

**O/336/12**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2566887  
BY LOGIC COMMUNICATIONS LIMITED  
TO REGISTER THE TRADE MARK**



**IN CLASSES 9, 16, 37, 38 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 101947 BY  
THE LOGIC GROUP ENTERPRISES LIMITED**

## BACKGROUND

1) On 13 December 2010 Logic Communications Limited (hereinafter the applicant), applied to register the following trade mark:



2) In respect of the following goods:

In Class 9: Apparatus for recording, transmission or reproduction of sound and images; vocal interaction telephone apparatus also provided with automatic delivery of calls; telephone magnetic cards; machines and mechanism for coin-operated apparatus; calculating machines and data processing equipment; electric apparatus and instruments all for use in telecommunications, optical, signalling, checking apparatus and instruments; apparatus for recording, transmission or reproduction of sound and/or images; magnetic data carriers, recording discs; calculating machines, data processing equipment and computers; computer programs; cards, wires, disks and semiconductor devices carrying computer programs; telecommunications apparatus, instruments, networks and circuitry; cables, cable systems, optical fibres, optical links, all for telecommunications; and parts and fittings for all the aforesaid goods.

In Class 16: Printed matter, newsletters, magazines, directories, brochures, leaflets, cards, stationery, paper and cardboard; photographs, instructional and teaching material; plastic materials for packaging; cards in the form of debit cards, credit cards, charge cards and telephone cards.

In Class 37: Construction and repair services relating to telecommunications facilities and equipment; installation, maintenance and repair services for telecommunications cables, wiring, facilities and equipment; underground, overhead and underwater construction, installation, maintenance and repair; cable splicing services; wiring; maintenance and repair of computer hardware consultancy, information and advisory services relating to the aforementioned services; information services relating to installation of security systems.

In Class 38: Telecommunication services; telecommunications services provided via the Internet; providing telecommunication connections to a global computer network; providing user access to the Internet or to a global computer network; telecommunication of information (including Web pages), computer programs and any other data; telecommunication access services; interactive electronic communication services; communication services over telecommunication networks, computer networks and fibre networks; provision of world-wide web facilities and structures; communication services by satellite, fibre-optic and

computer terminal networks; computer-aided message services; leasing and rental services in connection with communications apparatus and equipment; services for the establishment and exploitation of telecommunications; recording transmission, or reproduction of sound or images; broadcasting and transmission of radio, televisions and cable programmes; video conferencing; cable television broadcasting; telecommunication of home shopping services; providing access to electronic data, databases, bulletin boards and publications on remote computers or via computer networks; advisory, information, consultancy services relating to the aforementioned; voice, text, facsimile, video and data telecommunications services; frame relay telecommunications services; data packet switched services; teleconferencing services; private line telecommunications services; integrated services digital network (ISDN) telecommunications services; transmission of voice, text, facsimile, video and data; communications services allowing a phone number embodying a code to be dialled which then makes the call free to the dialler with the bill being for the recipient; switched voice, data, video and multimedia services; asynchronous transfer mode (ATM) services; providing connection and access to the public switched telephone network; operator and directory services; providing connections to private telecommunication networks; pay telephone services; collocation services for telecommunications apparatus and servers; providing back bone telecommunications services to others; delivery of data on or from computer networks, consultancy information and advisory services relating to the aforementioned services.

In Class 42: Scientific and industrial research services; technical project studies; computer services; computer programming; advisory services relating to computer based information systems; consulting services in the field of telecommunications; engineering design services; computer rental; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information provided on-line from a computer database or from the Internet; searching and retrieving information; hosting of websites on or from computer networks; creating and maintaining websites; hosting the Websites of others; disaster recovery services for data communications and computer systems; development of computer software application solutions; installation and maintenance of computer software; hosting the Websites of others; disaster recovery services for data communications and computer systems; development of computer software application solutions; installation and maintenance of computer software; creating indexes of information, data, sites and other resources on computer networks; leasing access time to a computer database.

3) The application was examined and accepted, and subsequently published for opposition purposes on 18 February 2011 in Trade Marks Journal No.6875.

4) On 17 May 2011, The Logic Group Enterprises Limited, (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Number	Mark	Filing and Registration Date	Class	Specification
CTM 1226620	THE LOGIC GROUP	01.07.1999 / 29.03.2005	9	Computers, and electronic apparatus being peripheral equipment for use with computers; electronic apparatus for encoding, reading or verifying encoded cards or data carriers in the nature of cards; cards and data carriers in the nature of cards; electronic apparatus for the storage, handling, switching or transmission of video or of data; parts and fittings for all the aforesaid goods; software.
			42	Consultancy services in the field of computer hardware, computer programming, or computer software; computer programming, computer software design and updating; provision of research and consultancy services in the field of computers, computer software, and information technology.

- b) The opponent relies upon the mark above for its opposition under section 5(2)(b). It contends that the marks of both parties share the same dominant element, namely the word LOGIC, and that both marks would be perceived and referred to by this single word. As a result the marks are visually, orally and conceptually similar. The opponent also contends that the goods and services are identical or similar and that there is a high risk of confusion.
- c) In relation to its opposition under section 5(3), the opponent contends that its mark has been used extensively in the UK and that it has built up a substantial reputation and goodwill. It claims that use of the mark in suit would ride on the back of its reputation and as a result it would lose custom as a result of unfair advantage being taken without due cause. The opponent would have no control over the quality of the goods or services provided under the mark in suit and these goods and services would be assumed by the average consumer to be from the opponent or from a company associated with the opponent.
- 5) On 26 July 2011, the applicant filed a counterstatement which denied the opponent's claims. The applicant put the opponent to strict proof of use in respect of the goods and services for which its mark is registered.
- 6) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 29 August 2012. At the hearing, the opponent was represented by Mr Kelly of Messrs Alexander Ramage Associates LLP; the applicant

was not represented but supplied written submissions which I shall take into account as and when required in my decision.

## **OPPONENT'S EVIDENCE**

7) The opponent filed a witness statement, dated 10 November 2011, by Gareth Wokes the Chairman of the opponent. He states that his company was incorporated in 1985 and that since 1989 has been providing trusted payment and loyalty solutions and is now an established market leader in these goods and services. He states that all the goods and services sold by his company are provided under and by reference to the trade mark THE LOGIC GROUP. He provides the following approximate figures for turnover under this mark in the UK:

Financial Year	£ million
2007-08	17.2
2008-09	17.6
2009-10	17.5

8) Mr Wokes states:

“My company provides multi-channel card payment solutions which allow our customers to take a myriad of payment types across all channels in a secure, scalable and flexible manner. My company also provides customer loyalty solutions maximising the benefits of a robust and flexible loyalty database which enables the clients to reap the benefits of a customer loyalty programme. My company also provides solutions in relation to security, fraud, and risk management to help our clients protect their business and enable them to implement and maintain a secure and compliant information environment which evolves in line with regulatory change. My company also provides information, management and insight solutions which assist organisations to derive the maximum benefit from their data. The solutions combine strategic consulting, business intelligence and data analytics in order to deliver insights into customer behaviour and to minimise the risk of fraud.

My company has, in my belief, built up a substantial reputation and goodwill in respect of the goods and services provided under and by reference to the trade mark THE LOGIC GROUP.”

## **APPLICANT'S EVIDENCE**

9) The applicant provided a witness statement, dated 28 February 2012, by Jeffrey Parker their Trade Mark Attorney. Mr Parker states that there are several hundred companies upon the Companies House register whose names begin with the word LOGIC but he did not print them out as the format made it unfeasible. He also claims to have counted the number of owners of trade marks on the UK-IPO records whose

names begin with LOGIC and found there to be exactly one hundred. He provides, but does not comment upon, the following exhibits:

- JP1: A copy of the entry in the Wikipedia encyclopedia regarding LOGIC which covers eighteen pages. Mr Parker does not comment on any particular aspect of this entry so I shall simply note that it states that logic is “studied primarily in the disciplines of philosophy, mathematics, semantics and computer science”.
- JP2: A list of registered trade marks on the IPO Register which contain the word “logic” and which have the word “computer/s” or “software” in their Class 9 or 42 specifications. I note that the list of marks includes, inter alia, “Logica”, “Teleologic”, “Logicare”, “Logical” and “Logicall” in addition to marks with device elements etc. There are fifty seven marks on the list which was compiled on 28 February 2012.
- JP3: A list of registered trade marks on the OHIM Register which contain the word “logic” and which have the word “computer/s” or “software” in their Class 9 or 42 specifications. I note that the list of marks includes, inter alia, “Logiciel”, “Logica”, “Logico”, “Logicalis”, “Logicube”, “Logicold”, “logi.cals”, “Logicacmg” and “Logictivity” in addition to marks with device elements etc. There are eighty six marks on the list which was compiled on 28 February 2012.
- JP4: He provides details of fifteen UK and OHIM registered marks which consist of the word “LOGIC”. These are owned by companies from all parts of the world. He also includes copies of these companies’ web pages as of 28 February 2012 which he states in his statement shows use of the relevant trade mark.

## **OPPONENT’S EVIDENCE IN REPLY**

10) The opponent filed a witness statement, dated 16 April 2012, by Paul John Kelly, their Trade Mark Attorney. He points out that Wikipedia can be edited by anyone, that because marks are on a register does not mean they are in use, the circumstances behind each mark’s acceptance is not known and the evidence of use provided does not show trade mark use and in any case post dates the application date and as such is not relevant.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

12) I will first consider the ground of opposition under Section 5(2)(b) of the Act which reads:

“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.”

13) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

14) The opponent is relying upon its trade mark CTM 1226620 which is clearly an earlier trade mark. Given the interplay between the dates that the opponent’s mark was registered, 29 March 2005, and the date that the applicant’s mark was published, 18 February 2011, the opponent’s mark is subject to proof of use as per The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases 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 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, 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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

15) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. In the instant case the publication date of the application was 18 February 2011, therefore the relevant period for the proof of use is 19 February 2006-18 February 2011. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);



- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

16) CTM 1226620 is registered for the following goods and services:

In Class 9: Computers, and electronic apparatus being peripheral equipment for use with computers; electronic apparatus for encoding, reading or verifying encoded cards or data carriers in the nature of cards; cards and data carriers in the nature of cards; electronic apparatus for the storage, handling, switching or transmission of video or of data; parts and fittings for all the aforesaid goods; software.

In Class 42: Consultancy services in the field of computer hardware, computer programming, or computer software; computer programming, computer software design and updating; provision of research and consultancy services in the field of computers, computer software, and information technology.

17) The applicant contends that the opponent has not shown actual use of its mark in relation to the goods and services for which it is registered. The opponent provided

turnover figures which whilst they were said to relate to use of the opponent's mark in the UK did not specify what goods or services the mark was used upon. The opponent merely commented as follows:

“My company provides multi-channel card payment solutions which allow our customers to take a myriad of payment types across all channels in a secure, scalable and flexible manner. My company also provides customer loyalty solutions maximising the benefits of a robust and flexible loyalty database which enables the clients to reap the benefits of a customer loyalty programme. My company also provides solutions in relation to security, fraud, and risk management to help our clients protect their business and enable them to implement and maintain a secure and compliant information environment which evolves in line with regulatory change. My company also provides information, management and insight solutions which assist organisations to derive the maximum benefit from their data. The solutions combine strategic consulting, business intelligence and data analytics in order to deliver insights into customer behaviour and to minimise the risk of fraud.”

18) It is not clear from this statement which, if any, of the goods and services for which it is registered it has used its mark upon. Mr Wokes could have stated that his company supplies computer hardware and software to enable payments to be processed. The opponent could have supplied invoices, copies of advertisements or promotional material. Third parties could have been invited to comment on goods and services provided by the opponent. Despite being professionally represented it offered merely a statement which referred to “solutions” being provided. It is for the opponent to show that “on the balance of probabilities” it has used its mark in respect of the goods and services for which it is registered and for which it relies upon in this opposition. It is not for me to speculate or infer what is meant by the opponent's evidence.

19) At the hearing Mr Kelly made the following points:

“MR. KELLY: The paragraph that starts, "My company provides ...." You have reference to solutions maximising the benefits of a robust and flexible loyalty database.

THE HEARING OFFICER: Yes. Does a database have to be on a computer?

MR. KELLY: Given the nature of what we are looking at, I would suggest, yes, it does, but I do accept the general argument that you are making in the sense that it is necessary to, at the very least, come down to specific goods or services for the purposes of you determining the opposition. All I can suggest to you is that at the very least we are looking at computer-related software goods which are designed to effectively protect and secure methods of, for example, credit card payments online and systems. On that basis, at the very least, I would suggest that we are looking at a limited computer software product, which is defined by reference to card payment solutions online, in essence to protect the user, whoever they may be, from any fraud or any other element of risk when using such systems.”

AND:

“If we go back to the first line of the paragraph in question where he says, "My company provides multichannel card payment solutions which allow customers ...." et al, I would say that is getting close. I fully appreciate the points you are making and the difficulty that you are experiencing in reading this, but I would suggest that that is getting close to being akin to the goods that I have just identified. Just as a point of clarification, that is how the opponent classes his business. The paragraph that we are looking at is how it identifies itself. The name of the opponent is also Logic so, in essence, the opponent does use the Logic Group in respect of everything that it provides.”

AND:

“Once again, all I can submit to you is this. You have already explained why it is not satisfactory but, to my mind, the solutions that we are talking about, by nature of what the company says they do and provide, are software solutions that enable them to provide the periphery services around preventing fraud, for example, or any risk. That is the only thing that I can try and take you to in order to go, at the very least, to an element of use in relation to software which is covered in Class 9. Given the nature of what the opponent does, I would suggest that the word "solution" in that instance could probably not have any other meaning. That would be my submission.”

19) I do not accept these contentions. Databases are not exclusive to computers and I cannot “read into” what was said by Mr Wokes in the light of what the company does as I have not been provided with any evidence of its activities other than the less than satisfactory comments regarding the “provision of solutions”. The opponent has utterly failed to show use of its mark on any of the goods or services for which its mark is registered. It cannot be said to have satisfied the *Ajax Brandbeveiliging BV v Ansul BV* criteria. In relation to the ground of opposition under Section 5(2)(b) the opponent has not proved genuine use of its earlier trade mark and so cannot rely upon it. Consequently, the ground of opposition under Section 5(2)(b) must fail. It also stands to reason that having failed to adduce any evidence of use of its mark the opposition under Section 5(3) must also fail.

## SUMMARY

20) The opposition has failed under all grounds pleaded.

## COSTS

21) The applicant has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£300
Preparing evidence and considering the evidence of the other party	£500
TOTAL	£800

22) I order The Logic Group Enterprises Limited to pay Logic Communications Limited the sum of £800. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this        day of September 2012**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**