

O-007-19

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 1354634
AND THE REQUEST BY MEZRIN LURII VALERILOVYCH**

TO PROTECT THE TRADE MARK

content guru

IN CLASS 35, 41 & 42

AND IN THE MATTER OF OPPOSITION

THERE TO UNDER NO 410788

BY CONTENT GURU LIMITED

BACKGROUND

1) On 4 January 2017, Mezrin Iurii Valeriiovych (hereinafter the applicant) on the basis of its international registration based upon its registration held in the Ukraine, requested protection in the United Kingdom of the trade mark shown on the front page under the provisions of the Madrid Protocol, with a priority date of 03 November 2016. Protection was sought for the following amended services:

In Class 35: Web indexing for commercial or advertising purposes; market studies; opinion polling; providing business information via a web site; compilation of information into computer databases; compilation of statistics: commercial information and advice for consumers [consumer advice shop]; marketing; marketing research; provision of an on-line marketplace for buyers and sellers of goods and services; writing of publicity texts; scriptwriting for advertising purposes; word processing; updating of advertising material; updating and maintenance of data in computer databases; web site traffic optimization / web site traffic optimisation; rental of advertising space; commercial information agency services; outsourcing services [business assistance]; commercial intermediation services; layout services for advertising purposes; news clipping services; advertising agency services / publicity agency services; search engine optimization for sales promotion/search engine optimisation for sales promotion; presentation of goods of communication media, for retail purposes; publicity material rental; rental of advertising time on communication media; direct mail advertising; publication of publicity texts; advertising / publicity; pay per click advertising; advertising by mail order; on-line advertising on a computer network; dissemination of advertising matter; design of advertising materials; systemization of information into computer databases; sales promotion for others; production of advertising films; negotiation and conclusion of commercial transactions for third parties.

In Class 41: Videotaping; electronic desktop publishing; providing on-line videos, not downloadable; providing on-line electronic publications, not downloadable; providing on-line music, not downloadable; game services provided on-line from a computer network; writing of texts; layout services, other than for advertising purposes; providing amusement arcade

services; club services [entertainment or education]; translation; mobile library services / bookmobile services; news reporters services; recording studio services; photographic reporting; music composition services; on-line publication of electronic books and journals; publication of books; publication of texts, other than publicity texts; entertainment services; production of music; film production, other than advertising films.

In Class 42: Web site design consultancy; software as a service [SaaS]; creating and maintaining web sites for others.

2) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3) On 13 November 2017 Content Guru Limited (the opponent) filed notice of opposition to the conferring of protection on this international registration. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Registration date	Class	Specification
Content Guru	EU 4888723	30.01.09	9	Security apparatus and instruments; telecommunications systems and computer hardware and software for financial transactions, transferring funds, accounting and billing.

b) The opponent claims that the goods are identical and/or similar and that the marks are confusingly similar. The mark therefore offends against Sections 5(1) & 5(2)(a) the Trade Marks Act 1994.

c) The opponent claims that it has reputation in its mark shown above and that the average consumer will form a link between the marks such that the applicant will

benefit from riding on the opponent's coat tails and gaining an unfair advantage. The applicant's mark will also erode the distinctiveness of the opponent's mark. As such the mark offends against section 5(3) of the Act.

d) The opponent claims that it has used its mark since 2005 and has goodwill in the UK in respect of the goods and services set out in annex A. Use of the applicant's mark would erode the distinctiveness of the opponent's mark and cause damage. The mark therefore offends against section 5(4)(a).

4) The applicant subsequently filed a counterstatement denying the opponent's claims and also puts the opponent to proof of use. The applicant also amended its specification deleting the class 9 goods and later amending its other classes.

5) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard but both filed written submissions which I shall take into account as and when necessary.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 9 April 2018, by Paul Martin Haitham Taylor the Deputy Chief Executive Officer and a co-founding director of the opponent company. He states:

"7. CONTENT GURU provides a cloud-based multi-channel communications platform, enabling converged management of all channels and devices through a secure web-based portal. As a cloud-based platform, all core hardware and software already exists in the network and is provided as a service."

And:

"10. Examples of services provided by CONTENT GURU are as follows:

10.1 Instant, automatic alerts in cases of emergency such as flooding, weather warnings, chemical leaks or terrorists threats. These alerts allow a business to contact the people affected by the incident without delay.

10.2 Intelligent IVR call handling for contact centres which improves call efficiency and customer service. Interactive Voice Response (IVR) is a technology that allows a computer to detect voice and dual-tone multi-frequency signalling.

10.3 Automated identification and verification. Examples of these are personalised automated greetings or robust identity checks before connecting through to an agent.

10.4 Automated secure payment processing allowing customers to pay by debit or credit card without giving details to an agent, improving agent productivity while protecting customers against fraud.

10.5 Multi channel mass broadcasting system allowing delivery of key messages through multiple channels.

10.6 Automatic re-routing and redundancy for service continuity and disaster recovery to prevent service interruptions and protect infrastructures.”

7) Mr Taylor states that all of these services are provided via the opponent’s STORM interactive communications platform. He also comments that specialist services enable CONTENT GURU (CG) goods and services to integrate diverse Customer Relationship Management (CRM) databases and link to Computer -Telephone integration (CTI) for comprehensive management and analysis of customer interactions across multiple channels. CTI, he states, is a common name for any technology that allows interactions on a telephone and a computer to be integrated or coordinated. Mr Taylor claims that the opponent has clients for is CG services such as, inter alia, Abercrombie & Fitch; Apple; easyjet; EDF Energy; G4S; National Rail; Paddy Power; Panasonic; Rightmove; Ryanair; Scottish Power; Sky; SSE; O2; Vodaphone; BBC; ITV and S4C. The STORM service sits between CG’s clients and the client’s customers and so the websites and publicity provided in the exhibits attached to the witness statement comment as much about STORM as CG.

8) Mr Taylor states that the CG mark and its product STORM have been widely used in Europe. Many of the customers mentioned above have businesses in Europe and so use for the mark CONTENT GURU for the UK and Europe.

Year	Turnover £ millions	Promotional activity £000
2008	6.5	n/a
2009	4.9	49
2010	3.3	87
2011	4.9	28
2012	5.4	38
2013	7.8	52
2014	9.5	120
2015	11.9	403
2016	16.2	485

9) Mr Taylor provides the following relevant exhibits:

- ST1: details of the exhibition in Switzerland in 2009 when CG unveiled STORM.
- ST2: Extracts from the opponent's website headed up CG which refers to its STORM product and other services offered by CG, all based around telephonic services including charity phone services to handle donations.
- ST3: Examples of use of CG's services by its customers, such as SMS services, hosting, donations and other telephone services.
- ST4: A press release regarding the partnership with Panasonic dated January 2014 where Panasonic used CG's services to offer its customers cloud communications services.
- ST5: A selection of invoices dated between 4 July 2007 – 29 June 2016. These are addressed to businesses throughout the UK and are for telecommunications and computer services and hardware including hosting. The mark CONTENT GURU is prominently used on these invoices.

- ST6: Details of various European exhibitions between 2007 – 2009, in Amsterdam, Prague, France, Hungary and Germany that the company attended and exhibited its services under the CG mark.
- ST7: A selection of invoices dated between June 2009 – October 2016 for services provided to companies in Italy, Germany, Eire, Denmark, France and Malta. All relate to telecommunications services and the mark CONTENT GURU is prominently used on these invoices.
- ST10: Copy of an invoice, dated 6 January 2011, relating to four advertisements in Cloud Computing magazine
- ST13: Copies of press releases sent out by CG between October 2015 and November 2016 all of which mention awards or contracts won by CG in respect of its telecommunications and computer services and hardware.

10) That concludes my summary of the evidence.

DECISION

11) The first ground of opposition is under section 5(4)(a) which reads:

“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, or

(b) [.....]

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

12) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon case* (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

13) Whilst Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely

separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

14) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;

- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

15) The mark in suit was applied for on 4 January 2017, with a priority date of 3 November 2016. The priority date is therefore the material date. However, if the applicant had used its trade mark prior to this then this use must also be taken into account. It could, for example, establish that the applicant is the senior user, or that the status quo should not be disturbed; any of which could mean that the applicant's use would not be liable to be prevented by the law of passing-off – the comments in *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer. There

is no evidence of the applicant using its mark prior to the material date. For the purposes of this ground of opposition **the material date must be 3 November 2016.**

Goodwill

16) The meaning of the term “goodwill” was set out in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL):

“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.”

17) 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 of 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.”

18) However, 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.”

19) Clearly, customers in the UK are required to have goodwill. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 47 of the judgment) that:

“I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.”

And later said, at paragraph 52:

“As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on

abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant.”

20) It is quite clear from the evidence that the opponent has a number of UK based clients for its various telephone goods and services. The applicant partially accepts this as it states in its submissions that the opponent has built up a reputation and goodwill in the mark CONTENT GURU in respect of “security apparatus and instruments; telecommunications systems and computer hardware and software for financial transaction, transferring funds, accounting and billing” all of which they contend are within class 9. The applicant contends that the opponent established a reputation in the fields that the opponent has claimed then it would have sought registration in additional classes to the solitary class 9 registration it currently holds and that it only opposed the applicant's International registration when it was extended to the UK. Of course, one does not require a registration to acquire goodwill and reputation, and if the opponent's business is based, as it would appear to be, in the UK, it would naturally oppose a mark identical to its own if used on goods and services it felt were ones on which it had acquired such goodwill and reputation. The opponent contends that it has goodwill and reputation in all of the goods and services listed at Annex A. However, in its submissions the opponent merely comments that the evidence supplied supports this claim without stating which aspect of the evidence it is relying upon for which good/service. This is not acceptable. It is for the opponent to make its case by reference to its evidence in relation to each good or service which it contends that it has shown use. I believe that the applicant's comments provide a more accurate reflection of the use shown. However, I would add that, in my view, the telecommunications services should not be restricted to financial transactions as they appear to me to cover all telecommunications services. **I therefore find that the opponent has shown it has goodwill and reputation in “security apparatus and instruments; telecommunications systems and computer hardware and software including, but not limited to financial transaction, transferring funds, accounting and billing”.**

Misrepresentation

21) When considering the issue of misrepresentation I take into account the case of *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, where 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.”

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.”

22) Regarding the difference between the test for likelihood of confusion under trade mark law and the test for misrepresentation under the law of passing off; this was commented upon in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ

41, where Kitchin L.J. considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

23) Although this was an infringement case, the principles apply equally under s.5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. It is clear that it is the plaintiff’s customers or potential customers that must be deceived from the comments in *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, where Morritt L.J. stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff’s customers or potential customers had been deceived for there to be a real effect on the plaintiff’s trade or goodwill.”

24) It is accepted that the parties do not need to be engaged in the same field of activity for passing off to occur. In *Harrods Limited v Harroddian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“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 R.P.C. 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 R.P.C. 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

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.'

25) In the instant case the marks of the two parties differ only in that the applicant's mark consists of lowercase letters whilst the opponent's mark has each of the two words beginning with a capital letter. Use of upper and lower case in a trade mark is regarded as fair and normal use and so would not be regarded as a difference. The applicant's mark has a very slight stylisation in the font, but this is negligible. To my mind the marks of the two parties are identical.

26) Given the wide range of computer and telecommunications services that the opponent offers any use of an identical mark upon any services which are similar or which could be considered an extension of the opponent's services will obviously cause misrepresentation. The opponent's submissions on which services would fall into this category were wholly inadequate merely stating that any services using the same mark would offend against s.5(4)(a). The authorities clearly do not accept such a premise. However, I do accept that a number of the services sought to be protected clearly are similar or would represent a natural extension to the opponent's business, equally there are others which I feel obviously do not fall into this category and where a substantial proportion of the public would not be deceived even by use of an identical trade mark. For the most part I believe that the split shown in the table below is self-explanatory.

Common field of activity with the opponent or natural expansion	Non-common field of activity
Class 35: Web indexing for commercial or advertising purposes; providing business information via a web site; compilation of information into computer databases; compilation of statistics: provision of an on-line marketplace for buyers and sellers of goods and services; updating and maintenance of data in computer databases; web site traffic optimization / web site traffic optimisation; search engine optimization for sales promotion/search engine optimisation for sales promotion; presentation of goods of communication media, for retail purposes; rental of advertising time on communication media; pay per click advertising; on-line advertising on a computer network; systemization of information into computer databases; writing	Class 35: market studies; opinion polling; commercial information and advice for consumers [consumer advice shop]; marketing; marketing research; scriptwriting for advertising purposes; word processing; updating of advertising material; rental of advertising space; commercial information agency services; outsourcing services [business assistance]; commercial intermediation services; layout services for advertising purposes; news clipping services; advertising agency services / publicity agency services; publicity material rental; direct mail advertising; advertising / publicity; advertising by mail order; dissemination of advertising matter; design of advertising materials; sales promotion for others; production of advertising films;

of publicity texts; publication of publicity texts;	negotiation and conclusion of commercial transactions for third parties.
In Class 41: electronic desktop publishing; providing on-line videos, not downloadable; providing on-line electronic publications, not downloadable; providing on-line music, not downloadable; game services provided on-line from a computer network; layout services, other than for advertising purposes; on-line publication of electronic books and journals; writing of texts; translation; publication of texts, other than publicity texts;	In Class 41: Videotaping; providing amusement arcade services; club services [entertainment or education]; mobile library services / bookmobile services; news reporters services; recording studio services; photographic reporting; music composition services; publication of books; entertainment services; production of music; film production, other than advertising films.
In Class 42: Web site design consultancy; software as a service [SaaS]; creating and maintaining web sites for others.	

27) As stated earlier, the activities in the left column are ones which I believe would be associated with the opponent given that the marks are identical. However, the services in the right hand column are so far removed from the services for which the opponent has goodwill (security apparatus and instruments; telecommunications systems and computer hardware and software including, but not limited to financial transaction, transferring funds, accounting and billing) that the public will not associate the services with the opponent even to consider if they are associated. For example, the production of music or films, arcade services, opinion polling or advertising services are highly skilled and specialist services and are not areas of activity that one would associate with a company specialising in, broadly speaking, telecommunications and computer systems.

Damage

28) In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

29) In the instant case the applicant has not used its mark in the UK. As such it is a *quia timet* action and it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* 56 RPC 429 Goddard L.J. stated:

“But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man's business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage.”

30) Consequently in the instant case if the opponent has established a goodwill and shown deception then damage can be considered as the automatic sequitur and the three elements of the classic trinity of passing-off will have been established.

31) The classic trinity having been found to exist in respect of some of the services sought to be registered those services will not be allowed onto the Register. The remaining services (see paragraph 26 above) will be permitted to receive protection in the UK.

32) In the light of this finding I decline to go onto the other grounds of opposition as the opponent's position is weaker under section 5(2)(b) and 5(3) and would not achieve any further reduction in the applicant's specification.

Conclusion

33) The applicant's mark can proceed to be protected in the UK for the following services only:

Class 35: market studies; opinion polling; commercial information and advice for consumers [consumer advice shop]; marketing; marketing research; scriptwriting for advertising purposes; word processing; updating of advertising material; rental of advertising space; commercial information agency services; outsourcing services [business assistance]; commercial intermediation services; layout services for advertising purposes; news clipping services; advertising agency services / publicity agency services; publicity material rental; direct mail advertising; advertising / publicity; advertising by mail order; dissemination of advertising matter; design of advertising materials; sales promotion for others; production of advertising films; negotiation and conclusion of commercial transactions for third parties.

In Class 41: Videotaping; providing amusement arcade services; club services [entertainment or education]; mobile library services / bookmobile services; news reporters services; recording studio services; photographic reporting; music composition services; publication of books; entertainment services; production of music; film production, other than advertising films.

COSTS

34) As the opponent was successful it is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side's statement	£300
Preparing evidence	£400
Preparing submissions and considering the other side's submissions	£300
TOTAL	£1200

35) I order Mezrin Iurii Valeriiovych to pay Content Guru Limited the sum of £1,200. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of January 2019

George W Salthouse
For the Registrar,
the Comptroller-General

ANNEX A

Computer hardware and computer software; computer installations, apparatus and instruments; computer systems; computer databases; data carriers; communications and security apparatus and instruments; computer software, firmware and hardware for use with computer networks; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting and retrieving publications, text, signals, software, information, data, code, sounds and images; computer hardware, middleware and software to enable the hosting and management of telecommunications services; telecommunications hosting and management systems; multiple caller processing software and systems; multiple caller management software and systems; customer relations management software and systems; interactive voice response systems; computer hardware, software and telecommunications systems for the provision of unified messaging services, audio conferencing and facsimile transmission; telecommunications systems enabling the management, running and operation of communications applications; computerised telephony systems; telecommunications systems and computer hardware and software for financial transactions, transferring funds, accounting and billing; computer software and telecommunications apparatus to enable connection to databases and the Internet; telecommunications goods; but not including keyboards, keypads, encoders for use with keyboards and keypads, data input and data output devices, visual displays, voice activated data input devices, mountings and kits and enclosures for mounting the aforesaid goods and not including parts and fittings for the aforesaid goods.

Advertising; business management; business administration; office functions; business management assistance; business organization and consultancy; professional business consultancy; business research; compilation of information into computer databases; systemization of information into computer databases; compilation of statistics; computerized file management; marketing research and studies;

organization of exhibitions for commercial or advertising purposes; information, advisory and consultancy services relating to all the aforesaid; all of the aforesaid in relation to telecommunications services.

Financial affairs; monetary affairs; payment processing services; electronic payment services; bank card, credit card, debit card, and electronic payment card services; payment administration services; automatic recording services for financial transactions; information, advisory and consultancy services relating to all the aforesaid.

Telecommunications services; provision of telecommunication links, computer intercommunication, network communication services, computerised data communications; computerised telephony services; provision of telecommunication connections to global computer network; communication by computer terminals; data transmission services; providing telecommunications and communications connections to multiple caller processing software and systems, multiple caller management software and systems and customer relations management software and systems; provision of access to electronic commercial communications systems, electronic contractual systems, electronic contracts, data transmission systems, commercial communications networks; electronic transmission of data; electronic transmission of contractual agreements and other documentation; providing telecommunications and communications connections enabling access to and facilitating electronic commercial transactions; telecommunications services utilising media such as CD-Roms and the Internet, intranet and extranet technologies; transmission and reception of data and of information; telephone, facsimile, telex, message collection and transmission, radio-paging and electronic mail services; on-line information services relating to telecommunications; network services; providing computer access to communication networks; data interchange services; transfer of data by telecommunications; hire, leasing or rental of apparatus, installations or components for use in the provision of telecommunication services; hosting and management of telecommunications services; provision of unified messaging services, audio conferencing and facsimile transmission; provision of access to a communications facility enabling provision and use of communications and applications.

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; consultancy in the field of computer hardware and software; all the aforesaid in the field of telecommunication including cloud-based communication and cloud-based technology services related to telecommunication; installation of computer software; maintenance of computer software; updating of computer software; computer system design; computer system analysis; creating and maintaining web sites for others; hosting web sites; design and development of communication systems; computer network services; design and development of computer networks; data security services; design and development of electronic data security systems; information, advisory and consultancy services relating to all the aforesaid.