

TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE  
MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION **m** 1560783  
BY NOVUS NETWORKS LIMITED  
TO REGISTER THE MARK **LIBERATOR**

AND

IN THE MATTER OF OPPOSITION  
THERE TO UNDER OPPOSITION **m** 42768  
BY PATAPSCO DESIGNS LIMITED

TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE MARKS ACT 1994

IN THE MATTER of trade mark  
application **m** 1560783 by  
Novus Networks Ltd to  
5 register a mark in class 9

and

IN THE MATTER of opposition  
thereto under opposition **m** 42768  
by Patapsco Designs Ltd

10 DECISION

Novus Networks Ltd applied on 1 February 1994 under section 17(1) of the Trade Marks Act 1938 to register the mark LIBERATOR in Class 9 for a specification of goods that has since been amended to:

15 “Computers; computing apparatus; encoded programs for computers and for  
calculators; electronic apparatus and instruments, all for storage, retrieval and  
transmission of data; magnetic tapes and cassettes, all for use therewith; punched  
(encoded) cards, electrical circuit boards, magnetic discs, punched (encoded) tapes,  
magnetic wires, magnetic filaments and integrated electrical circuits, all for the storage  
of analogue or digital data; audio-visual display apparatus adapted for use with  
20 computers; electronic input and output apparatus, all for linking telephone, radio or  
television apparatus to computers or to data transmission apparatus; electronic input  
and output keyboard apparatus and printout apparatus, all for use with computers,  
calculators or with data transmission apparatus; parts and fittings for all the aforesaid  
goods; computer software; all included in Class 9; none specifically adapted for use by,  
25 or for aiding the handicapped.”

The application was given the number 1560783. During the course of examination, an earlier registration of the mark LIBERATOR was raised as a citation, but the application was allowed to proceed under the provisions of section 12(2) on the basis of honest concurrent use from 1988. Consequently the application was published for opposition purposes on 19 April  
30 1995. On 6 July 1995 Patapsco Designs Ltd formally opposed the application.

I summarise the grounds of opposition as follows:-

- M** Section 12 — By reason of the opponent’s prior registration, 1457134, registration of the mark in suit would be contrary to the provisions of section 12 of the Trade Marks Act 1938 (as amended).

M Section 11 — By reason of the goodwill and reputation arising from the use of the opponent's mark, use by the applicant of the mark in suit would lead to deception and confusion.

5 M Section 17(2) — Registration of the mark in suit by the applicant would constitute a serious interference with the business of the opponent. In the circumstances, registration should therefore be refused in the exercise of the Registrar's discretion.

The details of the opponent's earlier registration, 1457134, are as follows:

	<u>No</u>	<u>Mark</u>	<u>Class</u>	<u>Goods</u>
10	1457134	LIBERATOR	9	Electronic networking apparatus for use with telephone systems for the transmission of data or voice communication signals; all included in Class 9

In response, the applicant filed a counterstatement denying each of the grounds pleaded.

Both parties seek an award of costs in their favour.

15 The matter came to be heard on 9 November 1998. At the hearing, the applicant was represented by Mr Arthur Ashton of Counsel, instructed by Chancery Trade Marks. The opponents were represented by Mr Henry Carr, Queen's Counsel, instructed by R G C Jenkins & Co.

20 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, and unless otherwise indicated, all references in the remainder of this decision are references to the provisions of the old law.

#### *The Evidence*

25 In these proceedings, the opponent filed two statutory declarations in evidence. The first by Paul Strawbridge, a Director of Patapsco Designs Ltd, dated 24 May 1996. The second, dated 28 May 1996, by Roger David George, a Registered Trade Mark Agent with the firm R G C Jenkins & Co.

30 The applicant also filed two statutory declarations. One by Christopher Holland, Managing Director of Novus Networks Ltd, dated 11 October 1995. The other by Sally Ann Schupke, a Trade Mark Agent with Chancery Trade Marks, dated 18 July 1996.

I have carefully considered all these declarations, and their corresponding exhibits, before reaching my decision. However, I do not propose to summarise the evidence of both parties in turn; instead, and in the particular circumstances of this case, I prefer to give a general outline of the facts, and refer to specific parts of the evidence as and when the need arises.

### *The Background*

In August 1988, a company called Libra Logic Limited (“Libra”) developed and marketed a communications controller under the mark LIBERATOR. However, Libra Logic ceased trading as a result of a resolution passed at an Extraordinary General Meeting called in December 1990. The liquidator filed his annual report in April 1992, and Libra Logic Limited was dissolved and struck off the register of companies on or about 13 July 1992. In the meantime, on 7 January 1991, one of the directors of Libra Logic, Mr Robert Gurney, became a director of another company, Bantagrove Limited, which subsequently changed its name to Novus Networks Limited (“Novus”).

Some of the assets of Libra transferred to the new company, Novus. In the event, the outcome of these proceedings turns on the circumstances surrounding the transfer of assets between these two companies, and in particular, whether Libra is a predecessor in title of Novus.

The opponent, Patapsco Designs Ltd (“Patapsco”), began using the same mark, LIBERATOR, in November 1990. Patapsco applied to register the mark on 1 March 1991, and, the application being successful, the mark was entered on the register of trade marks on 13 March 1993.

At the hearing, Mr Ashton handed up a summary of the technical features of the two LIBERATOR products, drawn from the evidence of the two parties. Rather than attempt to summarise the two products myself, I find it convenient to incorporate Mr Ashton’s summaries in my decision. The first summary describes the Novus LIBERATOR:-

"So it is true to say that with the Liberator you can, in principle, connect anything to anything."

Computers are, in many ways, like people. They come in a variety of shapes, sizes and colours. Most importantly, they also speak a large variety of languages. The way that one computer communicates with another computer is through a common language, or protocol. Unlike humans, computers are inflexible. Thus, whilst an American will understand most of what an Australian says, the computer equivalents would fail to understand each other, even with only small differences in the language.

The problem can be overcome. If only computers wish to communicate then they can, in effect to a common language (very much like a Thai person and a Sioux Indian agreeing to speak English). However, if a large number of computers wish to communicate this system soon breaks down (continuing the analogy, if there were a large number of people from a number of different countries it is unlikely that everybody can understand English). At that point a translator is required.

The Liberator is that translator. It understands a large number (if not all) the protocols that computers use to communicate and can translate one into another. It would be like placing a translator in the room full of foreign nationals. Not only can he speak the language of everybody in the room, but he can also translate several conversations at the same time.

Because computers can communicate through a variety of media (telephone lines, Ethernet including Internet, direct cabling, infrared, radio signals, satellite signals, television signals etc.) the Liberator is designed to be flexible. It is not limited to telephone lines, nor especially PABXs.

5 "Libra's Liberator can help to free you from these restrictions. It thinks and acts like an independent computer, which it is. It talks to multiple hosts and terminals in the language they understand with the ability to tailor network access to your specific requirements."

The function of the Liberator is to act as a translator for computers.

10 Turning then to Patapsco's LIBERATOR, the summary reads:-

"There is now a sensible and cost effective way of accessing the required bandwidth - as and when it is needed."

A PABX is an internal telephone exchange. It provides an "in-house" telephone system. Such a system is likely to have a large network of lines.

15 The amount of information that can be sent down a single telephone line in a PABX is limited by the physical capabilities of that line. Even the best, digital lines are limited to 64 Kilobytes per second (Kbps - a measure of information transmission).

20 Normally, for a voice telephone call this is not a problem - it would use much less of the lines maximum capacity. The capacity of a line is called its bandwidth.

The advent of video conferencing, and other applications that require high speed data transfer, has led to a boom in the industry of data transfer. Transmission rates of only 64Kbps are simply inadequate.

25 There are a variety of solutions, for example installing a special high speed, high bandwidth cable - this is expensive. Patapsco have adopted a different approach.

30 The Liberator is in effect a "routing device". When there is the need for a high bandwidth channel (for example, during a video conference) the Liberator 'looks' at the entire PABX network. It finds which lines are free and then uses them. Its most useful feature is that it can 'pool' lines. If more than one line within the PABX is available then it will use them.

35 By using the additional lines the Liberator gains the additional bandwidth of these lines, increasing the bandwidth to above the single line limit of 64Kbps. The maximum limit with the Liberator is 576Kbps.

The other (and novel) feature of the Liberator is its flexibility. If a line ceases to be available it looks for an alternative. If the bandwidth needs of the video conference increase, then it will find another line to compensate. If the needs diminish, then lines are released to other users.

The Liberator is limited to PABXs. It is an "in-house" system. However, it can be linked to Integrated Services Digital Network (ISDN) to communicate with computers outside of the PABX.

The Liberator's function is to increase the bandwidth for communication in a PABX.

Against this background, I now turn to consider the grounds of opposition.

*Section 12(1)*

This section of the Act reads as follows:

12(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods,
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description.

The opponent has an earlier registration of the mark LIBERATOR in Class 9 for "Electronic networking apparatus for use with telephone systems for the transmission of data or voice communication signals".

Clearly the marks at issue are identical, and the only issue that arises under section 12(1) is whether the respective goods are the same, or of the same description.

Mr Ashton conceded on behalf of the applicant that his specification of goods was probably broader than he could realistically hope to maintain, and he offered to amend the specification in a number of areas. To show how and where he was proposing to amend, Mr Ashton had broken down his client's specification into list form, as shown below.

1. Computers and computing apparatus for communication protocol handling.
2. Encoded programs for computers and for calculators.
3. Electronic apparatus and instruments, all for storage, retrieval and transmission of data, all for communication protocol handling.
4. Magnetic tapes and cassettes, all for use therewith.
5. Punched (encoded) tapes; magnetic wires, magnetic filaments and integrated electrical circuits, all for the storage of analogue or digital data.
6. Visual display apparatus adapted for use with computers.
7. Electronic input and output apparatus, for linking telephone, radio or television apparatus, to computers or to data transmission apparatus, all for communication protocol handling.
8. Printout apparatus, all for use with computers or with data transmission apparatus.
9. Parts and fittings for all the aforesaid goods.
10. Computer software; all included in Class 9.

In three places, Mr Ashton proposed to limit the specification by the addition of the underlined words — ‘for communication protocol handling’. I presume also that the entire specification should still be qualified by the amendment requested on 5 November 1998, adding the words:

‘...; none specifically adapted for use by, or for aiding the handicapped.’

5 In comparing the two specifications of goods for the purpose of section 12(1), I have found it helpful to consider the applicant’s specification in the list form shown above. For convenience, I repeat here the specification of the opponent’s prior registration (1457134):

Electronic networking apparatus for use with telephone systems for the transmission of data or voice communication signals; all included in Class 9

10 The standard test for opposition under section 12 has been laid down in the *OVAX* case<sup>1</sup> by Mr Justice Evershed. Applied to the facts of the present case, the test may be expressed as follows:

15 Assuming use of the opponent’s mark LIBERATOR in a normal and fair manner for the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion amongst a number of persons if the applicant uses the same mark normally and fairly in respect of any goods covered by the proposed registration?

20 On the question of similarity of goods, Mr Ashton referred me to a decision of Mr William Aldous QC (as he then was) sitting as the Secretary of State’s representative in the *CYBERVISION* case<sup>2</sup>.

In *CYBERVISION*, the applicant was seeking to register the mark CYBERVISION for ‘automatic machines incorporating computers and visual control apparatus for the assembly of components ....’. The mark CYBER was already registered in respect of ‘computer and communication apparatus and instruments ...’.

25 The Registrar had refused the later application on the grounds that the goods were the same, or of the same description. At page 2, Mr Aldous QC asks:

30 “Are the goods for which CYBERVISION is sought to be registered of the same description as the goods for which CYBER is registered? To answer this question it is not sufficient to see whether a description will cover both types of goods. This was reiterated by the House of Lords In the *Daiqiuri Rum Case* 1969 RPC 100. In that case, it was pointed out that the words “same description” as used in the Act indicate a similarity in various respects, but there was no conclusive test applicable to every case. The test is stated to be a business and practical test which I take to mean that I should look at the respective goods through the eyes of the ordinary trader. In doing so, I will consider the nature and composition of the goods, the respective uses

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<sup>1</sup>Smith Hayden & Co Ltd’s Application [1946] 63 RPC 97

<sup>2</sup>In the Matter of an appeal to the Board of Trade, in the Matter of Application m 1158023 by Automatrix Incorporated for the registration of a trade mark in Class 7; dated 5 November 1984.

and the trade channels through which they are bought and sold as suggested in Jellinek's Application [1946] 63 RPC 59.

5 Mr. Egan submitted that it was right to have in mind, when considering goods to which CYBERVISION would be applied, a simple machine which could have an arm which was controlled by a computer. This seems reasonable to me. He submitted that such a machine had substantial similarity in nature to a computer; the one being a computer coupled to a simple machine and the other a computer which could be used for any purpose. I see the force of that argument, but believe that an ordinary trader would not consider the nature of the two machines to be the same. A computer can be used to store data from which it can be retrieved for many purposes, whereas a computer controlled automatic machine for the assembly of components seems to me to be different in nature falling within the category of assembly machines which a computer does not.

10 I also cannot accept that the use of the notional machine falling with the specification of goods for which CYBERVISION is sought to be registered is the same as a computer. I cannot equate the way a computer works with the way a computer controlled machine for the assembly of components works. The one stores and provides data whilst the other assembles components.

15 As to trade channels. I accept that large companies may manufacture and sell both computers of a type and machines which will assemble components and in this respect there will be an overlap. However I would not expect that the main sellers of computer controlled automatic machine also sold computers.

20 I have come to the conclusion that automatic machines for assembly of components which are computer controlled are not goods of the same description as computers. I believe that this conclusion would coincide with the view of purchaser of such a machine who, while accepting that a computer might be the heart of the machine he was buying, would consider that what he was buying was a machine which did a particular job namely component assembly and was different in kind to a computer."

25 Mr Ashton submitted that the reasoning of this last paragraph which I have quoted from *CYBERVISION* would fit the facts of this case. He argued that although the goods of interest to both parties are broadly in the realms of electronic transmission of data, the one is for an entirely different purpose to the other. Mr Carr responded to this by saying that Mr Ashton appeared to be using instead the test for section 11 which compares notional use of the goods within the applicant's specification with the goods in relation to which the opponent has actually used his mark. I think Mr Carr's criticism is justified. Comparing the actual specifications, Mr Carr suggested that a computer modem would fall within the scope of both specifications. Even with the amendment offered by Mr Ashton, limiting certain terms within the specification to the field of communication protocol handling, Mr Carr still felt that the goods were probably the same, but at the very least, they were goods of the same description.

30 For my part, I can readily distinguish between the different functions which the applicant's goods and the opponent's goods perform. Nevertheless, when I apply the correct test for section 12 (see *OVAX* above), including normal and fair use of all the goods in the two specifications, I cannot escape the conclusion that there is a potential for some overlap between the two specifications.

In the event, the applicant's position is not greatly improved if I adopt the somewhat narrower construction advocated by Mr Ashton on the authority of *CYBERVISION*. It will not always be easy to apply a 'business and practical test', looking at the respective goods 'through the eyes of the ordinary trader'. Nevertheless, even if I give greater weight to the different technical functions which Mr Ashton has highlighted, I would still consider that these are goods of the same description. Taking the best view I can of the matter, I believe that there is a reasonable likelihood of deception or confusion amongst a number of persons and the opposition under section 12(1) would succeed accordingly.

However, my finding under section 12(1) of the Act is not the end of the matter since Mr Ashton claimed that the application should be accepted by virtue of the provisions of subsection 2 of section 12 of the Act.

This subsection states:-

12(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the court or the Registrar may permit the registration by more than one proprietor in respect of:-

- a. the same goods
- b. the same description of goods or
- k. goods and services or descriptions of goods and services which are associated with each other.

of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or Registrar, as the case may be, may think it right to impose.

The main matters for consideration under Section 12(2) were laid down by Lord Tomlin in the *PIRIE* case<sup>3</sup>. They are:

- (i) the extent of use in time and quantity and the area of trade;
- (ii) the degree of confusion likely to ensue from the resemblance of the marks, which is, to a large extent, indicative of the measure of public inconvenience;
- (iii) the honesty of the concurrent use;
- (iv) whether any instances of confusion have been proved;
- (v) the relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

In this case, a question also arises under section 7 as to whether the opponent can object to the applicant's mark becoming registered pursuant to section 12(2). Section 7 reads:

**Saving for vested rights**

7. Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly

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<sup>3</sup>Pirie's Trade Mark [1933] 50 RPC 147

resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior-

(a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or

(b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his;

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under subsection (2) of section twelve of this Act.

10 There is no doubt that the company called Libra used the mark LIBERATOR **before** Patapsco  
either registered it or used it. Whether Libra is a predecessor in title of Novus has, however,  
been questioned by the opponent, both in evidence by Mr George and by Mr Carr in the  
course of his submissions to me at the hearing. Mr Carr also questioned whether Libra and/or  
Novus has “continuously” used the mark since Libra first began to use the mark in August  
15 1988.

Mr Ashton, it must be said, did not rely upon section 7. He referred me to a decision of the Assistant Comptroller in the Matter of An Application by Frank George Whiting for the Registration of a Trade Mark<sup>4</sup>. At page 222, the decision reads:—

20 “Yet the goods for which the Applicant is seeking registration are not identical with any of the  
goods for which the Opponents’ Mark No. 556,083 is registered or in respect of which they have  
used their mark, and hence I am of the opinion that the Applicant cannot successfully rely upon  
the provisions of Sec. 7, although he can of course (as Mr. Johnston admitted) advance a case  
for the favourable exercise of discretion under Sec. 12 (2) of the Act, and it seems to me when it  
comes to Sec. 12 (2), the Applicant is in a stronger and not a weaker position by being unable to  
25 invoke the provisions of Sec. 7, for if under Sec. 7 he could have obtained registration of his  
mark in respect of goods within the Opponents’ specification of goods, a fortiori, he should be  
able to obtain registration in respect of goods not within the Opponents’ specification of goods.  
In view of my conclusion expressed above, it is I think unnecessary for me to deal with the other  
reason advanced by Mr. Johnston as to why he considered that the Applicant could not rely upon  
30 the provisions of Sec. 7, and which concerned the necessity of proving continuous user.”

According to Mr Ashton, as identical goods were not involved he could not benefit directly from section 7, though he claimed that his client was necessarily in a stronger position in relation to section 12(2) for the reasons given by the Assistant Comptroller in the WHITING case above.

35 Thus both Counsel were agreed, though for entirely different reasons, that section 7 did not apply. I therefore go on to consider the merits of the applicant’s claim to benefit from an exercise of the Registrar’s discretion under section 12(2), taking account of the relevant factors identified in the *PIRIE* case.

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<sup>4</sup>The *DREAMLAND* case [1952] RPC 219.

The applicant's claim that Libra is a predecessor in title of Novus is by no means a clear one. Mr George, in his declaration on behalf of the opponent, has questioned the veracity of Novus' claim to have acquired Libra's rights in the unregistered trade mark LIBERATOR. The applicant has not rebutted this challenge in evidence. Nevertheless, the matter appears to have been the subject of correspondence between the trade mark agents representing the two parties as long ago as August 1993. Some of this correspondence is before me in the form of exhibits to Mr George's declaration. On 27 August 1993, Ms Schupke replied to Mr George stating that:

“On the 21<sup>st</sup> December 1990, Libra Logic Limited was purchased from the Liquidator, Guy Huntingdon, including rights to the name LIBERATOR.”

Ms Schupke attached to her letter an extract from the purchase agreement. Unfortunately, the extract does not name the purchaser. It also contains the following clause among the definitions:

“the Business Assets” means the assets agreed to be sold and referred to in Clause 3.”

Unfortunately Clause 3 is not part of the extract. Mr George also exhibited a copy of the Liquidator's statement of account in relation to the winding up of Libra Logic Limited. The statement clearly shows that intellectual property rights were sold for £1001-00; unfortunately the statement does not declare who purchased these rights.

Given all the facts before me, I would be surprised if Libra were not in fact a predecessor in title of Novus. But as Mr Carr reminded me, the onus of proving title rests on the applicant in this situation, and the weight of that burden is increased by the fact that there has been a specific challenge. In the circumstances, I cannot be certain that Novus did acquire the rights to the unregistered mark LIBERATOR from Libra. I will therefore only consider the use of the mark by Novus.

According to Mr Holland, Managing Director of Novus, his company has sold goods under the mark in just about every part of the country. He gives the following as approximate retail sales figures relating to goods sold under the mark by Novus:—

<b>Year</b>	<b>£</b>
1991	400,000
1992	700,000
1993	1,200,000
1994	1,200,000

Mr Holland also gives the following approximate advertising figures:—

	<b>Year</b>	<b>£</b>
	1991	620
	1992	1,350
5	1993	1,500

The honesty of the concurrent use is not an issue between the parties, and there is no evidence that there have been any actual instances of confusion. Bearing in mind the highly specialised and technical nature of the equipment in which both parties trade, I am not surprised that there have been no instances of actual confusion. In neither case has the mark been used on goods which are likely to be purchased casually or by the public at large. Mr Carr submitted that I should still be considering notional use of goods within the two specifications for the purpose of guiding my exercise of the Registrar's discretion under section 12(2), but I have found this submission difficult to reconcile with the whole concept of section 12(2) which is directed towards a consideration of actual concurrent use in the market.

In all the circumstances I have decided that the applicant is entitled to benefit from an exercise of the Registrar's discretion under section 12(2) on the basis of honest concurrent use. I did have some doubts concerning the extent of Novus' concurrent use, but in the event I resolved those doubts in Novus' favour having regard to the probability that Novus may have acquired some rights from Libra, arising from use of the mark LIBERATOR, which would have predated the opponent's own use of the mark. In giving Novus the benefit of the doubt, I recognise that the scope of section 12(2) is not confined to honest concurrent use, but also permits registration in 'special circumstances'. Thus it is appropriate to say that I have also regarded the probability of Libra being a predecessor in title of Novus as a special circumstance peculiar to the facts of this case.

As for the breadth of the specification that should be allowed in the exercise of this discretion, it seems only reasonable that the specification should be limited to those goods in relation to which there has been concurrent use. I note for example that the specification contains the term 'computer software'. Other than the overall exclusion relating to goods adapted for use by, or for aiding, the handicapped, there is no further definition of the term 'computer software'. Bearing in mind Mr Justice Laddie's comments in the *MERCURY* case<sup>5</sup>, I am only prepared to allow this application to proceed under section 12(2) if the whole specification is subject to the limitation that Mr Ashton offered in respect of certain items — that is to say, "all for communication protocol handling".

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<sup>5</sup>Mercury Communications Limited v Mercury Interactive (UK) Limited [1995] FSR 850

## Section 11

This section is in the following terms:

5           **11.** It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disintitiled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

10 Mr Ashton submitted that the section 11 ground would fall away in the event that I found in favour of his client under section 12(2). This follows from a decision of Mr Justice Danckwerts in the High Court in *Spillers Application*<sup>6</sup>. The following extract is taken from page 337 of the judgment as reported in RPCs:—

15           “It seems to me that the construction put by the House of Lords in the cases to which I have referred on Secs. 11, 19 and 21 of the 1905 Act must also apply to Secs. 11 and 12 of the 1938 Act, and lead to the conclusion that cases where the Court or Registrar thinks fit to exercise the discretion conferred by Sec. 12 (2) do not fall within the general prohibition contained in  
20           Sec. 11. This being so, it would appear logical in cases which come within Sec. 12 (1) to consider first whether the case is one in which the discretion conferred by Sec. 12 (2) should be exercised so as to allow registration of the mark, and if the answer is in the affirmative, it cannot be necessary to consider Sec. 11 separately, because if there are reasons other than resemblance to an existing mark which cause the proposed mark to be disintitiled to the protection of the  
25           Court, such reasons must surely affect the exercise of the discretion conferred by Sec. 12 (2). It is not possible, as it seems to me, to apply the provisions of the Act as though they were in separate compartments.

          In the result, if there is any likelihood of confusion being caused, in my view it would not be right to interfere with the Assistant-Comptroller’s exercise of the discretion under Sec. 12 (2).”

25           Consequently I do not need to consider the opposition under section 11 any further.

### *Registrar’s Discretion*

30           There remains the matter of the Registrar’s discretion. I have in effect already exercised the Registrar’s discretion under section 12(2) in allowing this application to proceed. In the circumstances I feel that it would be inappropriate, if not perverse, to even consider exercising discretion in a different direction under section 17(2).

35           As I have indicated above, shortly before the hearing the applicant applied on Form TM21 to amend the specification. Mr Ashton also tendered a number of other amendments to assist his case under section 12(2), and in the event I have indicated that the application must be amended still further in order to proceed. The applicant will have one month from the expiry of the appeal period in which to file a form TM21 to amend the specification of goods accordingly. If he fails so to do the application will be refused. For the avoidance of doubt,

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<sup>6</sup>*Spillers Ld.’s Application to Register a Trade Mark [1952] RPC 327*

the application may, upon the filing of form TM21, proceed to registration with the following specification:—

5 Computers and computing apparatus; encoded programs for computers and for  
calculators; electronic apparatus and instruments, all for storage, retrieval and  
transmission of data; magnetic tapes and cassettes, all for use therewith; punched  
10 (encoded) tapes; magnetic wires, magnetic filaments and integrated electrical circuits, all  
for the storage of analogue or digital data; visual display apparatus adapted for use with  
computers; electronic input and output apparatus, for linking telephone, radio or  
television apparatus, to computers or to data transmission apparatus; printout apparatus,  
15 all for use with computers or with data transmission apparatus; parts and fittings for all  
the aforesaid goods; computer software; all included in Class 9; all for communication  
protocol handling; none specifically adapted for use by, or for aiding the handicapped.

The applicant, having been successful in these proceedings, is entitled to a contribution  
towards the costs of defending the application. I therefore order the opponent to pay to the  
15 applicant the sum of **£400**.

**Dated this 28<sup>th</sup> day of January 1999**

**Mr S J Probert  
Principal Hearing Officer  
For the Registrar, the Comptroller-General**