

O-166-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3110773

BY

LYNCARE SYSTEMS LIMITED

TO REGISTER THE TRADE MARK

ASSETTRAK

IN CLASSES 9, 35, 38, 42 AND 45

AND

THE OPPOSITION THERETO

UNDER NO 405567

BY

ASSETWARE LIMITED

BACKGROUND

1. On 15 May 2015, Lyncare Systems Limited (“the applicant”) applied to register the above trade mark for goods and services classified in classes 9, 35, 38, 42 and 45¹ under the Nice Classification system².
2. The application was published on 28 August 2015, following which Assetware Limited (“the opponent”) filed a notice of opposition against the application. The opposition is brought in respect of all of the applicant’s goods and services.
3. The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). The opponent relies upon the following UK Trade Mark (TM) registration in respect of its opposition under sections 5(2)(b) and 5(3) of the Act:

Mark details and relevant dates	Goods relied upon
<p>TM: 2044316</p> <p>Mark: ASSETTRACKER</p> <p>Filed: 7 July 2008</p> <p>Registered: 21 November 2008</p>	<p>Class 9</p> <p>Computer software; computer programs; all for asset management.</p>

4. In its statement of grounds, with regard to section 5(2)(b), the opponent states:

¹ The goods and services are listed in full at paragraph 47 of this decision.

² International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

“3. ASSETTRACKER and ASSETTRAK are virtually identical. Both trademarks are filed in plain capitals. The application for ASSETTRAK differing only by the omission of the silent letter ‘C’ and the letters ‘ER’ which are the last spoken element of the early registration for ASSETTRACKER. Phonetically and audibly ASSETTRACKER and ASSETTRAK are very closely similar, differing only by the addition of the last letters ‘ER’. Visually and conceptually the marks are very highly similar.

4. The goods of the earlier ASSETTRACKER are wholly contained within the specification of the application ASSETTRAK...The services of ASSETTRAK are related to the goods of ASSETTRACKER...

5. Customers are likely to believe that ASSETTRACKER and ASSETTRAK are associated in some way and that the goods/services come from the same entity, or are linked, when no such association exists.”

5. With regard to the opposition under section 5(3) the opponent states:

“8...The earlier ASSETTRACKER mark has a reputation having been used continuously in the UK for the goods of its registration, since at least 1995. Given the long established and exclusive reputation enjoyed under the opponent’s earlier ASSETTRACKER mark, use of the later application ASSETTRAK without due cause would result in serious dilution and erosion of that reputation.”

6. Under section 5(4)(a) of the Act the opponent relies on ASSETTRACKER which it states has been used throughout the UK since 1995 for computer software and computer programs, both for asset management. It states:

“9...The rights to the opponent’s earlier ASSETTRACKER mark were acquired prior to the filing date of the application for ASSETTRAK namely 15.05.15...Use of the Application ASSETTRAK constitutes a misrepresentation and causes confusion with the earlier ASSETTRACKER mark and would also cause damage to the opponent.”

6. The applicant filed a counterstatement on 5 March 2016 in which it denies all of the grounds of opposition and requests that the opponent provide proof of genuine use of its trade mark in respect of the goods for which it is registered.

7. Both sides filed evidence, neither side asked to be heard and both filed written submissions in lieu of attendance at a hearing.

EVIDENCE

The opponent's evidence

Witness statement of Stephen Daniel Moriarty and Exhibits SDM1 – SDM10

8. Mr Moriarty is a Director of the opponent and has held that position since 'before 28 December 1991'. His witness statement is dated 22 June 2016. The salient points from his evidence are as follows:

- The opponent was incorporated on 3 July 1987.³
- The opponent's trade mark ASSETTRACKER has been used in respect of software and computer programs since 'at least as early as 1995'.

9. Exhibits SDM1 and SDM2 are prints from Companies House and UKIPO websites, showing the opponent's company name registration and trade mark. Exhibit SDM3 comprises four prints taken from Wayback Internet archive. The first is dated 12 November 1999 and is taken from www.catsoft.co.uk. Under the heading 'Product Information' the fifth item is titled 'AssetTracker for Windows'. The text underneath reads, "*AssetTracker is the ultimate tool for controlling and monitoring the physical whereabouts of your assets.*"

10. The second page is dated 20 April 2000 and is taken from www.assetware.co.uk. The first heading reads, 'Core Applications' and lists AssetPro® and AssetAuditor.

³ Exhibit SDM1 is a print from Companies House which confirms the date.

Below these is the heading, 'AssetPro® Additional Modules', the fifth of which is 'AssetTracker', described as, "A unique system that allows control and management of a company's asset movements by utilizing handheld and barcode technology."

11. The third page is dated April 2001 and is taken from www.assetware.co.uk. The heading at the top of the page is AssetTracker®. The next two pages outline the key features of the system, the main points of which are as follows:

"AssetTracker will give you ultimate control over your assets. Valuable assets can now be monitored and managed more effectively thus raising the awareness of asset management within the organisation..."

Main Features

AssetTracker is the ultimate tool for controlling and monitoring the whereabouts of your physical assets. Comprising a handheld scanner, barcodes and software, its main features include:

- *ease of use*
- *latest handheld scanner technology*
- *very quick scanning and identification of assets*
- *interaction of scanner LCD display to maximize efficiency*
- *small hand sized scanners which are easily carried and stored*
- *simple menu driven software downloads & uploads data to & from the handheld*
- *wide selection of standard reports*
- *operates on industry standard PCs and Networks...*

How it works

When you purchase AssetTracker, you are buying a complete system to monitor your assets...

Integration

AssetTracker will happily accept data from AssetPro or any other asset database. This includes data from the fixed asset module of most

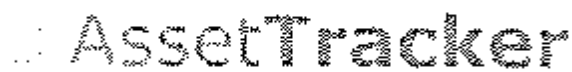
accounting systems, specialist fixed asset packages or even data from spreadsheets. We would however, recommend the use of AssetPro as it has been designed specifically to work with AssetTracker and vice versa.”

12. The next three pages of the exhibit are taken from www.assetware.co.uk and are from 15 April 2002. They contain the same information as the previous pages from April 2001.

13. The last pages of the exhibit are taken from the same assetware website and are dated June 2016. The following text is shown under the heading ‘Asset Tracking Systems’:

“Asset Tracking comes in many forms and here at Assetware we specialize in the tracking of assets that are linked to the company asset register through our range of asset tracking systems...”

14. One of the types of tracking software listed is:

The logo for AssetTracker, featuring the word 'AssetTracker' in a bold, sans-serif font. The 'A' is significantly larger than the other letters. The text is rendered in a dark, slightly pixelated or dithered style.

15. The last page of the exhibit contains the following:

“Our Customers

Our client base covers all areas of business from heavy industry through to office based businesses. Large corporates, government departments and small independents make up our clients and we are proud to work with each and everyone

About Assetware

With over 25 years of helping customers implement solutions that meet the fixed asset needs of their business, our flexible, friendly and consultative approach can help you to save time on your fixed assets...”

16. With regard to turnover, Mr Moriarty states:

“From 2010 to date the value of sales of goods under the ASSETTRACKER Trade Mark out of my company’s UK office is £77,091.69.”

17. Exhibit SDM4 is described as ‘representative invoices to UK clients’. Thirty four invoices have been provided, Twenty six of which refer to the period 22 January 2010 – 15 May 2015 (the relevant date). Three of the invoices relate to the sale of AssetTracker software for amounts ranging from £1250 to £2495. Seventeen of the invoices show sales of AssetTracker licence renewals and AssetTracker licence support with the value of those sales ranging from £410 to £4495.

18. Mr Moriarty describes Exhibit SDM5 as ‘representative invoices from my Company’s UK office to overseas clients’. Eighteen invoices have been provided, 11 of which refer to the period 21 April 2010 – 15 May 2015 (the relevant date). All of the invoices relate to sales of AssetTracker Software licences, AssetTracker licence renewals and AssetTracker licence support with the value of those sales ranging from £410 to £4495.

19. With regard to advertising and marketing Mr Moriarty states that the opponent ‘has not engaged in conventional advertising’, rather, the advertising and marketing revenue has been ‘directed to Search Engine Optimisation services and telemarketing’. Mr Moriarty states that the total amount spent on advertising since the beginning of 2010 amounts to £18,784.70.

20. Exhibit SDM6 is described as representative invoices from The Webmarketing Group, which is a Search Engine Optimisation and Digital Marketing Agency. The invoices relate to the promotion of the opponent’s website www.assetware.co.uk, using the phrase ‘asset tracking software’. The invoices are dated between 3 September 2012 and 3 March 2014. The first four are for £240 per month and £160 per month. The remaining invoices are all for £960 per month.

21. Exhibit SDM7 comprises six invoices from BMG Telemarketing to the opponent dated between 30 August 2012 and 6 November 2012. Each invoice is for four weeks

telemarketing, though it is not clear what form the telemarketing took or what specific goods or services were being marketed.

The applicant's evidence

Witness statement of Niamh Hall and attachments

22. Ms Hall is a trade mark attorney with FR Kelly, the applicant's representative in these proceedings. Her statement is dated 23 August 2015. At paragraph 3 of her statement she says:

"There are attached hereto printouts from the internet archive website Archive.org of various pages from the websites at Assetware.co.uk and assetware-technology.com for the period 2015 to 2003. These pages contain lists of products sold and services provided and none contain the trade mark ASSETTRACKER. Where a trade mark containing the word TRACKER appears, it is the trade mark ASSETWARE TRACKER."

23. And at paragraphs 7 and 8 of the same statement:

"Previous versions of the webpage presented by the Opponent dating from 2016 do not contain the trade mark ASSETTRACKER but rather the trade mark ASSETWARE TRACKER. Subsequent versions of the website presented by the Opponent dating from 2002 which referred to a module of the ASSETPRO product under the name 'ASSETTRACKER' do not contain the trade mark ASSETTRACKER. Despite the detailed descriptions of the Opponent's activities and offerings on its websites, none of the webpages from these websites archived from 2003 to 2015 accessed by me in my research contain the trade mark ASSETTRACKER."

The references to 'Assettracker' in the invoices submitted by the Opponent are not supported by these archived websites. No other supporting evidence has been submitted to indicate the trade marks under which those goods or services were provided. All of the indications on the Opponent's

own websites are that the trade marks which it used during that period did not include ASSETTRACKER but rather ASSETWARE TRACKER.”

The opponent’s evidence in reply

Second witness statement of Stephen Daniel Moriarty and exhibit SDM11

24. The exhibit attached to Mr Moriarty’s second statement is three screen shots taken from Wayback internet archive. Two are dated 3 February 2015 and one is dated 16 December 2014. The following mark is shown at the top of each page.



25. On the first page the mark is shown under a tab headed ‘trademarks’.⁴ On the second page it is shown above the heading ‘Contact’. The email address info@assetware.co.uk and the address for ‘AssetWare Technology Ltd’ are shown on the page. The third page shows the mark above a ‘Home’ tab. The heading is AssetTracker – The Next Generation. Beneath the heading is a small calendar icon with the date September 24th, 2011. Below that are the words: *“Be amongst the first to receive details of the new generation of AssetTracker software, please complete and submit your details on the form below.”*

26. Mr Moriarty states:

“6. ...even if I had not produced the attached screen shots, I have adduced evidence of the use of the Trade Mark on invoices, which formed exhibit SDM4 to my earlier Witness Statement. The invoices show sales associated with ASSETTRACKER in relation to the software, licences, renewal of licences and training and consultancy services thereto...”

⁴ In this example the last ‘R’ of ‘AssetTracker’ has been cut off from the right side of the print.

DECISION

27. This opposition has been brought on a number of grounds. I will deal first with the claim under section 5(4)(a).

The law

28. Section 5(4) of the Act states:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade...

(b) ...

A person thus entitled to prevent the use of a trade mark is referred to in his Act as the proprietor of an “earlier right” in relation to the trade mark.”

29. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

30. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or goodwill which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business."

31. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this

ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

32. Commenting on *South Cone* in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

The relevant date

33. Whether there has been passing off must be judged at a particular point (or points) in time. In the decision of the Court of Appeal in *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220 it was stated:

“165. ...Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury- Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

34. The above related to a community trade mark, however, the same applies to a UK national trade mark.

35. The filing date of the subject trade mark is 15 May 2015. There is no evidence or claim by the applicant that it has used its mark prior to this. Accordingly, the matter need only be assessed as of 15 May 2015.

Goodwill

36. The first hurdle for the applicant is to show that it had the required goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

37. In *Hart v Relentless Records* [2003] FSR 36, Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used ‘but had not acquired any significant reputation’ (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

38. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to

be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

39. See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA).

40. It is clear from the evidence provided by the applicant that since 12 November 1999 the opponent has offered a product for sale under the sign ‘AssetTracker’. Web archive pages from April 2000, 2001 and 2002 describe the ‘AssetTracker’ product in detail. Mr Moriarty states that sales under the sign AssetTracker amount to £77,091.69 from the beginning of 2010 to the date of his witness statement, 22 June 2016. This is supported by 24 invoices to customers in the UK⁵ dated between 22 January 2010 and the relevant date. They show sales of AssetTracker software, AssetTracker Licences, AssetTracker licence renewals, AssetTracker Licence support and AssetTracker training and consultancy. In each case the goods (and services) are described as ‘AssetTracker’ on the invoice. The invoices show sales made throughout the UK, including invoices to businesses in London and the surrounding area, as well as the midlands and parts of Scotland.

41. Advertising is said to be through web and telemarketing and search engine optimisation. Mr Moriarty states that £18,784.70 was spent on such services from 2010 to the date of his witness statement in June 2016. This is supported by invoices which show a regular pattern of payments for such services in respect of AssetTracker.

42. I note that the applicant states that pages from the opponent’s website from 2003 - 2015 (taken from Archive.com) show use of Assetware Tracker by the opponent rather than AssetTracker. It seems to me that there is no reason that both parties’ statements cannot be correct. The fact that some of the opponent’s web pages (dated before the relevant date) do not show AssetTracker does not preclude others from doing so.

43. Taking all of the evidence into account, I find that AssetTracker was distinctive of the opponent’s goodwill at the relevant date, and although fairly modest in terms of

⁵ *Addresses have been redacted but towns and cities are provided.*

volumes of sales (taking into account the size of the software market), was sufficient to be protected under the law of passing off. A fair characterisation of its business is as a provider of asset tracking/management software and the services to support such software. These support services can be best described as Software Licencing, and Training and Consultancy in relation to the software.

44. The sign AssetTracker is used for the most part in plain text in descriptions of the goods (and services) on invoices and product descriptions on the opponent's website. However, there is also some use shown of a stylised font with a figurative element before the word, which I have depicted above. In all cases, the first letter 'A' is shown as a capital letter as is the letter 'T'. Overall, the use shown is such that the words per se are distinctive of the business in which the opponent has goodwill.

Misrepresentation

45. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]?’

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148*. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175* ; and *Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

46. And later in the same judgment:

“... for my part, I think that references, in this context, to ‘more than *de minimis*’ and ‘above a trivial level’ are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

47. I have found the opponent to have goodwill in respect of asset tracking software, related software licences and training and consultancy services in relation to its use. The opponent makes its passing off claim in respect of all of the applicant's goods and services. However, in his first witness statement Mr Moriarty provides a table identifying where there is ‘clear overlap’ between the parties’ goods and services. For ease of reference, I reproduce the applicant's specification in full with the ‘overlapping’ goods and services in bold:

CLASS 9

Software, hardware, communications equipment, GPS systems, RFID (Radio Frequency Identification) systems and NFC (near field communication) **for controlling equipment, for transmitting, receiving, viewing, updating and managing data, inventory management and material handling, storage and retrieval, order preparation, shipping and receiving;**

software, hardware, communications equipment, GPS systems, RFID (Radio Frequency Identification) systems and NFC (near field communication) **for picking and counting of merchandise, asset management and tracking, personal identification, collection and verification, dispatching and scheduling, general data collection, equipment maintenance, repair, GPS driven mapping and direction finding;**

software for enterprise resource planning, customer relations management and supply chain management;

software for use in management of warehouses;

software for inventory, logistics and transport;

radio frequency identification services and equipment including readers, markers and proximity marks for tracking and tracing of goods and for access security, identification, authentication, inventory or physical state control;

computer software and databases for use in particular for tracking objects, authentication, managing inventories, optimizing delivery runs, financial transactions and production processes;

identification and authentication systems;

software for tracking and tracing goods and for automation of business processes;

electronic navigation, tracking and positioning apparatus and instruments;

apparatus and instruments for time-registration;

apparatus and instruments for GPS tracking and GSM tracking;

software for time registration;

software for GPS tracking and GSM tracking;

electronic identification apparatus;

radio frequency identification (RFI D) apparatus and devices;

radio signalling instruments for use in tracking;

computer programs;

computer software;

databases;

publications in electronic format;

GPS systems; tracking equipment in the form of GPS;

software for use in automated monitoring, detection and compliance in the fields of fraud and theft;

software for issuing notifications, for transmitting and displaying alert notifications in data, text, audio or image form, for transmitting and displaying messages or information or for transmitting security alerts to computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment;

software for near field communication;

integrated circuits (ICs);

RFID (Radio Frequency Identification) systems;

integrated Circuits for use in RFID systems;

RFID cards incorporating integrated circuits;

RFID chips and tags;

computer hardware and **software for creating, programming, encoding, scanning, reading and interpreting RFID chips and tags;**

software for use in the fields of locking and protection systems, alarm and monitoring systems, GPS systems, RFID (Radio Frequency Identification) systems, NFC (near field communication) or radio interfaces, data protection, data filtering, data back-up, data recovery, data regulatory compliance and disaster recovery;

NFC (near field communications) apparatus, instruments and equipment; integrated circuits for near field communications applications and mobile telephones and other mobile communications apparatus incorporating near field communications technology;

radio frequency identity verification devices;

Near field communication (NFC) technology-enabled devices;

Near field communication (NFC) technology-enabled readers;

parts, fittings and accessories for all the aforesaid goods.

CLASS 35

Inventory management;

inventory control;

business management and consultation services, namely, the control, management, computerized and manual tracking, and reporting of inventory and goods in transit;

supply chain management services;

systematization, storing/compilation and archiving of data and information in computer data bases accessible on the internet, including data and information relating to the tracking, authentication and managing inventories of goods and brands, **maintenance, rental, updating, design and outsourcing of computer programs and software;**

collection of data;

compilation, creation, management, maintenance and updating of registers and databases of information;

computerised business information retrieval;

customer support services to manage call and contact centre enquiries;

call centre services;

providing data collection, storage and retrieval services;

computerized data verification;

provision of information and advisory and consultancy services, all relating to the aforesaid.

CLASS 38

Telecommunications;

providing access to data and information on the internet, including data and information relating to tracking, authentication and managing inventories of goods;

establishing telemetry connections and remote data processing connections;

communication services by electronic computer terminals;

electronic transmission of messages and data;

providing transmission services to show, display and electronically transmit data, information, images, audio and video recordings on computer hardware, **computer software**, computer systems, Internet resources, mobile devices and telecommunications equipment;

providing data access and delivery services;

notification services and communication services, namely issuing notifications, transmitting and displaying alert notifications in data, text, audio or image form, transmitting and displaying messages or information or transmitting security alerts to computer hardware, **computer software**, computer systems, Internet resources, mobile devices and telecommunications equipment; provision of information and advisory and consultancy services, all relating to the aforesaid.

CLASS 42

Providing temporary use of non-downloadable computer software for tracking and tracing goods and physical assets;

technical and computer services used for transmitting, receiving, viewing, updating and managing data, inventory and material handling, storage and retrieval, shipping and receiving, ordering, picking and counting of merchandise, **asset management**

and tracking, dispatching and scheduling, general data collection, equipment maintenance, GPS-driven mapping and direction finding;

development and maintenance of databases and **development, updating and maintenance of software, especially for object identification, authentication, tracing, protection and tracking, inventory management and delivery run optimization;**

testing services; **designing, implementing and updating software solutions and providing them as a service relating to storage, back-up, anti-fraud, anti-theft and data security;**

providing temporary use of on-line, non downloadable software for use in the fields of remote monitoring, operating, control, maintenance and repair, remotely accessing, testing, operating, controlling and changing the settings and set-up of equipment;

providing temporary use of on-line, non-downloadable software for use in the fields of locking and protection systems, alarm and monitoring systems, GPS systems, RFID (Radio Frequency Identification) systems, NFC (near field communication) or radio interfaces, data protection, data filtering, data back-up, data recovery, data regulatory compliance and disaster recovery;

providing temporary use of on line, non-downloadable software for use in the fields of issuing notifications, transmitting and displaying alert notifications, messages and information, in each case to computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment;

monitoring of computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment;

designing, implementing and updating software solutions and providing them as a service relating to data protection, data storage, data filtering, data back-up, data recovery and data regulatory compliance;

installation, repair and maintenance in relation to software for creating, programming, encoding, scanning, reading and interpreting RFID or NFC chips and tags, integrated circuits for near field communication applications and apparatus incorporating near field communications technology;

provision of security services remotely or via software for the protection of computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment;

electronic storage of data, files, text, documents, photographs, images, video, and audio; electronic storage of data files to store and retrieve data via a global computer network;

maintenance, rental, updating, design and outsourcing of computer programs and software; provision of information and advisory and consultancy services, all relating to the aforesaid.

CLASS 45

Services for the tracking and tracing of goods and physical assets, including electronic tagging of goods and the surveillance and location of such electronic tags;

asset tracking for security purposes;

tracking and tracing of property;

identification marking of property and assets;

services for returning property; **collection of information relating to property and assets for tracing and cost/benefit analysis purposes;**

identity verification; security consultancy;

fraud and theft detection and deterrence services;

fraud and theft protection and prevention;

provision of information and advisory and consultancy services, all relating to the aforesaid.

48. The opponent's goodwill is associated with the sign AssetTracker. The applicant's mark comprises the words ASSETTRAK. The fact that the letter 'c' is 'missing' from the common spelling of the word 'TRACK' in the second half of the application may go unnoticed. However, even where it is noticed, it does not result in a significant degree of stylisation nor does it alter the fact that the relevant public will see the mark as the combination of two known words, ASSET and TRACK. Visually, the marks are fairly highly similar. Aurally, the respective marks break naturally into two parts, ASSET TRACK and ASSET TRACKER. The relevant public will be familiar with the pronunciation of these common words. The only difference between them is the addition of 'ER' at the end of the opponent's sign. They are aurally highly similar. Conceptually, both parties' marks clearly relate to the concept of tracking assets and are, again, highly similar.

49. With regard to the nature of the sign AssetTracker, the applicant comments in its submissions⁶ that a descriptive name is not easy to protect via passing off if the defendant adopts even an apparently minor difference.

⁶ Filed on 6 December 2016

50. I bear in mind the comments of Lord Simonds in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited*⁷, where he stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

51. See also: *McCain International Limited v Country Fair Foods Limited and Another* [1981] R.P.C. 69 (COA).

52. Descriptiveness is a matter of degree. In this case, I find the combination of words used in both marks to be descriptive of the vast majority of goods and services at issue. Notwithstanding that the sign AssetTracker may be inherently weak, I come to the firm view that the use shown by the opponent is such that the words will be seen as designating the commercial origin of the opponent’s software, etc. The mark is distinctive of the opponent.

53. Assuming use of these marks in respect of identical goods and services, I find that even after allowing for a greater degree of discrimination than usual on the part of the public because of the descriptive nature of the marks, a substantial number of the public would have been deceived. This is most likely to be the result of imperfect recollection of the opponent’s mark.

54. In addition, I make the same finding, that a substantial number of the public would have been deceived, where the applicant uses its mark for services which have a close connection with the opponent’s goods and services and also where it is used in respect of hardware where that hardware is of a specialist nature and is used within the same specific field of asset management and asset control. In all of these circumstances the

⁷ [1946] 63 RPC 39

public would be likely to consider the originator of the goods/services to be the same and would be deceived as a result.

55. The opponent has provided the list reproduced above, though I note there is no explanation or supporting information provided to explain why these goods and services are areas of overlap. The applicant has given no indication of where it thinks any dissimilarity may lie, nor has it contested the list provided by the opponent. Consequently, the assessment will be made using my own general knowledge.

56. I am required to consider normal and fair use of the contested application for all of the goods and services for which the application is made.

57. I conclude that the following goods and services are in the same field of commercial activity as the business in which the opponent has established goodwill. For the reasons provided above, use of the applicant's mark in respect of the following goods and services would constitute a misrepresentation:

Class 9

Software, hardware, communications equipment, GPS systems, RFID (Radio Frequency Identification) systems and NFC (near field communication) for controlling equipment, for transmitting, receiving, viewing, updating and managing data, inventory management and material handling, storage and retrieval, order preparation, shipping and receiving.

software, hardware, communications equipment, GPS systems, RFID (Radio Frequency Identification) systems and NFC (near field communication) for picking and counting of merchandise, asset management and tracking, personal identification, collection and verification, dispatching and scheduling, general data collection, equipment maintenance, repair, GPS driven mapping and direction finding; integrated Circuits for use in RFID systems; GPS systems; tracking equipment in the form of GPS; integrated circuits (ICs); apparatus and instruments for GPS tracking and GSM tracking;

software for enterprise resource planning, customer relations management and supply chain management; software for use in management of warehouses; software for inventory, logistics and transport;

radio frequency identification services and equipment including readers, markers and proximity marks for tracking and tracing of goods and for access security, identification, authentication, inventory or physical state control;

computer software and databases for use in particular for tracking objects, authentication, managing inventories, optimizing delivery runs, financial transactions and production processes;

identification and authentication systems;

software for tracking and tracing goods and for automation of business processes; software for GPS tracking and GSM tracking;

electronic navigation, tracking and positioning apparatus and instruments; electronic identification apparatus;

computer programs; computer software; databases;

software for use in automated monitoring, detection and compliance in the fields of fraud and theft;

software for issuing notifications, for transmitting and displaying alert notifications in data, text, audio or image form, for transmitting and displaying messages or information or for transmitting security alerts to computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment;

software for near field communication;

RFID (Radio Frequency Identification) systems; RFID cards incorporating integrated circuits; RFID chips and tags;

computer hardware and software for creating, programming, encoding, scanning, reading and interpreting RFID chips and tags; radio frequency identification (RFID) apparatus and devices; radio signalling instruments for use in tracking;

software for use in the fields of locking and protection systems, alarm and monitoring systems, GPS systems, RFID (Radio Frequency Identification) systems, NFC (near field communication) or radio interfaces, data protection, data filtering, data back-up, data recovery, data regulatory compliance and disaster recovery;

radio frequency identity verification devices;

Near field communication (NFC) technology-enabled devices; Near field communication (NFC) technology-enabled readers; parts, fittings and accessories for all the aforesaid goods.

Class 35

Inventory management; inventory control;

business management and consultation services, namely, the control, management, computerized and manual tracking, and reporting of inventory and goods in transit;

supply chain management services;

systematization, storing/compilation and archiving of data and information in computer data bases accessible on the internet, including data and information relating to the tracking, authentication and managing

inventories of goods and brands, maintenance, rental, updating, design and outsourcing of computer programs and software;

provision of information and advisory and consultancy services, all relating to the aforesaid.

Class 38

Providing access to data and information on the internet, including data and information relating to tracking, authentication and managing inventories of goods.

Class 42

Providing temporary use of non-downloadable computer software for tracking and tracing goods and physical assets.

Technical and computer services used for transmitting, receiving, viewing, updating and managing data, inventory and material handling, storage and retrieval, shipping and receiving, ordering, picking and counting of merchandise, asset management and tracking, dispatching and scheduling, general data collection.

Development and maintenance of databases and development, updating and maintenance of software, especially for object identification, authentication, tracing, protection and tracking, inventory management and delivery run optimization.

Testing services; designing, implementing and updating software solutions and providing them as a service relating to storage, back-up, anti-fraud, anti-theft and data security.

Providing temporary use of on-line, non downloadable software for use in the fields of remote monitoring, operating, control, maintenance and repair, remotely accessing, testing, operating, controlling and changing the settings and set-up of equipment;

Providing temporary use of on-line, non-downloadable software for use in the fields of locking and protection systems, alarm and monitoring systems, GPS systems, RFID (Radio Frequency Identification) systems, NFC (near field communication) or radio interfaces, data protection, data filtering, data back-up, data recovery, data regulatory compliance and disaster recovery.

Providing temporary use of on line, non-downloadable software for use in the fields of issuing notifications, transmitting and displaying alert notifications, messages and information, in each case to computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment.

Monitoring of computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment.

Designing, implementing and updating software solutions and providing them as a service relating to data protection, data storage, data filtering, data back-up, data recovery and data regulatory compliance;

Installation, repair and maintenance in relation to software for creating, programming, encoding, scanning, reading and interpreting RFID or NFC chips and tags, integrated circuits for near field communication applications and apparatus incorporating near field communications technology.

Electronic storage of data, files, text, documents, photographs, images, video, and audio; electronic storage of data files to store and retrieve data via a global computer network.

Maintenance, rental, updating, design and outsourcing of computer programs and software; provision of information and advisory and consultancy services, all relating to the aforesaid.

Class 45

Services for the tracking and tracing of goods and physical assets, including electronic tagging of goods and the surveillance and location of such electronic tags.

Asset tracking for security purposes; tracking and tracing of property; identification marking of property and assets;

collection of information relating to property and assets for tracing and cost/benefit analysis purposes; identity verification.

Provision of information and advisory and consultancy services, all relating to the aforesaid.

Damage

58. Having found that the goodwill and misrepresentation limbs of the test have been satisfied in respect of some of the goods and services, it follows that damage to the opponent's goodwill will arise, most obviously, by diverting trade from the opponent to the applicant.

59. Damage can also be wider than simply a loss of sales. In *Maslyukov v Diageo Distilling Ltd* Arnold J stated:

“85 Secondly, counsel submitted that the hearing officer had wrongly failed to recognise that damage resulting from Diegeo's loss of control over the marks, including erosion of distinctiveness of the marks, was sufficient damage to sustain a passing off action, as shown by the following passage from McAlpine at [20] which the hearing officer himself quoted at para.128 of the decision:

“When it comes to considering damage, the law is not so naïve as to confine the damage to directly provable losses of sales, or ‘direct sale for sale substitution’. The law recognises that damage from wrongful association can be wider than that. Thus in *Ewing v Buttercup Margarine Ltd (1917) 34 R.P.C. 232* Warrington L.J. said:

‘To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of ways. The quality of the goods I sell; the kind of business I do; the credit or otherwise which I might enjoy. All those things may immensely injure the other man, who is assumed wrongly to be associated with me.’

In so saying, he was not limiting the kinds of potential damage to those listed by him. Rather, he was indicating that the subtleties of the effect of passing off extend into effects that are more subtle than merely sales lost to a passing off competitor. In *Associated Newspapers Ltd v Express Newspapers* [2003] F.S.R. 909 at 929 Laddie J. cited this passage, referred to other cases and went on to say:

‘In all these cases [that is to say, the *Clock Ltd* case referred to above and *Harrods v Harroddian School* [1996] R.P.C. 679], direct sale for sale substitution is unlikely or impossible. Nevertheless the damage to the claimant can be substantial and invidious since the defendant's activities may remove from the claimant his ability to control and develop as he wishes the reputation in his mark. Thus, for a long time, the common law has protected a trader from the risk of false association as it has against the risk of more conventional goods for goods confusion.’

The same judge expressed himself more picturesquely, but equally helpfully, in *Irvine v Talksport Ltd* [2002] 1 W.L.R. 2355 at 2366. Having pointed out the more familiar, and easier, case of a defendant selling inferior goods in substitution for the claimant's and the consequential damage, he went on to say:

‘But goodwill will be protected even if there is no immediate damage in the above sense. For example, it has long been recognised that a defendant cannot avoid a finding of passing off by showing that his goods or services are of as good or better quality than the claimant's. In such a case, although the defendant may not damage the goodwill

as such, what he does is damage the value of the goodwill to the claimant because, instead of benefiting from exclusive rights to his property, the latter now finds that someone else is squatting on it. It is for the owner of goodwill to maintain, raise or lower the quality of his reputation or decide who, if anyone, can use it alongside him. The ability to do that is compromised if another can use the reputation or goodwill without his permission and as he likes. Thus Fortnum and Mason is no more entitled to use the name FW Woolworth than FW Woolworth is entitled to use the name Fortnum and Mason ...' 'The law will vindicate the claimant's exclusive right to the reputation or goodwill. It will not allow others so to use goodwill as to reduce, blur or diminish its exclusivity.' (at 2368)

In *Taittinger SA v Allbev Ltd* [1994] 4 All ER 75 at 88, Peter Gibson L.J. acknowledged that:

'Erosion of the distinctiveness of the name champagne in this country is a form of damage to the goodwill of the business of the champagne houses.' The same view was expressed by Sir Thomas Bingham MR at 93."

60. To illustrate the point further, I note that in *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, Mr Recorder Iain Purvis QC stated:

"Damage

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense

recognised in *Sir Robert McAlpine v Alfred McAlpine [2004] RPC 36* at 49 (the 'blurring, diminishing or erosion' of the distinctiveness of the mark)."

61. I therefore find that use of the applicant's mark at the relevant date was liable to be restrained under the law of passing off in respect of the goods and services I have identified above.

The opponent's 5(2)(b) case

62. Section 5(2)(b) is as follows:

"5. - (2) A trade mark shall not be registered if because -

(a)...

(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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

63. Under this ground the opponent relies on its earlier registered trade mark AssetTracker. The mark was registered on 21 November 2008 for 'computer software, computer programmes, all for asset management'. The mark is subject to proof of use in accordance with section 6A of the Act. Invoices referred to above provide evidence of continuing sales of AssetTracker software, turnover figures are also provided and while they are not large in terms of the software market, which I would expect to be substantial, they are large enough to be considered genuine use. Given the nature of the evidence filed by the opponent, bearing in mind that the proof of use period is five years preceding the date of filing of the application, I find that use is shown for the goods which are the subject of the registration. The goods are clearly identical, the opponent's falling within computer software (and computer programmes) in the applicant's specification.

64. I have already concluded that the marks are fairly highly similar visually and are aurally and conceptually highly similar. The average consumer will be a business or professional consumer, paying a higher than average level of attention. The purchase

is primarily a visual one with the first encounter with the mark likely to be made online or from a corporate brochure, though I do not rule out an aural element. The distinctive character of the earlier mark is at the lower end of the scale, which the applicant maintains results in a finding of no likelihood of confusion.

65. In considering that point, I bear in mind the decision in *Formula One Licensing BV v OHIM*,⁸ in which the CJEU found that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

66. And the decision in *L'Oréal SA v OHIM*,⁹ in which the CJEU found that:

⁸ *Case C-196/11P*

⁹ *Case C-235/05 P*

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

67. In short, a registered trade mark must be assumed to have at least some distinctive character and that is one of the factors making up the multifactorial assessment and should not substitute for the necessary consideration of the similarity of the marks in question. Taking all of these competing factors into account, there is a likelihood of confusion between the opponent’s earlier mark and the application.

68. Consequently, the opposition under section 5(2)(b) succeeds in respect of some of the goods and some services related to asset tracking. For reasons explained below I do not propose to list them here.

The opponent’s 5(3) case

69. Section 5(3) of the Act states as follows:

“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...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.”

70. In relying on this ground, the opponent relies on the same mark and evidence as it did in support of its objection under section 5(2) of the Act. In order to get a case off the ground, under section 5(3), the opponent must prove that its earlier mark has a reputation. Reputation in this context means that the earlier trade mark is known by a significant part of the public concerned with the goods covered by that mark (see paragraph 26 of the CJEU’s judgment in *General Motors Corp. V Yplon SA (CHEVY)*)¹⁰

71. At paragraph 27 of the same judgment the Court stated:

“In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking promoting it.” the CJEU’s comments in CHEVY it is known that for a reputation to exist, the relevant marks must be known by a significant part of the public concerned and that particularly important considerations are the market share held by the marks, the intensity, geographical extent and duration of use and the level of promotion undertaken.”

72. Earlier in this decision, in my consideration of the opponent’s goodwill, I concluded that sales were fairly modest. Sales figures for a five and half year period amount to a little over £77k. Marketing spend for the same period is said to be a little below £19k. I have no indication from either side as to the size of the software market, which I would expect to be considerable, or any indication from the opponent as to what share of that market its ASSETTRACKER mark occupies. The level of promotion is modest and I have little evidence regarding intensity of the opponent’s use, or the size of its investment in the mark. In short, the opponent has not shown that the earlier trade

¹⁰ [1999] ETMR 122

mark ASSETTRACKER is known by a significant part of the public concerned with the goods/services covered by that mark.

73. Given that finding it is not possible for the opponent to show the necessary reputation required by *Chevy* and I find that the action under the 5(3) ground fails at the first hurdle.

74. The opposition under section 5(3) of the Act fails.

In summary

75. The opponent has been successful under 5(2)(b) and 5(4)(a) of the Act and has failed under section 5(3). For the reasons provided above, particularly the decision in *Formula One*, the opponent's case under 5(2)(b) would have succeeded to the same extent as its case under 5(4)(a), even if I had reached the conclusion that ASSETTRACKER was too descriptive to found a successful passing off action.

76. In respect of section 5(4)(a) I have identified a range of goods and services which are conflicting. The same list is applicable to my finding under 5(2)(b).

77. Where the applicant has a broad term such as software in its specification I have decided not to offer a fallback position, particularly as it is clear from the material before me that both parties operate in the field of asset management and asset tracking and are unlikely to be interested in goods and services in an unrelated field. In reaching this conclusion I have borne in mind Tribunal Practice Notice 1/2012 which states:

“3.2.2 Defended Proceedings

d) ...Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal.”

78. Consequently, the application may (subject to the outcome of any other proceedings) proceed to registration for the following:

Class 9

Apparatus and instruments for time-registration; software for time registration; publications in electronic format; NFC (near field communications) apparatus, instruments and equipment; integrated circuits for near field communications applications and mobile telephones and other mobile communications apparatus incorporating near field communications technology.

Class 35

Collection of data; customer support services to manage call and contact centre enquiries; call centre services; providing data collection, storage and retrieval services; computerized data verification; compilation, creation, management, maintenance and updating of registers and databases of information; computerised business information retrieval.

Class 38

Telecommunications; establishing telemetry connections and remote data processing connections; communication services by electronic computer terminals; electronic transmission of messages and data; providing transmission services to show, display and electronically transmit data, information, images, audio and video recordings on computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment; providing data access and delivery services; notification services and communication services, namely issuing notifications, transmitting and displaying alert notifications in data, text, audio or image form, transmitting and displaying messages or information or transmitting security alerts to computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment; provision of information and advisory and consultancy services, all relating to the aforesaid.

Class 42

Technical and computer services used for equipment maintenance, GPS-driven mapping and direction finding; provision of security services remotely or via software for the protection of computer hardware, computer software, computer systems, Internet resources, mobile devices and telecommunications equipment.

Class 45

Services for returning property; security consultancy; fraud and theft detection and deterrence services; fraud and theft protection and prevention.

COSTS

79. Both parties have achieved a measure of success. Whilst the opponent has won with regard to goods and services related to asset management, its opposition was filed against all of the applicant's goods and services, with no explanation provided as to why that should be the case. As a consequence, other than recovery of the opponent's official fees, the parties should bear their own costs.

80. I order Lyncare Systems Limited to pay Assetware Limited the sum of £200. This sum is to be paid within fourteen days or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of April 2017

Ms Al Skilton

For the Registrar,

The Comptroller-General