

O-757-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS
3272414, 3272429 & 3272417
BY DOME GROUP FINANCIAL ADVISERS LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NOS 412720, 412721 & 412722
BY DOME CONSULTING LIMITED**

Background and pleadings


1. On 22 November 2017, Dome Group Financial Advisers Limited (“the applicant”) applied to register as trade marks **DOME** (“the contested DOME mark”), **DOME Group** (“the “DOME Group” mark”) and the figurative marks shown below (a series of two) (“the contested figurative marks”), under numbers 3272414, 3272417 and 3272429 respectively:



Each of the applications was accepted and published for opposition purposes on 9 March 2018. Following amendments to the specifications, registration is now sought for the following services:

Class 36: Financial services, excluding lending services; investment services; financial asset management services; investment management services; advisory services in relation to all of the aforesaid services.

2. Oppositions were filed on 8 June 2018 by Dome Consulting Limited (“the opponent”). The grounds are based upon ss. 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The oppositions are under all grounds directed against all of the services in the applications. The details of the oppositions under ss. 5(2)(a) and 5(2)(b) for the three applications are shown below:

| Earlier trade mark | Goods/services relied upon under ss. 5(2)(a)/5(2)(b) | Basis of opposition |
|--|--|---|
| <p>UK trade mark number 2635043</p> <p>DOME</p> <p>Filing date 17 September 2012</p> <p>Registration date 28 December 2012</p> <p>Registered in classes 9, 35, 37, 42</p> | <p>All services in classes 35 and 37</p> | <p>UK 3272414: s. 5(2)(a)</p> <p>UK 3272417: s. 5(2)(b)¹</p> <p>UK 3272429: s. 5(2)(b)</p> |
| <p>European Union trade mark registration 13299681</p>  <p>Filing date: 25 September 2014</p> <p>Registration date: 10 April 2015</p> <p>Registered in classes 9, 35, 37, 42</p> | <p>All services in classes 35 and 37</p> | <p>UK 3272414: both ss. 5(2)(a) and 5(2)(b)</p> <p>UK 3272417: s. 5(2)(b)</p> <p>UK 3272429: s. 5(2)(b)</p> |

3. Under ss. 5(2)(a) and 5(2)(b), the opponent claims that the marks are identical or similar and that the services are also identical or similar, which not only will lead to a likelihood of confusion but has already led to confusion.

¹ The ground under s. 5(2)(a) was withdrawn at the hearing.

4. Under s. 5(3), the opponent relies upon both UK2635043 and EU13299681, shown above, for each of its oppositions. In each opposition, it relies upon all of the goods and services for which the marks are registered. It claims that its earlier marks have a reputation such that use of the applications would cause the relevant consumer to believe that there is an economic connection between the parties where there is none. It further claims that use of the applications would allow the applicant to take unfair advantage of an association with the standards, awards and reputation gained by the opponent. The opponent also claims that its reputation as a provider of high-quality software and services would be tarnished by an association with the unproven business of the applicant. There would, the opponent claims, also be dilution of the distinctive character of the earlier marks through the use of the application, resulting in internet traffic being diverted from the opponent and blurring the distinctiveness of the earlier marks.

5. Under s. 5(4)(a), the opponent claims that it has used the sign **DOME** in London and throughout the UK since 1995 in relation to the following goods and services:

Computer software, business advisory and consultancy services (particularly to those in the building and/or construction industries), business administration, office functions, business management, business advisory and consultancy services, business project management, project management; construction project management, computer project management services; computer software design, computer services; information and consultancy services in connection with computers and computer software, renting and leasing of computer software and/or computer programmers, engineering services, architectural services, technical writing for others.

6. The opponent claims that it has goodwill associated with the sign and that the use of the applications constitutes a misrepresentation to the public which will result in damage to the opponent's business, including loss of sales, loss of enquiries, and damage to its

reputation and the capacity of its sign to distinguish its business. The opponent claims that it has already experienced instances of confusion.

7. The applicant filed counterstatements denying the grounds of opposition and putting the opponent to proof of its claims.

8. Given their dates of filing, the opponent's trade marks qualify as earlier marks in accordance with s. 6 of the Act. As EU13299681 had not been registered for five years at the date of publication of the contested applications, it is not subject to the use conditions in s. 6A of the Act. UK2635043, however, had been registered for five years by the contested marks' publication date and is subject to proof of use. The opponent provided a statement of use in respect of all of the goods and services relied upon and it was put to proof of such use by the applicant. The relevant period for demonstrating use of this mark is 10 March 2013 to 9 March 2018.

9. Both parties filed evidence. A hearing took place before me on 16 September 2019, at which the opponent was represented by Jamie Muir Wood of counsel, instructed by JP Mitchell Solicitors and the applicant by Guy Tritton of counsel, instructed by HGF Limited.

Evidence

10. I have read all of the evidence but will summarise it only to the extent I consider necessary. The evidence also contains submissions which I will not summarise but will bear in mind and refer to as appropriate.

Opponent's evidence

11. This consists of two witness statements of Neil Miller. Mr Miller is the managing director of the opponent.

12. Mr Miller’s evidence is that he founded the opponent company in 1995.² Companies House documents dated October 2018 show the nature of business as “development of building projects” and “management of real estate on a fee or contract basis”.³

13. Mr Miller states that the opponent operates “in the fields of commissioning management, O&M, documentation, technical authoring and independent verification, all of which are specialist services provided in relation to construction projects”.⁴ Further, the opponent’s services are “in the building and construction industry [...] in relation to major construction projects, where finance plays a leading role. Those services include the provision of services relating to project budgets and costings [...]”.⁵ He explains that the projects in which the opponent is involved “are typically large-scale, important construction projects involving major UK institutions”, that they are of “very high value”, and he stresses the opponent’s reputation for excellence in services and standards.⁶ He lists clients and contractors which include major companies but does not give dates of any contracts.⁷ Mr Miller asserts that the opponent is neither a construction company nor a project management company.⁸

14. Archive prints of the opponent’s website are provided, dated from December 2004 to September 2017.⁹ From 2004, the opponent describes itself as a commissioning management, certification, validation and electronic documentation consultant, under the introductory “Your building should operate smoothly and effectively to support your business”.¹⁰ By 2014, the services listed are: commissioning management, validation & certification, software solutions for BIM, digital web-based O&M manuals, project collaboration software, defect management software, documentation management, technical authoring, to which are added in 2015 “Health & Safety files” and operational

² Miller 1, §§4-6.

³ Exhibit NDM1.

⁴ Miller 2, §6.

⁵ Miller 1, §36.

⁶ Miller 1, §15.

⁷ Miller 1, §14; Miller 2, §15.

⁸ Miller 2, §10.

⁹ NDM7.

¹⁰ p. 108.

support, including maintenance management, though I note that these are advertised as “tailored individual services”.¹¹ The prints from 2014 describe the “Documentation and Technical Authoring division” which is said to revolve around Dome Connect and which specialises in “the management, collation, writing and delivery of electronic template Operating and Maintenance Manuals, Health & Safety files and Energy log Books, Project Completion Files, BREEAM and LEED certification, Tenant Handbooks, Commissioning data and more”.¹² From 2013 to 2017, the opponent’s “About Dome” information states that it provides “project commissioning management to the construction and property development industry and innovative software solutions to the property, construction, asset and FM global markets”.¹³ There is evidence dated in the relevant period of the opponent’s appointment to provide, in the UK, Dome Connect/iSnag and document management services, and to act as validation engineer, commissioning manager, commissioning validation, O&M manager and technical author, including in 2014 as O&M manager and technical author on the £1.5 billion Elephant and Castle redevelopment, due to complete in 2025.¹⁴ One report from 2014 indicates that the selection of Dome Connect for an office block redevelopment is at least the fourth time that the property company has engaged the opponent.¹⁵ A news post details the opponent’s delivery of construction projects in 2014 in various London locations as well as Leeds.¹⁶ The web prints include details of projects from 2005 to 2009, which include projects with UK locations, such as Livingston, Aberdeen, Manchester and London.¹⁷ “Dome” is visible throughout in word-only form. From 2004, it is also visible as part of a device. EU 13299681 is present on pages from 27 June 2014; the evidence is not particularly clear but it is possible that it is in the EU mark with the word “GROUP” beneath the device, similar to the mark shown at paragraph 17, below.

15. Dome Connect (“used for project collaboration, BIM management, snagging & defect management, commissioning management, O&M Manuals”) and iSnag (“a

¹¹ p. 143.

¹² p. 136.

¹³ See in particular pp. 133 and 178.

¹⁴ For example, pp. 146, 148, 152, 153, 156-158

¹⁵ p. 152.

¹⁶ p. 150.

¹⁷ For example, pp. 112, 123,

powerful mobile snagging & defect management software tool”) appear on the opponent’s website from 2012.¹⁸ Mr Miller provides further information concerning this software.¹⁹ He describes Dome Connect as a project management tool used by end-clients, developers, project managers, construction managers, contractors and buildings managers, among others. It is, he says, “software used to access and manage drawings, operation & maintenance information, specifications, commissioning test data and manufacturer’s literature”.²⁰ The exhibited prints, undated save for the printing date, describe it as both an “Estates & Facilities Management tool” and, during construction, a documentation project management tool, which bridges the gap between the design, construction and occupation of a building. iSnag is described as “used for the management and resolution of defects in construction projects”.²¹ The opponent’s GROUP mark is visible at the top of the first page detailing this software. Evidence is provided of four awards won by the opponent in relation to its iSnag product between 2012 and 2015 and one in relation to its Dome Connect product in 2015.²²

16. Products called Gravity and Gravity CX are announced in 2015.²³ The first is a platform for “project collaboration and documentation management, construction field management, commissioning management, BIM coordination and delivery, 3D model visualisation, asset management/CAFM and of course O&M management”. Gravity CX is a commissioning management platform. Dome Connect Gravity software won an award in 2015 for project collaboration software.²⁴ I note that the various individual software products are, in the relevant period, referred to as “Dome Technology software”.²⁵

¹⁸ p. 133.

¹⁹ Miller 1, §§18-19 and NDM5.

²⁰ Miller 2, §6.

²¹ Miller 2, §6.

²² Miller 1, §20 and NDM6. See also NDM7, pp. 170, 172-173

²³ p. 149.

²⁴ p. 145.

²⁵ See, for example, pp. 149-150, 153.

17. What appears to be promotional material indicates that the opponent has been involved in over 1000 projects since 1995.²⁶ The documents are not dated but year on year growth is shown from 1995 to 2013 (p. 21). Concerning the projects in the UK and the EU, the opponent's role is most frequently described as "Commissioning Management", "O&M Management & Technical Authoring", along with provider of iSnag and Dome Connect. The following mark appears on every page:



18. Prints from the website www.domegroup.co.uk are provided, which show EU13299681 as reproduced at paragraph 17, above, but with "GROUP" instead of "CONSULTING" beneath it ("the opponent's GROUP mark").²⁷ There are projects in the UK and Europe. Most are not dated. However, one in the UK is said to have been ongoing since June 2013 (for commissioning management, O&M documentation, technical authoring, iSnag) (p. 54), and a shopping centre in Leeds is dated 2011-2013 (for commissioning management, O&M documentation, technical authoring, Dome Connect; this may be the same project as noted above) (p. 55).

19. Further details of the opponent's commissioning management and independent verification services are exhibited at NDM4, which show the opponent's GROUP mark as above. The prints show only the printing date of October 2018. Commissioning is described as "the process of ensuring that systems are designed, installed, functionally tested, and capable of being operated and maintained to perform in conformity with the design intent".²⁸ The commissioning process all appears to be in relation to construction projects ("ensuring your buildings work properly"). I note the comment that "Our project team would provide specialist technical expertise providing the roadmap for successful

²⁶ NDM2.

²⁷ NDM3.

²⁸ p. 91. This is reflected in the statement at p. 85 regarding commissioning management and at NDM12, p. 19.

commissioning of all MEP systems [...]” and that the opponent’s independent verification services are said to work with the “software solution” Dome Connect to ensure that building commissioning meets the expectations and standards necessary.

20. Definitions of “verification and validation”, “observations and measurements” (“O&M”) (both from Wikipedia), “technical author” (from Target jobs) and “commissioning management” (from a company called Cleartech) are provided.²⁹ None is dated other than the printing date. I will return to these as necessary later.

21. Turnover is provided for the ten years 2008 to 2018.³⁰ Turnover from 2013 has been at least £7.9 million annually. Mr Miller explains that approximately 78 per cent of the 2017/2018 revenue was work in the UK, of which around 80 per cent was in London, whilst around 7 per cent of revenue was generated in Europe.³¹ This, he says, is representative of the territorial coverage of the business.

22. Marketing spend from 2008 to 2018 is given as follows:³²

| | |
|-----------|----------|
| 2008/2009 | £32,095 |
| 2009/2011 | £999 |
| 2011/2012 | £3,722 |
| 2012/2013 | £48,699 |
| 2013/2014 | £8,426 |
| 2014/2015 | £36,099 |
| 2015/2016 | £45,874 |
| 2016/2017 | £5,804 |
| 2017/2018 | £37,154. |

Most of the marketing budget is spent on marketing/PR and sponsorship, with significant amounts also spent on events.³³ In addition, the company employed a digital

²⁹ NDM12.

³⁰ Miller 1, §8.

³¹ Miller 1, §12.

³² Miller 1, §25.

media manager and a graphic designer to manage the company's social media, other web offerings and promotional material.³⁴

23. Mr Miller lists a number of events and awards at which the earlier marks are said to have been used and promoted.³⁵ There is evidence that the opponent sponsored a charity bike ride in June 2014, though only "iSnag" is visible in the image shown.³⁶ I note that there is a reference to another cycling event in August 2017 (the Ziggurat charity ride), and an image of a cycling jersey bearing the opponent's GROUP mark, said to be dated 2014: Mr Miller states that these are used in connection with charitable rides and events.³⁷ The opponent also sponsored a Porsche racing team in 2014 and a team in the Porsche Carrera Cup GB in May 2015.³⁸ Photographs said to be from that period show the opponent's GROUP mark on racing vehicles and their parts, as well as on clothing and umbrellas for such events.³⁹ There is also reference to the move, in 2017, of a driver to the Porsche Mobil1 Supercup, a Formula 1 World Championship series, along with a photograph of a racing car with the opponent's GROUP mark.⁴⁰

24. Mr Miller gives evidence of four instances of alleged confusion.⁴¹ These are:

- i) A telephone call received on 10 January 2018 from a financial services recruitment agency. The caller wished to speak to the COO of the applicant and had mistakenly called the opponent;
- ii) A letter received on or around 26 January 2018 intended for the applicant but misaddressed;
- iii) An accounting statement mistakenly sent to the opponent on 12 April 2018, relating to courier services provided to the applicant;

³³ Miller 1, §27.

³⁴ Miller 1, §26.

³⁵ Miller 1, §28.

³⁶ p. 155.

³⁷ Miller 1, §28 and NDM9, pp. 187, 207-210.

³⁸ Miller 1, §28.

³⁹ NDM9 pp. 181-186, 197-198, 200-201 and NDM7 pp. 169-172.

⁴⁰ NDM10, pp. 215-216. See also NDM9, p. 199.

⁴¹ Miller 1, §40 and NDM11.

iv) A delivery intended for the applicant but wrongly sent to the opponent's address on or around 4 May 2018.

25. Mr Miller's evidence is also that the applicant tops the Google rankings and has displaced the opponent in the process.⁴² He states that this has had an immediate impact on the traffic experienced by the opponent.

Applicant's evidence

26. This consists of two witness statements of Tolga Akar and the witness statements of Jonathan Thurgood, Mike Carr, Jonathan Dunn, Terence Charles Tatham and Frazer Powell.

Jonathan Thurgood's evidence

27. Mr Thurgood is a Trade Mark Attorney at the applicant's firm of professional representatives.

28. Mr Thurgood provides a list of the top fifty construction contractors to October 2018, taken from www.constructionnews.co.uk.⁴³ He exhibits a report, drawn from building.co.uk, which shows the ranking of project management companies in construction, ordered by number of staff, in 2017 and 2018.⁴⁴ There is also exhibited an undated list of UK registered companies in the construction or real estate field with the word "Dome" in their name.⁴⁵ No further information is given.

⁴² Miller 1, §47.

⁴³ JMT1.

⁴⁴ JMT2.

⁴⁵ JMT3.

29. There are exhibited articles from Wikipedia about corporate finance and construction management, which discuss various aspects of these services.⁴⁶ The only visible dates are the printing date in November 2018.

30. Mr Thurgood also exhibits an article regarding the “5 Stages of Project Management in Construction”, which is dated January 2017.⁴⁷ The article uses the Project Management Institute definition of project management as “the application of knowledge, skills, tools and techniques to a broad range of activities to meet the requirements of a particular project”.

31. There is evidence of other software products containing the word “Dome” which are on the UK market but little detail is given.⁴⁸ There is also evidence concerning a construction company in the US.⁴⁹ Although a Facebook page gives the price range as “££££”, the description states that the company operates in the San Francisco Bay area. It is not clear how this assists.

Tolga Akar’s evidence

32. Mr Akar is the sole Director of the applicant. He describes the formation of the company in 2016 and its intended purpose, as well as its principal areas of business.⁵⁰ Mr Akar also explains that the deals handled by the applicant range from SU\$150m to US\$1bn, and that its fees are between US\$15K and US\$10m.⁵¹ He says that the applicant is not involved in the construction or construction advisory sectors and that it does not develop or offer software of any kind.⁵²

33. Mr Akar says that he chose the name “DOME” because “a dome spans the walls or pillars of a building, much as my own corporate and commercial experience spans the

⁴⁶ JMT6, JMT7.

⁴⁷ JMT9.

⁴⁸ JMT10.

⁴⁹ JMT11

⁵⁰ Akar 1, §§3-4, 7-10.

⁵¹ Akar 1, §§11-12.

⁵² Akar 1, §15.

East (Turkey and the states of the Middle East) and the West”.⁵³ He also states that he had never heard of the opponent before it objected to the applicant’s name.⁵⁴

34. In his second statement, Mr Akar gives evidence that he has never met or spoken to the witnesses whose evidence is detailed below and that they are independent of his company.⁵⁵

Jonathan Dunn’s evidence

35. Mr Dunn is the managing director and principal shareholder of J P Dunn Construction Limited, which was incorporated in February 1999 and is a specialist sub-contractor engaged in groundworks and constructing concrete frames.

36. Mr Dunn gives evidence that his company wins work through competitive tenders but that the ultimate client does sometimes “have a say on whether we are appointed”.⁵⁶ He also gives evidence that, in his experience of the sector, he has never heard of a construction management company having any involvement in the provision of M&A or investment services.⁵⁷

Terence Tatham’s evidence

37. Mr Tatham is a retired Chartered Quantity Surveyor and Chartered Builder, who spent his entire professional life in the construction sector.

38. Mr Tatham gives evidence that typical clients of construction management firms are development companies and the public sector.⁵⁸ He explains that construction management companies are usually engaged where the client wishes to start work on

⁵³ Akar 1, §5.

⁵⁴ Akar 1, §17.

⁵⁵ Akar 2, §2.

⁵⁶ Dunn, §5.

⁵⁷ Dunn, §6.

⁵⁸ Tatham, §4.

site prior to the design being developed or completed, and where the client is not capable of managing the construction process itself.⁵⁹ The construction manager would oversee the construction process, by scheduling and co-ordinating the works (alongside other consultants), including procuring and managing contractors and providing cost estimates and budgets.⁶⁰ Mr Tatham states that he is not aware of any construction company which also provides M&A or investment advice, or is part of such a business.⁶¹

Frazer Powell's evidence

39. Mr Powell is a Construction Director at Knowles & Associates Ltd. His evidence is that the main tasks in construction management are managing the construction process on behalf of a client and ensuring its compliance with requirements.⁶² He too gives evidence that he is not aware of any construction management company that has a mergers & acquisition business or is part of such a business.⁶³

Mike Carr's evidence

40. Mr Carr is a Chartered Mechanical Engineer and MEICA (Mechanical, Electrical Instrumentation, Control and Automation) Project Manager.

41. Mr Carr says that construction management companies “manage and oversee the building or fit-out and commissioning of structures, in whole or in part”.⁶⁴ He gives evidence that a construction management company may have an in-house design team or that it may source such work externally; and he explains that it will be familiar with the appropriate Regulations, exhibited separately, and select suitable contractors.⁶⁵

⁵⁹ Ibid.

⁶⁰ Tatham, §5.

⁶¹ Tatham, §11.

⁶² Powell, §3.

⁶³ Powell, §7.

⁶⁴ Carr, §4.

⁶⁵ Carr, §6; MC1.

42. Mr Carr also states that he is not aware of any construction management company which has or is part of an M&A/investment advisory business.⁶⁶

Proof of use

43. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

⁶⁶ Carr, §12.

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services”.

44. Section 100 of the Act is also relevant, which reads:

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

45. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundesvereinigug Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein*

at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the

evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]”.

46. In *Awareness Limited v Plymouth City Council*, BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of

protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”.

and further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted”.

47. In *Dosenbach-Ochsner AG Schuhe Und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The

evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

48. There is considerable distance between the parties on the issue of genuine use. Mr Muir Wood submitted that the opponent’s evidence shows use across the specification or, if not, at least for “business advisory and consultancy services”.⁶⁷ At the hearing, Mr Tritton said that the applicant’s position is that the evidence is insufficient to establish genuine use. If there is any use, he submitted, it regards the services in class 37, not class 35; in the alternative, he submitted that the specification should be restricted to “commissioning management, O&M, documentation, technical authoring and independent verification”.

⁶⁷ Opponent’s skeleton argument, §33.

49. There is ample evidence of “DOME”, in word-only form, in use on the opponent’s website throughout the relevant period. Further, it is settled law that use of a trade mark includes its independent use and its use as part of a composite mark, provided that it continues to be indicative of the origin of the product (or, as here, services): *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 at [31] to [35]. Accordingly, use of the opponent’s GROUP mark, the same mark with “CONSULTING” instead of “GROUP” and use of EU13299681 all constitute use of UK2635043. I do not agree with Mr Tritton’s submission that “Dome Connect” is a form which would offend against s. 6A(4)(a). He offered no explanation of why use in that form alters the distinctive character of the trade mark. As outlined by Richard Arnold QC (as he then was) in *Nirvana Trade Mark*, BL O/262/06 at [33]-[34], the relevant considerations are how the mark was presented, where the distinctive character of the registered mark lies, what the differences between the presentation and registered mark are, and whether these differences alter the distinctive character of the registered mark. The combination of “Dome” with the word “Connect” does not, in my view, introduce a difference which alters the distinctive character of the word “DOME”, in which the distinctiveness of the registered mark rests: the meaning and distinctiveness of that word remain unaffected by the addition of “Connect”. I do not consider that the differences between the mark as registered and as used alter the distinctive character of the registered mark. The use is also acceptable as part of a composite mark under the principle described in *Collosseum*. For the avoidance of doubt, I also consider that use of “Dome Technology” constitutes use of an acceptable variant, “Technology” being inherently non-distinctive for the goods in relation to which it has been used and having no effect on the distinctive character of the mark.

50. As regards the goods and services in respect of which there has been use, the opponent’s evidence is not well presented. Technical, specialist services are referred to with little or no narrative or additional detail to assist me in determining what these services are or how they tally with the specification relied upon. Mr Miller’s evidence is that his company provides specialist services “in the fields of commissioning management, O&M, documentation, technical authoring and independent verification,

all of which are specialist services provided in relation to construction projects”. However, Mr Miller also denies that the company is either a construction company or a project management company. That is somewhat at odds with the specifications relied upon.

51. The impression I get from the evidence is that the opponent’s core business is commissioning management. It is also tolerably clear that the opponent has in the relevant period been engaged on a variety of projects as O&M manager/documentation, technical author and documentation manager, as well as having provided at least two of its software products to the industry from 2013, namely Dome Connect and iSnag, and having launched a third in 2015, all of which were presented under the “Dome Technology” banner. Precisely what the services entail and how they align with the specification relied upon is a matter to which I will return shortly. For the present, however, I note that commissioning is described as “the process of ensuring that systems are designed, installed, functionally tested, and capable of being operated and maintained to perform in conformity with the design intent”.⁶⁸ Commissioning management appears to be a service which plans, oversees and reports on the design, installation, testing, operation and maintenance capability/requirements of systems integral to a building’s proper function. In the case of the opponent, this appears to include all mechanical, electrical and plumbing systems. I also note that Mr Miller squarely puts his business in the construction industry, as opposed to the technology industry. Other than the evidence of its own software products, there is nothing in the evidence to suggest that the opponent offers computer services to third parties. The evidence does not, in my view, support a conclusion that the opponent’s validation and verification services were anything other than part of the building commissioning services, primarily concerned with mechanical, electrical and plumbing systems.

52. The evidence is that the opponent has had a turnover of over £7.9 million each year since 2013, around 78 per cent of which was in the UK. There is evidence that, despite

⁶⁸ p. 91. This is reflected in the statement at p. 85 regarding commissioning management and at NDM12, p. 19.

the work being concentrated in London, it was not exclusively so. Moreover, the projects in which it has been involved appear to be major construction projects, including the construction of a shopping centre in Leeds. Marketing spend varies considerably but is not, on the whole, insignificant. As pointed out by Mr Tritton, the services relied upon are various and there is no breakdown to assist me. I do not think that this is fatal to the opponent's claim to genuine use. Even though only an indeterminate portion of the turnover will be attributable to the individual goods and services, the overall figure is reasonable and there is consistent use throughout the relevant period, evidence of completed projects, repeat business and marketing efforts. On balance, I am satisfied that there has been genuine use of the mark as set out by Mr Miller, i.e. commissioning management, O&M, documentation, technical authoring and independent verification.

Fair specification

53. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Carr J summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46".

Class 9

54. The evidence shows that "Dome Connect" has a dual function as a facilities management tool and, during construction, as a project management tool. iSnag is a snagging and defect management tool, whilst the Dome Connect Gravity product provides a range of project, documentation and commissioning management options. These all appear to be different categories of software; Dome Connect is clearly posited

as a software application that may be used both before and after the construction phase, potentially throughout the building's functional life. It appears to me that the opponent's software offerings are fairly represented by the term "computer software". There is no use shown in respect of any hardware or equipment.

Commissioning management: class 35 or 37?

55. The WIPO explanatory note to class 35 reads as follows:

"Class 35 includes mainly services rendered by persons or organizations principally with the object of:

1. help in the working or management of a commercial undertaking, or
2. help in the management of the business affairs or commercial functions of an industrial or commercial enterprise,

as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services".⁶⁹

56. The explanatory note for class 37 reads:

"Class 37 includes mainly services rendered by contractors or subcontractors in the construction or making of permanent buildings, as well as services rendered by persons or organizations engaged in the restoration of objects to their original condition or in their preservation without altering their physical or chemical properties".

The same explanatory note indicates that class 37 also includes "services auxiliary to construction services like inspections of construction plans".

⁶⁹Available at:

https://www.wipo.int/classifications/nice/nclpub/en/fr/?explanatory_notes=show&lang=en&menulang=en¬ion=class_headings&version=20190101 [accessed 26 November 2019].

57. Commissioning management does not strike me as principally intended to assist in the workings or management of a business. I see no reason to doubt the (applicant's) evidence that a commissioning management company might be engaged when a client is unable or unwilling to carry out the commissioning function itself but that does not equate to a service proper to class 35: the same could be said of any service which carries out a task the business itself cannot, or does not find it convenient to, effect. On the contrary, commissioning management appears to be closely connected with construction services and indeed, at least on the evidence before me, appears to be a "service auxiliary to construction services". Despite Mr Miller's evidence that the opponent is not a project management company, the commissioning management services it offers appear to fall within "project management", construed broadly: the opponent manages the project, which is the commissioning of a building. That leaves the question of whether the use which has been shown of commissioning management and related services entitles the opponent to rely upon all of the services registered in class 37. I consider that it does. The services are already limited to the building/construction fields; as off-site building project management is not proper to class 37, there is no need to restrict the broader terms "building project management" and "construction project management services" to on-site services. I acknowledge that commissioning management is, as Mr Tritton put it, a known term of art. However, the evidence shows that the term covers oversight, planning and management relating to the installation of various different systems, relating to at least mechanical, electrical and plumbing systems. The opponent may rely upon all of its services in class 37.

Class 35

58. I acknowledge that the opponent provides services to businesses but there is no evidence that the opponent offers advice to companies about their business (for example, strategies on business development, marketing, reputational management). I note that "business advisory and consultancy services relating to building and construction projects" is a term in the earlier specification. The interpretation of specifications was considered by Carr J. in *Pathway IP Sarl v Easygroup Ltd* [2018]

EWHC 3608 (Ch). After considering the judgment of the Court of Appeal in *Altecnic Ltd's Application* [2001] EWCA Civ 1928, the judgments of Arnold J in *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* [2012] EWHC 3440 (Ch), as well as the CJEU's judgment in *IP Translator*, Case C-307/10, EU:C:2012:361, he said that:

“79. I have reached the provisional view, in the light of the respondent's arguments, that it is appropriate to use class number as an aid to interpretation of the specification where the words used in the specification lack clarity and precision. This applies to granted registrations as well as to applications, and therefore applies in the context of infringement actions and revocation claims. My reasons for reaching this conclusion are set out below.

80. Of course, in many cases, it will be unnecessary to use the class number in this way, as the words chosen in the specification will be sufficiently clear and precise. Indeed, in the present case, I consider that the disputed phrase "provision of office facilities" is sufficiently clear and precise, so that its ordinary and natural meaning can be ascertained without reference to the class number.”

It is important to note that:

- (i) the judge's decision was 'provisional' indicating that he did not think that the matter was clear cut;
- (ii) the guidance is to consider the class number only where the meaning of the disputed term is not sufficiently clear and precise;
- (iii) where a term is sufficiently clear and precise on its face, the fact that the term covers goods/services that may also (or should have been) registered in other classes is irrelevant to the scope of protection afforded to the term, or to questions of use of the mark in relation to those goods/services;

(iv) Where the term is not sufficiently clear and precise, the class number may be relied on to construe the scope of protection, i.e. to narrow the meaning of the term to goods/services in the class concerned.

59. Building and construction consultancy services are proper to class 37. That does not preclude a conclusion that the opponent may rely upon “business advisory and consultancy services relating to building and construction projects” if the term is sufficiently clear and precise. However, in my view the term is ambiguous. On the one hand, it may be argued that these are simply construction advisory services. On the other hand, the services may be services which are first and foremost business advice services, advising on the implications of building and construction projects for the business (for example, whether there is a business need to expand premises or whether there are other options for the business to achieve the same end), rather than on the niceties of the building and construction projects themselves. In those circumstances, it is appropriate to take the class number into account. I consider that “business advisory and consultancy services relating to building and construction projects” are business services rather than construction services. The opponent not having shown that it provides business consultancy/advisory services, it may not rely upon the term.

60. There is evidence that the opponent offered and was appointed to act as “O&M Manager” in the relevant period. Had there been no other evidence on the point, I would have assumed that this was a reference to operations and maintenance, consistent with references in the evidence to, for example, operation support (p.133), “resolving building operational problems, along with maintenance [...] management” (p. 136), “operation and maintenance of facilities [...] maintenance management” (p. 143) or “Operating and Maintenance manuals” (p. 136). This would align with the other services offered by the opponent, which appear to be concerned with appointing buildings for use. However, Mr Miller has provided a definition of “O&M” as “observations and measurements”.⁷⁰ The term is said to be “an international standard which defines a

⁷⁰ See Miller 1, §16 and NDM12.

conceptual schema encoding for observations, and for features involved in sampling when making observations” and “one of the core standards in the OGC Sensor Web Enablement suite, providing the response model for Sensor Observation Service”. Observations “result in the estimation of the value of a feature property and [involve] application of a specified procedure, such as a sensor, instrument, algorithm or process chain”. There is no other attempt to explain what these services are. It seems to me that this term, as defined in Mr Miller’s evidence, would form part of the opponent’s verification services or be part of its software’s function. As all of the appointments mentioned in the evidence are of the opponent as “O&M manager”, there is, consequently, no evidence that the opponent was appointed to act in an operational maintenance capacity (save in relation to technical authoring of operations & maintenance manuals), although such services appear to have been available. In the absence of any breakdown of turnover or other evidence to show that the use in relation to these services was warranted in the sector, I find that there is no genuine use in respect of wider operational and maintenance services, specifically those which would be found in class 35.

61. The specification contains “business administration” and there is some evidence that the opponent has provided “documentation management”. It appears that this is principally in connection with its Dome Connect software but there is an indication that the opponent manages and collates, as well as writes, various electronic documents, which is a service provided in tandem with its software.⁷¹ I am prepared to accept that the opponent has provided document management services. On the same basis, I am prepared to accept that the opponent has also provided “compilation of information and analysis for input into computers and databases”. It seems to me that these are distinct categories and fair ways of describing the opponent’s services.

62. I do not consider that the evidence is sufficient to show that the opponent has offered any of the other services in class 35.

⁷¹ p. 136.

Class 42

63. I have indicated above that the opponent has shown use in relation to technical authoring. This is equivalent to “technical writing for others” in the registered specification.

64. I have also indicated above that the opponent provides verification services in respect of its core commissioning offering. It does not have testing services registered separately. However, it does have “engineering services”. That is a broad term which would encompass all of the subsets of engineering services and which would also reasonably include quality/function/safety testing. Given that engineering services is very wide, I have considered whether the opponent should be permitted to rely on the term at large. It would appear that its services are not confined to one field of engineering, such as electrical engineering, but span various disciplines. However, the evidence also only goes to verification and validation services. I consider that the average consumer would describe the opponent’s services as engineering testing services.

65. There is little evidence on the specific issue of whether the opponent’s commissioning services include off-site work. I note, however, that there are occasions where the opponent is shown to have been appointed as commissioning manager and Dome Connect has been chosen as the commissioning tool.⁷² It is a logical inference that the use of a software tool which specifically allows remote management of the commissioning process by the commissioning manager is likely to involve some off-site management. I am prepared to accept that there has been use in respect of “off site building project management”.

66. I am not prepared to accept, on the rather woolly evidence before me, that there has been use in respect of the other services in class 42. Although the opponent clearly has a technical arm, the evidence is insufficient for me to conclude that these services have

⁷² For example, p. 157.

been offered to third parties. As regards Dome Connect, though it is plainly successful it appears to have been offered as a software product, not as a service.

67. The opponent may therefore rely upon the following goods and services:

Class 9: Computer software.

Class 35: Document management services; compilation of information and analysis for input into computers and databases.

Class 37: Building project management; construction project management services; on site building project management; on site project management relating to the construction of buildings.

Class 42: Off site building project management; Engineering testing services; Technical writing for others.

Sections 5(2)(a) and 5(2)(b)

68. The relevant sections of the Act read as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

69. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

70. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

71. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

72. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

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

73. In *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Sanco SA v OHIM*, Case T-249/11, the General Court (“GC”) indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2009:428, the GC stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

74. I also bear in mind the comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13, where he warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I

therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

75. Only classes 35 and 37 are relied upon under ss. 5(2)(a) and (b). The services to be compared are:

| Earlier specifications | Contested specification |
|--|--|
| <p><u>EU13299681</u></p> <p>Class 9: Computer software; project management software; facilities management software; computer software and telecommunication apparatus (including modems, CD-ROMs, CD disks and DVD disks); apparatus and equipment for on-line connection from and to computer databases and the Internet.</p> <p>Class 35: Business advisory and consultancy services to those in the building and/or construction industries; business administration to those in the building and/or construction industries; office functions to those in the building and/or construction industries; business management assistance provided to those in the construction industry; business advisory and consultancy services relating to building and construction projects; business project management to those in the building</p> | <p>Class 36: Financial services, excluding lending services; investment services; financial asset management services; investment management services; advisory services in relation to all of the aforesaid services.</p> |

and/or construction industries;
compilation of information and analysis
for input into computers and databases to
those in the building and/or construction
industries.

Class 37: Building project management;
construction project management
services; on site building project
management; on site project
management relating to the construction
of buildings.

Class 42: Computer project management
services; off site building project
management; project management
[design]; project management [technical
support]; computer software design;
computer services; information and
consultancy services in connection with
computers, computer software and
information contained therein; renting and
leasing of computer software and/or
computer programmes; engineering
services; architectural services; technical
writing for others.

UK2635043

Class 9: Computer software.

Class 35: Document management

| | |
|--|--|
| <p>services; compilation of information and analysis for input into computers and databases.</p> <p>Class 37: Building project management; construction project management services; on site building project management; on site project management relating to the construction of buildings.</p> <p>Class 42: Off site building project management; Engineering testing services; Technical writing for others.</p> | |
|--|--|

76. Mr Muir Wood submitted at the hearing that the opponent’s best case is with “business advisory and consultancy services”. I have found that there has been no genuine use in respect of these services under UK2635043. However, as it seems to me that the strongest case for the opponent is in respect of its EU mark’s class 35 services, that is where I will begin.

77. All of the applicant’s services provide the consumer with advice regarding and/or the means of managing money. That would include, for example, advice about particular financial products, comparisons between different providers of such products and planning investments to maximise one’s returns. The earlier “business advisory and consultancy services to those in the building and/or construction industries; business management assistance provided to those in the construction industry” are both wide enough to include, for example, advice regarding the efficient allocation of financial or human resources, how to increase market share or cost price analysis. The business advice may include certain financial aspects, such as tax advice, the level of investment that will be required to enter a new market or reports on the business’s assets/financial

health. That said, business consultancy services are unlikely to provide advice on specific financial products or investments, which would be provided by financial institutions. I do not consider that there is a competitive relationship: although there may be financial aspects to the class 35 services, they are not alternatives to one another. There may be a degree of complementarity, though I do not consider it particularly pronounced.⁷³ The applicant's evidence of separate fields is not relevant as it does not relate to the services under consideration. These services are similar but only to a low degree.

78. Despite having carried out the assessment in respect of business services provided to those in the building or construction industries, it does not seem to me that there is anything particular about these services which would, by dint of their recipients, make them materially different from the broader business services identified by Mr Muir Wood as the opponent's best case. It would appear, therefore, that none of the other goods or services is likely to offer a better case for the opponent. I can see no reason why that would be so; indeed, I can see no similarity: the nature, purpose and channels of trade of the respective goods and services are different, users coincide only at a superficial level and there is neither competition nor complementarity. It follows that the oppositions under ss. 5(2)(a) and (b), insofar as they are based on UK2635043, are dismissed.

The average consumer and the nature of the purchasing act

79. The parties are agreed that the average consumer for the services at issue is a professional or corporate buyer and will pay a high degree of attention when sourcing the services.⁷⁴ I proceed on that basis.

⁷³ I note that in Case T-301/09, EU:T:2012:473 the GC upheld a finding of a low degree of similarity between 'management consultancy services' and 'consultancy services relating to business operations' on the one hand and financial services on the other, particularly investment management services, finding at [56] "a certain connection, or even a degree of complementarity".

⁷⁴ Opponent's skeleton, §37, applicant's skeleton §§22-24.

Distinctive character of the earlier trade mark

80. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public: *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)”.

81. The relevant services are the opponent’s business advisory/consultancy and management assistance services in class 35. As UK2635043 cannot be relied upon in respect of these services, only EU13299681 is relevant. However, my comments regarding the services provided by the opponent and their respective classification are

equally applicable to the EU mark: there has been no use shown of the mark in relation to the relevant services in class 35 and there is, therefore, only the inherent position to consider.

82. The word “dome” has no clear connection with the services at issue. Equally, it is an ordinary English word. The device is not particularly striking. Overall, the mark is inherently distinctive to a medium degree.

Comparison of trade marks

83. The CJEU held in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, that:



“54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer”.

84. The applicant denies that the trade marks are identical. I agree. The device element above the word “dome” in the earlier EU13299681 is not, in my view, so insignificant that it would go unnoticed by an average consumer. The opposition against UK3272414 under this ground is dismissed.

85. I turn, then, to the comparison for the purposes of s. 5(2)(b). The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

86. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

| Earlier mark | Contested marks |
|---|--|
|  | <p>(i) DOME</p> <p>(ii) DOME Group</p>  <p>(iii)</p> |

87. The earlier mark consists of the word “dome” presented in lower case in a slightly stylised typeface, in white on a black background. Spanning the letters “om” is a curved green line. Whilst the device and stylisation make some contribution, the most dominant element of the mark is the word “dome”.

(i) DOME application

88. The overall impression of this mark is contained in the single word “DOME” of which the mark consists.

89. There is a plain visual similarity with the earlier mark because of the shared word “dome”/“DOME”, though there are also differences because of the particular presentation of the earlier mark. The marks are visually similar to a high degree. As the device and stylisation of the earlier mark will not be verbalised, the marks are aurally identical. The notion of a dome, which is a common architectural feature and is likely to be known to the public, is shared between the marks. The device in the earlier mark, if it makes any conceptual contribution, merely reinforces the word element. The marks are conceptually identical.

(ii) DOME Group

90. The mark consists of the word “DOME”, presented in capital letters, with the word “Group”. Given its position and the weaker distinctive character of the word “Group”, which is likely to be taken as identifying a group of companies, the word “DOME” is more dominant.

91. In addition to the visual similarities and differences identified at paragraph 89, above, there is an additional difference because of the word “Group” in the contested mark. These marks are visually similar to a fairly high degree. The word “Dome” will be articulated in both marks, with the addition of the word “Group” in the contested mark, which I consider will be verbalised. They are aurally similar to a medium degree. The concept of a dome is shared by each but “Group” introduces an additional concept. The marks are conceptually similar to a fairly high degree.



92. The different colouring of these marks makes no material difference, as the black-and-white mark may be used in any colour. I will, for convenience, treat them as one. There is a significant device element, of a dome in outline, presented above the word “DOME”, in capital letters. Given their relative size and positioning, the contribution made by these elements to the overall impression is roughly equal.

93. The earlier and contested marks both include the word “dome”/“DOME”. There are device elements in both. Although both could be said to indicate a dome, the device in the later mark is a fairly detailed line drawing of a dome compared with the device in the earlier mark, which is merely a curved green line. These marks have a medium degree of visual similarity. Aurally, neither device will be articulated and both marks will be verbalised identically as “Dome”. As the devices reinforce the word dome in each mark, that is the conceptual meaning both will carry: the marks are conceptually identical.

Likelihood of confusion

94. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion involves the consumer

recognising that the marks are different but nevertheless concluding that the later mark is another brand of the earlier mark owner: *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 at [16].

95. I will consider first the position for the contested word mark. The marks are visually similar to a high degree and both aurally and conceptually identical. Those are factors which point strongly towards confusion. Set against that, however, is that the services are similar only to a low degree. Further, these services will be selected with a high level of attention. I also bear in mind that, for the similar services, the earlier mark has a medium level of distinctiveness. However, despite the low degree of similarity between the services, they are not so remote that the consumer will not think that the undertakings are economically connected. On the contrary, my view is that, when confronted with the later mark, the consumer is likely to think that these are variant marks used by the same or an economically connected undertaking. There is a likelihood of indirect confusion.

96. Turning to the “DOME Group” mark, my view is also that there would be a likelihood of indirect confusion. There is less visual and aural similarity between the marks overall and a degree of conceptual difference. However, the indication in the later mark that there is a group of companies operating under the “Dome” mark does not offer a sufficient point of differentiation: it is itself suggestive of other entities potentially trading under the same dominant element. The limited similarity between the services and the medium distinctive character of the earlier mark are inadequate to compensate in the applicant’s favour for the similarities between the marks.

97. In respect of the contested figurative marks, there is plainly a lesser degree of visual similarity. However, the marks are aurally identical and any conceptual meaning in the device elements simply reinforces the same conceptual message. Again, my view is that despite the limited similarity between the services there is a likelihood that the consumer, even one paying a high degree of attention, will think that the services are offered by related economic undertakings. There is a likelihood of indirect confusion.

Section 5(3)

98. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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”.

99. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Saloman*, [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L’Oreal v Bellure* [2009] ETMR 55; and Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

100. In *General Motors*, the CJEU considered the assessment of reputation as follows:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

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

27. 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 in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade

mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it”.

101. As one of the earlier marks is an EUTM, I also keep in mind the guidance of the CJEU in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, EU:C:2009:611, at [20] to [30] and *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at [69].

102. The applicant’s position is that any reputation enjoyed by the opponent is, at best, limited and certainly not EU-wide. Mr Muir Wood submitted that the opponent’s use in a niche area is sufficient for a qualifying reputation under this ground.

103. I have given my views, above, on the use which has been made of the earlier UK mark. As there is no evidence that the EU mark has been used on services different from the UK mark, it cannot improve the position for the opponent. I will therefore begin with the position under UK2635043.

104. The evidence shows that the opponent is involved in large-scale projects and that its annual turnover is almost £8 million. There is evidence of marketing expenditure, though there is little beyond sponsorship information to demonstrate the scale or scope of the dissemination of such advertising. There is also some information regarding industry awards which the opponent has won for its specialist software.

105. The applicant is right that most of the opponent’s has been conducted in London; the opponent admits as much. The applicant is also right to point out that there is no breakdown of the turnover for the various services upon which reliance is placed. That is a failing. Although, given the services provided by the opponent, I do not accept the applicant’s contention that the relevant market is the construction sector as a whole, I have no evidence of the size of the niche market in which the opponent operates. Whilst the turnover is not insignificant, I would point out that it is not in any way broken down, that much of the evidence is not dated within the relevant period and that, whilst there

are claims to the opponent's renown, all of these claims bar the evidence of awards come from the opponent itself, thus reducing the evidential weight of such statements. It seems likely, taking into account in particular the size of the projects in which the opponent has been involved and the awards it has won, that the opponent had at the relevant date a moderate reputation in software and the niche sphere of commissioning management, specifically the goods and services in classes 9, 35, 37 and 42 identified at paragraph 67, above.

106. The question of whether a link will be established was considered in *Intel*, the factors being outlined at paragraph 99(d), above. I have already given my views on the strength of the opponent's reputation. The earlier mark is inherently distinctive to an average degree. It is likely to benefit from enhanced distinctiveness but the evidence only supports a modest uplift: it has an above average level of distinctive character.

107. The applicant accepts that its UK 3272414 ("DOME") is identical to UK2635043.

108. As far as the "DOME Group" mark is concerned, my analysis of the overall impression at paragraph 90, above, applies equally here. The marks share the word "DOME" and differ because of the word "Group". There is a fairly high degree of visual similarity and a medium degree of aural similarity. The concept of a dome is shared by each but "Group" introduces an additional concept of a group of related undertakings. The marks are conceptually similar to a fairly high degree.

109. Turning to the contested figurative marks, there is a significant device element which introduces a visual difference but both marks share the same word "DOME". They are visually similar to a medium degree. Aurally and conceptually, they are identical.

110. I can see no similarity between the contested goods and services and the goods and services in which a reputation has been established. Their only point of potential overlap is in users, which is at too high a level of generality for there to be similarity on

that basis alone. I acknowledge that finance will be required for construction projects. I also note that Mr Miller states that his company provide services relating to project budgets and costings.⁷⁵ There is no documentary evidence going to the opponent's provision of such services. Although the services in class 37 will have monetary implications, I do not think that building or construction project management services, whose core purpose is to manage works and contractors, have any similarity in nature or purpose with financial services: advising on the price of items/work is a long way from providing financial advice per se; if it were not, any tradesman offering a quotation could be said to be offering connected financial services. These services are unlikely to be offered by the same companies, they are not in competition nor are they complementary: financial advice/having funds in place may be important to ensure that the project can go ahead but it is not important for the provision of the services in class 37.

111. None of the other goods or services in the opponent's mark offers it a stronger case: they do not coincide in any of the factors identified in the case law, save for users, which on its own is insufficient to engage overall similarity.

112. I do not consider that there would be any confusion: the distance between the goods and services is too great, and the reputation and distinctiveness of the earlier mark insufficiently strong, to give rise to confusion. I have not overlooked the purported evidence of actual confusion filed by the opponent. It does not, however, show that there has been any confusion in the course of trade, let alone that those who misaddressed post or telephoned the wrong company were paying the high degree of attention conceded.

113. Taking all of the above factors into account, my conclusion is that no link would be made even in respect of the contested "DOME" mark. The at best moderate reputation of the earlier mark is insufficient, despite its slightly enhanced distinctiveness and despite the identity between the marks, to bridge the gap between the respective goods

⁷⁵ Miller 1, §36.

and services. A link is even less likely where there is a lesser degree of similarity between the marks.

114. The evidence does not show that either the use or the reputation of the EU mark is any stronger than in respect of the UK mark. The same considerations apply to the (dis)similarities between the goods and services. Even allowing for a similar enhancement in the mark's distinctive character, the claim under s. 5(3) would fail for the same reasons as given above, compounded by the greater differences between the marks at issue.

115. The claim under s. 5(3) is dismissed accordingly.

Section 5(4)(a)

116. Section 5(4)(a) states:

“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”.

117. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a Deputy Judge of the High Court stated that:

“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)”.

118. Although Mr Akar indicates that the applicant has been trading, he has provided no details of any such use in his evidence. That being the case, the relevant date is the date of application, namely 22 November 2017.⁷⁶

Goodwill

119. The House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“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”.

120. I am, for the reasons given above, satisfied that the opponent had goodwill at the relevant date in a business offering computer software, document management

⁷⁶ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11 at [43].

services and compilation of information and analysis for input into computers and databases (insofar as they fall within the “office functions” relied upon), building project management, construction project management services, on site building project management, on site project management relating to the construction of buildings, off site building project management, engineering testing services and technical writing for others. The sign “DOME” was distinctive of that business at the relevant date.

Misrepresentation

121. 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]”.

123. It is trite law that there is no requirement for a common “field of activity” for an action in passing off to lie: *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. at p. 714. It is clear from the same case, however, that whilst the absence of a common field of activity is not fatal, it remains a relevant factor, though it may be less important where the claimant’s sign is a household name. Millett L.J. went on to say:

“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.’”.

124. I have found, above, that there is no similarity between the contested goods and service and those in respect of which the opponent has a protectable goodwill. Although it is not fatal to the claim that the fields of activity are different, my view is that this will, when considered with the high level of attention with which these goods and services will be selected, counteract the similarity between the sign and the marks. I do not consider that use of the marks would at the date of application have constituted a misrepresentation to the relevant public. The passing off claim fails accordingly.

Conclusion

125. The oppositions under s. 5(2)(b) have been successful, though they have failed under both s. 5(3) and s. 5(4)(a). The applications will be refused.

Costs

126. The opponent has been successful and is entitled to an award of costs, which are sought on the scale (Tribunal Practice Notice (2/2016) refers). I award costs to the applicant as follows:

| | |
|--|--------|
| Official fees (£200 x 3): | £600 |
| Filing the notice of opposition and considering the counterstatements: | £600 |
| Filing evidence and considering the other party's evidence | £700 |
| Preparing for and attending a hearing: | £800 |
| Total: | £2,700 |

127. I order Dome Group Financial Advisers Limited to pay Dome Consulting Limited the sum of **£2,700**. This sum is to be paid within twenty-one days of the expiry of the

appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of December 2019

Heather Harrison

For the Registrar

The Comptroller-General