

**o/013/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3160978  
BY INTELERAD MEDICAL SYSTEMS INCORPORATED**

**TO REGISTER THE TRADE MARK:**

**PANORAMA**

**IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 407697 BY CODRA INGENIERIE INFORMATIQUE**

## **Background and pleadings**

1. On 22 April 2016, Intelrad Medical Systems Incorporated (“the applicant”) applied to register the trade mark **PANORAMA** for “computer software which assists in the delivery of data relating to medical imaging” in class 9.

2. The application was published for opposition purposes on 15 July 2016. It is opposed by Codra Ingenierie Informatique (“the opponent”). The opposition, which is based upon sections 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application.

3. Under sections 5(1), 5(2)(a) and 5(3), the opponent relies upon its international trade mark registration no. 806846 for the trade mark **PANORAMA**. The international registration date of the opponent’s mark is 18 June 2003. The UK was designated on the same date and protection in the UK was granted on 14 August 2005. The mark is registered for the following goods and services:

Class 9: Software for monitoring automatic industrial processing; software for monitoring computer remote control processes; software for monitoring industrial equipment in a computing environment.

Class 42: Design and development of monitoring software.

4. Under s. 5(1), the opponent relies upon all of the goods in class 9; under ss. 5(2)(a) and 5(3) the opponent relies upon all of the goods and services for which the mark is registered.

5. Given the date of designating the UK which, in accordance with Regulation 2 of the Trade Marks (International Registrations) Order 2008, is the filing date of the opponent’s trade mark, the opponent’s mark qualifies as an earlier mark in accordance with s. 6 of the Act. The opponent states in its Notice of Opposition that it has used its trade mark in

relation to all of the goods and services relied upon. This statement is made because the earlier mark is subject to the proof of use provisions contained in s. 6A of the Act. According to s. 6A, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the mark applied for. The relevant period is, therefore, 16 July 2011 to 15 July 2016.

6. The opponent claims that the marks are identical and the goods are identical and that the application should be refused under s. 5(1). Alternatively, under s. 5(2)(a), it claims that there is a likelihood of confusion because the marks are identical and because the goods and services are identical or similar.

7. Further, the opponent claims under s. 5(3) that the earlier mark has a reputation for the registered goods and services and that use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the earlier mark and/or be detrimental to its distinctive character. The opponent claims that:

“[unfair] advantage is inevitable due to the investment that the Opponent has made to market and promote its distinctive trade mark, the Applicant will benefit from riding on the coat tails of that reputation. Furthermore, detriment will be caused by dilution of the ability of the Opponent's trade mark to identify the goods and services for which it is registered as coming from the Opponent. Use of the Applicant's mark leads to dispersion of the identity and hold upon the public mind of the Opponent's earlier mark”.

8. The opponent also claims that it has acquired goodwill under the sign PANORAMA as a result of the use of that sign throughout the UK since January 2001. The goods and services in relation to which the opponent claims to have used the sign are identical to those of its registered mark, shown at paragraph 3, above. According to the opponent, use of the applicant's mark would amount to a misrepresentation to the public, which would be likely to damage the goodwill in the opponent's business.

9. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of the use of the earlier mark in respect of the goods for which it is registered (though not the services). The applicant admits that the marks are identical but denies that the goods and services are identical or similar. It claims that the goods are specialist goods in different business areas and denies that the relevant consumer will make a link between the marks, due to the “very different and specialist nature of the respective goods”. The applicant also claims that “[due] to the distinct difference in business areas and the type of software the public are unlikely to believe there is a trade connection or association between the opponent and the Applicant”. The applicant put the opponent to proof of both its reputation and its goodwill.

10. Both parties filed evidence. A hearing took place before me on 7 November 2017, at which the opponent was represented by Andrew Marsden for Wilson Gunn and the applicant by Aaron Wood for Wood IP limited.

### **Case management conference**

11. During the proceedings (at the applicant’s evidence stage), the applicant raised an issue regarding the status of the opponent. It asserted that there was no legal entity called “Codra Ingenierie Informatique” and that the opposition should be struck out for the opponent’s want of legal standing. The tribunal sought the opponent’s comments and appointed a provisional case management conference (“CMC”) should the matter not be resolved in writing by a deadline given in the letter. The opponent responded by providing the trade mark certificate for the earlier mark, which identifies the holder as “Codra Ingenierie Informatique” and records its legal form as “société anonyme”, as well as the details of the subsequent change in legal form from SA to SAS. In its letter, the opponent suggested that it is not a requirement for French companies to use the designation SA or SAS. Mr Wood filed submissions indicating that he was not satisfied with the opponent’s explanation and wished sequential evidence rounds to be appointed to deal with the issue. He claimed that the designation is required on legal documents in France and at the EUIPO.

12. The parties' submissions at the CMC did not deviate from their previously filed written submissions. I was not convinced that the applicant's pursuit of this point, after having received the opponent's explanation, was either necessary or an efficient use of the tribunal's resources. However, the address for the opponent on the form TM7 being different from that on the register for the holder of the earlier mark (not an issue which the applicant had identified), I directed that the opponent provide a witness statement confirming that:

- "the opponent identified on the form TM7 and Codra Ingenierie Informatique SAS are one and the same company;
- that that company is a legal entity;
- that the opponent identified on the form TM8 and the proprietor of the earlier mark are the same legal entity".

13. The statement was duly provided and the usual evidence rounds resumed.

## **Evidence**

### **Opponent's evidence in chief**

14. This consists of the witness statement of Eric Oddoux, the president of the opponent company. The witness statement is accompanied by exhibits P1 to P6.

15. Mr Oddoux states that the opponent has "two business lines; publishing Panorama software and providing expertise in industrial, technical, and embedded IT projects".<sup>1</sup> He says that "[the] Panorama software information system has been providing industrial automation solutions for 25 years" and that it is a "communication platform, supervising plants with technical difficulties and security constraints as well as very simple systems".<sup>2</sup> He explains that "[the] Panorama suite of software comprises software for

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<sup>1</sup> §2.

<sup>2</sup> §3.

data acquisition, real time monitoring of equipment, communication, data archiving and reporting” and that the opponent provides software design and development services “as its software is routinely optimised for its client’s particular implementations”.<sup>3</sup>

16. Mr Oddoux gives approximate turnover figures “in respect of goods and services provided in the United Kingdom”.<sup>4</sup> I note that the figures are neither broken down according to the goods and services, nor is there any estimate of approximate percentages for the goods and services. It is not explicitly stated that the goods/services were provided under the mark “Panorama”. The figures are:

2011 £350,000  
2010 £392,000  
2013 £599,000  
2014 £614,000  
2015 £600,000

17. Exhibit P1 consists of nine product brochures. The first five bear copyright dates of 2014 or 2015.<sup>5</sup> The sixth brochure is also said to date from 2015.<sup>6</sup> “Panorama” is used throughout, on its own in word-only form, in the combination “Panorama E<sup>2</sup>” and as shown below:



18. The brochures describe the possible applications of the opponent’s Panorama product across various sectors, such as transportation and nuclear energy. For example, the “GEO-SCADA” brochure states that:

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<sup>3</sup> §4.

<sup>4</sup> §7.

<sup>5</sup> pp. 5-25.

<sup>6</sup> pp. 26-30 and Oddoux §6.

“Water, gas, petroleum, electricity, transportation, multiple sites, monitoring/safety... Companies operating large plants need a single tool offering a comprehensive overview of the entire site with detailed information on each device. Panorama provides a fully adapted architecture, communications with all types of equipment over any medium, safety features and the capacity to integrate data from other information systems”.<sup>7</sup>

19. The same brochure also states that “Panorama E<sup>2</sup> collects information from local devices according to status changes or according to a schedule in order to refresh and centralize vital decision-support data in real time”.<sup>8</sup> I note that similar claims about the management and control of various systems and access to a range of applications through the opponent’s interface are made in all of the brochures. UK companies/entities are referenced in several of the brochures (e.g. London Underground (p. 8), Gatwick, Heathrow and Manchester airports (p. 20)), though the dates of the projects are not given.

20. The remaining brochures have copyright dates in 2016. They do not clearly indicate whether they were current during the relevant period, though it is likely that at least the “Panorama SUITE 2016” brochure was available throughout 2016. The following marks are visible, both in the stylised versions shown below and in word-only form:

**Panorama SUITE 2016**  
(i) SCADA | DATA HISTORIAN | COMMUNICATION PLATFORM (pp. 31-34);

(ii) **Panorama COM** (pp. 35-37);

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<sup>7</sup> p. 6.

<sup>8</sup> Ibid.

**Panorama**  
***HISTORIAN*** (iii) (pp. 38-43)

21. In the “Panorama SUITE 2016” brochure, the “Panorama E<sup>2</sup>” product is described as “the ideal multi-purpose SCADA platform for building powerful, modern applications”.<sup>9</sup> Again, a range of applications are identified, from pharmaceutical batch management to safety supervision in the oil and gas industries.<sup>10</sup> I note that the contact details for all of the brochures are Codra Software Limited (which Mr Oddoux confirms is a wholly owned subsidiary of the opponent) at a UK address.

22. Exhibit P2 consists of information about “Panorama Days” in the UK in 2011, 2012 and 2014. These appear to have been promotional events for various products, including the Panorama SCADA applications and, at the 2011 event, the Panorama E<sup>2</sup> system. There appear to have been 3 locations for the 2012 events, namely London, Manchester and Aberdeen. There is also a print dated 2015 from the opponent’s website, detailing the opponent’s scheduled attendance in Aberdeen that year at SPE Offshore Europe. It is described as “one of the world’s largest technical conference and exhibitions for the offshore E&P industry”.<sup>11</sup>

23. At exhibit P3 is an advertisement for the “Panorama SUITE 2016” which appeared in *Control Engineering Europe* in March 2016. The magazine’s 2016 media pack is also exhibited, which puts UK circulation at 6,892 copies.<sup>12</sup>

24. Exhibit P4 includes an article dated 2008 which discusses the National Grid’s purchase of Panorama technology to manage equipment at its facility in the UK, which went live in 2000. There is also an article about the selection of Panorama E<sup>2</sup> SCADA for the upgrade and maintenance of the London Underground. The date of the sale is

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<sup>9</sup> p. 32.

<sup>10</sup> p. 27.

<sup>11</sup> p. 57.

<sup>12</sup> pp. 63-64.



not clear: the article is dated 2008 but there are references to the opponent's software being used from 2000.

25. Exhibit P5 contains various articles which refer to Panorama specifically as a SCADA solution (or as a "software framework" (p. 90)), dated between 2010 and 2015. One is clearly from a UK website (p.88), another appears to be UK-centric, as it refers to UK towns and cities without explanation (p. 89).

26. Exhibit P6 contains three extracts from contracts, the most relevant of which is what appears to be an accepted offer to Telent (signed on 4 December 2013) in relation to a project for Network Rail. A number of Panorama products are proposed such as licences (including licence keys), licence updates, consultancy and training. The total is in excess of £550,000 inclusive of options. There are also four purchase orders and eleven invoices dated between June 2012 and February 2016 which have their billing details in the UK and itemise "Panorama" products, though I note that, as Mr Wood points out, the invoice at p. 151 relates to services only. There are multiple references to "Panorama E<sup>2</sup>" functional servers (e.g. pp. 136. 141) and server licences (e.g. pp. 162, 164). The cost of the products varies: for example, a functional server costs £6,456 at p. 141 and £6,130 at p. 144. Most of the invoices total in the tens of thousands of pounds but, as the final price for the individual items has been redacted, it is impossible to determine exactly how much revenue was generated by the sale of individual products.

#### Applicant's evidence

27. The applicant's evidence consists of the witness statement of Anna Perry, a consultant with the applicant's professional representatives. Ms Perry describes research she undertook about the opponent, providing her findings in ten exhibits (AP1-AP10). Exhibits AP1-AP3 and AP5-AP9 consist of prints from the opponent's website. None is clearly dated: all bar AP3 bear a 30-year anniversary logo, indicting the period 1986-2016, but some (e.g. AP1, AP5) also have 'agenda' dates in 2017. I note that

there are references to “Panorama” in each of exhibits AP1-AP3, which all refer to the opponent as specialising in industrial IT/computing. AP5 to AP10 give more information about the opponent’s services and the way in which they are provided.

28. Exhibit AP4 is print from [www.wonderware.com](http://www.wonderware.com) which explains the meaning of SCADA. It explains that:

“SCADA is not a specific technology, but a type of application. SCADA stands for supervisory control and data acquisition. Any application that gets operating data about a system in order to control and optimize that system is a SCADA application. That application can be a petrochemical distillation process, a water filtration system, a pipeline compressor or just about anything else”.

29. Exhibit AP10 consists of prints of the financial statements of Codra Software Limited for the years 2011, 2012, 2013 and 2015, along with the abbreviated accounts for 2014.

#### Opponent’s evidence in reply

30. This consists of the witness statement of Andrew Marsden, the opponent’s trade mark attorney, which is dated 7 August 2017. There is one exhibit (AM1) which contains prints from the opponent’s website describing the business, and the products and services it offers. The extent to which the pages were current in the relevant period is not clear: all bear a printing date in July 2017 but there are copyright notices dated 2013-2016 and 2016<sup>13</sup>, as well as “agenda” dates in 2017.<sup>14</sup>

31. That concludes my summary of the evidence, to the extent that I consider it necessary.

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<sup>13</sup> p.17; pp. 3, 5, 19 and 25.

<sup>14</sup> pp. 20-23, 27.

## **Proof of use**

32. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. 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

(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”.

33. 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”.

34. 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 *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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]”.

35. The correct approach to assessing the evidence is to view the picture as a whole, including whether individual exhibits corroborate each other.<sup>15</sup>

36. At the hearing, Mr Wood made a number of criticisms of the opponent's evidence, which he says is insufficient to establish genuine use. It is true that the evidence could have been more clearly explained. The issue which most exercised the parties was the matter of the turnover figures provided by Mr Oddoux. Mr Wood claimed in his skeleton argument that "the turnover figures and other aspects of Codra's evidence are misleading or factually incorrect".<sup>16</sup> If the applicant wished to challenge the veracity of what Mr Oddoux says, the appropriate course would have been to request cross-examination of Mr Oddoux. As the applicant made no such request, it is not now open to Mr Wood to dispute whether Mr Oddoux is telling the truth. Mr Wood is, of course, perfectly entitled to highlight any inconsistencies or gaps in the opponent's evidence.

37. Mr Wood submitted that the indication at p. 86 of the opponent's evidence that Codra UK handles international sales confirms that:

"[...] all of the international sales, by which we ask you to infer sales outside of France, which is where their head office is, are handled by them. So we are seeing turnover stated by the opponent is the entire turnover of the UK subsidiary, a UK subsidiary that is doing the international work, not just goods and services in the UK but selling them in relation to other countries as well".

38. Mr Wood also directed me to the contract with Telent (p. 100) and submitted that "[we] have a long list of countries there. Those are the overseas services and software which are provided, we say, by Codra Software Limited and figure in the turnover figures". However, no dates are given for the projects: they merely appear in the contract as examples of "[some] of our latest Panorama references". Whilst Mr Wood is

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<sup>15</sup> See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited* ("*Lambretta*") BL O/065/14.

<sup>16</sup> §16.

plainly right that the evidence shows that Codra UK handles international sales and marketing (or did so in 2013), what the evidence does not show is that any of the international sales mentioned either in the Telent contract or elsewhere took place in the relevant period (and that they would, therefore, be covered by the turnover figures provided by Mr Oddoux). The applicant has not provided any evidence of sales to third parties (whether inside or outside the UK) in the relevant period which would undermine the evidence of turnover given by Mr Oddoux.

39. Mr Wood also complains that Mr Oddoux's statement refers to "goods and services provided in the United Kingdom" at large and suggests that this is an attempt to mislead. There is nothing in the point: Mr Oddoux has claimed an approximate level of turnover for goods and services in the UK and the applicant's own evidence puts Codra UK's turnover at roughly the same figure. It would have been preferable if Mr Oddoux had identified the level of turnover in relation to specific goods and services but I infer nothing about his motives from the failure to do so.

40. The turnover figures provided show a steady increase from £350,000 p.a. in 2011 to £600,000 in 2015. I bear in mind that Mr Oddoux does not explicitly state that the goods and services to which the turnover figures relate are goods and services sold under the mark "Panorama". Given that Mr Oddoux has given unchallenged evidence that the opponent has two business strands (publishing Panorama software and providing expertise), and as the turnover figures are not broken down, a proportion of the turnover, potentially even the greater part, no doubt relates to the services. However, the evidence is not limited to the turnover figures. There are a number of invoices to UK addresses which specifically show products identified as "Panorama" and, in particular, "Panorama E<sup>2</sup>" products. Whilst they may not be sold in vast quantities, the cost of the items is not negligible, with, for example, one server costing several thousand pounds.

41. It is clear that the use of a registered trade mark includes both its independent use and its use in a composite mark or in conjunction with another mark, provided that the



registered trade mark alone continues to identify the trade origin of the goods.<sup>17</sup> That is likely to be the case where the registered mark plays an independent distinctive role. In this case, the word “Panorama” clearly plays an independent distinctive role in both the word-only and stylised combination “Panorama E<sup>2</sup>”. The same also applies to its use in combination with “COM”, “SUITE 2016” and “HISTORIAN”. Use of all of these marks constitutes use of the mark “PANORAMA”. For the record, I do not consider that the use in title case is material, as notional and fair use of the mark would include use in upper case, lower case, or title case. Adopting the multifactorial assessment described above, I conclude that there have been sales under the mark “PANORAMA” sufficient to constitute genuine use in the relevant period.

42. The next step is to decide whether the opponent’s use entitles it to rely on all of the goods for which it is registered. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the

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<sup>17</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 (CJEU) at [31]-[35].

average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made".

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more

of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 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. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered”.

43. Mr Wood confirmed at the hearing that “where it says “functional server and work station” [in the opponent’s evidence], it is not clear to us that that is just software, but that is not something we have challenged at this stage”. My own understanding of “servers” is that they are computer programmes which provide functions to other devices. I see no reason why a server would not be software. As to the specific nature of the software, Mr Wood made much of the fact that the opponent has not demonstrated that its goods have been used in hospitals, or that, if they have, it is in relation to facilities management. However, given the terms of the opponent’s specification, that is not relevant to the issue of genuine use. The evidence shows that the opponent provides “SCADA” software. The applicant has adduced evidence that “SCADA” means supervisory control and data acquisition software, a definition which Mr

Marsden accepted at the hearing. It is clear that the software was promoted as capable of monitoring and controlling a wide range of processes in many different spheres of activity, including industry. There is also evidence that the opponent's Panorama E<sup>2</sup> software is used on the Kittiwake offshore platform to monitor and control the fire and gas detection system, which includes automatic failsafe responses. The opponent's specification does not lend itself to further subcategorisation and I am satisfied that the specification on record is a fair reflection of the way in which the goods would be described by the average consumer. Consequently, the opponent may rely upon all of its registration in class 9, as well as the services in class 42 (for which evidence of use was not required), namely:

Class 9        Software for monitoring automatic industrial processing; software for monitoring computer remote control processes; software for monitoring industrial equipment in a computing environment.

Class 42       Design and development of monitoring software.

### **Sections 5(1) and 5(2)(a)**

44. Sections 5(1) and 5(2)(a) of the Act read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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) [...]

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

45. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. Although some of these principles relate to section 5(2)(b), I include them to show the interdependency of the various elements in the assessment of a likelihood of confusion. The principles are:

(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.

### **The average consumer and the nature of the purchasing act**

46. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then

determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

47. Mr Marsden’s only comment on the average consumer was to the effect that the consumer for the parties’ goods and services would be the same. Mr Wood submitted that “the people who would be dealing with building control and overseeing production processes are different to the medical professionals who would be dealing with medical imaging”.

48. The goods and services at issue strike me as specialist and not typically bought by the general public. I consider that the average consumer is likely to be a business user, whether buying on behalf of a commercial undertaking or, for example, a person professionally charged with the purchase of software for use in the field of medicine. I reject Mr Wood’s argument that the average consumer includes medical professionals: whilst a medical professional may use medical imaging equipment, there is nothing in the evidence to suggest that a medical professional would have any responsibility for purchasing the software which processes the data relating to medical imaging.

49. The purchasing process itself is likely to be primarily visual, involving inspection of websites and brochures. However, I also consider that aural considerations will play a

role, for example in discussions with sales representatives. The level of attention will vary across the category but, given the potentially large sums at issue, coupled with the need to ensure, for example, compatibility with existing systems, speed and security, I consider that the level of attention will be reasonably high, though not at the very highest level.

### **Identity of trade marks**

50. There is, sensibly, no dispute that the marks are identical.<sup>18</sup> I find accordingly.

### **Comparison of goods and services**

51. 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”.

52. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

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<sup>18</sup> Applicant’s skeleton argument, §3.



- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

53. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

54. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the

way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

55. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating 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”.

56. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, 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”.

57. In *Sanco SA v OHIM*, Case T-249/11, the 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*. The purpose of examining whether

there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”.

58. I also bear in mind Mr Alexander’s comments in the same case, 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”.

59. The goods and services to be compared are:

Opponent's goods and services	Applicant's goods
<p><u>Class 9</u>: Software for monitoring automatic industrial processing; software for monitoring computer remote control processes; software for monitoring industrial equipment in a computing environment.</p> <p><u>Class 42</u>: Design and development of monitoring software.</p>	<p><u>Class 9</u>: Computer software which assists in the delivery of data relating to medical imaging.</p>

60. At the hearing, Mr Marsden submitted that the goods in class 9 are identical because in the applicant's specification:

“the data is undefined, other than it must relate in some way to medical imaging. We are talking about software which helps in the delivery of that data. We consider that that falls within the scope of the opponent's class 9 specification. [...] it could be medical imaging equipment that is being monitored and that data is being delivered and processed in relation to it”.

61. In the alternative, he suggested that the goods should be considered highly similar as:

“these are both software products. They both deal with data. They both deal with the delivery of data, and they can both relate to medical imaging. It is quite clear that there is an overlap, so there will be an overlap of the users, the uses, the nature, purpose and, potentially, the channels of trade”

and:

“these goods can be used in conjunction, alongside each other, in the same environment and within the same industry”.

62. He also submitted that “monitoring is akin to supervision. You cannot monitor or supervise without dealing with data. You have to gather, collect, store and communicate data to be able to monitor”.

63. For his part, Mr Wood denies that the goods are identical on the basis of the specifications not being identically worded. He also disputed that “monitoring” extends to the gathering, storing or communicating of data. He submitted that:

“My friend says that the things which could be monitored would include medical imaging equipment. I have read the specification again in class 9, and I am not sure what the medical imaging equipment would be, because it does not seem to be an automatic industrial processing. It does not seem to be a computer remote-control process, and it does not seem to be industrial equipment as such. It is medical equipment”.

64. Mr Wood also submitted that the applicant’s “computer software which assists in the delivery of data relating to medical imaging” is not monitoring software. He did not offer an explanation of what the applicant’s software actually is.

65. In a case such as this, involving nebulous terms on both sides, evidence or submissions regarding the goods covered by the terms at issue would have been helpful. Although there is some evidence showing the goods and services of interest to the opponent, there is nothing to assist me in determining the scope of the specification applied for. I must therefore do the best I can with the information before me.

66. I focus on the opponent's class 9 term "software for monitoring computer remote control processes". It is not limited to industrial equipment or processing, as Mr Wood accepted. Those goods represent, in my view, the opponent's best case: if the opposition fails in respect of these goods it is unlikely to succeed in relation to the other goods and services, which are less similar.

67. The most relevant definitions of "monitor" in the *Collins English Dictionary* are:

"Noun

1. a person or piece of equipment that warns, checks, controls, or keeps a continuous record of something

[...]

Verb (transitive)

10. to act as a monitor of

11. to observe or record (the activity or performance) of (an engine or other device)

12. to check (the technical quality of) (a radio or television broadcast)".<sup>19</sup>

68. The same dictionary defines "remote control" as:

"1. control of a system or activity by a person at a different place, usually by means of radio or ultrasonic signals or by electrical signals transmitted by wire".<sup>20</sup>

69. Bearing the parties' submissions and the above definitions in mind, I take the view that "software for monitoring computer remote control processes" in the opponent's specification covers software which observes, checks and controls processes which are controlled from a different location by a computer.

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<sup>19</sup><https://www.collinsdictionary.com/dictionary/english/monitor> [accessed 19 December 2017].

<sup>20</sup><https://www.collinsdictionary.com/dictionary/english/remote-control> [accessed 19 December 2017].

70. As far as the applicant's specification is concerned, it seems to me that software which "assists" in the delivery of data could cover a whole range of goods. However, I take the view that the natural reading of the term is that this is software the primary purpose of which is to aid the delivery process itself, such as by regulating the speed of downloads or by compressing and decompressing image files in order to make transmission more efficient.

71. I have no evidence or submissions to assist me in determining whether the delivery of data relating to medical imaging involves a computer remote control process. It does not seem to me that a natural reading of the terms in the respective specifications is that they describe the same software, whether phrased differently or with one term being encompassed by the other. I do not consider that the goods are identical and the opposition under s. 5(1) is dismissed accordingly.

72. In terms of any similarity between the goods, the core purpose of the opponent's "software for monitoring computer remote control processes" is observation. The applicant's "computer software which assists in the delivery of data relating to medical imaging" has a different core purpose, which is to aid data delivery. There is an overlap in nature because the parties' respective goods are both types of software but that is at a high level of generality. The users will intersect. Whilst I note Mr Wood's submission that the trade channels will not overlap, that argument appears to be based on the premise that the opponent's goods only cover building management software. I have found that not to be the case. I see no reason why the software goods at issue would not coincide in their channels of trade. I am not persuaded that there is a competitive relationship between the goods at issue, though they may be used together and be perceived as being the responsibility of the same undertaking, and thus have a complementary relationship. I find that the goods are similar to a low degree.

## **Distinctive character of the earlier trade mark**

73. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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 determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. 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)".

74. Invented words usually have the highest degree of distinctive character, while words which are descriptive of the goods normally have the lowest. Distinctiveness can be enhanced through use of the mark. Mr Wood made no submissions regarding the earlier mark's distinctive character. Mr Marsden submitted that the earlier mark is highly distinctive.

75. The opponent has not made an explicit claim of enhanced distinctiveness but it has filed evidence of use. The overall turnover figures are not negligible but they do not specify the amount of turnover in relation to the particular goods at issue. There is no evidence of the size of the market or the opponent's share of it and only limited evidence of the opponent's promotional activities. On the basis of the evidence filed, I am unable to determine that the earlier mark has an enhanced distinctive character in relation to the goods at issue.

76. Turning to the inherent position, "Panorama" is a dictionary word that is neither allusive nor descriptive of the goods at issue. I consider that the earlier mark has an average level of inherent distinctive character.

### **Likelihood of confusion**

77. 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 them 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]).

78. The marks are identical. The earlier mark has an average degree of inherent distinctive character. Those factors weigh in the opponent's favour. In the applicant's favour is that the goods are only similar to a low degree and that they are purchased with a reasonably high level of attention. Balancing all of the competing factors, I take the view that the identity of the marks, notwithstanding the low degree of similarity between the goods, will give rise to a likelihood of confusion. In making that decision, I have not overlooked the reasonably high level of attention with which the goods will be purchased. However, I do not consider that it is sufficient to avoid the likelihood of confusion. The opposition succeeds under s. 5(2)(a).

### **Other grounds**

79. As the opposition has succeeded in its entirety under s. 5(2)(a), there is no need to consider the remaining grounds, as they do not materially improve the opponent's position.

### **Conclusion**

80. The opposition has been successful. Subject to appeal, the application will be refused.

### **Costs**

81. Mr Marsden asks for costs on the usual scale, save for in relation to the CMC where he asked for off-scale costs on the basis that "[as] was proved by the outcome of the case management conference, it was a meaningless and fairly pointless issue to pursue. It put our client to additional time and cost". Mr Wood claimed that, in relation to the CMC, "it is fair for us to have checked whether or not the opponent owns the right on which they rely". He also requested off-scale costs "to deal with the evidence which

they put in, which is clearly not covering the claims they have made and the rights they have” and because of what he describes as “egregious behaviour” by the opponent.<sup>21</sup>

82. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. Although the issue raised by the applicant regarding the status of the opponent was not wholly unwarranted, I am not persuaded that the applicant’s conduct in relation to the CMC was proportionate to the issue. I do not consider an off-scale award to the opponent to be appropriate but I will make an award on the usual basis in respect of the CMC.

83. I see no reason why the applicant should be entitled to costs, let alone costs off the scale. There is no support whatsoever for the applicant’s complaints about the conduct of the opponent and the criticisms of the opponent’s evidence are without merit.

84. I award costs to the opponent on the following basis:

Official fees:	£200
Preparing the Notice of Opposition and considering the counterstatement:	£200
Filing evidence and considering the other side’s evidence:	£600
Preparing for and attending CMC and substantive hearing:	£1000
<b>Total:</b>	<b>£2000</b>

85. I order Intelerad Medical Systems Incorporated to pay Codra Ingenierie Informatique the sum of **£2000**. This sum is to be paid within fourteen days of the expiry of the appeal

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<sup>21</sup> Skeleton argument, §26.

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

**Dated this 05<sup>th</sup> day of January 2018**

**Heather Harrison  
For the Registrar  
The Comptroller-General**