to Evolution (Electronic Security Systems) Limited the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of October 2009

**C J BOWEN
For the Registrar
The Comptroller-General**