O-322-14

TRADE MARKS ACT 1994

IN THE MATTER OF THE APPLICATION BY ERLANG SOLUTIONS LTD UNDER NO 2564446 FOR REGISTRATION OF THE TRADE MARK

AND

IN THE MATTER OF OPPOSITION NO 101972 THERETO BY TELEFONAKTIEBOLAGET L M ERICSON

THE BACKGROUND AND THE PLEADINGS

1) On 28 August 2012 Erlang Solutions Ltd filed application no 2564446 to register the following trade mark for goods and services in classes 9, 16, 35, 36, 38, 41 and 42:

The application was published in the Trade Marks Journal on 25 February 2011.

2) Telefonaktiebolaget L M Ericson opposes the registration of the Applicant's mark on grounds under sections 5(2)(b) and 5(3) of the Trade Mark Act 1994 ("the Act"). The opponent relies on the following trade mark registered under no 2003165 for the following goods:

ERLANG

> **Class 9**: Computers; recorded computer programmes; computer apparatus; computer equipment; computer peripheral devices; computer keyboards; recorded computer software; parts and fittings for all the aforesaid goods.

3) The mark relied on by the opponent was filed on 23 November 1994 and completed its registration procedure on 29 September 1995. The consequences of these dates are that: i) the opponent's mark constitutes an earlier mark in accordance with section 6 of the Act, and ii) it is subject to the proof of use conditions contained in section 6A of the Act, the registration procedure having been completed more than five years before the publication of the applicant's mark. The relevant period during which genuine use must be proved is 26 February 2006 to 25 February 2011.

4) The applicant filed a counterstatement, denying the grounds of opposition and requiring the opponent to prove use of its mark for the goods relied on. Both sides filed evidence. The matter came to be heard before me on 12 February 2014 at which the opponent was represented by Mr Simon Malynicz of counsel, instructed by Marks & Clerk LLP; the applicant was represented by Mr Stephen Hodson of Mewburn Ellis LLP.

THE EVIDENCE

The opponent's evidence

5) In a witness statement of 3 April 2013 Ms Carolina Lion states that she is the Manager, Trade Marks and Domain Names, of the opponent, a position she has held since 1 September 2007 and that she has worked as a trade mark lawyer for the opponent since 1992. She makes the following statements:

- The opponent currently has 110,000 employees working with customers in more than 180 countries worldwide. It provides telecommunications equipment and services to mobile and fixed network operators. More than

40% of the world's mobile traffic passes through the opponent's networks and it currently has over 1000 networks in more than 180 countries. The remit of its business is providing telecommunication services and multimedia solutions to consumers worldwide.

- ERLANG is a general purpose computer programming language that was designed at the Ericsson Computer Science Laboratory in the 1980s as part of a project to find out what aspects of computer languages made it easier to program telecommunications systems. The name references the Danish mathematician and engineer Agner Krarup Erlang and is also a portmanteau of the phrase 'ERicsson LANGuage'.

- The opponent currently provides the entire source code of the current Erlang system free of charge at the website www.erlang.org. ERLANG was released to the open-source community in 1998.

- The ERLANG language is used within the telecommunication industry and has several possible telecommunication applications; for example, to control a switch, or convert a protocol. Although ERLANG is open source, the Opponent is the largest user of ERLANG, as it uses it to write software for use in its telecommunications systems.

- The commercial utilisation of ERLANG is extensive. For example, the company Facebook uses ERLANG. There are ERLANG news sites including Planet Erlang, (www.planeterlang.org), Erlang D.A.C.H (www.erlang-dach.org) and, further, a Google group. There are also conferences: The Erlang User Conference takes place in Stockholm annually.

- Since its inception in the 1980s, there have been numerous articles published concerning ERLANG, along with books which teach people how to write and use the language.

- Because of the length and duration of use of the ERLANG programming language by and with the consent of the opponent, it is the opponent's belief that the consistent and extensive use of the mark ERLANG since the 1980s in relation to a computer programming language means that it has developed a significant reputation within the UK and, moreover, that this reputation is associated with the opponent.

6) Ms Lion attaches a number of exhibits to her witness statement, as follows:

- **Exhibit CL1** is a brochure entitled 'THIS IS ERICSSON', which provides background information on the opponent. It bears a copyright notice of 2012. For 2011 it gives its number of employees as 105,000 and its net sales as US $35 billion. It also states that the opponent is the fifth largest software supplier in the world. It shows that the opponent is now (and must also have been during the relevant period) a large company. However, it makes no reference to the ERLANG programming language or mark, or goods or services provided in connection with it.

- **Exhibit CL2** consists of two pages from www.erlang.se, described by Ms Lion as marketing materials from the Opponent's website. The first page (marked "updated: 2011-07-19") states that:

> "Erlang/OTP [Open Telecom Platform] is available in two versions: a licensed one with full support, and an open source version with the entire source code free of charge".

The second (undated) page reads:

> "Currently we cannot take on new customers for support licenses but we are working on a new way to handle this. We hope to have this running sometime during late 2008/ early 2009".

Given that the website still bore this statement when printed out in 2013, the inference seems to be that no customers for support services were taken on afterwards. In her witness statement Ms Lion also appears to quote an extract from the opponent's website, outlining the opponent's use of ERLANG, its commercial application and the types of goods within which ERLANG is used. However this passage does not actually appear in **Exhibit CL2**. Part is, in any case, repeated in **Exhibit CL4**.

- **Exhibit CL3** contains a print-out from 2013 of a page from the website www.erlang.org, bearing a 2011 copyright notice. It includes the following (italics have been added by me):

> "Erlang is a programming language designed at the Ericsson Computer Science Laboratory. Open-source Erlang is being released to help encourage the spread of Erlang outside Ericsson. We are releasing free of charge: The entire *source code* of the current *Erlang system.*" Extensive libraries of code for building robust fault-tolerant distributed applications. All with documentation. All the above software has been battle tested in a number of Ericsson products".

The page containing the relevant download links, also with a 2011 copyright notice, is contained in **Exhibit M&C1** (see below). It announces that "Erlang/OTP R16B has been released!", provides links to earlier releases too, and explains that "Open-source Erlang is being released to help encourage the spread of Erlang outside Ericsson". The page in **Exhibit CL3** then refers to the "Erlang Public License" and, following the rubric "Commercial Erlang/OTP", continues: "There are a number of products available that may be of interest for professional and amateur Erlang programmers (printed documentation, courses, etc.)".

Exhibit CL3 also contains an undated "ERLANG PUBLIC LICENSE" document. It includes the following (italics have been added by me):

> "'1.6 Initial Developer' means the individual or entity identified as the Initial Developer in the *Source Code* notice required by Exhibit A". [Exhibit A:

"...The Initial Developer of the Original Code is Ericsson Utvecklings AB. Portions created by Ericsson are Copyright 1999 ..."].

1.10: "'Original Code' means the *Source Code* of computer software code which is described in the Source Code notice required by Exhibit A". [Exhibit A: "*Software* distributed under the License is distributed on an 'AS IS' basis..."]

2.1: "The Initial Developer hereby grants You a world-wide, royalty-free, non-exclusive license, subject to third party intellectual property claims: (a) to use, reproduce, modify, display, perform, sublicense and distribute the Original Code (or portions thereof) with or without Modifications ..."

3.5: "You must duplicate the notice in Exhibit A in each file of the source code, and this license in any documentation for the Source Code ..."

The "Source Code Notice" in Exhibit A contains the following:

"Exhibit A. The contents of this file are subject to the Erlang Public License; you may not use this file except in compliance with the License. You should have received a copy of the Erlang Public License along with this *software*."

- **Exhibit CL4** is an undated document (printed from www.erlang.org in March 2013) called "WHAT IS ERLANG", beginning as follows (italics have been added by me):

  1.1 What is Erlang?

  Erlang is a general-purpose programming language *and runtime environment*. .....

  1.2 What is OTP?

  OTP (Open Telecom Platform) is a large collection of libraries for Erlang to do everything from compiling ASN.1 to providing a www server. Most projects using "Erlang" are actually using "Erlang/OTP", i.e. the language and the libraries. OTP is open source.

  The document goes on to list, in general terms, the kinds of applications Erlang is or is not appropriate for. It also lists examples of corporate users, including Facebook and T-Mobile, but there is nothing to indicate whether any of these companies are based in the UK. There is also a list of universities using Erlang for research and teaching (these include Kent, Sheffield and Heriot-Watt).

- **Exhibit CL5** consists of several documents, including: a brief abstract of a doctoral thesis of October 2000 referencing the programming language Erlang; a list (copyright 2011, printed out in 2013 from www.erlang.org) of references to other papers, materials and courses, undated or dating from 1997,1998 and 2000; a list of books (on pages 41-54) many of which have

Erlang in their title, all, however, dating from before 2002; a synopsis and online reviews of the book *Erlang Programming: A Concurrent Approach to Software Development* by Francesco Cesarini and Simon Thompson from the website of a US retailer; and the results of a search for ERLANG on the website amazon.co.uk which includes*: Programming Erlang: Software for a Concurrent World* by Joe Armstrong (18 July 2007), *Erlang Programming: A Concurrent Approach to Software Development* by Francesco Cesarini and Simon Thompson (26 June 2009), and Erlang and OTP in Action by Martin Logan et al. (5 December 2010).

7) In addition to Ms Lion's witness statement the opponent filed written submissions to which it appended two further exhibits. Exhibits attached to submissions cannot be accepted as evidence of fact, so they were subsequently appended to a witness statement of 19 November 2013 from Ms Esther Gottschalk, a partner for the trade mark agents acting for the opponent in these proceedings. **Exhibit M&C1** consists of pages (copyright 2011) taken from the website www.erlang.org/download.html. I have described them in paragraph 6 (bullet point 3) above. **Exhibit M&C2** contains a paper from 1993 describing the development of the Erlang programming language.

The Applicant's evidence

8) In a witness statement of 4 June 2013 Mr Francesco Cesarini, makes the following statements. He founded the applicant in November 1999 and has been its Technical Director for over 3½ years. He is the joint author of a book entitled "Erlang Programming: A Concurrent Approach to Software Development" (which is referred to in the Opponent's evidence). He has co-authored numerous academic papers and articles on the Erlang programming language and systems written using it. He is also a lecturer of computer programming at both the University of Oxford and the IT University of Gothenburg and is a regular speaker at computer programming conferences. He attaches as **Exhibit FC1** a printout of his profile page on 'Linked In', providing biographical information.

9) Mr Cesarini states that "it is [his] understanding that, in the usually accepted way the terms are used, 'computer software' has a distinct and separate meaning from 'programming languages'". He later adds that this is a distinction that any computer scientist or computer programmer would understand. In support of his opinion he attaches as **Exhibit FC2** a copy of the Wikipedia entry for 'computer program', and as **Exhibit FC3**, a selection of dictionary definitions taken from the 'Dictionary of Computing' (OUP 1986), the 'Macmillan Dictionary of Information Technology' (London 1989), 'The New Penguin Dictionary of Science' (London 2004), and the 'Dictionary of Science and Technology' (Edinburgh and New York 1995).

10) I also note from Mr Cesarini's evidence **Exhibit FC2**, where it is explained that "source code" is the human-readable form of a computer program; source code may be converted into an executable file (which enables the computer to execute the instructions) by a compiler or interpreter". Mr Cesarini states that, to the best of his knowledge, the ERLANG programming language was made open source by Ericsson in December 1998.

11) In a witness statement of 4 June 2013 Mr Stuart Whitfield states that he is the applicant's Chief Executive Officer. Like Mr Cesarini, he explains his opinion that, 'computer software' has a distinct and separate meaning from 'programming languages', and that the distinction is well known and accepted.

12) In a witness statement of 30 July 2013 Prof. Simon John Thompson explains that he is Professor of Logic and Computation at the University of Kent, has never been a paid employee of the applicant, but has been a partner in a number of projects, and is co-author, with Mr Cesarini, of a book entitled "Erlang Programming", first published by O'Reilly, Inc. in 2009. He explains his opinion that a typical software developer at an IT solutions provider, whom he regards as being the typical user of a computer programming language, would understand a programming language to be the tool used to build a computer program or software, and the program or software to be what is produced.

THE PROOF OF USE PROVISIONS

13) As stated earlier, the proof of use provisions apply to the opponent's mark. The use conditions are set out in section 6A(3) of the Act as follows:

> "…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."

14) Section 100 is also relevant; it reads:

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

15) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

> "In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07*Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider* v *OHIM* [2006] ECR I-4237):
>
> "(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"”

16) The relevant period for my assessment is the five year period ending on the date of publication of the applicant’s mark, namely 26 February 2006 to 25 February 2011. The Opponent is required to prove that during this period, and in relation to the relevant goods, there was genuine use by it, or with its consent, of its mark. At the hearing Mr Malynicz confirmed that the Opponent’s case is put wholly on the basis that it has shown genuine use for *recorded computer programs* and *recorded computer software*. Mr Hodson argued that the evidence did not establish genuine use at all, but even if it did, there was no use in relation to the goods relied upon. I will come back later to the specification point, and to whether the goods on which the mark is claimed to have been used fall within the ambit of the goods relied upon, but

I will firstly assess what goods, as a matter of fact, the earlier mark has been used on, and whether there is genuine use for such goods in the UK.

On what goods has ERLANG potentially been used?

17) I start with this question in order to understand the context of what is under discussion. Erlang is the name of the computer programming language to be used by programmers and developers. However, what the opponent has made available is not simply a programming language in the abstract. **Exhibit CL4** explains that "OTP (OpenTelecom Platform) is a large collection of libraries for Erlang to do everything from compiling ASN.1 to providing a www server. Most projects using 'Erlang' are actually using 'Erlang/OTP', i.e. the language and the libraries. OTP is open source". In Mr Hodson's submission this showed that the source code and tools which can be downloaded from the opponent's www.erlang.org website were supplied under the "branding" OTP, Erlang being used only in connection with the programming language itself in the abstract. He argued that references to Erlang/OTP" reflect this split branding. I disagree. I think that "Open Telecom Platform" and its abbreviation OTP are simply used descriptively to indicate conveniently the source code, libraries of code and tools released for the use of solutions providers who use the Erlang programming language to create software. Moreover the reference to "open-source Erlang" in **Exhibit CL3** must be seen in the context of the statement that what is being released is "the entire *source code* of the current *Erlang system"* [emphasis added]. This is followed immediately by a reference to "extensive libraries of code for building robust fault-tolerant distributed applications". ERLANG is also used in **Exhibit CL4** in connection with tools used by solutions providers: "Erlang is a general-purpose programming language *and runtime environment"*. [emphasis added]". Use must simply be "in relation" to the goods. I have no doubt from the evidence provided that Erlang is potentially being used not simply in relation to the computer language itself in the abstract, but also in relation to the source code and accompanying libraries of code. It is, effectively, the Erlang system (a term which is referenced above).

Has ERLANG been genuinely used in the UK in the relevant period?

19) I have used the word "potentially" above because Mr Hodson argued that the opponent's evidence does not provide a single concrete example of a sale of the opponent's goods within the UK during the relevant period. My first observation is that simply because the goods are free of charge does not mean that this cannot constitute genuine use. It is not uncommon for commercial concerns to release free, open-source versions of their software. The circumstances before me do not seem on a par with the distribution of promotional items to encourage the sale of something else as per *Silberquelle*. The facts are much closer to that in C-320/07 P, *Nasdaq*, where it was stressed that:

> "It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings."

20) In the circumstances before me, the free distribution of the goods has the capacity to constitute genuine use in the terms of maintaining or creating a share in the market for those goods. However, regardless of the findings I have made so far, the question still remains as to whether the evidence establishes that there has been genuine use in the UK in the relevant period.

21) Ms Gottschalk appends to her witness statement as **Exhibit M&C1** pages from the website www.erlang.org to show how the goods can currently be downloaded. They bear a copyright notice of 2011. They include the Erlang Public License. Ms Lion appends to her witness statement a copy of the Erlang Public License, which she says governs the use of ERLANG in the UK. Neither the website excerpts nor the agreement contain any reference to the UK. The agreement is governed by Swedish law and subject to Swedish jurisdiction. American rather than UK spelling is used both on the website and in the agreement, indicating that an international, rather than a specifically UK, audience is being addressed. Mr Hodson objected that the website pages did not necessarily fall within the relevant period, which ends on 25 February 2011; moreover there was nothing to show that they were aimed at the relevant UK market with a view to establishing a market share in Erlang in that market, or that the list of undated links to previous releases had been available to download in the relevant period.

22) In *1–800 FLOWERS* [2001] EWCA Civ 721Buxton L.J. said:

> "137..... There is something inherently unrealistic in saying that A 'uses' his mark in the United Kingdom when all that he does is to place the mark on the Internet, from a location outside the United Kingdom, and simply wait in the hope that someone from the United Kingdom will download it and thereby create use on the part of A....
>
> 138. ....the very idea of 'use' within a certain area would seem to require some active step in that area on the part of the user that goes beyond providing facilities that enable others to bring the mark into the area. Of course, if persons in the United Kingdom seek the mark on the Internet in response to direct encouragement or advertisement by the owner of the mark, the position may be different; but in such a case the advertisement or encouragement in itself is likely to suffice to establish the necessary use...."

23) The same issue arose before Jacob J. in *Euromarket Designs Inc v Peters* [2001] F.S.R. 20, where he said:

> "25. Miss Vitoria says that the Internet is accessible to the whole world. So it follows that any user will regard any website as being 'for him' absent a reason to doubt the same. She accepted that my Bootle fishmonger example in 800 FLOWERS is that sort of case but no more. I think it is not as simple as that. [In] 800 FLOWERS I rejected the suggestion that the website owner should be regarded as putting a tentacle onto the user's screen. Mr Miller here used another analogy. He said using the Internet was more like the user focusing a super-telescope into the site concerned; he asked me to imagine such a telescope set up on the Welsh hills overlooking the Irish Sea. I think Mr Miller's analogy is apt in this case. Via the web you can look into the

> defendant's shop in Dublin. Indeed the very language and the Internet conveys the idea of the user *going to* the site — 'visit' is the word. Other cases would be different — a well-known example, for instance, is Amazon.com. Based in the U.S. it has actively gone out to seek world-wide trade, not just by use of the name on the Internet but by advertising its business here, and offering and operating a real service of supply of books to this country. These defendants have done none of that."

24) The opponent has provided no evidence that it has actively advertised its Erlang goods in the UK. However, it has made ERLANG source code and libraries of code for building applications available on a free and open source basis expressly as a means of getting the programming language more widely known and used among teachers and solution providers. A number of books have been written on ERLANG programming – one of them co-authored by Mr Cesarini in 2009 – and are available in the UK. The Erlang Public License is no doubt also intended to encourage the teaching of ERLANG programming. In addition to the three named UK universities, the Opponent's website signposts commercial sources where "support and training courses" are available on a commercial basis (see **Exhibit CL4**). One of these is Erlang-solutions.com. This seems to indicate that the opponent not only knew of, but encouraged the applicant's support and training activities, referring potential clients to the applicant. It would be useful to have better information about the nature of the relationship between the opponent and applicant during the relevant period, but none has been provided by either. When considered in the round, it seems to me that the download website, whilst not targeted at any specific country, will have been available, accessed and utilized by persons in the UK. The commentary of the opponent's witnesses supports this.

25) In terms of the relevant period, I bear in mind Mr Hodson's point that the 2011 copyright notice meant (in his submission) that the chances were that it was outside the relevant period (which ended in February 2011) and that the previous available "releases" on the right hand side were undated. Mr Malynicz argued it was unrealistic to suppose that they did not extend back into relevant period. I agree. Moreover, I note that Exhibit CL5 of Mr Cesarini's witness statement contains a review of the book on Erlang programming co-authored by him in 2009. It is dated 29 September 2009 and contains the reference "What I particularly liked about this book is that it is up to date with the latest R13 release …", which appears to put that release right in the relevant period. It seems logical to conclude that throughout the relevant period whatever was the current release was available to download and that previous releases were also listed as seen on the download web-site.

26) It is difficult to gauge the exact extent of use – i.e. how many downloads were made during the relevant period by persons in the UK. Quantum, though, is not the be all and end all here. Listed as users are three UK universities. It also stretches credibility to imagine that the applicant, with its UK presence, did not use and download the goods in the course of its commercial activities as providers of "Erlang solutions". None of this can be pinned exactly to the relevant period, but the whole context of the evidence suggests to me that the downloads were available and would have been used, including use in the UK. Whilst I accept that the evidence could have been much clearer, I am satisfied that there has been genuine use in the UK in the relevant period of ERLANG in connection with the "Erlang system" source code

and accompanying pre-written code to enable use of the Erlang programming language.

Use with consent

27) This issue was discussed at the hearing, but I do not consider it necessary to go into the ins and outs of this. This is because I have in any case already found that ERLANG has been used via the download website set out in the evidence, and this is clearly use by the opponent.

A fair specification

28) Before coming to the phrasing of a fair specification, I must be sure that the goods in relation to which the mark has been used fall within the ambit of the goods relied upon.

29) In their respective witness statements Mr Cesarini, Mr Whitfield and Prof. Thompson give their opinions as to the distinction to be drawn between computer programming languages on one hand and computer programs or computer software on the other. Because of its technical and specialised nature this amounts to expert evidence. The procedure for the submission of expert evidence, as detailed in Tribunal Practice Notice (2/2012), has not been followed. Whatever their expertise in the relevant field, none of these witnesses can be said to be wholly disinterested; Mr Cesarini and Mr Whitfield are directly associated with the Applicant, and Prof. Thompson has been a partner in a number of projects and has co-authored a book with Mr Cesarini. I have kept this in my mind when assessing how much weight to afford to their evidence.

30) I have considered the Wikipedia entry and various dictionary definitions and extracts in **Exhibits FC2 and FC3**. They point to a distinction between a computer programming language in the abstract on one hand and the computer programs or computer software produced in that language on the other. I think that this is probably a difference which would be generally understood and recognized in trade, and that members of the public or the trade would be unlikely to regard a computer programming language in the abstract as covered by the terms *recorded computer programs* or *recorded computer software*. However, what the Opponent has made available is more than just an abstract programming language. It is not simply the programming language in its abstract form that the mark is used in relation to. I have already explained that I am satisfied that the mark has been used in relation to the source code of the "Erlang system", libraries of code for building programmes. I have no doubt that these products do fall within the terms relied upon.

32) Having found that the goods on which the mark has been used fall within the ambit of the terms relied upon, I must now consider what would be a fair specification for those goods. The fair specification must not be pernickety[1]. It is necessary to consider how the relevant public are likely to describe the goods[2]. The

[1] See *Animal Trade Mark* [2004] FSR 19.

[2] See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.

General Court ("GC") in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

> 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 relating to which the goods or services for which the trade mark has actually been used actually 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.
> 53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

33) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

> "However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods concerned"

34) In a case such as this, care needs to be taken to ensure that the goods are not described in an overly broad manner. The goods used are narrow in scope and

provided in a specialist field. The broad terms relied upon cover a whole host of programs/software for various purposes. I do not consider it pernickety to include in the fair specification a reflection that the goods are in essence source code relating to the use and implementation of a programming language and libraries of code for building programs in that language. The "Erlang system" is provided to persons to run on their computers for the programming of further code. I come to the view that a fair specification would be:

> Recorded computer software/programs relating to the use and implementation of a computer programming language

SECTION 5(2)(b)

35) Section 5(2)(b) of the Act reads:

> 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.

36) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union CJEU in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

> "(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, in certain circumstances, be dominated by one or more of its components;

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

(g) a lesser degree of similarity between the goods or services may be offset by a great 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

Comparison of the goods

37) When comparing the respective goods/services, if a term clearly falls within the ambit of a term in the competing specification then identical goods/services must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 – "*Meric*") even if there are other goods within the broader term that are not identical. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include*, inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

38) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

> "(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."

39) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensible for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

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

40) In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* were he warned against applying too rigid a test:

> "20. In my judgment, the reference to "legal definition" suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*."

41) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that "in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade"[3] and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning[4]. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

> "..... 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) (IPTRANSLATOR)* [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."

42) At the hearing Mr Malynicz conceded that some of the goods/services were <u>not</u> similar to the goods of the earlier mark. However, after the hearing I felt it incumbent upon me to seek clarification on some (but not all) of those concessions as, having reviewed the transcript of the hearing, there were certain tensions with other comments made during the hearing. I only sought clarification in relation to terms where such tension arose. However, in its response the opponent's position was one of wishing to resile from all the concessions made at the hearing, not just the ones I sought clarification upon; it says any concessions were made in error, made in the heat of the hearing. The applicant considers it inappropriate for the opponent to resile from its position, not least because it would not have addressed the issue of similarity of goods in its submissions at the hearing because the position had been conceded. My initial observation is that where a clear and unambiguous tension-free concession has been made, the opponent will have to live that. The matter will not be reopened. Where tension does arise, I will consider the matter further and will detail below where this arises and what I consider appropriate to do about it. I will now go through the various applied for goods and services.

43) The applied for goods in class 9 read:

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[3] See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

[4] See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

> Computers; data processing equipment; downloadable electronic publications; telecommunications apparatus; recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; recorded computer programs; computer apparatus and equipment; computer peripheral devices; computer keyboards; recorded computer software; computer components; personal electronic devices; electronic devices for receiving television and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith; computer programs for managing communications and data exchange between handheld computers and desktop computers; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; parts and fittings for all of the aforesaid goods.

The concession issue does not arise here. The most basic way of summarising Mr Malynicz's submissions is that in comparison to the opponent's goods, anything that is software is identical, and anything that is hardware is similar. Of course, those submissions were made on the basis of the earlier mark's relied upon covered goods which I have now further limited, in line with my proof of use assessment. The goods, as limited, fall within the ambit of *computer software, software downloadable from the Internet, recorded computer programs, and recorded computer software* in the applicant's class 9 specification*;* they are therefore identical under the guidance in *Meric.* The way a programming language is used may play a significant role in the way a program is sold, as certain languages have particular attributes in a particular field or fields. (Indeed, this is obviously part of the commercial rationale for the opponent's interest in promoting the Erlang computing language). This can be so in the case of firmware or programs to be used in connection with telecommunications equipment, for example. In such cases there will be a moderate degree of similarity because of the complementary relationship between a computer language programming system, as reflected in the software tools represented by the opponent's goods, and finished programs. I also agree with Mr Malynicz in relation to the hardware. All of the goods (save for one exception that I will come to) can be used for computing in some form (even telecommunications apparatus which could be built in or used in conjunction with a computing device). Again, there seems to be a complementary relationship between a computer language programming system and items of computing hardware, where the users assume that the hardware has been coded with the language or uses it in a certain way. I accept, though, that the nature of the link gives rise only to a low degree of similarity. I conclude with "electronic publications". Such a publication could be for the instruction of the user in relation to the computing language or some other form of guide. Again, there seems to be a clear complementary relationship, leading to at least a moderate degree of similarity.

44) Mr Malynicz then moved on to certain (but not all) services in class 35, as follows, which he argued were similar:

> Retail services connected with the sale of computers, data processing equipment, downloadable electronic publications, telecommunications apparatus, recorded media, computer hardware and firmware, computer software, software downloadable from the Internet, recorded computer

programs, computer apparatus and equipment, computer peripheral devices, computer keyboards, recorded computer software, computer components, personal electronic devices, electronic devices for receiving television and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith, computer programs for managing communications and data exchange between handheld computers and desktop computers, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording disc, paper, cardboard and goods made from these materials, printed matter, stationery, printed publications, books, documentation for use in the development of computer software programs, instruction manuals for use in the development of software for computers

45) The argument was based upon the complementary relationship between retailing on the one hand and the retailed goods on the other[5]. Of course, the complementary relationship is clearest when the retailed goods corresponded with the goods of the earlier mark. Whilst some of the goods do correspond (because the goods of the earlier mark fall within software as per my earlier findings) others do not and are, effectively, a further step away. Even so, I still consider that a complementary relationship can still exist, albeit of a lower level, given the type of relationship I have already described between computer languages and computer programming language systems, as reflected in the software tools represented by the opponent's goods, and the resulting programs and hardware coded in those languages. The only aspect of the services which are not similar is the retailing of printed matter, stationery, printed publications, books, documentation for use in the development of computer software programs, instruction manuals for use in the development of software for computers and downloadable electronic publications, which I consider to be a further step away again compared to the goods themselves[6].

46) Mr Malynicz argued that all of the applicant's services in class 42 and 45 were similar to the goods of the earlier mark. The services are:

Class 42: Technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; consulting services relating to computer data handling; consulting services relating to computer software; advice relating to the development of computer systems; computer software development; computer systems development; design services relating to the development of computerized information processing systems; development of computer codes, computer languages, computer programmes; development of computer software; development of computer software application solutions; development of computer systems; development of data programs; development of software;

[5] See, for example, Case T-116/06, *Oakley Inc. v. OHIM*
[6] See paragraphs 52 and 54 below

development of systems for the processing of data; development of systems for the storage of data; development of systems for the transmission of data; computer services; computer programming; computer consultancy and technical support; arranging and conducting conferences and exhibitions, all relating to computing; maintenance of computer software; installation of computer software; advisory services relating to computer software, computer software design, acquisition of computer software; computer software engineering; computer software programming; custom design of computer software; software engineering; updating of computer software; custom design of software packages; development of computer software application solutions; services for the writing of computer software.

Class 45: Computer licensing; computer software licensing; licensing of computer firmware; licensing of programs stored on data carriers

47) All of the above services are, essentially, computer related and the role of programming language systems within them is an important factor; for example, where the development or design in question is being built upon the programming language or the way it is used. The same applies to the various licensing services. I consider this complementary relationship to result in a moderate degree of similarity. The only services listed above which I do not consider to be similar are "design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others" which are more general and less technical in nature, making the link with a computer language less clear.

48) Turning to class 41, this reads:

Class 41: Education; providing of training; entertainment; training services; courses for the development of consulting skills; instruction in the development of computers; training in the development of computer memories, computer programs, software systems and integrated circuits; arranging and conducting of conferences, conventions, presentations, seminars, symposiums; business training services; computer assisted training services; computer based training; computer training; publishing services.

49) This class represents the first tension I discussed earlier because in relation to similarity of goods/services in this class Mr Malynicz stated:

"The first few lines of 41 are, you could say, non-computer-related, but then we get to "instruction in the development of computers" and all the way down to the end, we are going to say that there is similarity through complementarity because there is a high degree of dependence and similarity between those"

49) The above could be seen as a concession that the services detailed in the "first few lines" (those preceding instruction in the development of computers) are not similar. However, the tension that arises is that the terms "education; providing of training, training services" clearly cover the specific computer related training which are later specified and claimed to be similar. On the *Meric* principle, if the specific are found to be similar then so are the more general terms. Furthermore, the

concession itself is perhaps not the clearest. Therefore, I consider it appropriate to deal with the general terms I have identified in addition to those argued by Mr Malynicz as being similar. In this regard the applicant cannot really claim to be prejudiced or lacking an opportunity to make submissions on similarity, because the services on which similarity will be assessed are the same services as were claimed to be similar. I consider it unnecessary (because the point was cleanly and clearly conceded) to deal with the following services:

> Entertainment; courses for the development of consulting skills

50) But it is necessary to consider the following:

> Instruction in the development of computers; training in the development of computer memories, computer programs, software systems and integrated circuits; arranging and conducting of conferences, conventions, presentations, seminars, symposiums; business training services; computer assisted training services; computer based training; computer training; publishing services.

51) It seems to me that the proprietor of a computer programming language system could well be expected to offer training and instruction (and symposiums etc) in its use. This gives rise to a moderate degree of similarity on a complementary basis. However, this does not extend to "business training services" which are of a different character. Furthermore, the "publishing services" are not obviously similar as there is nothing to suggest (and it is not obvious to me) that publishing services are provided in specialist fields such as those relating to the goods of the earlier mark.

52) The remaining goods and services are in classes 16, 25, 28, 35 (the residue of the class not already discussed), 36 and 38. At the hearing Mr Malynicz stated:

> "For the moment, we would say on classes 16, 25, 28, 35 and, in so far as I have not mentioned them 36 and 38, all of that is dissimilar – we accept it is dissimilar to recorded computer software and recorded computer programs..."

53) The rest of the paragraph relates to the establishment of a link for the purposes of section 5(3) of the Act, a provision which can be relied upon absent goods/service similarity. The concession here is abundantly clear. When I reviewed the transcript I could see no tensions in relation to classes 25, 28 35 (the residue), 36 & 38. Therefore, despite the opponent attempting to resile from its position, I consider it inappropriate to re-open the matter. In any event, even if an analysis was made all of the goods and services are a step further away from what I have already assessed and no real similarity is established. **The goods are not similar.** That then leaves class 16 which reads:

> **Class 16:** Paper, cardboard and goods made from these materials; printed matter; stationery; printed publications; books; documentation for use in the development of computer software programs; instruction manuals for use in the development of software for computers.

54) At the hearing similarity was conceded as per Mr Malynicz's statement in paragraph 52 above. However, there is something of a tension because the retailing

of class 16 goods is claimed to be similar to the goods of the earlier mark. Mr Malynicz also referred to books during the course of the hearing, however, having reviewed the transcript he does not at any point refer to them as similar. Indeed, in the transcript he also states:

> "I am going to come back to them. When I say "leave them", I am going to come back to them. I want to focus on the things that are within my penumbra of protection under 5(2)"

55) Further, when Mr Malynicz referred to books later in his submissions he did so with regard to unfair advantage under section 5(3). I also note that in his submissions Mr Hodson highlighted that class 16 (and other classes) had been rowed back from (in terms of similarity) and had been "given" to him. Mr Malynicz did not come back on this. Taking all this into account, I do not consider it appropriate for the opponent to resile from its clear position despite the tension I have identified. The goods must be held to be dissimilar, not least because the opponent has not explained why they are similar to the goods in class 9 for which the earlier mark is entitled to protection.

Summary of goods/services similarity

56) The following are identical or similar (to the degrees set out above):

> **Class 9:** Computers; data processing equipment; telecommunications apparatus; recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; recorded computer programs; computer apparatus and equipment; computer peripheral devices; computer keyboards; recorded computer software; computer components; personal electronic devices; electronic devices for receiving television and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith; computer programs for managing communications and data exchange between handheld computers and desktop computers; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; parts and fittings for all of the aforesaid goods.
>
> **Class 35:** Retail services connected with the sale of computers, data processing equipment, telecommunications apparatus, recorded media, computer hardware and firmware, computer software, software downloadable from the Internet, recorded computer programs, computer apparatus and equipment, computer peripheral devices, computer keyboards, recorded computer software, computer components, personal electronic devices, electronic devices for receiving television and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith, computer programs for managing communications and data exchange between handheld computers and desktop computers, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording disc, paper, cardboard and goods made from these materials.

Class 41: Education; providing of training; training services; instruction in the development of computers; training in the development of computer memories, computer programs, software systems and integrated circuits; arranging and conducting of conferences, conventions, presentations, seminars, symposiums; computer assisted training services; computer based training; computer training.

Class 42: Technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design services; consulting services relating to computer data handling; consulting services relating to computer software; advice relating to the development of computer systems; computer software development; computer systems development; design services relating to the development of computerized information processing systems; development of computer codes, computer languages, computer programmes; development of computer software; development of computer software application solutions; development of computer systems; development of data programs; development of software; development of systems for the processing of data; development of systems for the storage of data; development of systems for the transmission of data; computer services; computer programming; computer consultancy and technical support; arranging and conducting conferences and exhibitions, all relating to computing; maintenance of computer software; installation of computer software; advisory services relating to computer software, computer software design, acquisition of computer software; computer software engineering; computer software programming; custom design of computer software; software engineering; updating of computer software; custom design of software packages; development of computer software application solutions; services for the writing of computer software.

Class 45: Computer licensing; computer software licensing; licensing of computer firmware; licensing of programs stored on data carriers.

57) The following are not similar:

Class 9: Downloadable electronic publications.

Class 16: Paper, cardboard and goods made from these materials; printed matter; stationery; printed publications; books; documentation for use in the development of computer software programs; instruction manuals for use in the development of software for computers.

Class 25: Clothing, footwear and headgear.

Class 28: Games and playthings; playing cards; gymnastic and sporting articles.

Class 35: Advertising; business management; business administration; office functions; electronic data storage; advertising services provided via the Internet; data processing; provision of business information; business consulting services; business consultancy; business consultancy relating to data processing; business consultancy services relating to the administration of information technology; business management and organization consultancy; consultancy; business development services; retail services connected with the sale of downloadable electronic publications, printed matter, stationery, printed publications, books, documentation for use in the development of computer software programs, instruction manuals for use in the development of software for computers, clothing, footwear and headgear, games and playthings, playing cards, gymnastic and sporting articles.

Class 36: Insurance; financial services; real estate agency services; building society services; banking; stockbroking; financial services provided via the Internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information.

Class 38: Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; receipt and delivery of messages, documents and other data by electronic transmission; radio and television broadcasting.

Class 41: Entertainment; courses for the development of consulting skills; business training services; publishing services.

Class 42: Design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others;

The average consumer and the purchasing process

58) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

59) The average consumer in the case of the opponent's goods will be computer programmers and developers. They will adopt a reasonably high level of care and consideration and it is likely that the mark will be encountered in a predominantly visual manner. In relation to the applicant's goods, to the extent that the same goods are involved then the same analysis applied. However, in relation to other types of program or hardware or the various services I have found to be complementary, the average consumer could be a member of the public. The latter is more likely to be confused so I will focus upon this group. I consider, again, that a reasonable degree of attention be shown and the mark encountered more visually than aurally.

Comparison of the marks

60) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are shown below.

The Applicant's Mark	The Opponent's Mark
	**ERLANG**

61) Despite is stylisation, the applicant's mark will be clearly be seen and referred to as Erlang. The marks are aurally identical. The stylisation is borne in mind, but I come to the clear view that the marks are still visually similar to a high degree. ERLANG has no meaning likely to be known by the average consumer. There is neither conceptual similarity nor difference. Overall, I conclude that the marks are highly similar.

The distinctiveness of the earlier mark

62) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent perspective, the earlier mark is highly distinctive. As I have already stated, it will be perceived as an invented word. Whilst I have found that the earlier mark has been genuinely used, I am far from satisfied that the evidence establishes that the distinctiveness of the mark has been further enhanced. Without being in a position to assess in concrete terms the significance of ERLANG in the relevant market then I must leave the matter to be assessed on the basis of the inherent degree of distinctiveness. While I accept the sincerity of Ms Lion's statement that she and her colleagues believe that, by virtue of long use, the mark enjoys a reputation, I need more than that. The decision is for the Tribunal, and I require concrete data from which I could conclude that the necessary reputation has been established in the UK.

Likelihood of confusion

63) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG,* paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

64) In relation to the goods which are not similar or identical to the goods of the earlier mark (as set out in paragraph 57) then there can be no likelihood of confusion[7]; the ground under section 5(2)(b) fails accordingly for such goods. However, in relation to the other goods and services I have found identity or similarity (of varying degrees) between the goods and services. That there are varying degrees of similarity is important because of the interdependency between the various factors. However, the marks are highly similar and the earlier mark highly distinctive. I come to the view that there is a likelihood of confusion on the basis that all of the goods and services will be perceived as coming from the same (or related) trade source as the computer programming language systems provider itself. It is not as though the applicant's mark uses the word ERLANG in some quasi descriptive way to suggest that what they are providing relates to Erlang programming but is not from the company responsible for providing the goods covered by the opponent's specification. The nature of the mark instead leads to a shared origin assumption.

SECTION 5(3)

65) Section 5(3) of the Act reads:

> "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 Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

66) The scope of Section 5(3) has been considered in a number of cases, most notably: *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, C.A. *Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Davidoff & Cie SA v Gofkid Ltd (Davidoff)* [2003] ETMR 42, *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd (Adidas-Salomon)* (C-408/01), *Intel Corporation Inc v CPM (UK) Ltd* ("*Intel*") (C-252-07), *L'Oreal v Bellure NV* [2009] ECR I-5185 and in *Specsavers International Healthcare v Asda Stores Ltd.* [2012] EWCA Civ 24.

Reputation

67) In order to succeed under this ground the earlier mark must have a reputation. In *General Motors Corp v Yplon SA* (*CHEVY*) [1999] ETMR 122 and [2000] RPC 572 Chevy the CJEU stated:

[7] See *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-398/07

"The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark."

68) In making this assessment all the relevant factors must be taken into account, including the duration, extent and geographical area of use of the mark, and the scale and scope of investment in promoting the mark (see *CHEVY* at paragraph 41). Detail which would enable me to assess clearly the impact of the mark in the field is lacking. Whilst books have been written about ERLANG, this does not necessarily indicate a significant degree of mark awareness. ERLANG may be a niche product known only by a small subset of the market. The fact is that, owing to the absence of more detailed evidence, I do not know. As I have already stated, Ms Lion's words to the effect that a reputation is enjoyed through long use in the UK is no more than an assertion. Moreover, long use does not equate to reputation. The question as to whether a reputation exists is a matter for the tribunal to make on the evidence. On the basis of the evidence filed, I cannot hold that a qualifying reputation exists. **The ground under section 5(3) is dismissed.**

OUTCOME

69) The opposition succeeds, and the mark is to be refused, in respect of the following:

Class 9: Computers; data processing equipment; telecommunications apparatus; recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; recorded computer programs; computer apparatus and equipment; computer peripheral devices; computer keyboards; recorded computer software; computer components; personal electronic devices; electronic devices for receiving television and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith; computer programs for managing communications and data exchange between handheld computers and desktop computers; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; parts and fittings for all of the aforesaid goods.

Class 35: Retail services connected with the sale of computers, data processing equipment, telecommunications apparatus, recorded media, computer hardware and firmware, computer software, software downloadable from the Internet, recorded computer programs, computer apparatus and equipment, computer peripheral devices, computer keyboards, recorded computer software, computer components, personal electronic devices, electronic devices for receiving television and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith, computer programs for managing communications and data exchange between handheld computers and desktop computers, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording disc, paper, cardboard and goods made from these materials,.

Class 41: Education; providing of training; training services; instruction in the development of computers; training in the development of computer memories, computer programs, software systems and integrated circuits; arranging and conducting of conferences, conventions, presentations, seminars, symposiums; computer assisted training services; computer based training; computer training;

Class 42: Technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design services; consulting services relating to computer data handling; consulting services relating to computer software; advice relating to the development of computer systems; computer software development; computer systems development; design services relating to the development of computerized information processing systems; development of computer codes, computer languages, computer programmes; development of computer software; development of computer software application solutions; development of computer systems; development of data programs; development of software; development of systems for the processing of data; development of systems for the storage of data; development of systems for the transmission of data; computer services; computer programming; computer consultancy and technical support; arranging and conducting conferences and exhibitions, all relating to computing; maintenance of computer software; installation of computer software; advisory services relating to computer software, computer software design, acquisition of computer software; computer software engineering; computer software programming; custom design of computer software; software engineering; updating of computer software; custom design of software packages; development of computer software application solutions; services for the writing of computer software.

Class 45: Computer licensing; computer software licensing; licensing of computer firmware; licensing of programs stored on data carriers.

70) The opposition fails, and the mark is to be registered, in respect of the following:

Class 9: Downloadable electronic publications.

Class 16: Paper, cardboard and goods made from these materials; printed matter; stationery; printed publications; books; documentation for use in the development of computer software programs; instruction manuals for use in the development of software for computers.

Class 25: Clothing, footwear and headgear.

Class 28: Games and playthings; playing cards; gymnastic and sporting articles.

Class 35: Advertising; business management; business administration; office functions; electronic data storage; advertising services provided via the Internet; data processing; provision of business information; business consulting services; business consultancy; business consultancy relating to data processing; business consultancy services relating to the administration of information technology; business management and organization consultancy; consultancy; business development services; retail services connected with the sale of downloadable electronic publications, printed matter, stationery, printed publications, books, documentation for use in the development of computer software programs, instruction manuals for use in the development of software for computers, clothing, footwear and headgear, games and playthings, playing cards, gymnastic and sporting articles.

Class 36: Insurance; financial services; real estate agency services; building society services; banking; stockbroking; financial services provided via the Internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information.

Class 38: Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; receipt and delivery of messages, documents and other data by electronic transmission; radio and television broadcasting.

Class 41: Entertainment; courses for the development of consulting skills; business training services; publishing services.

Class 42: Design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others;

71) I have considered whether any of the terms for which I have upheld the opposition could be amended so as to avoid a likelihood of confusion. Whilst in theory it may be possible to do so, the nature of the applicant's business demonstrates that what they are interested in as the very things for which a likelihood of confusion will arise. In the circumstances, I do not consider it appropriate to consider revised specifications.

COSTS

72) Given the fairly equal measure of success, I do not propose to favour either party with an award of costs in this matter.

Dated this 22nd day of July 2014

Martin Boyle
For the Registrar,
The Comptroller-General