

O-023-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2243942
BY FOCUS BUSINESS SOLUTIONS LIMITED
TO REGISTER THE TRADE MARK:**



IN

CLASS 42

AND

**THE OPPOSITION THERETO
UNDER NO 91150**

BY

**INFORMATION BUILDERS, INC
BASED UPON THE EARLIER TRADE MARKS:**

FOCUS

AND



Trade Marks Act 1994

**In the matter of application no 2243942
by Focus Business Solutions Limited
to register the trade mark:**



**in class 42
and
the opposition thereto
under no 91150
by Information Builders, Inc**

BACKGROUND

1) On 30 August 2000 Focus Business Solutions Limited, which I will refer to as Solutions, applied to register the above trade mark. The application was published for opposition purposes in the “Trade Marks Journal” on 17 July 2002 with the following specification:

computer programming, updating of computer software, providing access to information via the Internet; all relating to services provided to the financial services industry.

The above services are in class 42 of the International Classification of Goods and Services. The application was published with the following information:

“Honest concurrent use with Registrations 1362427 (5880, 3906), 1362428 (5892, 5646).”

2) On 16 October 2002 Information Builders, Inc, which I will refer to as Information, filed a notice of opposition to the application. Information is the owner of three United Kingdom trade mark registrations:

- No 934918 of the trade mark **FOCUS**. This is registered for:

magnetic tapes and magnetic discs, all being for use with data processing apparatus and instruments or with computers.

The above goods are in class 9 of the International Classification of Goods and Services. (At the time of the filing of the opposition the Register showed *taps* instead of *tapes*. This error has since been rectified.)

- No 1362427 of the trade mark:



This is registered for:

computer programs, magnetic tapes, disks, wires and filaments, all for use with computers; encoded tapes, disks, wires, cards and filaments, all for use with computers; parts and fittings for all the aforesaid goods; all included in Class 9.

The trade mark was advertised before acceptance under the provisions of section 18(1) of the Trade Marks Act 1938. It also proceeded upon the basis of honest concurrent use, claimed from 1977, under the provisions of section 12(2) of the 1938 Act.

- No 1362428 of the trade mark:



This is registered for:

computer programming; consultancy services relating to the design, development and operation of computer memories, integrated circuits and computer programs; all included in Class 42.

Information claims that the trade mark of Solutions is similar to each of its trade marks and encompasses similar or identical goods. Consequently, there is a likelihood of confusion and registration of the application would be contrary to section 5(2)(b) of the Act. Information seeks the refusal of the application in its entirety and an award of costs.

3) Solutions filed a counterstatement in which it denied the claims of Information at some length and in great detail. Solutions requests that the opposition is dismissed and seeks an award of costs.

4) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing, so I am making this decision from the documentation before me.

EVIDENCE

5) Both sides furnished a good deal of evidence. However, this case is based on section 5(2)(b) of the Act and I do not consider that the evidence, in the circumstances of this particular case, filed will affect the outcome. Solutions, in the evidence of Mark Loosemore, considers that the use or otherwise of the trade marks of Information will have an effect on the outcome upon the case. Mr Loosemore states at paragraph 83 of his witness statement:

“Although the services provided under the Application are similar to the registered trade mark 1,362,428 there is no likelihood of confusion between this mark and the Application by reason of its non-use.”

Whether the trade mark has been used or not in the United Kingdom is not relevant in this case. The trade mark is a valid registration and is protected for notional and fair use upon all the services for which it has been used. This is the case for all the trade marks of Information. In the particular circumstances of this case I do not consider that summarising the evidence will serve any useful purpose.

DECISION

Likelihood of confusion - section 5(2)(b) of the Act

6) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

The trade marks upon which Information relies are earlier trade marks in the terms of section 6(1)(a) of the Act.

7) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

8) Owing to the nature of the trade mark and the specification, if Information cannot succeed in relation to registration no 1362428 it will not succeed in relation to either of its other two trade marks.

Comparison of services

9) Solutions admits that the services of 428 and its application are similar. *Computer programming* and *updating computer software* services are, respectively, identical and exceptionally close to those of 428. There is no limitation of the services of the registration, so it will encompass services provided to the financial services industry.

Comparison of trade marks

10) The trade marks to be compared are:

Earlier registration:	Application:
	

11) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG* page 224). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* page 84, paragraph 27).

12) In its counterstatement Solutions dissects the respective trade marks in a manner worthy of a pathologist. However, customers do not indulge in the analysis and dissection of trade marks. They consider them in their entirety. There are differences between the trade marks. However, the distinctive and dominant element of the trade marks is the common element, the word FOCUS. I do not consider that anything turns upon the case in which the word is written. The word must be phonetically and conceptually identical. Visually the words are not identical. However, the word cannot be divorced from its meaning and so, taking into account the trade marks are unlikely to be compared directly, I consider that the FOCUS elements of the trade marks are visually similar.

13) Mr Hobbs QC, sitting as the appointed person, in *Torreomar* [2003] RPC 4 stated:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1988] FSR 283).”

In this case I have not the least doubt, comparing the respective trade marks in their entirety, that they are distinctively similar; and distinctively similar to a high degree.

Conclusion

14) Solutions comments upon the absence of confusion in the market place. However, this seems a paradoxical comment as it also claims that Information’s trade marks have not been used. If they have not been used how could there be an opportunity for confusion? Even if

there has been use of all the trade marks this would tell me little. I am considering the trade marks without any other matter or context, such as the names and reputation of the owners. I also have to consider the possibility of Information's trade mark being used for identical services in identical circumstances. In such circumstances is it realistic to argue that there is not a likelihood of confusion?

15) The application proceeded to publication upon the basis of honest concurrent use. Section 7 of the Act deals with honest concurrent use:

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

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

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

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

In *Codas Trade Mark* [2001] RPC 14 the Hearing Officer stated in relation to honest concurrent use:

“If, for example, the trade mark the subject of the application for registration and the trade mark the subject of the earlier right were identical, and the specification of goods or services of the application was identical to the specification of the goods or services covered by the earlier trade mark, then refusal must follow under section 5(1), which bars absolutely the registration of identical trade marks in respect of identical goods or services (unless the proprietor of the earlier trade mark consents to the registration of the later trade mark). But in relation to section 5(2) the respective trade marks or respective specifications of goods or services may only be similar and the fact that there has been actual use of the trade mark in suit concurrently with the earlier trade mark, may be relevant in determining whether there is a likelihood of confusion.”

All that honest concurrent use can do is to get an application to publication. It cannot save an application if there is an opposition and it is considered that there is a likelihood of confusion. The concept of honest concurrent use, both under the current act and the 1938 Act, has always had the flaw that inevitably an applicant does not show actual honest concurrent use. The applicant will show use of his or her trade mark, not that of some other person. So in effect

what is being shown is use and not honest concurrent use. The concept falls down when there has been no use of the other trade mark or use only in relation to some of the goods or services for which it is registered. There has been no opportunity for the respective goods and services to co-exist in the market place.

16) In deciding if there is a likelihood of confusion I have to take into account various factors. The distinctiveness or otherwise of the earlier trade mark is of importance as there is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). 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, judgement 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). I consider that the trade marks of Information are neither allusive nor descriptive of the goods and services for which they are registered. I am of the view that the trade marks enjoy a reasonable degree of inherent distinctiveness. The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case identical and highly similar goods are involved, and highly similar trade marks are involved. Information's position is strengthened from both sides of the equation. The services of the application are clearly specialist services supplied to a specialist and educated consumer. It seems to me that a careful and educated decision will be made in purchasing these services. However, owing to the proximity/identity of the services and the proximity of the trade marks, I do not consider that the nature of the purchasing decision will militate against a likelihood of confusion. What could militate are matters extraneous to the respective trade marks, such as clear identification with the proprietors. The sorts of things that might assist Solutions in the "real world" of a passing-off case (see for instance the factors listed by Christopher Floyd QC (Sitting as a Deputy Judge of the High Court) in *Teleworks Ltd v Telework Group Plc* [2002] RPC 27 for not finding for the plaintiff) cannot assist it in the "idealised world" of section 5(2)(b). In this "idealised world", as I have indicated, I have to consider normal and fair use for all the goods and services covered and use of the respective trade marks as they stand, which have no other identifiers of origin with them.

17) Taking all the above factors into account I have no doubts in coming to the conclusion that there is a likelihood of confusion and that the application is to be refused in its entirety.

COSTS

18) Information Builders, Inc having been successful is entitled to a contribution towards its costs. I order Focus Business Solutions Limited to pay Information Builders, Inc the sum of £1450. This sum is 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 27th day of January 2004

**David Landau
For the Registrar
the Comptroller-General**