

O-322-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2456228
IN THE NAME OF ROB KEVE TO REGISTER THE TRADE MARK
MOODMETER IN CLASSES 9, 35 AND 42**

AND

**IN THE MATTER OF APPLICATION NO 2456239
IN THE NAME OF ROB KEVE TO REGISTER THE TRADE MARK
MOOD MAP IN CLASSES 9, 35 AND 42**

AND

**OPPOSITION THERETO UNDER NOs 96956 AND 96958
IN THE NAME OF SALAMANDER ENTERPRISES LIMITED**

Trade Marks Act 1994

**IN THE MATTER OF application No 2456228
in the name of Rob Keve to register the trade mark
Moodmeter in Classes 9, 35 and 42**

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**IN THE MATTER OF application No 2456239
in the name of Rob Keve to register the trade mark
Mood map in Classes 9, 35 and 42**

And

**Opposition thereto under No.s 96956 and 96958
in the name of Salamander Enterprises Limited**

BACKGROUND

1. On 22 May 2007, Rob Keve made an application to register the trade marks Moodmeter and Mood map in Classes 9, 35 and 42 in respect of the following specifications of goods:

- | | |
|-----------------|--|
| Class 09 | Computer software for business process mapping and the reporting and analysis of customer feedback. |
| Class 35 | Opinion polling; provision of business information relating to business process mapping and the reporting and analysis of customer feedback; advertising services provided via the Internet. |
| Class 42 | Industrial analysis and research services; design and development of computer software for business process mapping and the reporting and analysis of customer feedback. |

2. On 25 April 2008, Salamander Enterprises Limited filed notice of opposition to the application the grounds of opposition, in summary, being as follows:

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|------------------------------|---|
| Under Section 5(2)(b) | because the marks applied for are similar to an earlier mark and is in respect of goods or services to an earlier mark. |
| Under Section 5(3) | because the mark applied for is identical or similar to an earlier mark with a reputation. |
| Under Section 5(4)(a) | by virtue of the law of passing off. |

3. The applicants filed a counterstatement in which they deny that the respective marks are the same or similar, and consequently submit that there can be no passing off. They require that the opponents prove use of the word MOOD but only in relation to “customer feedback”. With their Counterstatement the applicant filed a Form TM21 limiting the goods and services for which the applicant’s seek registration to the following:

- Class 09** Computer software for business process mapping and the reporting and analysis of customer feedback.
- Class 35** Opinion polling; provision of business information relating to business process mapping and the reporting and analysis of customer feedback; advertising services provided via the Internet.
- Class 42** Industrial analysis and research services; design and development of computer software for business process mapping and the reporting and analysis of customer feedback.

4. Only the opponents filed evidence in these proceedings which insofar as it may be relevant I have summarised below. As the evidence for each case is identical I have only summarised one set. Neither party requested to be heard, electing instead to have the matter determined from the papers. After a careful study of the evidence I now go on to give my decision.

Opponent’s evidence in chief

5. This consists of a Witness Statement dated 13 February 2009 from Richard Whittington, Chief Technology Officer of Salamander Enterprises Limited, a position he has held since 1996. Mr Whittington says that as part of his responsibility he is involved in the technical issues within his company, and specifically, for the transformation of capital (monetary and intellectual) into information technology. Part of this role involves Mr Whittington with the commercial and financial operations of his company including market research and gathering knowledge of competitor’s products. Mr Whittington says that he was also a co-founder of Mood International Limited and The Salamander Organization Limited in the mid 1990s, these companies being wholly-owned subsidiaries of Salamander Enterprises Limited.

6. Mr Whittington states that the trade mark MOOD was first used by Mood International Limited in the UK in 1996 and subsequently extended to other territories. He also mentions the trade mark KNOWLEDGE MAP first being used by The Salamander Organization Limited in the UK in the year 2000. Both have been in continuous use.

7. Mr Whittington says that Mood International Limited was created for the development of software products under the MOOD trade mark but has become a marketing vehicle. Exhibit RW1 consists of prints from the websites of Salamander. The exhibit mentions MOOD in connection with business architecture as live operational and management systems throughout the web...providing connectivity across the programme, with online

access to a range of applications and systems. MOOD is also referred to as “The Mood platform...improving the consistency and ease of use of performance reporting...” and as “software from Salamander” shown with the symbol ®. Mood is mentioned in various forms such as MOOD TECHNOLOGY, MOOD Toolset, MOOD SOA. An extract from Waybackmachine, an internet archive site confirms the existence of www.tsorg.com from 3 March 2000, with pages from the archive dating from 2001 showing MOOD being used in conjunction with a globe logo and the ® symbol, and the statement “The toolset is powered by Mood ®.”

8. One page sets out the history of Salamander from its formation in 1996 with the goal to excel in “management techniques, in advanced technologies for managing enterprise architecture and in delivering transformation ...” Profiles of company officers confirm Mr Whittington’s involvement as co-founder of MOOD and Salamander in the mid 1990s. Mr Whittington describes the goods and services sold under the MOOD as a suite of software products including MOOD Business Architect, MOOD Business Integration Server and MOOD Repository Manager, confirming that these have been sold in the UK for more than 12 years.

9. Mr Whittington refers to a product M4 which he describes as the “MODAF Methodology Managed in MOOD”, a software framework which has been widely accepted across the UK Defence Sector as a standard framework.” This is mentioned in the pages of Exhibit RW1. Exhibit RW2 consists of brochures that mention MOOD Enterprise Business Model, the M4 – Modaf Methodology Managed in Mood”, the MOOD Blueprint, Mood Transformation Toolset, Mood Technology, Mood Enterprise Solutions, Mood Business Architect, etc. The exhibit also includes marketing leaflets mentioning Mood Technology. Although none of the exhibit is dated, Mr Whittaker says that the exhibit shows “...typical examples of the way in which the trade mark has been used since its introduction.”

10. Mr Whittington next mentions the trade mark KNOWLEDGE MAP saying that this is used by his company to refer to business models generated and published using MOOD branded software and as a vehicle for a range of marketing activities relating to MOOD software products. He says that some of these marketing activities are detailed on the website www.knowledgemap.co.uk details of which are shown as Exhibit RW3. This consists of prints taken on 11 February 2009. The welcome page contains the MOOD and globe logo with Mood Technology above, but apart from this relates to KNOWLEDGEMAP. Exhibit RW4 is provided as evidence of the use of KNOWLEDGEMAP and MOOD, and includes:

Article dating from 21 August 2007 entitled Business Modelling For CxOs. This contains a paragraph referring to Salamander providing a methodology and tool for organizational transformation delivered through its MOOD software.

Article dated 3 January 2008 entitled Enterprise architecture tools overview. Under the heading “Five main tool providers” this mentions, amongst others, “Salamander with Mood”. An overview of Salamander – Mood Transformational

Toolset refers to Salamander having been founded in 1996 and a claim of “200 implementations of Mood...”

Case Study entitled “U.K. Ministry of Defence and Defense Industry Cooperate to Define a Future Information Architecture to Transform Defense Supply Chains” published on 11 December 2006. Under Support Domain Map/Support Options Matrix Mapping the paper refers to “...high level mapping within the Mood model of the logistics functions and services to the various support domains and support options”.

Magazines entitled INSIGHT dating from 2005 (noted as Issue3) and Spring 2007 published by The Salamander Organization for its customers, partners and suppliers. These set out details of MOOD, and case studies relating to the use MOOD by customers. The later issue mentions the Mood Transformation Technology having achieved TOGAF 8 certification.

Medallists of the Technology Awards 2005 listing the Mood Transformation Toolset.

Presentations by Dr Dick Whittington to The Open Group to the IT Architecture Practitioners’ Conference Europe 2005 entitled “Exploiting architecture methods and tools to deliver business benefit; Using the Mood transformation toolset in complex defence programmes.”

11. Mr Whittington gives details of the turnover for goods and services under MOOD in the years 1998 to 2008:

Year	Turnover in Pounds Sterling
2008	12 million
2007	9 million
2006	6 million
2005	5 million
2004	3.8 million
2003	3 million
2002	2.2 million
2001	0.9 million
2000	0.5 million
1999	0.4 million
1998	0.4 million

12. Mr Whittington next gives the approximate amounts spent on advertising MOOD in the UK

Year	Advertising expenditure in Pounds Sterling
2008	350,000
2007	300,000
2006	250,000

2005	200,000
2004	150,000
2003	100,000
2002	50,000
2001	50,000
2000	50,000
1999	50,000

13. Mr Whittington says that the MOOD and KNOWLEDGE MAP trade marks are also promoted by word of mouth via presentations, sponsorship of events and exhibitions at national and international conferences. He mentions various events which, apart from The Open Group EA Practitioners Conference in Lisbon and London in November and December 2006, respectively, occurred after the relevant date or are not dated. Mr Whittington says that the events held outside of the UK would have been attended by representatives from the UK.

14. Exhibit RW5 consists of the results of a search on Google on 11 February 2009 for MOOD, MOOD Technology and Salamander Enterprises Limited.

15. That completes my summary of the evidence insofar as it may be relevant to these proceedings.

Decision

16. The opponents rely on one earlier mark No. 2108133 for a series of two marks: MOOD and Mood. This achieved registration on 1 April 1997 which being more than five years prior to the relevant date in these proceedings means that the Trade Marks (Proof of Use, etc) Regulations 2004 apply. This provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(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, ...

(5) ...

(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...”

17. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

18. The opponents claim use in respect of all goods and services for which their earlier mark is registered, namely:

Class 09 Computer software for business management, business development and business organisation; but not relating to publicity or advertising services.

Class 35 Advisory and consultancy services relating to business management, business development and business organisation; business planning services; business research services; business appraisal services; compilation and provision of business information; preparation and writing of business reports;

information and advisory services, all relating to the above; but not including publicity or advertising services.

19. The requirements for “genuine use” have been set out by the European Court of Justice (“the ECJ”) in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2005] ETMR 114.

20. In *Ansul*, the ECJ held as follows:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such 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...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

21. In *La Mer* the ECJ held as follows:

21. ... it is clear from paragraph [39] of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive even if that use is not quantitatively significant. Even minimal use can therefore

be sufficient to qualify as genuine, on condition that it is deemed justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case by case assessment which it is for the national court to carry out....

...

25. In those circumstances it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.”

22. As I have previously said, the applicants require the opponents to prove use of the word MOOD/MooD but only in relation to “customer feedback”. They have not challenged that there has been use of MOOD/MooD in respect of any other goods or services for which the earlier mark is registered. Consequently I will restrict my consideration of the opponent’s use solely to determining whether there has been use of MOOD/MooD in relation “customer feedback”. Before going on to determine whether there is any genuine use I must first be clear what the applicant’s mean by “customer feedback”.

23. An application to register a trade mark must be made in relation to specified products and/or services. As a service “customer feedback” most likely relates to the provision of information on the business activity, most probably to enable it to assess its performance in relation to customer expectations, or to assist a business in its management and/or development. It may be provided at the customer’s own volition, or obtained through a formal research. There is no mention of “customer feedback” in the specifications of the opponent’s earlier mark. However, such an activity would seem to be covered by the services in Class 35, in particular in the terms “business research services” and “compilation of business information”. The item “computer software for business management” listed in Class 9 of the earlier mark is similarly capable of describing a system that enables customers to provide feedback, and in the compilation and analysis of the data received.

24. Having determined that goods and/or services that may relate to “customer feedback” are covered by the opponent’s earlier mark, the next question is whether the opponent’s have used MOOD/MooD in this area. The evidence provided by Mr Whittington describes MOOD/MooD as a suite of software products, and for purposes such as “management techniques in advanced technologies for managing enterprise architecture and in delivering transformation ...” which may well incorporate a mechanism for reporting but connected to the performance of the system. There is nothing that I can see that relates to goods or services for the purpose of enabling customer feedback.

25. With my findings in relation to the proof of use in mind I will now go on to consider the substantive issues of the opposition. The first ground is under Section 5(2)(b). That section reads as follows:

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

(a) ...

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

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

26. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

27. Turning first to consider the similarity or otherwise of the respective marks. The applicant seeks to register two word marks MOODMETER and MOOD MAP, in both cases with the initial letter M in upper case with all other letters in lower. The opponent's earlier mark consists of the word MOOD in two forms, the first entirely in upper case, the second with the letters M and D in upper case with the intervening letters "o" in lower. For the record I do not consider this mode of representation to change the fact that it is the word MOOD or the likely perception of this by the relevant consumer. Self-evidently the applicant's marks encompass the entirety of the opponent's earlier mark, but that, of itself does not necessarily make them similar.

28. MOOD is an ordinary word in common use in the English language, to most recognisable as a reference to a state of mind, atmosphere, temper or feeling, and much less so as a category of verb or verbal inflection that expresses semantic and grammatical

differences. Neither meaning is a direct or obvious reference to the nature, quality or any other characteristic of the goods or services of the earlier mark: it is a word with a strong distinctive character.

29. The applicants have not said how they came to adopt the mark but to me it seems likely that MOOD was selected as reference to the goods and services for which it is used. These are primarily concerned with obtaining opinions and views, or in other words “moods” on the perceptions of goods and services received. Although I have equated “moods” to “views” and “opinions” the use of “moods” in such a context is an allusory reference rather than direct or apt. The suffix words “METER” and particularly “MAP” (mapping is mentioned in the specification) are both descriptive of a characteristic of the goods and services for which the applicants seek registration, namely that they are for the reporting, analysis and mapping of views, opinions or feedback, in the latter case as a diagrammatical model of this information. In the context of the goods and services these words have a reasonably obvious descriptive meaning that would be well known to the relevant consumer.

30. Looking at the respective marks from a visual perspective. Insofar as these all consist of or contain the word MOOD there must be a degree of similarity to the eye, but self evidently, the additional elements in the applicant’s marks must mean that they are not identical. The opponent’s marks can only be seen as the word MOOD; I have already said that I do not consider the mode in which the second mark is represented affects this. In the applicant’s mark MOOD MAP the word MOOD is the first (a positioning generally accepted as having most significance) and most distinctive element, which fixes the attention of the eye. I consider this mark to be visually similar to the opponent’s earlier mark.

31. Although also containing MOOD as its first element, being a portmanteau word the position is a little less clear in respect of the applicant’s mark MOODMETER. To my mind the fact that the mark is constructed from the joining of two separate and well known words will be reasonably obvious to the relevant consumer. The eye readily picks this out, probably because the joining point of the D in MOOD and M in METER are unusual in combination. Adding my views on the distinctiveness of the elements I reach the conclusion that this mark is also visually similar to the opponent’s earlier mark.

32. The factors expressed in my consideration of whether there is visual similarity also impact upon the determination of whether the respective marks are aurally similar; namely; the commonality of the word MOOD, this being the first and a separated element (actual and perceived) of the applicant’s marks. MOOD will have the significant influence on how the marks sound when spoken. My view is that the marks are also aurally similar to a significant extent.

33. That MOOD is part of the applicant’s marks must mean that there is the potential for them to convey the same idea as the opponent’s mark consisting of MOOD on its own. The question is whether the additional elements of the applicant’s marks are likely to change the message. To the relevant consumer the word MOOD on its own will most

likely convey the idea of ambience, or more likely, a state of mind, good or bad. As I have already said, the suffix words METER or MAP are words that relate to some characteristic of the goods and/or services in that they create the idea of something that can measure or record but with the focus remaining connected with the core MOOD idea. I consider the marks to be similar in their concept.

34. The established tests in assessing the similarity or otherwise of goods and services is set out in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v.Metro-Goldwyn-Mayer*. I must consider the uses and users of the respective goods or services, the physical nature of the goods or acts of service, the trade and distribution channels through which they reach the market. In the case of self-serve consumer items this will also include consideration of where the respective goods are likely to be found, particularly in multi product outlets such as supermarkets. The extent to which the respective goods or services are competitive or complementary is also a relevant consideration guided by how they are classified in trade, and known by the relevant consumer.

35. I have already considered and determined the question of the opponent's use in relation to customer feedback and must keep this in mind, but as this is the extent to which the applicants required proof of use I can take all other goods and services into account.

36. Following their limitation of the application, the applicant seeks registration in respect the following goods and services:

- Class 09** Computer software for business process mapping and the reporting and analysis of customer feedback.

- Class 35** Opinion polling; provision of business information relating to business process mapping and the reporting and analysis of customer feedback; advertising services provided via the Internet.

- Class 42** Industrial analysis and research services; design and development of computer software for business process mapping and the reporting and analysis of customer feedback.

37. The opponent's earlier mark also includes Class 9, in their case also encompassing "computer software" but for "business management, business development and business organisation." There is an exclusion of software relating to publicity or advertising services. In *Mercury Communications Limited v Mercury Interactive (UK) Limited* [1995] FSR 850, Laddie J held that defining characteristic of "computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs".

38. On its face this seems to be saying that where two potentially conflicting marks both cover software for distinct applications or as an operating system rather than an application, these may not be regarded as similar enough to cause confusion. This must be taken in the

context of the issue being considered in the *Mercury* case which was at the breadth of protection afforded by a specification for computer software at large. Laddie J was not stating that software for different purposes cannot be similar. There will be situations where the types of software and/or their uses are so distant that although they are identical to the extent that they are software, they cannot be considered to be similar. Conversely, there will be situations where the nature and purpose of two types of software, whilst not being the same, is sufficiently related to be taken as being similar. I mention this simply to set the scene.

39. In the case in hand, both specifications contain software so are clearly of the same nature. They are both for business use which to my mind makes it very likely that the users will be the same. The applicant's software is for "process mapping" and the reporting and analysis of customer feedback" whereas the opponent's is for "management, development and organisation." By its usual and ordinary meaning, "business management" must encompass all aspects of managing a business which is quite capable of including "business process mapping". Software for reporting and analysing customer feedback deals with one aspect of processing business related information. Business management by its nature involves the handling of customer information for a number of reasons, and from a variety of sources and not necessarily directly from customers, for example, the impact of advertising, competitor sales activity, the demographics of customers, etc. So taking account that goods for customer feedback are excluded from the consideration, on its face the purposes of the respective goods are the same and/or similar, and either in direct competition, or at the very least complementary to each other.

40. Software of this type is specialised in its use and most likely will be provided to a knowledgeable and informed end user. Given that both types of software are for use in business activities I see no reason why the relevant consumer should not believe that they have originated from the same source.

41. IT goods reach the market in a number of ways, occasionally directly from the manufacturer /creator but in my experience more usually through a retailer selling a range of hardware and/or software products from a variety of sources. I am also aware that when on sale software will be displayed by use or application, so business software will be grouped together and even when for different purposes will be located in close proximity. Users of such goods will be well used to making a choice from a selection of providers.

42. Taking all of the above into account I reach the view that all of the goods of Class 9 of the application are the same as or similar to the goods in Class 9 of the earlier mark.

43. The opponent's earlier mark and the applicant's marks also have Class 35 in common. The application lists the "provision of business information relating to business process mapping and the reporting and analysis of customer feedback". This, in my view corresponds to the service of "compilation and provision of business information" contained in the specification of the opponent's earlier mark. For the same reasons that I

gave in respect of the software, I do not consider that removing “customer feedback” from the scope of the opponent’s specification has the effect of separating the services. In my view very similar services remain.

44. The opponent’s specification for Class 35 excludes “publicity or advertising services” which means that there is no conflict with the “advertising services provided via the Internet” contained within the application. This leaves the service of “opinion polling”. Whilst information from such an activity may originate from customers and be used by a business, it is not in the ordinary sense an activity that would be carried out in business management, development, planning, research, appraisal, or in the preparation and writing of business reports. Opinion polling is not what is usually described by the term “customer feedback” and I consider it to be a service distinct from those for which the earlier mark is registered.

45. This leaves the specification in Class 42 of the application. The opponent’s earlier mark does not include this class so the question is whether any of their goods and services in Classes 9 or 35 are the same or similar. The applications firstly seek registration in respect of “industrial analysis and research services”. Whilst this may be carried out by, or provided as a service to a business, it is not a business service in the sense of being connected to the running of the business. It may be of the same physical nature as business analysis and research and potentially supplied to the same end user, but such a service is different in its purpose. It is neither competitive nor complementary to service for the management of a business.

46. The same cannot be said of the remainder of the specification which is concerned with services for the “design and development of computer software for business process mapping and the reporting and analysis of customer feedback”. Earlier in my decision I found the applicant’s software in Class 9 to be similar to the software covered by the corresponding class of the earlier mark. Their services in Class 42 are for the same purpose as their software goods, and for the same reasons, the only difference being that this is the provision of bespoke, perhaps delivered by a programmer, rather than off-the-shelf software. I consider these services to be similar to the software in Class 9 of the earlier mark.

47. The opponents say that the trade mark MOOD/MooD was first used by Mood International Limited, a wholly-owned subsidiary of the opponents. There is a small inconsistency in the date of first use given by Mr Whittington. He initially states this to be 1996 but later mentions it being 12 years which given the date of his Statement is 2009 would place it as having commenced in 1997. The latter date is consistent with the turnover figures which date from 1998, but whether the date of first use is 1996 or 1997 nothing turns on this. The earliest documented use can be found in the extract from Waybackmachine which refers to use of MOOD in 2000 – 2001, in a logo and as a word alone, both accompanied by the “Registered” symbol. The applicants do not question the date of first use claimed or that the opponent’s have the rights to the benefit of this use. In fact, apart from requiring proof of use in respect of “customer feedback” they do not challenge any of the opponent’s evidence or the claims made. Therefore, on the basis

of the guidance provided by Mr Richard Arnold Q.C. (as he was) when acting as the Appointed Person in *Extreme O/161/07*, I shall take the evidence at face value based on its likely credibility.

48. Mr Whittington describes the goods and services sold under MOOD as a suite of software products including MOOD Business Architect, MOOD Business Integration Server and MOOD Repository Manager. The opponent's website describes Salamander's goal as being to excel in "management techniques in advanced technologies for managing enterprise architecture and in delivering transformation ...". Other parts of the evidence mention MOOD in connection with "business architecture as live operational and management systems throughout the web...providing connectivity across the programme, with online access to a range of applications and systems." MOOD is also referred to as "The Mood platform...improving the consistency and ease of use of performance reporting...".

49. The opponent's use of MOOD/MooD has been in a logo form but to a significant extent as a word on its own. They have also used it in various other forms such as MOOD TECHNOLOGY, MOOD Toolset, MOOD SOA although the opponent's have not relied upon this.

50. Details of turnover and advertising have been provided although no information that would enable me to put this into the context of the market. An article dated 3 January 2008 entitled Enterprise architecture tools overview contains a list of "Five main tool providers", and mentions there having been "200 implementations of Mood..." but again without knowing more about the size of the market I cannot assess what this means. Even so, taking that their trade appears to be in a specialised area it does not seem unreasonable to say that on its face the use appears to be significant. It has also taken place over about a decade. Taken together I do not consider it unreasonable to infer that their use of MOOD/MooD has been of a scale likely to create an impact on the market and the relevant consumer. I am bolstered in this by the details of the contracts with some high-profile and prestigious organisations, participation in industry events, and the success of the Mood Transformation Toolset in the Technology Awards 2005.

51. I therefore consider it reasonable to accept that the opponents have established a reputation under the name MOOD in respect of services and software for delivering "advanced technologies for managing enterprise architecture and in delivering transformation ...". Whilst this reputation is in respect of goods and services contained within the scope of the earlier mark, it is considerably narrower. It may add to the equation when considering the similarity of the marks but not to the extent of any similarity found in the respective specifications.

52. In summary, the words METER and MAP do not occupy an independent distinctive role in the applicant's mark, nor do they change the distinctive character of MOOD which I have found to be the distinctive and dominant element. Added to other factors such as the identity of the goods and services, channels of trade and consumer, the opponent's reputation and adopting the global approach advocated, I take the view that

use of the marks applied for in respect of the following goods and services will lead the consumer to believe that the respective goods and services originate from the opponent's or some linked undertakings:

- Class 09** Computer software for business process mapping and the reporting and analysis of customer feedback.
- Class 35** Provision of business information relating to business process mapping and the reporting and analysis of customer feedback.
- Class 42** Design and development of computer software for business process mapping and the reporting and analysis of customer feedback.

53. There is a likelihood of confusion in respect of these goods and services, particularly after taking into account the possibility of imperfect recollection. The opposition under Section 5(2)(b) succeeds in respect of these goods and services, but fails in respect of:

- Class 35** Opinion polling; advertising services provided via the Internet.
- Class 42** Industrial analysis and research services.

54. My decision under Section 5(2)(b) effectively decides the matter, that is unless the opponents have established a reputation and/or goodwill that could be damaged or taken unfair advantage of by the applicant's use of Moodmeter/Mood map in relation to the services in Class 35 and 42. These are the services where I do not consider there to be a likelihood of confusion, namely, "opinion polling and advertising services provided via the Internet" and "industrial analysis and research services." Section 5(4)(a) of the Act. That section reads as follows:

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)

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

55. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation."

56. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472).

Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur."

57. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced, as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429. As there is no evidence that the applicants have ever used the mark applied for, the relevant date for the purpose of these proceedings should be regarded as the date of application, that is, 22 May 2007.

58. In my assessment of the ground under Section 5(2)(b) I came to the view that at the relevant date (which is the same under this and the earlier ground) the opponents had established a reputation under the name MOOD in respect of services and software for delivering “advanced technologies for managing enterprise architecture and in delivering transformation ...”. I see no reason why they should not also have accrued goodwill in the same.

59. This leads on to the question of misrepresentation. The general principle is that it is not permissible to represent one business in such a way that it will lead to the belief that it is connected to another in any way that is likely, in reality, to lead to damage the other business. In *Harrods Ltd. v. Harrodian School Ltd.* case [1996] R.P.C. 687, Millet L.J. explained the position as follows:

“In its classic form the misrepresentation which gave rise to an action for passing off was an implied representation by the defendant that his goods were the goods of the plaintiff, but by the beginning of the present century the tort had been extended beyond this. As Lord Diplock explained in the *Advocaat* case [1979] A.C. 732 at pages 741-2, it came to include the case ‘where although the plaintiff and the defendant were not competing traders in the same line of business, a false suggestion by the defendant that their businesses were connected with one another would damage the reputation and this the goodwill of the plaintiff’s business.

60. He went on to say that it is not necessary to prove that the defendant’s (applicant’s) goods will actually be mistaken for those of the claimant (opponent) if the relevant public would take the defendant’s products as something for which the claimant had made himself responsible.

61. I have already given my reasons why I consider the respective marks to be similar and I need not say any more about this. There is no requirement that the applicant be carrying on a business which competes with that of the opponent or any natural extension of the opponent’s business. However, the fields of activity are an important and highly relevant consideration in deciding whether there is a likelihood of confusion among the common customers of the parties: “.whether there is any kind of association, or could be in the minds of the public, any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant”: *Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabels Escort Agency)* [1972] R.P.C. 838 at page 844 *per Russell L.J.* 3Q.

62. Whilst the opponents do not have to prove actual damage to their goodwill in order to succeed in an action for passing off, there will be no cause of action where there is no damage or prospect of damage to the goodwill of the claimant’s business. As Buckley LJ stated in *Bulmer (HP) Ltd v J Bollinger SA* [1978] R.P.C. 79:

“It is well settled that the plaintiff in a passing-off action does not have to prove that he has actually suffered damage by loss of business or in any other way. A probability of damage is enough, but the actual or probable damage must be

damage to him in his trade or business, that is to say, damage to the goodwill in respect of that trade or business”.

63. Confusion, particularly in the sense of the public not distinguishing the services of the applicant and the opponent is not necessarily indicative of an action for passing off. Confusion may arise whether or not there has been a misrepresentation, but it may not be damaging to the claimant. See *County Sound plc v Ocean Sound Ltd* [1990] F.S.R. 367 CA. In *Barnsley Brewery Co Ltd v RBNB* [1997] F.S.R. 462 Robert Walker J stated:

“There must be deception, whether intentional or unintentional. If there is no deception, mere confusion or the likelihood of confusion is not sufficient to give a cause of action”.

64. I must bear in mind that although the opponent and the applicant may not be in competition with each other, it is still possible for there to be damage. According to Warrington LJ in *Ewing v Buttercup Margarine Co Ltd* [1917] 34 R.P.C. 232:

“To induce the belief that my business is a branch of another man’s business may do that other man damage in all kinds of ways. The quality of goods I sell; the kind of business I do; the credit or otherwise which I might enjoy – all those things may immensely injure the other man who is assumed wrongly to be associate with me”.

65. My determination of the ground under Section 5(2)(b) has removed the goods and services from the applications that I consider to be either the same or similar to those of the earlier mark. The services remaining in the application are, in my view activities that exist in a different market sector to that in which the opponent’s reputation/goodwill exists. The purposes of the services are different. Whilst I do not have any information as to how the relevant market segments, I consider the services of “opinion polling”, “advertising services provided via the Internet” and “industrial analysis and research services” to be sufficiently distinct from those for which the opponents have a goodwill and reputation such that there is no real likelihood of any connection that could lead to deception. In the circumstances of this case I consider the ground under Section 5(4)(a) does not add anything to my findings under Section 5(2)(b) and is dismissed.

66. The remaining ground is under Section 5(3) which reads as follows:

5.- (3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

67. The standard test for the sort of reputation that is needed to underpin a Section 5(3) action is set out in *General Motors Corp v Yplon SA* [2000] R.P.C. 572. In this case the Court concluded that the requirement implies a certain degree of knowledge amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it. From this it can be seen that in a similar way as the previous ground, the foundation of an objection under Section 5(3) is the reputation acquired by a mark through its use.

68. I have already said that I consider the respective marks to be similar (and why) so the first hurdle has been cleared. I have also explained why, in my view, the opponents can be accepted as possessing a reputation under the name MOOD in respect of services and software for delivering “advanced technologies for managing enterprise architecture and in delivering transformation ...”

69. In the context of an objection under Section 5(3), establishing the significance of any reputation forms a cornerstone in the relevant consideration of whether the applicant’s use of a similar mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark, taking into account the question of “due cause”. It is here that the lack of detail hits home, particularly in being able to gauge the extent of any reputation. I have some information on turnover and advertising and there having been 200 implementations of Mood, but nothing much about the market in which the opponent’s operate. I have nothing that informs me on the intensity, geographical extent and duration of their use. In the context of Section 5(2)(b) where reputation is but one “factor” in the assessment I felt able to infer that the opponents had made use on a scale likely to create an impact on the market, particularly bearing in mind the specialised nature of the goods and services. However, I am not able to say with any degree of certainty that the opponent’s earlier mark is known by a significant part of the relevant sectors of the public, and I do not consider it to be right to infer this by filling in the gaps. I therefore dismiss the ground under Section 5(3).

70. In summary, the opposition succeeds under Section 5(2)(b) in respect of:

- | | |
|-----------------|---|
| Class 09 | Computer software for business process mapping and the reporting and analysis of customer feedback. |
| Class 35 | Provision of business information relating to business process mapping and the reporting and analysis of customer feedback. |
| Class 42 | Design and development of computer software for business process mapping and the reporting and analysis of customer feedback. |

but fails in respect of:

Class 35 Opinion polling; advertising services provided via the Internet.

Class 42 Industrial analysis and research services.

and the application is free to proceed in respect of these services.

71. The opponents sought to prevent registration of the application in its entirety so have succeeded in part. The applicants in turn limited the scope of the registration in an attempt to avoid the objection; they also succeeded in part. On this basis I do not consider it appropriate to make an award of costs.

Dated this 14th day of October 2009

**Mike Foley
for the Registrar
the Comptroller-General**