

O-202-13

**TRADE MARKS ACT 1994
SUPPLEMENTARY DECISION**

**IN THE MATTER OF APPLICATION NO. 2549801
BY
EMAP LIMITED
TO REGISTER THE TRADE MARK**

GENESIS

IN CLASSES 09, 16, 35, 38, 41 AND 42

AND

**OPPOSITION THERETO UNDER NO. 101372
BY
GENESYS TELECOMMUNICATIONS LABORATORIES, INC.**

1. On 30 January 2013, I issued a provisional decision in relation to this opposition.
2. In the original decision I stated the following:

“101. The remaining terms on which I have yet to draw a conclusion are ‘computer software, computer programs and computer databases’. These are broad terms which include a range of goods which are not similar to the specific goods named in the opponent’s specification. For example ‘computer software for computerised telecommunications and telephony control’ cannot be said to be similar to computer software for e.g. the design of nuclear power stations.

102. The Registry’s practice in this regard is stated in Tribunal Practice Notice (TPN) 1 of 2012 at paragraph 3.2.2(c) which states:

“c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties’ submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.”

103. In respect of the specific goods at issue I am mindful of the comments of Laddie J in the *Mercury Communications* case¹ in which he said:

“In my view it is thoroughly undesirable that a trader who is in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those far removed from his own area of interest. If he does he runs the risk of his registration being attacked on the grounds of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

104. The applicant is allowed 21 days from the date of this decision to consider my comments above and to provide me with submissions/proposals for a list of goods which fall within the broad phrase “‘computer software, computer programs, computer databases’ which, in its view, do not clash with the opponent’s goods in class 9. These submissions should be copied to the opponent, who will then be allowed a further 21 days from receipt of the

¹ *Mercury Communications Limited v Mercury Interactive (UK) Limited* [1995] FSR 850

applicant's submissions to provide any submissions they may have on the applicant's proposals. I will review both parties' submissions and issue a supplementary decision in which I will also determine costs."

6. On 22 February 2013, the applicant filed submissions in which it stated:

"We note that the Hearing Officer has not yet drawn a conclusion regarding the terms "computer software, computer programmes and computer databases" currently recited in Class 9 of the UK trade mark application number 2549801.

In this regard we can inform the Examiner that these goods are for the processing and provision of information and intelligence relating to marketing and to the advertising and media industries.

In this regard, the applicant will be willing to amend the specification of Class 9 in respect of these particular goods to:

"Computer software, computer programmes and computer databases for processing and provision of information and intelligence relating to marketing and to the advertising and media industries".

These goods are not the same nor similar to "computer software for computerised telecommunications and telephony control".

7. On 20 March 2013, the opponent filed its submissions in which it stated:

"The Applicant's proposal for amendment of the Class 09 goods computer software, computer programs and computer databases to computer software, computer programs and computer databases for processing and provision of information and intelligence relating to marketing and to the advertising and media industries is, in the Opponent's view, insufficient to circumvent similarity with the Opponent's goods under that class. This is due, in part, to the use of vague industry headings i.e. media. The media industry is a very large one which is broad in its scope and the Opponent is concerned that there remains the potential of similarity with the respective parties' goods under Class 09.

The Opponent therefore proposes that the Applicant's suggested amendments be tweaked as follows (amendments in bold):

*Computer software, computer programs and computer databases for processing and **the** provision of information and intelligence relating to marketing and to the advertising and media industries, **none of the aforesaid relating to computerised telecommunications and telephony control.**"*

8. The specification suggested by the applicant and amended by the opponent is, in my view sufficiently defined to reflect the applicant's own area of interest and to avoid a likelihood of confusion between the respective parties' marks.

9. As a consequence of my findings class 9 of the application should be amended in the following terms:

Computer software, computer programs and computer databases for processing and the provision of information and intelligence relating to marketing and to the advertising and media industries, publications in electronic form but not including any publications relating to religion or rock music, supplied on-line from databases or from facilities provided on the Internet (including web sites); none of the aforesaid relating to computerised telecommunications and telephony control."

Costs

10. As both parties have achieved a measure of success it is appropriate that the parties bear their own costs.

Appeal period

11. In my original decision I stated:

"105. The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision and so will not commence until the supplementary decision is issued."

12. Consequently the appeal period for my decision dated 30 January 2013 and this supplementary decision in respect of class 9 and costs commences with the issuing of this decision.

Dated this 16th day of May 2013

**Ms. Al Skilton
For the Registrar
The Comptroller General**