

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 220808 and in the matter of an Opposition thereto.

IDOM CONSULTING LIMITED Applicant

IDOM S.A. Opponent

The application

1. On 23 March, 2000, IDOM CONSULTING LIMITED, a British company of Royal London House, 22-25 Finsbury Square, London EC2A 1DS, United Kingdom made application (No. 2000/01026) to register the mark shown below as a Trade Mark in respect of a specification of services that was amended in the course of the examination of the application to read as indicated:



Class 35:

Business management services; project consulting services and advisory and consultancy services relating thereto; provision of management information and business data by means of computer and other electronic means.

Class 37:

Installation, maintenance and support services relating to computers; advisory and consultancy services relating to the aforesaid services.

Class 42:

Installation, maintenance and support services relating to computer software.

2. The application was accepted for registration and advertised accordingly under No. 220808 in Journal No. 1933 on 9 January, 2002.

3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 28 February, 2002 by IDOM S.A. of Avda. Lehendakari Agirre 3, 48014 Bilbao, Spain. The Applicant filed a counter-statement on 17 June, 2002 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996. Following the completion of the filing of evidence, the parties were invited to state whether they wished to be heard in the matter and both indicated that they did not and that the Controller should decide the opposition on the basis of the evidence filed.
4. Acting for the Controller, I decided the opposition on 30 August, 2005. The parties were notified on that date that I had decided to uphold the opposition and to refuse registration insofar as the services in Class 35 were concerned but to dismiss the opposition and to allow the mark to proceed to registration in respect of the services in Classes 37 and 42. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of Opposition

5. In its Notice of Opposition the Opponent enumerates a number of facts and grounds of opposition, which may be summarised as follows:
 - (i) The Opponent has for many years carried on business as a provider of, *inter alia*, business, construction and engineering services.
 - (ii) The Opponent is the proprietor of the trade mark shown below, which it has applied to register as a Community Trade Mark in Classes 35, 37 and 42 (CTMA No. 847236 dated 10 June, 1998).



- (iii) The Opponent has used this trade mark in connection with the services mentioned in sub-paragraph (i) and the trade mark denotes, and has long denoted, both to the trade and to the public services rendered by the Opponent and distinguishes those services from the like services of other undertakings.

- (iv) The mark that the Applicant seeks to register offends against the provisions of Sections 6, 8, 10 and 37 of the Act.
- (v) It is identical with the Opponent's earlier mark and the services for which registration is sought are identical with those for which the Opponent's mark is protected.
- (vi) It is identical with or similar to the Opponent's earlier mark and the services for which registration is sought are identical with or similar to those for which the Opponent's mark is protected to the extent that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association.
- (vii) It is identical with or similar to the Opponent's earlier mark and, even if the services for which registration is sought are not similar to those for which the Opponent's mark is protected, registration should be refused to the extent that the Opponent's mark has a reputation in the State and the use of the mark applied for without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark.
- (viii) The application for registration was made in bad faith by the Applicant.
- (ix) The mark is not used or proposed to be used by the Applicant or with its consent in relation to the services specified in the application.
- (x) Registration of the mark would be contrary to Council Directive No. 89/104 EEC to approximate the laws of the Member States relating to Trade Marks.
- (xi) The application should be refused in exercise of the Controller's discretion.

Counter-Statement

6. In its Counter-Statement the Applicant admits that the Opponent is the applicant for registration of Community Trade Mark No. 847236 but notes that that application has been opposed. It denies all of the grounds of opposition raised against its application and calls for further and better particulars from the Opponent in respect of its claimed use of, and reputation under, the trade mark cited in the Notice of Opposition.

The evidence

Rule 20

7. Evidence filed by the Opponent under Rule 20 consisted of a Declaration (and 7 exhibits), which appears to be dated 21 March, 2003 of Fernando Querejeta San Sebastian, Director General of the Opponent. Much of this Declaration is taken up with the deponent's opinion as to the similarities of the respective marks and the respective services of the parties and the resultant likelihood of confusion. These are matters that fall to me to decide and, in deciding them, I have not been influenced by the opinions expressed by this deponent and nor do I propose to rehearse those opinions here. As regards matters of fact that are within the knowledge of the deponent, the following points emerge from the Declaration:

- (i) The Opponent was formed in Spain in 1957 as a firm of engineering consultants. It has offices throughout Spain and, through its subsidiary companies and alliances, has a presence elsewhere within the European Union, South America, Africa and Asia.
- (ii) In addition to the Community Trade Mark Application cited in the Notice of Opposition, it has registered, or applied to register, its trade mark, IDOM and device, in Spain, Peru, Ecuador, Chile, Mexico, Colombia, Argentina and Brazil.
- (iii) Its services include project design and studies relating to computers and computer software and it has provided such services to the Basque and Galician Governments as well as to the companies Euskaltel and Drinka Rioja, SA.
- (iv) It is a member of MERGE, a European network of experienced consulting engineering firms offering a range of technical services and expertise in Western, Central and Eastern Europe.
- (v) It opened an office in London in 2001 and a scheme designed by that office was successful in a tender competition run in 2002 by the Office of Public Works for the regeneration of the North Quays in Waterford.

Rule 21

8. Evidence filed by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits PJM No. 1 and PJM No. 2) dated 16 September, 2003 of Pamela Jane Millar, Company Secretary of the Applicant. In addition to disagreeing with a number of the opinions expressed in the Opponent's evidence under Rule 20, Ms. Millar states that her company is the proprietor of a United Kingdom registration of the same mark that is the subject of the present application, which is registered as of 7 April, 1997 and therefore predates the Community Trade Mark Application on which the Opponent relies for its opposition to this application. She also states that her company has traded in Ireland in 1997, 1998 and 1999 and exhibits copy invoices from those years bearing the trade mark and addressed to companies in this jurisdiction.

Amendment of specification of services

9. When filing its evidence under Rule 21, the Applicant requested that the list of services covered by its application be restricted by the insertion, at the end of the list of services for each Class, of the words "***all relating exclusively to banking and banking technology***". That amendment was accepted and published in Journal No. 1980 on 29 October, 2003. The Opponent was then informed of the amendment in accordance with Rule 26(i) and invited to state whether it wished to abandon the opposition, amend the Notice of Opposition or pursue the opposition on the basis of the Notice as given. The Opponent did not respond to that communication within the period prescribed by Rule 26(iii) and was, accordingly, deemed to have expressed a wish to proceed with the Notice of Opposition as given.

The evidence (contd)

Rule 22

10. Evidence filed by the Opponent under Rule 22 consisted of a further Declaration (and 1 exhibit) dated 18 November, 2004 of Fernando Querejeta San Sebastian. He denies that the Applicant's earlier United Kingdom registration has any relevance to the present proceedings and he also denies a claim made in the Applicant's evidence under Rule 21 to the effect that his company is an

engineering company with no interest in banking and banking technology, which is the field of activity of the Applicant. In this regard, Mr. San Sebastian says that his company's activities are not limited to engineering in the traditional sense but extend to many areas, including telecommunications, computing and software development and he exhibits an extract from his company's website, which, he says, illustrates that his company provides such services.

The issues

11. Several grounds of opposition to this application were cited in the Notice of Opposition but many of those grounds were not subsequently substantiated by relevant evidence. So, for example, there is no evidence supporting the Opponent's claims that the application for registration was made in bad faith by the Applicant or that the Applicant did not use or propose to use the mark propounded for registration in relation to the services specified in the application. Nor has the Opponent's claim that the application offends against the provisions of Section 6 of the Act been particularised or supported by evidence or reasoned argument. In fact, the only grounds of opposition in respect of which a *prima facie* case has been made out in the evidence are those under Section 10 of the Act, based on the Opponent's Community Trade Mark No. 847236. The relevant provisions of Section 10 under which objection was raised in the Notice of Opposition are at subsections (1) to (3) and I have confined my consideration of the matter to those provisions. I consider each in turn below.

Section 10(1) – are the respective marks and the respective services identical?

12. Section 10(1) of the Act prohibits the registration of any trade mark that is identical with an earlier trade mark and is sought to be registered in respect of goods or services that are identical with those for which the earlier trade mark is protected. An "earlier trade mark" is defined in Section 11 of the Act as including a Community Trade Mark that has a date of application for registration earlier than that of the opposed trade mark. The Opponent's Community Trade Mark Application No. 847236, which was pending at the time that the present application for registration was filed, has since matured to registration and constitutes an earlier trade mark as against this application.

13. However, the mark which the Applicant seeks to have registered is not identical with the Opponent's mark, the subject of the Community Trade Mark registration. While each may be regarded as primarily consisting of the word IDOM, that word is presented in different typefaces in the respective marks and, more importantly, the marks contain figurative elements which are different, one from the next. While they are very similar, therefore, the marks are not identical and the prohibition on registration contained in Section 10(1) of the Act cannot apply. For that reason, I have decided to dismiss the opposition insofar as it is based on that Section.

Section 10(2) – is there a likelihood of confusion on the part of the public?

14. Section 10(2) of the Act reads as follows:

“A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and would 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 would 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 of the later trade mark with the earlier trade mark.”

15. I have already found that the respective trade marks are not identical and the provision at paragraph (a) of Section 10(2) cannot, therefore, apply. As regards paragraph (b), the criteria to be met in order for the prohibition on registration to apply are (i) similarity of marks, (ii) identity or similarity of services and, (iii) a resultant likelihood of confusion.

Similarity of marks

16. I have already noted that the respective marks are very similar. The dominant and distinguishing feature of each is the word IDOM. While the figurative elements accompanying that word are different in the respective marks, those figurative

elements are positioned in the same place in each mark and they share a generally square outline. Having regard to the fact that the average consumer does not normally analyse a trade mark's component elements and it is, therefore, the overall impression created by a trade mark that is normally perceived by the consumer, I would say that there is a very high degree of similarity between the respective marks in this case.

Identity or similarity of services

17. The services of the present application are those listed in paragraph 1 above, as subsequently amended by the addition of the words mentioned in paragraph 9, viz., "*all relating exclusively to banking and banking technology*". The services for which the Opponent's earlier Community Trade Mark No. 847236 is protected are as follows:

Class 35:

Economic and market studies and analysis; business studies and business organisation; business planning, control, inspection, monitoring, information and surveying; import, export and commercial and sole agency.

Class 37:

Services relating to the construction of housing and buildings in general, as well as of works and constructions of all kinds.

Class 42:

Engineering project design and project studies.

18. As regards the respective services in Class 35, I think that "*business management services*" and "*provision of management information and business data*", as contained in the application for registration, are essentially the same as "*business organisation; business planning, control, inspection, monitoring, information and surveying*", in respect of which the earlier mark is protected. As to "*project consulting services and advisory and consultancy services relating thereto*" in the application for registration, these can reasonably be regarded as similar to the types of services that may be categorised under the general term "*business*

planning” and which are, therefore, also embraced by the earlier registration. The fact that the services of the application have been restricted to such services relating exclusively to banking and banking technology does not affect the question of whether they are similar to those for which the earlier mark is protected. The services of business planning, control, etc. of the Opponent’s Community Trade Mark registration are not restricted to any particular field of business activity and, so, must be regarded as covering banking also and the protection afforded by that registration extends to the provision of the relevant services to the banking sector. Accordingly, I find that, as regards the respective services in Class 35, the services of the application are similar to those for which the earlier trade mark is protected and the second requirement of the objection under Section 10(2)(b) is therefore fulfilled in respect of those services.

19. Looking at the services in Class 37, it is clear that the earlier trade mark is protected in respect of a specific category of services, namely, construction services. The services included in Class 37 in the application for registration are all related to the installation and maintenance of computers, specifically in the area of banking and banking technology. These are essentially different fields of commercial activity. The Opponent’s services fall within the construction industry and the Applicant’s relate to the information technology industry. They are clearly not identical services and nor do I think they could reasonably be regarded as similar as they have different purposes (*construction as opposed to computer installation*), would be availed of by consumers with different needs (*accommodation or infrastructure needs as opposed to information technology needs*) and would be delivered by experts with different skills and qualifications (*builders, engineers, architects, quantity surveyors as opposed to I.T. experts and computer technicians*). For these reasons, I find that the requirement of similarity of services is not fulfilled as regards the services in Class 37 of the opposed application and that the objection under Section 10(2)(b) cannot apply as regards those services.

20. Turning, lastly, to the respective services in Class 42, it is immediately apparent that those covered by the application for registration are in a very specific area of activity, namely, the installation, maintenance and support of computer software

for the banking sector. The services for which the Opponent's earlier mark is protected are cast in much broader terms, being "*engineering project design and project studies*". Given their ordinary meaning, those services would be understood as including the design of civil, mechanical or electrical engineering projects, including the preparation of the requisite drawings, flow-charts, plans, etc.. The Opponent asserts that they should also be regarded as embracing computer engineering and says that, in fact, it provides such services, including software development in the telecommunications area.

21. In interpreting the scope of protection afforded by the registration of a mark in respect of specified services, it is necessary to strike a balance between an interpretation that is too narrow, and therefore unfairly restricts the scope of protection enjoyed by the registered proprietor, and one that is too broad and would unfairly restrict the operations of other undertakings. The requirement that a trade mark be registered in respect of specific goods and/or services is intended, *inter alia*, to create certainty among competitors of the registered proprietor as to the extent of the property rights enjoyed by the proprietor by virtue of the registration. Where the services for which a mark is registered includes a relatively broad term, as in the present case, I think the correct approach to the interpretation of the scope of protection of the registration is to regard it as covering only services of the type that the average person would normally understand as falling within the broad term. If other services could conceivably be included within the broad term but would normally be designated by another name or placed in a more specific category, then I think it is fair to conclude that the scope of protection of the registration does not extend to those services.

22. In the present case, I consider that the ordinary meaning of "*engineering project design and project studies*" is as I have set out in paragraph 20. While the design of computer systems, including computer software, might be described as computer engineering and could, conceivably, be seen to fall within the term "*engineering project design*", I do not think it would normally be so regarded and I conclude that a proper interpretation of the services for which the Opponent's earlier mark is protected would exclude such services. That being the case, I find that the respective services are not similar for largely the same reasons that I set

out as regards the services in Class 37. Here again, therefore, the prohibition on registration contain in Section 10(2)(b) is inapplicable.

23. Before leaving the question of the similarity or otherwise of the respective services, I should comment that the division of services into different classes is primarily an administrative device and the fact that services may fall in different classes does not, of itself, mean that they are dissimilar. While I have not engaged in a comparison of the services other than by reference to the respective services in each class individually, I have also looked at each of the specific services mentioned in the application and considered whether it might be regarded as similar to any of those for which the earlier mark is protected, regardless of the class in which the latter is registered. As it happens, that comparison does not yield any different results to those that I have set out in paragraphs 18, 19 and 22.

24. In light of the foregoing, I need only concern myself further with the services in Class 35 and whether, in the context of those services, there is a likelihood of confusion on the part of the public.

Likelihood of confusion

25. According to the case law of the European Court of justice (ECJ), the likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case¹. Those factors include, in all cases, the degree of similarity of the respective marks and the respective goods or services, the degree of distinctiveness of the earlier mark, the overall impression created by the marks, the circumstances of the trade in the relevant goods or services and the likely perception of the average consumer of those goods or services. Furthermore, a global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa². In the present case, I have already noted that there is a high degree of similarity between the marks and

¹ *Sabel BV v. Puma AG and Rudolph Dassler Sport* (C251/95) [1998] 1 C.M.L.R. 445, para 22

² *Lloyd Schhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* (C342/970 [1999] 2 C.M.L.R. 1343, para 19

that the overall impression created by each is essentially the same. I have also found that, as regards the services in Class 35, the services of the application for registration are either the same as, or similar to, those for which the Opponent's mark is protected. The combined effect of those factors, viz., very similar marks and very similar services, is such as to significantly increase the likelihood of confusion on the part of the public.

26. The services in question would normally be availed of by businesses seeking to improve their organisational efficiency, achieve savings in operating costs, deliver projects on time and within budget, etc., etc.. The selection of service-providers by the relevant consumers is likely to involve careful consideration of a number of factors, including the reputation and track-record of the service-provider, the level of expertise of its staff as evidenced by relevant qualifications, the professionalism of sales pitches and written proposals and, of course, the competitiveness of the price quoted. All of those factors, which are among the circumstances of the trade in the relevant services, are likely to have the effect of reducing the likelihood of confusion between the services of the Applicant and those of the Opponent based on the similarity of the respective trade marks. The circumstances in question are very different from those obtaining in respect of the trade in low value or everyday consumer goods, in which the level of attention paid to the selection of items for purchase is significantly lower and in which, as a result, similarities between trade marks are much more significant in determining a likelihood of confusion on the part of the public.

27. Nevertheless, the circumstances of the trade in the relevant services are not such as to completely eliminate the likelihood of confusion resulting from the high degree of similarity of the marks. The possibility that some businesses, being aware of the Opponent's services and having a certain regard for them, might be attracted to the Applicant's services in the mistaken belief that the Applicant's use of a similar trade mark signalled an economic link between it and the Opponent cannot be ruled out. As a trade mark for business consultancy services, IDOM is a highly distinctive word, having no obvious connection to the services in question. I think that the likely perception of the average consumer of such services would

be that the use of that mark by two different undertakings must suggest a connection between them.

28. On the whole, I find that the high degree of similarity between the respective marks and the respective services, combined with the fact that the Opponent's mark is quite distinctive, lead to the conclusion that there is a resultant likelihood of confusion on the part of the public, notwithstanding that that likelihood is tempered somewhat by the circumstances of the trade in the relevant services. For that reason, I find that the opposition to registration under Section 10(2)(b) of the Act is supported as far as the services in Class 35 are concerned and I refuse the application insofar as it covers those services.

Section 10(3) – does the Opponent's mark have a reputation entitling it to special protection?

29. Section 10(3) of the Act reads as follows:

“A trade mark which –

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.”

30. The purpose and effect of that provision is to afford an extra level of protection to marks that have a reputation over and above that which is given to other trade marks. Unlike Section 10(2), the protection given by Section 10(3) extends to cases involving the use of the opposed mark on goods or services that are not similar to those for which the earlier mark is protected and nor is there any requirement on the Opponent to show that there is a likelihood of confusion on the part of the public. The Opponent must, however, show that its earlier trade mark enjoys the requisite reputation and it must show how the use of the opposed mark

would take unfair advantage of, or be detrimental to, the distinctive character or reputation of its (the Opponent's) mark.

31. The present opposition is based on the Opponent's earlier Community Trade Mark No. 847236 and, in accordance with the wording of section 10(3), the requirement on the Opponent is to show that that mark has a reputation in the Community, which of course includes the State³. The matter is to be judged as of the date of filing of the opposed application, viz., 23 March, 2000, which is regarded as the relevant date for the purposes of the opposition. While the Opponent's evidence is to the effect that it was established some 43 years prior to the relevant date and that it has traded extensively since then, it has not provided clear evidence of the extent of turnover under its trade mark, the market share held by it or the amount invested in its promotion. Nor has any independent evidence been produced in the nature of statements from third parties, such as chambers of commerce or other trade and professional associations, to support the Opponent's claim that its mark enjoyed a reputation within the Community at the relevant date. I am satisfied, therefore, that the Opponent has not discharged the onus on it to show that its earlier Community Trade Mark had the requisite reputation to ground an objection to the registration of the Applicant's mark based on section 10(3) of the Act and I dismiss the opposition under that Section accordingly.

Conclusion

32. The opposition is successful as far as the services in Class 35 are concerned but not as regards those in Classes 37 and 42. The application may proceed to registration subject to the Applicant restricting (under section 44 of the Act) the services covered by it to those in Classes 37 and 42 only.

Tim Cleary
acting for the Controller
28 September, 2005

³ In the Notice of Opposition the Opponent claims, specifically, that the mark has a reputation in the State.