

O/001/18

TRADE MARKS ACT 1994

TRADE MARK APPLICATIONS 3184553 AND 3184555

BY SKILLSOFT CORPORATION

AND OPPOSITIONS 408671 & 408673 BY MR JAMIE TAYLOR

AND

TRADE MARK REGISTRATION 2427733

IN THE NAME MR JAMIE TAYLOR

AND

APPLICATION 501653 FOR REVOCATION FOR NON-USE

BY SKILLSOFT CORPORATION

Background and pleadings

1. Skillsoft Corporation (“Skillsoft”) applied to register **PERCIPIO** and **PERCIPIO BY SKILLSOFT** on 8th September 2016. The applications are numbered 3184553 and 3184555, respectively. Skillsoft claims priority from earlier filings of the marks in the USA on 2nd September 2016 (“the relevant date”).

2. The goods/services covered by the applications are:

Class 9: Computer software, namely, software to deliver educational content.

Class 41: Educational services, namely, providing instructional courses in the field of professional development and skills training; information, consultancy and advisory services relating to the aforesaid.

Class 42: Providing non-downloadable software for the purpose of delivering educational content; information, consultancy and advisory services relating to the aforesaid.

3. The applications were published for opposition purposes on 2nd December 2016.

4. The applications are opposed by Mr Jamie Taylor who is the proprietor of earlier trade mark 2427733 - **Percipio** – which was entered in the register on 12th January 2007 and covers:

Class 9: Computer software and electronic downloadable publications.

Class 38: Providing user access to a global computer network including databases.


Class 41: Providing training; providing on-line electronic publications.

Class 42: Design and development of computer software; maintaining and hosting websites.

5. Mr Taylor claims that the contested marks are identical or similar to the earlier trade mark, are to be registered for identical or similar goods/services, and there is a likelihood of confusion on the part of the public. Consequently, registration should be refused under s.5(1), s.5(2)(a) or s.5(2)(b) of the Trade Marks Act 1994 (“the Act”).

6. Additionally, Mr Taylor claims that the earlier mark has acquired a reputation in relation to all the goods/services for which it is registered and that the contested marks would, without due cause, take unfair advantage of the reputation of the earlier mark (“free-riding”) or would be detrimental to its reputation (“tarnishing”) or distinctive character (“blurring”). Consequently, registration should be refused under s.5(3) of the Act.

7. As the earlier trade mark had been registered for more than 5 years as at the date of publication of the contested marks, Mr Taylor provided the required statement of use indicating that the earlier mark had been used in relation to all the goods/services for which it is registered during the period 3rd December 2011 to 2nd December 2016 (“the second relevant period”).

8. Mr Taylor claims that PERCIPIO in word form and  have been used in the UK since 1st July 2011 in relation to:

“Computer software and electronic downloadable publications; software to enable users to create websites, web pages, downloadable PDFs, to provide online courses, information guides, evidential toolkits, all for the purpose of educating policy makers, commissioners and practitioners to make decisions based upon evidence and to enable them to provide cost-efficient and useful services. Providing user access to a global computer network including databases. Providing training; providing online electronic publications. Design and development of computer software; maintaining and hosting websites; providing non-downloadable software for the purpose of delivering educational content: software as a service; online interactive tools providing booking and vetting systems, web frameworks, standard or evidence online course and evidence tracking systems, interactive social mobility maps, toolkits, eLearning, online courses, schools databases, eLearning and assessment platforms, graphing tools. Information, consultancy and advisory services in respect of all of the above goods and services.”

9. According to Mr Taylor, he has acquired goodwill in a business identified by the above marks. Further, use of the contested marks would amount to a

misrepresentation to the public which would damage his goodwill. Therefore, registration of the contested marks should also be refused under s.5(4)(a) of the Act on the basis of his rights under the law of passing off.

10. Skillsoft filed counterstatements denying the grounds of opposition and putting Mr Taylor to proof of the use, reputation and goodwill claimed in the notices of opposition.

11. Additionally, on 8th May 2017, Skillsoft filed an application under s.46(1)(b) of the Act for trade mark 2427733 to be revoked for non-use during the periods 7th September 2011 to 6th September 2016 (“the first relevant period”) or 7th May 2012 to 6th May 2017 (“the third relevant period”). Skillsoft requests that the registration of the mark should be revoked with effect from 7th September 2016 (i.e. the day before the filing date of its own applications) or 7th May 2017.

12. Mr Taylor filed a counterstatement denying the grounds for revocation. According to Mr Taylor, trade mark 2427733 was used during the relevant periods in relation to all the goods/services for which it is registered.

13. The opposition and revocation proceedings are consolidated.

Representation

14. Mr Taylor is represented by Bristows LLP. Skillsoft is represented by Taylor Wessing LLP. A hearing took place on 23rd November 2017 at which Paul Walsh of Bristows appeared on behalf of Mr Taylor, and Guy Hollingworth appeared as counsel for Skillsoft.

The evidence

15. Only Mr Taylor filed evidence. This consists of Mr Taylor’s witness statement dated 7th July 2017 and a short statement from a Ms Husslein, who is a lawyer at Bristows. Ms Husslein’s evidence goes to the meaning of the word ‘percipio’. Apparently, it means ‘I perceive’ in Latin. Mr Taylor says that PERCIPIO has been

used since 2011 by Percipio.me Ltd (until 2014) and later by Percipio Global Ltd. He is (or was) a director of both. The companies used the trade mark with Mr Taylor's consent.

16. According to Mr Taylor:

“Percipio Global Ltd offers a wide range of products and services under the PERCIPIO trade mark to universities, non-profit organisations, community organisations and various government departments in the United Kingdom. The product and services offered under the PERCIPIO mark by Percipio Global Ltd includes notably the creation and the development of websites, online toolkits, online courses and searchable databases. I created a software product sold under the name PERCIPIO which enables the customers to create websites, web pages, downloadable PDFs, online courses and toolkits.”

17. Historical pages from the website of percipio.me are in evidence.¹ These date from 2011 to 2015. Mr Taylor says that they evidence “a wide range of the services which are performed under the Mark.” It is not easy to see from the 11 web pages in evidence exactly which services Mr Taylor's companies provided under the PERCIPIO mark. It seems clear that they involved designing, developing² and hosting³ bespoke websites for customers.

18. Mr Taylor provides a sample of 5 service proposals made to potential customers during the relevant periods.⁴ The first is dated June 2012 and was made to Kings College, London. It is for the design of a website. It appears to have been a website for students to use to identify places or positions from which they could study abroad. It was to use the computer languages PHP, HTML5 and Javascript. The intention was that the site would be hosted on a dedicated server, which could be a King's College's server or an externally hosted server. The estimated service costs came to £24,800.

¹ See exhibit JT-1

² See JT-1 page 13

³ See JT-1 page 19

⁴ See exhibits JT-2 to JT-6

19. The second service proposal was also for website design and development. It was addressed to The Social innovation Partnership and appears to have been for a website for use in evaluating youth projects in and around London. The bid included costs for Percipio.me Ltd to develop, host and maintain the website. The total cost was estimated at £30k.

20. The third service proposal was also for the design and development of a website, this time for the Education Endowment Foundation. It seems to have been intended to turn a 10k page static document called the DIY Evaluation Guide into an accessible website for teachers and academics to use to create attainment reports identifying gaps in a school's attainment levels. It is not clear whether Percipio.me Ltd was to host this site. The estimated development cost was around £40k.

21. The fourth service proposal dated January 2014 was made to the What Works Centre for Local Economic Growth. It was also for the design and development of a website at an estimated cost of £29k. It included options for hosting and maintenance. I note that the section on hosting states that *"We're not a dedicated website hosting company so we don't own our own servers."* However, it goes on to say that *"Should a dedicated platform be required we can supply, manage and maintain a server on your behalf."* Hosting the site would cost £2.5k per annum.

22. The fifth service proposal is dated November 2015. It appears to have been for continuous development of the website of the Education Endowment Foundation. The estimated cost was £228k for 50 weeks work.

23. Mr Taylor provides 33 invoices, 27 of which are dated within the first relevant period.⁵ 22 of the invoices are addressed to the Education Endowment Foundation. Others are addressed to London Metropolitan University, The Sutton Trust, Centre for Economic Performance and Viewpoint Ltd. The services listed in the invoices are consistent with website development, maintenance and hosting. I note that the invoice dated 27th July 2016 addressed to London Metropolitan University covered

⁵ See exhibits JT-7 to JT-12

“software updates”, “create a dedicated template style for blogs” and 4 days’ work for “site documentation and staff training.”

24. The evidence also includes statements of accounts paid to Mr Taylor’s companies by the Education Endowment Foundation, Centre for Cities and the London Metropolitan University.⁶ These cover the period July 2014 to 14th June 2017 (i.e. some are after the end of the relevant periods). The Education Endowment Foundation appears to be one of Mr Taylor’s main customers. The invoices cover several £100,000’s worth of business. The invoices addressed to the other two customers are in the £10,000s.

25. Mr Taylor says that all sites and software developed by his companies have the trade mark PERCIPIO in the source code which is visible if the source code is inspected in a web browser. He provides historical examples from the website of the Education Endowment Foundation.⁷ Mr Taylor also provides copies of webpages from the website of the Education Endowment Foundation that have the words *“PDF generation by Percipio”* in small letters in the bottom right hand corner of each page.⁸ The pages are dated between 16th September 2016 and 13th January 2017. Mr Taylor says that during the period 13th June 2014 to 19th June 2017 *the webpage which redirects to these webpages has been viewed 2,811,092 times.* It is not clear to me what this means. It appears to mean that an associated webpage has been viewed 2.8m times, but it is not clear whether this means that the webpages in evidence have been viewed on this scale. Perhaps more relevantly, Mr Taylor says that the websites developed for Viewpoint Ltd and Kings College, London have *“Powered by Percipio”* (in very small letters) at the bottom right hand corner of each page. He exhibits examples from 2013 to 2015.

26. Finally, Mr Taylor says that he has never seen the need to advertise his companies’ services. Rather, work is obtained through word of mouth recommendations.

⁶ See exhibit JT-13

⁷ See JT-14

⁸ See JT-15

Genuine use of trade mark 2427733

27. It is convenient to start my assessment by considering whether Mr Taylor’s evidence is sufficient to show genuine use of trade mark 2427733 in the first relevant period. If not, and the trade mark is consequently revoked for non-use with effect from 7th September 2016 (i.e. the day before the relevant date) there will be no need to separately consider the position during the later second and third relevant periods. However, genuine use of the mark after the end of the first relevant period, but prior to the date of the application for revocation, is sufficient to defeat the application for revocation: section 46(3) of the Act refers. Consequently, in considering whether Mr Taylor has shown genuine use during the first relevant period, it is also necessary to take account of any such use in the period 7th September 2016 to 8th May 2017.

The law

28. Section 46(1) of the Act (so far as relevant) states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c).....
.....

(d).....

(2) -

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) -

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

29. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

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

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

31. At the hearing, counsel for Skillsoft submitted that the evidence showed use of Percipio in relation to design and development of websites for customers in certain sectors. Consequently, there was no evidence of use of the mark in relation to any goods or services in classes 9, 38 or 41. So far as class 42 was concerned, it was submitted that an appropriate specification would be:

“Design and development of bespoke websites for universities, non-profit making organisations, community organisations and government departments.”

32. Mr Taylor’s representative submitted that the evidence showed use of the Percipio mark in relation to all the registered goods/services. In this connection, Mr Walsh drew my attention to the statement in paragraph 6 of Mr Taylor’s witness statement where he says “*I created a software product sold under the name*

PERCIPIO which enables the customers to create websites, web pages, downloadable PDFs, online courses and toolkits.”

33. This paragraph contains the only references in Mr Taylor’s statement to a product, i.e. to goods. All his other statements about his companies’ commercial offerings refer to the “*services*” provided. Moreover, although Mr Taylor says that he “*created*” a software product, he does not say in terms that he or his companies sell software. None of the invoices, statements of account and service proposals in evidence mention the sale of software. I acknowledge that one of the invoices in evidence refers to the provision of “*software updates*”, but that could refer to the provision of updates to the third party software used to develop the website, such as Javascript. In any event, it does not show that Percipio software was sold to the client.

34. I acknowledge that the websites developed by Mr Taylor’s companies required be-spoke software to be written for the clients. And those with sufficient interest in the websites appear to have been able to use a certain browser function to view the source code. To those (probably few) that did, they would have seen the Percipio mark. Additionally, the websites developed for Viewpoint Ltd and Kings College, London have “*Powered by Percipio*” (in very small letters) at the bottom right hand corner of each page. It is not clear how many people viewed these webpages, still less how many would have noticed the words “*Powered by Percipio*”. In any event, I do not consider that any of this shows a trade in software as goods. Rather, it shows a trade in website creation services for which software was developed as part of the service. There is no evidence that the clients acquired title to the software used to provide the websites.

35. Mr Walsh referred me to a page from Percipio.me’s website⁹ which included as a heading ‘client access Login’. However, all that shows is that the company’s clients had access to web space and/or a database via the Percipio.me website. It does not show any use of the mark in relation to the sale of software. Mr Walsh also drew my attention to a reference in a service proposal in exhibit JT-2 to provide an “*on-brand*

⁹ See JT-1, page 13 of the evidence

*content managed solution that can be updated in-house by Study Abroad and Internships.*¹⁰ That appears consistent with the purpose of the proposal, which was to develop “*an external website solution*” for Kings College. Again there is nothing in this evidence which shows that software was being offered for sale under the mark Percipio. According to Mr Walsh, the references in two invoices in JT-7¹¹ to an “*interactive toolkit*” were, in context, references to the sale of software. However, the context does not make that clear to me. In circumstances where Mr Taylor himself makes no express claim to have sold software under the mark, these very ambiguous references in his exhibits are insufficient to show that Percipio has been used in relation to a trade in software as goods.

36. Mr Walsh relied on pages from a ‘Teaching & Learning Toolkit’¹² as evidence that the mark at issue had been used in relation to *electronic downloadable publications* and *on-line electronic publications*. However, as counsel for Softskill pointed out, the document appears to have been provided to the public under the mark Education Endowment Foundation. The reference in the bottom corner of the document to “*PDF generation by Percipio*” appears to be a reference to the technical process through which the document is generated. This does not show that Percipio was used in relation to *electronic downloadable publications* themselves, still less in relation to *on-line electronic publications*.

37. Mr Walsh submitted that the evidence showed that Percipio had been used in relation to *providing user access to a global computer network including databases* in Class 38. It is permissible to take into account the class number specified by the applicant when assessing the meaning of the descriptions of services provided.¹³ The services covered by class 38 are telecommunications services. There is no suggestion that Mr Taylor or his companies provide telecommunications services, such as those provided by an internet service provider, or provide access to a private network. Providing a website which users can access via their own internet service provider involves no telecommunications services in class 38. Consequently, there is no evidence of use of Percipio in relation to services in this class.

¹⁰ See JT-2, page 26 of the evidence

¹¹ Pages 84 and 86 of the evidence

¹² See JT-15

¹³ *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA)

38. There is one reference in an invoice dated 27th July 2016 to Percipio Global Ltd having provided 4 days' work on "*site documentation and training*".¹⁴ Mr Walsh relied on this use. Counsel for Skillsoft submitted that the use was (a) a single instance incapable on its own of showing genuine use of the mark in relation to training services, and (b) just an adjunct to Mr Taylor's website design and development business and not intended to create a share in the market for training services.

39. I see no reason, in principle, why use of a mark in relation to training services which are ancillary to a trade in other goods or services cannot constitute genuine use of the mark in relation to training services. For example, no one would doubt that the Ford Motor Company provides vehicle maintenance and repair services. The fact that those services are directed at owners of Ford vehicles and are, to some extent, contingent on the sale of Ford vehicles, does not mean that Ford is not in the market for vehicle servicing and repairs. It is therefore all a matter of fact and degree. The question is whether the use that has been shown is sufficient to be "*deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant... services.*"

40. I accept the submission made on behalf of Skillsoft that the provision of a couple of days training as an adjunct to one website design and development service over a period of 5 years or more is not sufficient to show that Mr Taylor has made a real or serious commercial effort to develop a market for training services under the mark Percipio. Indeed, there is nothing in Mr Taylor's witness statement which expressly claims that he has. The closest he comes to this is his claim to have provided "*online courses*" under the mark. However, in context, this appears to be a reference to the users of the websites his companies have developed for educational establishments rather than to any courses provided by Mr Taylor's companies. I therefore find that Mr Taylor has not shown genuine use of the mark in relation to training services in class 41.

¹⁴ See JT-9, page 111

41. This leaves *design and development of computer software; maintaining and hosting websites* in class 42. At the hearing, Mr Walsh proposed a revision to the specification in class 42 which he submitted was justified on the basis of the use shown of the earlier mark. The revised specification was:

“Web-based design and development of computer software in the education and training fields; maintaining and hosting websites”

42. Counsel for Skillsoft took the position that the addition of ‘web-based’ made little or no difference. He objected to the inclusion of the reference to the education and training fields on the grounds that the limitation lacked clarity. He also pointed out that it seemed to be at odds with Mr Taylor’s own evidence, which did not limit his customers to those in these fields.

43. In response to a question from me, Mr Walsh clarified that the proposed limitation to particular fields of activity did not necessarily limit the purpose of the software developed under the services. Rather it identified the users of the service and therefore provided a general indication of the possible purposes of the software developed through the services.

44. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,¹⁵ Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

¹⁵ [2016] EWHC 3103 (Ch)

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

45. In my view, neither this limitation to groups of users, nor the one proposed by counsel for Skillsoft, are sufficiently clear and specific to be acceptable. They are also irrelevant. This is because the purpose of descriptions of services is to define the services at issue (as opposed to those that use them). If the software being developed as a service is not necessarily for education and training purposes, then

the limitation proposed by Mr Walsh tells one nothing about the services themselves. It does not identify a subcategory of services. It just muddies the water. I therefore reject it. For the same reasons, I reject the limitation to categories of users proposed by Skillsoft, as set out in paragraph 31 above.

46. I find that an appropriate description of Mr Taylor's design and development services is:

Design and development of software for use in the creation and development of bespoke websites.

47. Although Mr Taylor's companies do not appear to be actively competing for website hosting services, I am satisfied that such services were provided under the mark during the relevant period and that these were additional services to website design and development. I am also satisfied that website maintenance services were provided under the mark. In my view, the use shown is sufficient (just, in the case of hosting services) to constitute a real attempt to create or maintain a share of the market for these services. It therefore shows genuine use of Percipio in relation to these services.

48. Consequently, the registration of trade mark 2427733 should be revoked for non-use with effect from 7th September 2016, except in relation to:

Design and development of software for use in the creation and development of bespoke websites; maintaining and hosting websites

49. As I have already considered use after the end of the first relevant period, but prior to the date of the application for revocation, in order to decide if s.46(3) applies, it is not necessary to separately consider whether there was genuine use of the mark in the third relevant period. And given the degree of overlap between the first and second relevant periods, the above finding means that Mr Taylor has also provided proof of use sufficient to satisfy s.6A of the Act in relation to the second relevant period. Therefore, he can rely on the above specification for the purposes of his oppositions to Skillsoft's applications.

Opposition under s.5(1) and s.5(2)(a) to application 3184553

50. Section 5(1) and 5(2) of the Act is as follows:

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

(2) A trade mark shall not be registered if because –

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

(b) 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.”

51. Skillsoft’s trade mark is identical to Mr Taylor’s earlier trade mark. This is because if there is any difference between PERCIPIO and Percipio, it is so insignificant that it is likely to go unnoticed by average consumers.¹⁶

Comparison of goods and services

52. The relevant comparison is as follows:

Skillsoft’s goods/services	Services for which the earlier mark is entitled to protection
Class 9: Computer software, namely, software to deliver educational content.	

¹⁶ See *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, CJEU, Case C-291/00

<p>Class 41: Educational services, namely, providing instructional courses in the field of professional development and skills training; information, consultancy and advisory services relating to the aforesaid.</p> <p>Class 42: Providing non-downloadable software for the purpose of delivering educational content; information, consultancy and advisory services relating to the aforesaid.</p>	<p>Class 42: Design and development of software for use in the creation and development of bespoke websites; maintaining and hosting websites</p>
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53. The goods/services covered by classes 9 & 41 of the contested application are manifestly not identical to the services for which the earlier mark is entitled to protection. Counsel for Softskill drew my attention to the judgment of Laddie J. in *Mercury Communications Limited v Mercury Interactive (UK) Limited*¹⁷ where the judge said:

“In my view, the defining characteristic of a piece 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. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory.”

54. I find that the services in class 42 are not identical because the software services provided under the marks are for different purposes. This means that the opposition under s.5(1) fails. In order to assess the opposition under s.5(2)(a) it is necessary to decide whether the respective goods/services are similar.

¹⁷ [1995] FSR 850

55. In the judgment of the CJEU in *Canon*,¹⁸ the court stated that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

56. In *Kurt Hesse v OHIM*, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,¹⁹ the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

57. So far as Skillsoft’s educational services in class 41 are concerned, I find that the respective services are different in nature (education v technical services) and purpose. Further, the method of use is different and the services are not in competition. Some types of training services could be complementary to software development services, but the class 41 services covered by the contested application are nothing to do with software design/development for websites etc. Therefore, these services are not similar.

58. Turning next to the goods in class 9, I find the respective goods/services are different in nature, the one being goods and the other services. The respective software/software services serve different functions, so there is no material similarity of purpose. It follows that the goods/services are not in competition. Nor are they

¹⁸ Case C-39/97, at paragraph 23 of the judgment

¹⁹ Case T-325/06

complementary. Consumers do not need software to create and development bespoke websites, or website maintenance/hosting services, in order to be able to use software for delivering educational content. Nor do those wishing to sell the latter software need services for the design and development of software for websites etc. in order to be able to do so. The users of Mr Taylor's services will be businesses and organisations wishing to develop and maintain websites. The users of Skillsoft's educational software are likely to be those seeking education or training, as well as organisations seeking to provide educational services. I recognise that there is likely to be some overlap of users amongst the latter group. Nevertheless, I conclude that there is no overall similarity between the respective goods/services.

59. My finding about the non-similarity of purposes also applies to the comparison between the parties' services in class 42. However, there are these differences. Firstly, the respective services are more similar in nature because they are both services relating to software rather than goods v services. Secondly, non-downloadable software is likely to be software which is accessed remotely, but which runs on a website. Therefore, services for the design and development of software for creating a website and maintaining websites are likely to be indispensable or important for the provision of non-downloadable software for delivering educational content. Put simply, you have to have a website (or similar technical platform) in order to offer non-downloadable software. This means that the services may be viewed as complementary, at least in the literal sense of that word, by providers of educational services. This is because the possible connection between the parties' trade marks will be more evident to businesses operating and running software on their websites than end users of non-downloadable software for educational purposes, who will not usually be conscious of the trade mark for the software used to create, development or maintain the website they are using. I conclude that there is a very low degree of similarity between the respective services in class 41. Although my reasons for coming to this conclusion are different, my conclusion on this point is not very different to that of counsel for Skillsoft who submitted that there was a "*negligible or very low*" degree of similarity between the class 42 services.

Global comparison

60. As the respective goods/services in class 42 are similar to a degree, it is necessary to conduct a global comparison of the likelihood of confusion. It is not necessary to do so with regard to the contested goods/services in classes 9 & 41. This is because my finding that these are not similar to the services for which the earlier mark is entitled to protection is fatal to the opposition under s.5(2) so far as those goods/services are concerned.²⁰

61. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

²⁰ See *Waterford Wedgwood plc v OHIM* – Case C-398/07 P (CJEU)

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer

62. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

63. Counsel for the applicant submitted that the services at issue would be selected with an above average degree of attention. For Mr Taylor's part, I think Mr Walsh suggested an average degree of attention.

64. As I noted earlier, users of Mr Taylor's services will be businesses and organisations wishing to acquire, develop and maintain bespoke websites. The users of Skillsoft's non-downloadable educational software are likely to be those seeking education or training, as well as organisations seeking to provide educational services. Businesses and organisations wishing to acquire or develop a bespoke website, or purchase non-downloadable educational software to run on a website, will be making important decisions for their business which involve significant expenditure. They will therefore pay an above average level of attention when it comes to the selection of a service provider. End users of such websites and consumers of non-downloadable educational software accessed via such websites, are likely to pay an average level of attention when using websites or selecting non-downloadable educational software from such sites.

65. It seems likely that the respective services will be selected mainly through visual means, from promotional material or websites, but word of mouth recommendations are also likely to play a part on the selection process, particularly when it comes to the selection of a service provider for the design, development and maintenance of software for bespoke websites.

Distinctive character of the earlier mark

66. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

67. Counsel for Skillsoft accepted that the earlier mark is reasonably distinctive. Mr Walsh submitted that the earlier mark was highly distinctive.

68. I accept Mr Walsh’s submission. It appears that Percipio is a Latin word, but neither side argued that its meaning would be known to relevant average UK consumers. It is therefore as highly distinctive as an invented word. The full extent of Mr Taylor’s use of the earlier mark is not clear from his evidence. It does not appear to have been used on a very substantial scale. Nor does it appear that significant sums have been spent promoting the mark. In my view, the evidence does not show

that the distinctive character of the earlier mark had been materially enhanced through use prior to the relevant date.

Likelihood of confusion

69. The identity between the marks and my finding that the marks are highly distinctive is not sufficient to create a likelihood of confusion amongst end users of non-downloadable software for delivering educational content. This is partly because of the very low similarity between the respective services, but mainly because such users are unlikely to pay attention to the trade mark used by the undertaking that provided the services used to create the software for, maintaining and hosting, the website (even if they can find that party's trade mark on the website). So far as this group of consumers are concerned, they will be using the services of the undertaking that operates the website.

70. However, businesses and organisations in the education and training fields, who are consumers of services for the design and development of software for, and maintenance and hosting of, bespoke websites, may also be consumers of non-downloadable educational software to run on their websites. And consumers in this group are likely to see (and hear) the trade marks used by the undertakings marketing both kinds of services. It is true that consumers in this group are likely to pay an above average level of attention when choosing a service provider. However, that is unlikely to be enough to eliminate the likelihood of confusion where the marks are identical. Having earlier noted that the respective services may be complementary in the literal sense, the key issue therefore seems to be whether the respective services are complementary in the sense stated in the case law, i.e. whether the relationship between them is such that the group of consumers under consideration is likely to assume that the same undertaking is responsible for both types of services. If so, there is a likelihood of confusion amongst this group.

71. I have not found this an easy matter to decide. On the one hand, the purposes of the respective software services is different. And as Laddie J. pointed out in *Mercury Communications*, in the context of software as goods, the function of the software is a vital consideration. On the other hand, it does not seem to me so unlikely that a

provider of services for the design and development of software for creating and developing bespoke websites etc. would also provide non-downloadable educational software intended to run on websites, that the possibility of a common trade source should be dismissed. I have taken into account that Skillsoft's services are inherently targeted at consumers in the education and training sectors, and Mr Taylor's software design and development services for websites could notionally be (and, in part, are) targeted at consumers in the same fields.²¹ On balance, I have concluded that organisational consumers of the respective services in these fields are more likely to assume that the identical marks at issue are used by the same undertaking, or by related undertakings, than that unrelated parties are coincidentally using PERCIPIO in relation to the services at issue. I therefore find that there is a likelihood of confusion amongst this group of users/potential users of Skillsoft's services in class 42.

72. Is a likelihood of confusion amongst consumers in this group enough to constitute a likelihood of confusion? It is now established that there may be a likelihood of confusion even if many average consumers will not be confused. The question is whether there is a likelihood of confusion amongst a sufficient number or proportion of average consumers so as to justify the intervention of the court or tribunal.²² In my view, there is sufficient likelihood of confusion. Consequently, the s.5(2)(a) ground of opposition succeeds against application 3184553 in class 42.

Opposition under s.5(2)(b) to application 3184555

73 I adopt my earlier findings as regards the comparison of goods/services, average consumers and the distinctiveness of the earlier mark. This means that the opposition under s.5(2)(b) also fails in classes 9 and 41 because the goods/services are not similar and there is therefore no likelihood of confusion.

²¹ See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, at paragraph 78 of the judgment

²² See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), Mann J. and the case law cited at paragraphs 27 and 28.

Comparison of marks

74. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

75. The respective trade marks are shown below:

Percipio	PERCIPIO BY SKILLSOFT
Earlier trade mark	Contested trade mark

76. The marks are plainly similar because Mr Taylor’s mark makes up the first word of the contested mark. This introduces a fairly high degree of visual and aural similarity, particularly as PERCIPIO appears at the beginning of the contested mark and therefore strikes the reader (or listener) before ‘BY SKILLSOFT’. However,

those latter words are by no means negligible in terms of the visual and aural impressions created by the mark as a whole.

77. As I found earlier, PERCIPIO will be regarded as a meaningless word by average UK consumers. SKILLSOFT as a whole also seems meaningless. It follows that neither mark has any conceptual identity which increases or reduces the likelihood of confusion based on the way the marks look and sound. Further, the words PERCIPIO BY SKILLSOFT do not form a unit having a meaning that is any different from that of the individual words.

Likelihood of confusion

78. I have carefully considered whether my earlier findings on the likelihood of confusion at paragraphs 69- 71 above also apply to the PERCIPIO BY SKILLSOFT mark or whether the addition of BY SKILLSOFT is sufficient to avoid a likelihood of confusion.

79. PERCIPIO plainly has an independently distinctive role in PERCIPIO BY SKILLSOFT.²³ I have therefore decided that the addition of 'BY SKILLSOFT' is not sufficient to avoid the same likelihood of confusion described above. The difficulty is that although these words may be sufficient to avoid a likelihood of confusion amongst Mr Taylor's existing customers, who will know that his businesses are not called SKILLSOFT, it will not be sufficient to enable those who come across the parties' marks in the future to distinguish between the services of these undertakings. To put it another way, unless you know the name of the undertaking behind PERCIPIO you will not know whether it is (or is not) SKILLSOFT. It is not uncommon for house marks to be used with marks for particular services on some occasions and for the service mark to be used alone on other occasions, e.g. BBC and iPlayer. It would be perfectly rationale for consumers to assume that SKILLSOFT sometimes use PERCIPIO alone and sometimes with BY SKILLSOFT. I have therefore come to the conclusion that the opposition under s.5(2)(b) to application 3184555 succeeds in class 42.

²³ See *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

Passing-off right ground

80. Section 5(4)(a) states:

“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.”

81. In *Discount Outlet v Feel Good UK*,²⁴ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL, namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “a *substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

²⁴ [2017] EWHC 1400 IPEC

82. Mr Taylor's pleaded case is that he has used PERCIPIO in plain word and stylised form in relation to the goods/services listed at paragraph 8 above, including "online courses and toolkits." In his evidence he says:

"The product and services offered under the PERCIPIO mark by Percipio Global Ltd includes notably the creation and the development of websites, online toolkits, online courses and searchable databases. I created a software product sold under the name PERCIPIO which enables the customers to create websites, web pages, downloadable PDFs, online courses and toolkits."

83. Looking at Mr Taylor's evidence as a whole, I believe that the Percipio software he provides enables his customers to develop, inter alia, "online courses and toolkits" for their users/customers. Those services would be offered to the end user under the customer's own name and branding. Consequently, any resulting goodwill would belong to Mr Taylor's customers, not to him. I see no evidence of goodwill that goes wider than the services I have already considered under the s.5(2) grounds of opposition.

84. At the hearing, Mr Walsh suggested that the goodwill might be enough to sustain a ground of opposition based on passing-off rights, even if it was not enough to support the opposition based on earlier registered marks. It is true that the legal tests for protectable goodwill and genuine use are not the same. Nevertheless, I see no evidence of a wider goodwill than I have already considered. In particular, I do not accept that the single invoice for a couple of day's training is sufficient to create a protectable goodwill in relation to training services. The use in question is far too trivial for that.²⁵

85. This means that the protectable goodwill in Mr Taylor's business coincides with the services I have already considered under s.5(2). In these circumstances, I see no greater capacity for use of the contested marks to deceive "a substantial number" of Mr Taylor's customers or potential customers than it is to create a likelihood of

²⁵ See *In Hart v Relentless Records* [2002] EWHC 1984 (Ch)

confusion for s.5(2) purposes. If anything the case based on s.5(4)(a) is weaker, particularly with regard to the use of the PERCIPIO BY SKILLSOFT mark in relation to the services in class 42.

86. I therefore find that the opposition under s.5(4)(a) takes Mr Taylor's case no further.

Opposition under section 5(3)

87. Section 5(3) states:

“(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 European Union trade mark or international trade mark (EC), in the European Union) 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.”

88. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the

public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to

have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court’s answer to question 1 in *L’Oreal v Bellure*).

89. Mr Taylor claims that the earlier mark has acquired a reputation in relation to all the goods/services for which it is registered. However, having found that the mark has only been put to genuine use in relation to *design and development of software for the creation and development of bespoke websites; maintaining and hosting websites*, I must reject the claim to a broader reputation.

90. So far as these services are concerned, I remind myself that the CJEU stated in *General Motors* that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular 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 in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

91. The key points in this case are that:

- (i) there is no evidence of the market share held under Percipio;
- (ii) based on what evidence there is, the market share looks likely to be small;
- (iii) the full extent of the use of Percipio is not clear from the evidence because there are no turnover figures;
- (iv) the total number of customers appears relatively small from the material in evidence;
- (v) the use of the mark goes back about 5 years;
- (vi) there has been no active promotion of the mark, Mr Taylor relying on word of mouth recommendations;
- (vii) Mr Taylor's customers appear to be concentrated in and around London.

92. In these circumstances, I cannot find that the earlier mark was known at the relevant date by a significant part of the UK public concerned by the services listed in paragraph 89 above. Consequently, the opposition under s.5(3) falls at the first hurdle.

Outcome

93. Trade mark 2427733 will be revoked with effect from 7th September 2016, except in relation to:

Design and development of software for the creation and development of bespoke websites; maintaining and hosting websites

94. Trade mark applications 3184553 and 3184555 will be refused in class 42 and registered in classes 9 and 41 for:

Class 9: Computer software, namely, software to deliver educational content.

Class 41: Educational services, namely, providing instructional courses in the field of professional development and skills training; information, consultancy and advisory services relating to the aforesaid.

Costs

95. Both sides achieved a measure of success in the oppositions. I direct that each side should bear its own costs for those proceedings.

96. Skillsoft was significantly more successful than Mr Taylor in the revocation proceedings and is therefore entitled to a contribution towards the cost of those proceedings. I assess these as follows:

£300 for filing the application for revocation and considering the counterstatement;

£300 for considering Mr Taylor's evidence;

£400 for attending a hearing and filing a skeleton.

97. I therefore order Mr Mr Jamie Taylor to pay Skillsoft Corporation the sum of £1000 within 14 days of the end of the period allowed for appeal.

Dated this 2nd day of January 2018

**Allan James
For the Registrar**