TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 2603479 BY BYTEMARK INC

AND IN THE MATTER OF OPPOSITION No. 103100 BY BYTEMARK COMPUTER CONSULTING LIMITED

AND IN THE MATTER OF REGISTEED TRADE MARK No. 2605360 IN THE NAME OF BYTEMARK COMPUTER CONSULTING LIMITED

AND IN THE MATTER OF THE JOINT APPLICATION FOR A DECLARATION OF INVALIDITY No. 84607 BY BYTEMARK LIMITED AND BYTEMARK INC

DECISION

Introduction

1. This is an appeal from the decision of Mr George Salthouse, acting for the Registrar, dated 21 November 2013 (O-469-13), in which he:

   (1) Allowed Opposition No. 103100 by Bytemark Computer Consulting Limited ('***BCCL***') to Trade Mark Application No. 2603479 by Bytemark Inc ('***BIN***'); and

   (2) Dismissed the Joint Application for a declaration of Invalidity No. 84607 by Bytemark Limited and Bytemark Inc against Registered Trade Mark No. 2605360 in the name of BCCL.

2. On 2 December 2011 BIN filed Trade Mark Application No. 2603479 requesting registration of the mark BYTEMARK.

3. The application was made in respect of the following goods:

   Class 9: Computer communications software to allow customers to access bank account information and transact bank business; Computer software for controlling self-service terminals; Computer software that provides web-based access to applications and services through a web operating system or portal interface; Computer software, namely, an application allowing sales and field service employees to update and receive data stored in an enterprise's computer databases in real time, using a mobile device, with full telephony integration with the telephone and/or software features of the mobile device; Customer self service electronic checkout station for

point of sale; computer software that resides on a mobile device for the purposes of managing, storing, editing, and conducting a financial transaction.

Class 35: Electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; data processing; provision of business information.

4. The application was published in the Trade Marks Journal No 6922 on 13 January 2012.

5. On 12 March 2012 BCCL filed a Notice of Opposition. The single Ground of Opposition was under Section 5(4)(a) of the Trade Marks Act 1994 ('***the Act***'). On the Form TM7 in support of the Section 5(4)(a) of the Ground of Opposition BCCL indicated in substance as follows:

(1) That the earlier mark relied upon was BYTEMARK;

(2) That the mark was first used in 2001 and had been used throughout the United Kingdom since that date;

(3) That the goods and services in relation which the earlier mark had been used were "*Internet hosting services, rental of computers for data storage, processing and serving to internet users, data storage, processing and serving services to internet users, electronic data storage, data processing, provision of business information, computer consultancy services, computer software updating services, computer software, computer software updates, computer software that provides web-based access to applications and services through a web operating system or portal interface, computer communications software facilitating customers to access [BCCL's] services, domain name registration services."*; and

(4) "*By virtue of the long standing, nationwide, substantial use of the trade mark BYTEMARK, [BCCL] holds considerable reputation and goodwill in the mark. Use of the identical mark in relation to the identical and/or similar goods/services will amount to a misrepresentation that the goods/services of [BIN] or that there is some affiliation or connection between the parties, or endorsement of [BIN's] goods/services by [BCCL]. The resultant confusion is likely to cause damage to [BCCL's] goodwill and reputation in the mark.*"

6. On 15 May 2012, BIN filed a Counterstatement denying all the grounds.

7. On 13 July 2012 BIN and Bytemark Limited jointly applied for a declaration of invalidity in respect of Trade Mark Registration No. 2605360 for the word

BYTEMARK in the name of BCCL. In accordance with the nomenclature adopted by the Hearing Officer save where appears otherwise I shall hereafter in this Decision refer to the joint applicants as BIN.

8. Trade Mark Registration No. 2605360 was filed on 22 December 2011. That application was not opposed and the mark was registered on 26 October 2012 for the following services:

> Class 35: Automated data processing; electronic data processing; online data processing services; presentation of companies on the Internet and other media; advertising on the Internet, for others; computerised file management, data storage, database services, namely systematisation and collating of data in computer databases, digital data processing, auctioneering, including on the Internet, investigations, research in databases and on the Internet, for others, promotion of companies on the Internet and other media, rental of advertising space, including on the Internet (banner exchange), arranging commercial and business contacts, including via the Internet, advertising in the Internet, for others.
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> Class 36: Automated payment of accounts; collection of payments; credit card payment processing; credit services for payment of insurance premiums; credit services for the payment of insurance premiums; electronic payment services; financial payment services; information services relating to the automated payment of accounts; payment administration services; payment transaction card services; processing of payments for banks; processing of payments in relation to charge cards; processing of payments in relation to credit cards; arranging financial transactions; automated banking services relating to charge card transactions; automated banking services relating to credit card transactions; financial transaction services; payment transaction card services; processing charge card transactions for others; processing credit card transactions for others; processing debit card transactions for others; provision of information relating to credit card transactions; money transfer services utilising electronic cards.
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> Class 38: Telecommunications services; communications services; telephone, mobile telephone, facsimile, telex, message collection and transmission, radio-paging, call diversion, answerphone, directory enquiries and electronic mail services; forwarding of messages of all kinds to Internet; transmission, delivery and reception of sound, data, images, music and information; telecommunications services over the Internet including but not limited to services provided using voice over Internet protocol (VOIP); provision of access and/or

connectivity to broadband networks whether fixed, portable or wireless; transmission of text, messages, sound and/or pictures; provision of audio visual content; electronic message delivery services; on-line information services relating to telecommunications; data interchange services; transfer of data by telecommunication; satellite communication services; broadcasting services; broadcasting or transmission of radio or television programmes and of films, teleshopping and web shopping programmes; videotext, teletext and viewdata services; broadcasting and delivery of multimedia content over electronic communications networks; video messaging services; video conferencing services; video telephone services; telecommunication of information (including web pages), computer programs and any other data; providing user access to the Internet; providing telecommunications connections or links to the Internet or databases; providing user access to the Internet (service providers); provision and operation of electronic conferencing, discussion groups and chat rooms; providing access to digital music websites on the Internet; providing access to MP3 websites on the Internet; delivery of digital music by telecommunications; providing access to telecommunications infrastructures for other operators; telecommunication access services; computer aided transmission of messages and images; communication by computer; news agency services; transmission of news and current affairs information; hire, leasing or rental of apparatus, instruments, installations or components for use in the provision of the aforementioned services; advisory, information and consultancy services relating to all the aforementioned.

Class 42: Web hosting services; maintaining and hosting the web sites of others; hosting of Internet sites; hosting of digital content on the Internet; computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for searching and retrieving information from databases and computer networks; providing platforms on the Internet, operating chatlines, chat rooms and forums; technical consultancy and aid in the field of computer hardware and computer software; providing technical advice and assistance for the operation of data processing equipment; services of the creation, design and development of a data bank including electronic information; consultancy services relating to computer hardware and computer software; leasing of computer hardware and computer software; development of computer programs; maintenance and updating of computer software; design and development of computer hardware; creating, operating and maintaining web sites, web pages and portals for logging text, images and music provided either via

computers or mobile telephones; hosting websites; rental of database servers; operating and providing search engines.

Class 45: Compilation, creation and maintenance of a register of domain names.

9. The Grounds of Invalidity relied upon contended in substance that:

(1) BIN was the proprietor of Trade Mark Application No. 2603479;

(2) Bytemark Limited was the exclusive licensee of BIN;

(3) BIN/Bytemark Limited first used the mark BYTEMARK "*in February 2011 as a result of the registration of the domain name bytemark.co*" and "*has subsequently been used in the United Kingdom since that date*";

(4) As a consequence of the such use BIN/Bytemark Limited enjoyed significant goodwill and reputation in a number of countries including the United Kingdom "*in relation to the development of its mobile payment and ticketing system and solutions business*"; and

(5) By reason of the aforesaid Trade Mark Registration No. 2605360 was liable to be declared invalid in its entirety under Section 5(1), 5(2)(a), 5(3) and/or Section 5(4)(a) of the Act.

10. On 5 February 2013 BCCL filed a Counterstatement denying all grounds and expressly put BIN and Bytemark Limited to proof of the claimed reputation.

11. The Opposition and the Application for a declaration of Invalidity were subsequently consolidated. Both parties filed evidence.

12. At the hearing before the Hearing Officer BCCL was represented by Mr Peter Colley (instructed by Messrs Groom Wilkes & Wright LLP). BIN was not represented, but had previously provided written submissions.

The Hearing Officer's decision

13. The Hearing Officer allowed the Opposition on the Ground of Section 5(4)(a) of the Act.

14. Having summarised the evidence and identified the relevant law the Hearing Officer went on to making the following findings in paragraphs 26 to 31 of his Decision:

> 26) I turn to assess the evidence filed by BCCL in the present proceedings as set out earlier in this decision. Although its

evidence is flawed in that its turnover figures appear to relate to world wide sales it has provided a sample of invoices over a number of years which, whilst modest in the sums involved, cannot be regarded as anything other than genuine, and have not been so challenged by BIN. To my mind, BCCL has clearly demonstrated that it has used the word "Bytemark" in relation to hosting services and also software allowing the data stored to be amended and retrieved. It also monitors customers' accounts and sends them alerts as well as offering services such as domain name rental and software licences. BIN contended that BCCL had used the mark "bytemark hosting". Whilst there is clear use of the mark "bytemark hosting" when used in relation to hosting services I do not consider that the average consumer will view the word "hosting" as having any trade mark or origin significance. Further, there is clear evidence of the use of "bytemark" solus. BCCL has overcome the first hurdle in showing that at the material date it had goodwill in the mark Bytemark in relation to hosting services and computer software.

27) It is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade. The point can be supported by reference to the following passage from Millet L.J.'s judgment *in Harrods Ltd v Harrodian School Ltd* [1996] RPC 697:

> "There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by Wynn-Parry J. in *McCulloch v May* [1948] 65 RPC 58 when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* (1902) 2 Ch. 282 (The Times Newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing-off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing-off must prove is not the existence of a

> common field of activity but likely confusion among the common customers of the parties.
>
> The absence of a common field of activity, therefore is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration."

Also:

> "It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services."

And:

> "Passing off is a wrongful invasion of a right of property vested in the plaintiff, but the property which is protected in an action for passing off is not the plaintiff's proprietary right in the name or get-up which the defendant has misappropriated but the goodwill and reputation of the business which is likely to be harmed by the defendant's misrepresentations."

28) In the instant case BIN is seeking registration of the following specification:

In Class 9: Computer communications software to allow customers to access bank account information and transact bank business; Computer software for controlling self-service terminals; Computer software that provides web-based access to applications and services through a web operating system or portal interface; Computer software, namely, an application allowing sales and field service employees to update and receive data stored in an enterprise's computer databases in real time, using a mobile device, with full telephony integration with the telephone and/or software features of the mobile device; Customer self service electronic checkout station for point of sale; computer software that resides on a mobile device for the purposes of managing, storing, editing, and conducting a financial transaction.

In Class 35: Electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; data processing; provision of business information.

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

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

30) To my mind there is a clear overlap between the goods and services applied for by BIN and those in which BCCL has shown it has goodwill. Mr Stewart of BCCL provided the following definition of hosting as "a web hosting service is a type of Internet hosting service that allows individuals and organisations to make their website accessible via the World Wide Web" (see paragraph 17 above). It is clear that BCCL has a number of different clients including a bank which conduct financial transactions via the servers they rent from BCCL and that BCCL provides a range of software to monitor the customers' data. There is clear evidence that BCCL provides software licences, and at exhibit MB9 an unambiguous reference to custom built software to meet specific client requirements. When this is added to the unquestionable identicality of the marks there is clearly misrepresentation. The evidence of emails being received by BCCL which were meant for BIN merely strengthens my view and also provides evidence of potential damage. BIN's explanation that the confusion was due to both parties having someone called Alex working for them is risible.

31) The opposition under Section 5(4)(a) is therefore successful against all the goods and services in the application's specification.

15. Having allowed the Opposition on the Ground of Section 5(4)(a) of the Act the Hearing Officer went on to deal with the Application for a declaration of Invalidity quite shortly in paragraph 33 of his Decision:

> 33) Because of my earlier finding BIN does not have an earlier mark to rely upon under its invalidity request. Therefore, its invalidity grounds based upon Sections 5(1), 5(2)(a) and 5(3) must all fail. Moving onto the section 5(4)(a) ground, I have found earlier in this decision that BCCL is clearly the senior user of the mark and therefore BIN cannot succeed under this ground either.

The Grounds of Appeal

16. BIN appealed to the Appointed Person under Section 76 of the Trade Marks Act 1994. The Grounds of Appeal contend in substance that:

    (1) The Hearing Officer erred by making a narrow finding of fact in relation to the scope of BCCL's protectable goodwill and then based his conclusions on a different and broader finding of fact in relation to scope of BCCL's protectable goodwill; and

    (2) The Hearing Officer erred by failing to carry out a proper global assessment of all relevant factors when considering the issue of passing off.

17. The ancillary or 'general comments' made in further support of these primary Grounds of Appeal were broadly that the reasons given in support of the Hearing Officer's decision were not adequate and the Hearing Officer has erred in giving no weight to the evidence of six of BIN's witnesses on the basis that they were merely providing an opinion.

18. As was rightly made clear in the skeleton of argument on behalf of BIN it was not in dispute that the relevant law had been correctly cited by the Hearing Officer rather that the law had been erroneously applied.

19. Further, for the purposes of the appeal it was accepted on behalf of BIN that the Hearing Officer's finding that BCCL had goodwill under the mark BYTEMARK in relation to "*hosting services and also software allowing the data stored to be amended and retrieved*" (paragraph 26 of the Decision).

20. It is convenient to note at this stage that the finding of the Hearing Officer that the relevant date for the purposes of considering the Grounds of Opposition was 2 December 2011, the filing date of Trade Mark Application No. 2603479, on the basis that there was no evidence of use by BIN or Bytemark Limited of the mark BYTEMARK in the United Kingdom prior to that date. That finding is not challenged on appeal.

21. No Respondent's Notice was filed by BCCL.

22. At the hearing of the appeal Mr Jonathan Moss (instructed by Lawrie IP Limited) appeared on behalf of the Appellants, Bytemark Limited and Bytemark, Inc; and Mr Thomas St Quintin (instructed by Groom Wilkes and Wright LLP) appeared on behalf of the Respondent, Bytemark Computer Consulting Limited.

Standard of review

23. The appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.

24. More recently in Fine & Country Ltd v Okotoks Ltd (formerly Spicerhaart Ltd) [2013] EWCA Civ 672; [2014] FSR 11 Lewison LJ said at paragraph [50]:

> The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. . . .

25. This approach was reiterated by the Court of Appeal in Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115]. Moreover in paragraph [115] Lord Justice Lewison said:

> 115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: see *Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55; *Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

26. As was rightly accepted by the parties, it is necessary to bear these principles in mind on this appeal.

Decision

The scope of the relevant goodwill

27. As part of the assessment for conflict under Section 5(4)(a) of the Act it was necessary for the Hearing Officer to determine which goods and/or services of BCCL had a goodwill and reputation under the mark BYTEMARK.

28. The Hearing Officer's findings, based on the evidence that he had summarised in paragraphs 9 to 18 of his Decision were set out in paragraph 26 of his Decision as follows:

> To my mind, BCCL has clearly demonstrated that it has used the word "Bytemark" in relation to hosting services and also software allowing the data stored to be amended and retrieved. It also monitors customers' accounts and sends them alerts as well as offering services such as domain name rental and software licences.

29. These findings were reinforced in paragraph 30 of his Decision the Hearing Officer where the Hearing Officer went on to state:

> Mr Stewart of BCCL provided the following definition of hosting as "a web hosting service is a type of Internet hosting service that allows individuals and organisations to make their website accessible via the World Wide Web" (see paragraph 17 above). It is clear that BCCL has a number of different clients including a bank which conduct financial transactions via the servers they rent from BCCL and that BCCL provides a range of software to monitor the customers' data. There is clear evidence that BCCL provides software licences, and at exhibit MB9 an unambiguous reference to custom built software to meet specific client requirements.

30. It is accepted by BIN for the purposes of the present appeal that the Hearing Officer was correct to find that BCCL had a protectable goodwill under the mark BYTEMARK in respect of "*hosting services and also software allowing the data stored to be amended and retrieved*". What is disputed on appeal is the finding in last sentence of paragraph 26 that BCCL has "*goodwill in the mark Bytemark in relation to hosting services and computer software*".

31. In support of this Ground of Appeal BIN rely on: (1) what is said to be an internal inconsistency in the Hearing Officer's reasoning in paragraph 30 of his Decision; and (2) that the term 'computer software' is an incredibly broad term and that the evidence

filed on behalf of BCCL does not support a goodwill in respect of software beyond "*software allowing the data stored to be amended and retrieved*".

32. As to the internal inconsistency in paragraph 26 of the Decision it seems to me that the only basis upon which the conclusion given in the last sentence of paragraph 26 can be regarded as inconsistent with the earlier findings of fact in the paragraph is if one considers the first sentence in the quotation set out in paragraph 28 above out of context. In particular it requires the reader to ignore the second sentence in the quotation set out in paragraph 28 above. In addition it ignores the findings made in paragraph 30 of the Decision, which provide further support for the conclusion reached by the Hearing Officer in paragraph 26.

33. With regard to the second proposition, that the term 'computer software' is a broad term and is not supported across the entirety of its breadth by the evidence of use filed on behalf of BCCL I have some sympathy with the submissions on behalf of BIN. It has long been appreciated in the context of the trade mark registrations that a registration for 'computer software' will normally be too wide: see for example the judgment of Laddie J. in Mercury Communications Limited v. Mercury Interactive (UK) Limited [1995] FSR 850. It seems to me that, by way of analogy, when considering the question of the scope of goodwill for the purposes of passing off care must be taken to consider whether the evidence supports a claim to 'computer software' or should be further limited by reference to the specific area of trade or business relative to which the software is created for or used. An example of this was given by Laddie J. in Mercury (above) is of software used in a flight simulator being an entirely different product from software which enables a computer to optically character read text or design a chemical factory.

34. It is also necessary, when assessing the evidence for the purposes of the passing off claim on paper (and there was no cross-examination in this case) the guidance that the Hearing Officer clearly identified in paragraphs 24 and 25 of his Decision.

35. In the present case, as noted by the Hearing Officer there was evidence before him that BCCL licensed software products to its clients. An example is the "Symbiosis System" described in the evidence of Mr Bloch. In addition there was evidence before the Hearing Officer, in particular in Exhibit MB9, that BCCL supplied custom built software to its customers. There is nothing in the evidence to suggest that such software was created for or used in any one particular area of trade or business. An example from MB9 from BCCL's website in 2002 stated as follows:

> **Who are we?**
>
> Bytemark Computer Consulting is a partnership of flexible IT consultants, all of us with a passion for computer and information technology.

> We can help you with anything IT-related but our speciality services are *bespoke software design, electronic commerce, internet strategies & services* and *intranet and custom-built office systems.*
>
> . . .
>
> **How we write software**
>
> Custom built software development is a difficult and involved process, and we realise that it's more than just a technical one: you need to be sure you know what you're getting for your money throughout the process, which is why you will see results from us quickly and often. From some initial design ideas we will go ahead and implement a prototype within a week or two, and continue to flesh the prototype into a finished product - - our philosophy is to allow you to have a working product as soon as possible, and to refine as time and budget permits.

One of the examples of past work given on the same page stated:

> Financial
> analysis
>
> We are currently developing for a client a unique concept for a web based currency market analysis tool to be published later this year.

36. In addition on this appeal BIN have accepted that BCCL had a protectable goodwill under the mark BYTEMARK in respect of "*hosting services and also software allowing the data stored to be amended and retrieved*". As Mr St Quinton, on behalf of BCCL submitted, "*software allowing the data stored to be amended and retrieved*" is a very broad category of software and that it "*is difficult to think of any piece of software which does not allow data to be retrieved or amended*".

37. Given the totality of the evidence before the Hearing Officer; the findings of fact made by the Hearing Officer on the basis of that evidence as set out in paragraph 26 and confirmed in paragraph 30 of his Decision; and having regard to the concession for the purposes of this appeal that BCCL had a protectable goodwill under the mark BYTEMARK in respect of "*hosting services and also software allowing the data stored to be amended and retrieved*" it seems to me that the Hearing Officer was not clearly wrong to conclude as he did that BCCL has "*goodwill in the mark Bytemark in relation to hosting services and computer software*".

The failure to make a global assessment when considering the issue of passing off

38. As noted in paragraph 18 above it was not at any point suggested that the Hearing Officer did not identify the correct legal approach to the assessment that he was required to make in relation to the law of passing off for the purposes of Section 5(4)(a) of the Act.

39. What is stated in the Grounds of Appeal is that the Hearing Officer failed when assessing the likelihood of confusion "*to conduct a global appreciation of all the relevant factors*". The Grounds of Appeal then go on to identify the relevant factors not by reference to the case law relevant to the law of passing off but by reference to the case law relating to the assessment of the likelihood of confusion i.e. the principles applicable to the assessment for conflict under Section 5(2) of the Act.

40. In my view the absence of any specific reference to any of the criteria derived from the case law under Section 5(2) of the Act is not properly to be regarded as an error and all the more so given that it is accepted by BIN that the Hearing Officer had correctly identified the relevant law for the purposes of the assessment he was required to make under Section 5(4)(a) of the Act.

41. In addition in paragraphs 20 to 22 of the Statement of the Grounds of Appeal the analysis of the assessment of the issue of passing off which it said on behalf of BIN that the Hearing Officer should have done is made by reference to the *actual* commercial activities of BIN/Bytemark Limited. Those activities are identified in the Grounds of Appeal as "*a software app for a very specific purpose, namely the purchase and reservation of tickets for travel, events and entertainment*". In this connection it is to be noted that much of the evidence filed on behalf of BIN is put forward on the basis of the *actual* commercial activities of BIN.

42. In fact as was correctly accepted at the hearing of the Appeal, and as the Hearing Officer correctly stated in paragraph 30 of the Decision below, it is necessary for the relevant assessment for conflict to be made by reference to the manner in which BIN's sign could be used across the specification *applied for*.

43. Moreover, as the Hearing Officer clearly appreciated, it is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade for there to be liability (paragraph 27 of the Decision). Therefore the requirement for any detailed findings, as there would be under section 5(2) of the Act, as to the similarity or otherwise of the goods or services is not necessary before making a finding of conflict under Section 5(4)(a) of the Act.

44. The marks in the present case are identical. Having set out in paragraph 28 of the Decision the specification of the mark applied for the Hearing Officer went on to state that "*there is a clear overlap between the goods and services applied for and those in*

which BCCL has shown its goodwill". The Hearing Officer gave examples in support of his findings of a clear overlap by reference to certain of the goods and services provided by BCCL. It is true that the Hearing Officer did not give detailed findings by reference to the similarity of each of the goods and/or services applied for but as set out above it was not necessary for him to do so.

45. On the basis of those findings the Hearing Officer came to the view that the use of the mark BYTEMARK in respect of the goods and services applied for would result in a misrepresentation leading or likely to lead the public to believe that the goods or services offered by BIN are goods or services of BCCL. In my view this was a finding which the decision taker was entitled to take and I have not been persuaded otherwise.

46. There is no requirement for there to be evidence of actual confusion in support of a claim under Section 5(4)(a) of the Act: c.f. by way of example Neutrogena v. Golden [1996] RPC 473.

47. In the present case evidence of a number of email and telephone enquiries that were received by BCCL meant for BIN were put before the Hearing Officer. They were not limited to the emails referred to by the Hearing Officer in paragraph 30 of his Decision, which it was contended by BIN were simply the result of a typing error in an email address, but also included, for example, an enquiry from a journalist from the Financial Times which was quite clearly not the result of a typing error in an email address.

48. This evidence was not relied upon by the Hearing Officer in making his Decision. As the Hearing Officer made clear he regarded the material as merely strengthening the view that he has already come to and also "*provides evidence of potential damage*".

49. It seems to me that whilst the criticism of BIN's explanation in relation to some of this material might have been differently expressed the Hearing Officer was correct in the approach that he took to this material.

The adequacy of the reasoning

50. The Hearing Officer's decision was structured in the form that is usual in the UK IPO. That is to say a short section on the background, followed by a summary of the relevant evidence filed on behalf of the parties in so far as the Hearing Officer considered it relevant. It has not been suggested on this appeal that the summary is not accurate.

51. In my view whilst the Decision itself is shortly expressed, and could have drafted so as to provide more detail, it is nonetheless sufficient to show the basis upon which the

Hearing Officer acted and therefore for the reasons set out by Lewison LJ in Fage UK Ltd v. Chobani UK Ltd (above) I do not consider that to the extent that this is a separate Ground of Appeal that it is justified.

The finding that no weight should be given to the witness evidence of six of BIN's witness statements

52. For completeness, I turn to the criticism of the Hearing Officer's approach to the evidence of six of the witness statements filed on behalf of BIN. In paragraph 15 of his Decision the Hearing Officer assesses this evidence in the following terms:

> BIN also filed six proforma witness statements where various companies have stated that when they hear the name Bytemark they think of BIN and that they have never heard of BCCL. These are of no assistance to me in reaching my decision as the wording is virtually identical and the individuals are merely providing an opinion.

53. It is not disputed that the witness statements are in identical form. Each contains the following paragraphs:

> 3. Whenever I hear or read the name Bytemark I think only of Bytemark Limited, a business which offers mobile applications for ticketing, payments and stadium solutions.
>
> 4. I have never heard of or had any dealings with Bytemark Computer Consulting Limited and have no knowledge of its hosting services.

What is said on behalf of BIN is that the Hearing Officer was wrong to characterise the statements as statements of "*opinion*" such as to be of no assistance to the decision taker.

54. The issue of the weight to be given to proforma affidavits or witness statements is a familiar one. In Re Christiansen's TM [1885] 3 RPC 54 at 60 Lord Esher MR stated:

> Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names at the bottom.

55. In relation to the stereotyped witness statements in the present case there is no evidence as to any of the circumstances in which the witness statements came to be made including in particular how the witnesses were selected, what they were asked and the context in

which they were asked to provide statements. Nor is the evidence linked to any particular time frame.

56. Whilst it is correct to say that the contents of the witness statement do not give an opinion but rather give factual evidence of the state of knowledge of each individual witness it is difficult to see the value of such evidence in the context of the assessment which the Hearing Officer was required to make.

57. Further, I accept the submission made on behalf of BCCL that the question of weight for the Hearing Officer was moreover unaffected by the lack of cross-examination. As Mr Geoffrey Hobbs QC sitting as the Appointed Person in CLUB SAIL Trade Marks [2010] RPC 32 stated:

> 38. ... it is not obligatory to regard the written evidence of any particular witness as sufficient, in the absence of cross-examination, to establish the fact or matter (s)he was seeking to establish.

See further more generally the observations of Mr Hobbs at paragraphs [37] to [41] of that Decision.

58. In the circumstances, whilst his reasoning could have been otherwise expressed, it seems to me that the Hearing Officer was entitled to take the view that the evidence contained in the witness statements was of no assistance to him in reaching the decision he had to make.

Conclusion

59. In the circumstances, it does not seem to me that BIN has identified any material error of principle in the Hearing Officer's analysis or that the Hearing Officer was plainly wrong. In the result I have decided that the Hearing Officer was entitled to allow Opposition No. 103100 by BCCL to BIN's Trade Mark Application No. 2603479.

60. Given the findings that I have made in relation to the Decision of the Hearing Officer in the Opposition; and given that the finding that BCCL is the senior user is not challenged by BIN it is not necessary for the applications for invalidity to be remitted to the Registry for further consideration.

61. In the result the appeal fails.

62. Neither side has asked for any special order as to costs. Since the appeal has been dismissed, BCCL is entitled to its costs. I order that BIN pay a contribution towards BCCL's costs of £1,500, to be paid within 14 days of the date of this decision, together with the £2, 900 costs awarded by the Hearing Officer below.

Emma Himsworth Q.C.

Appointed Person

30 January 2015

Mr. Jonathan Moss (instructed by Lawrie IP Limited) appeared on behalf of the Appellants, Bytemark Limited and Bytemark, Inc

Mr. Thomas St Quintin (instructed by Groom Wilkes and Wright LLP) appeared on behalf of the Respondent, Bytemark Computer Consulting Limited

The Registrar was not represented at the hearing and took no part in the Appeal