

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2205277
BY GREEN CATHEDRAL LIMITED
TO REGISTER A TRADE MARK IN CLASSES 9, 38 & 42**

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DECISION AND GROUNDS OF DECISION

BACKGROUND

1. On 7 August 1999, Green Cathedral Limited of The Barn, Cambridge, CB4 5BP applied under the Trade Marks Act 1994 for registration of the trademark CLICKSTREAM in classes 9, 38 and 42. The goods and services claimed were as follows:

Class 9

Computers, computer equipment and peripherals, computer software and programs, recorded computer data, programs and software; all the foregoing for use in the design of or use of or provision of Internet and Intranet services, Web pages and HTML or similar documents or monitoring use of such services.

Class 38

Electronic mail, bulletin board and e commerce services; Internet and Intranet computer communications; communication of Internet and Intranet usage information.

Class 42

Computer programming and computer program design, and computer equipment and program consultancy; all in the field of Internet and Intranet use, Web page design and maintenance and the provision of HTML and similar documents; provision of Internet, Intranet, and Web page monitoring services.

2. Objection was taken to the application under Section 5(2) of the Act in respect of the following Community Trade Mark which is now registered:

| | |
|-----------------------|-------------|
| <u>Number</u> | 1050889 |
| <u>Mark</u> | clickStream |
| <u>Specifications</u> | |

Class 9

Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of

sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; computer software; computer software (sold as a unit with manuals); computers; computer hardware; electronic and electromechanical peripheral apparatus, all for use with computers; computer networks; computer programs and programming languages; microprocessors; central processing units; circuit boards; semi-conductor devices; computer displays; computer monitors; video monitors; projectors; integrated circuits; storage and network controllers and devices; data recorded magnetically, electronically, or optically; instructional material relating to computers and to data, all recorded magnetically, optically or electronically; magnetic, optical and electronic data recording materials.

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book-binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching materials (other than apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks; instruction manuals (sold as a unit with computer software).

Class 42

Computer services; consultancy, design, testing, research and advisory services, all relating to computing and computer programming; Website design services; computer programming; computer systems analysis; computer timesharing; research and development of computer hardware and software; technological services relating to computers; rental and leasing of computers; computer programming; computer rental and updating of computer software; computer software design; computer database leasing; providing access to electronic communications networks and electronic databases; transfer and dissemination of information and data via computer networks; hosting of Websites; computer network services; providing access to the Internet; providing access to and leasing access time to computer databases and networks; compilation, storage, analysis and retrieval of data and information; computer help-line services; technical support services relating to computer hardware, computer software, computer networks and the Internet; computer network services; on-line services for the search, retrieval, indexing and organisation of data on electronic communication networks and for enhancing the performance and function of such networks; information, consultancy and advisory services relating to all the aforesaid services including such services provided on-line or via the Internet or extranets.

3. The legal representatives for the applicant company, Mills and Reeve, Solicitors, argued in correspondence that there is sufficient difference between the goods and services of the two applications and consequently there is no likelihood of confusion on the part of the relevant public. This submission was rejected by the Examiner, and so the Trade Mark agent proceeded to file evidence of use in an effort to claim that the application may proceed by

nature of honest concurrent use under Section 7(2) of the Trade Marks Act 1994. This evidence was later rejected by the Examiner on the basis that it is inadequate and does not show that there has been honest concurrent use of the two trade marks within the meaning of the Act.

HEARING AND DECISION

4. At a hearing at which the applicants were represented by Mr Goodger of Mills and Reeve Solicitors, the objection under Section 5(2) of the Trade Marks Act 1994 was maintained, and following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the reasons for my decision.

5. Section 5(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 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 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."

6. The relevant part of the Act which deals with honest concurrent use is Section 7 which reads as follows:

"**Section 7(1)** This section applies where on an application for the registration of a trade mark it appears to the registrar -

- (a) that there is an earlier trade mark in relation to which the conditions set out in Section 5(1), (2) or (3) obtain, or
 - (b) that there is an earlier right in relation to which the condition set out in Section 5(4) is satisfied,
- but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the Registrar shall not refuse the application by a reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purposes of this section "honest concurrent use" means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of Section 12(2) of the Trade Marks Act 1938."

7. The relevant part of the Act which deals with the effect of acquiescence is Section 48

which reads as follows:

"48.-(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right -

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark."

THE PRIMA FACIE CASE FOR REGISTRATION

8. Mr Goodger argued at the hearing that the word "CLICKSTREAM" is only semi-descriptive and so minor differences in presentation should be sufficient to allow the two marks to co-exist. He pointed to the split in the cited mark, brought about by the capital letter "S" in the middle of the word. This therefore gives the presentation of two words. I rejected this argument and maintained that the citation is confusingly similar within the meaning of Section 5(2) of the Act. The agent made no submission at the hearing in respect of any differences in the goods and services claimed. I therefore maintained the view that the goods and services claimed by the applicant in classes 9 and 42 are subsumed within the class 9 and class 42 specifications of the earlier mark. As far as class 38 is concerned, I maintained that services such as "computer network services" in class 42 of the earlier mark are similar services to those claimed in class 38 by the applicant.

HONEST CONCURRENT USE AND ACQUIESCENCE: THE APPLICANT'S EVIDENCE

9. The evidence comprises a Statutory Declaration with two accompanying exhibits.

10. The Statutory Declaration is by Dr Michael Woodley, a Director of the applicant company since November 1996. He confirms that the applicant company has specialised since at least April 1997 in website design, development and publication, and in the development of software for use with the Internet. He states that from April 1997 to date, the company's website has published much information about the CLICKSTREAM computer software product. A CD-rom carrying a sample of the latest Website is given as an exhibit.

11. Dr Woodley goes on to give details of the number of hits on the company's website between April 1997 and July 1999 which amounts to in excess of two million file requests, and whereby over eleven and a half thousand page impressions specifically relate to pages that

mention the CLICKSTREAM product. In addition, he states that the company has received a significant number of e-mails enquiring about the product under this trade mark. In addition, he states that the mark has been used in a number of promotions at a total cost of £3,000.

12. Dr Woodley then goes on to give information concerning the owners of the cited mark who are based in South Africa. He states that the company, Y3K.ICE (Proprietary) Limited, appears to be a web-hosting and/or web-design company and that they therefore would have a substantial understanding of the Web and activities on the Web, and that in his opinion companies in this field will be well aware of any competitors activities involving their use of trade marks. His company, he states, carried out a search in 1997 before commencing use of the trade mark CLICKSTREAM, and found no reference to use by the owner of the cited mark at that time.

13. Dr Woodley concludes that the owners of the cited mark must have been aware of his company's use of the trade mark CLICKSTREAM for some time before making their own application. Consequently, he has demonstrated with the statements made in his Statutory Declaration that there was honest concurrent use of the mark by his company for a sufficiently long period of time and that the owners of the cited mark will have been aware of, and by implication acquiesce in, his company's application, in respect of the goods and services applied for.

HONEST CONCURRENT USE AND ACQUIESCENCE: DECISION ON THE EVIDENCE

14. At the hearing, Mr Goodger submitted that the evidence filed is sufficient to warrant the waiver of the Section 5(2) objection on the basis of honest concurrent use.

15. Section 7(3) of the 1994 Act states that "honest concurrent use" means use by the applicant as would formerly have amounted to honest concurrent use under Section 12(2) of the 1938 Trade Marks Act. The effect of this section is therefore to introduce the old law of honest concurrent use into the new Act. The Registrar's practice under the 1938 Trade Marks Act was to focus on the use that had been made of the later filed application. The requirements in this respect are quite rigorous in that five years good use before the date of application is usually regarded as a good starting point, but that of course may be varied depending upon the scale of use and the extent of advertising.

16. The approach to be followed when considering honest concurrent use is set out by Lord Tomlin in the House of Lords in the *Alex Pirie and Sons Ltd* application (1933) 50 RPC 147. A summary of the factors that the tribunal should take into account when considering an application for honest concurrent use is given in Kerly's Law of Trade Marks and Trade Names (13th Edition) at page 261 as follows:

- (1) the extent of use in time and quantity and the area of the trade;
- (2) the degree of confusion likely to ensue from the resemblance of the marks which is to a large extent indicative of the measure of public inconvenience;
- (3) the honesty of the concurrent use;
- (4) whether any instances of confusion have in fact been proved; and

(5) the relative inconvenience which would be caused if the mark were registered.

17. And also on page 262;

Public Interest

18. The tribunal should always consider the public interest. This has long been a matter taken into account in determining whether there is honest concurrent use. Accordingly the Registrar should always consider whether the public are adequately protected. The tribunal will consider whether it is just to register, even if there is some confusion.

19. I note from the judgement that Lord Tomlin considers that a certain degree of confusion between the two marks is tolerable if the overall equitable considerations outweigh the risk. Indeed the *Pirie* application was eventually allowed to proceed on the basis of honest concurrent use after full consideration of the facts had been given. The considerations therefore are all a matter of degree, and the points as summarised by Kerly's Law of Trade Marks and Trade Names earlier in this decision must therefore be carefully considered in any claim for honest concurrent use. I shall go on to consider the points as they arise in the summary.

(1) *the extent of use in time and quantity and the area of trade*

The applicants have not clearly set out the extent of their use of the mark CLICKSTREAM. The length of use made prior to filing is short in any case at just two years. The level of advertising and promotion is not substantial. The Statutory Declaration of Dr Woodley makes a number of assumptions, not least that people involved in this particular industry will know of the trade marks of others because the use of the Internet is universal.

(2) *the degree of confusion is likely to ensue from the resemblance of the marks is to a large extent indicative of the measure of public inconvenience*

The two marks consist essentially of the word CLICKSTREAM. The near identity of the marks and of the majority of the goods and services means, in my view, that the likelihood of confusion and therefore the measure of public inconvenience is high.

(3) *the honesty of the concurrent use*

Based on the evidence before me, I believe that the applicant's use of the mark is honest.

(4) *whether any instances of confusion have in fact been proved*

There is no evidence of confusion, but neither is there any evidence of use of the earlier mark.

- (5) *the relative inconvenience which would be caused if the mark were registered*

It does of course cause inconvenience to the applicant to refuse registration of the mark as there is evidence of an existing business at the date of application. However, the case for honest concurrent use has not been made because of the paucity of the evidence filed. The period of trading under the mark prior to the application having been made is short. The near identity of the marks and the goods and services for which registration is claimed is a significant factor that the evidence has failed to address. Consequently, I consider that it would be more of an inconvenience to the owners of the earlier mark to accept for registration a near identical mark in another ownership.

20. Finally, I turn to the claim by Dr Woodley that the applicant's mark should be allowed to proceed because of acquiescence. The requirements for acquiescence as set out in Section 48 of the Act have not been met. The applicant claims just two years use prior to filing the application, and the extent of the use is not given.

CONCLUSION

21. The application is not registrable because it is debarred from registration under Section 5(2) of the Act.

22. The evidence filed to substantiate the claim that the mark has acquired honest concurrent use is not considered sufficient to satisfy the Registrar that registration of the applicant's mark would be prudent.

23. The evidence filed to substantiate the claim for acquiescence within the meaning of Section 48 of the Act is insufficient.

24. In this decision I have considered all documents filed by the applicant and all the arguments submitted to me in relation to this application, and for all the reasons given above, it is refused under the terms of Section 37(4) of the Act.

Dated this 13 day of December 2001.

Janet Folwell
For the Registrar
The Comptroller General