

O-041-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 2320179 IN THE NAME OF INITIATIVE SOFTWARE LIMITED  
TO REGISTER A TRADE MARK IN CLASSES 9, 16, 41 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 92073 IN THE NAME OF  
CAPTIVA IMPORT EXPORT BETEILIGUNGS GMBH**

## **Trade Marks Act 1994**

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in the name of Initiative Software Limited  
to register a trade mark in Class 9, 16, 41 and 42**

**And**

**IN THE MATTER OF opposition thereto  
under No. 92073  
in the name of Captiva Import Export Beteiligungs GmbH**

### **BACKGROUND**

1. On 9 January 2003, Initiative Software Limited made an application, numbered 2320179, to register the trade mark CAPTAVIA in Classes 9, 16, 41 and 42 in relation to the following specifications of goods and services:

- Class 09:** Computer software; computer programs; magnetic, electro-magnetic and optical data recording means; programs and software for data management, customer relationship management, management information and economic development activity.
- Class 16:** Printed matter, publications, publicity, promotional and advertising material, leaflets, fax sheets, brochures, manuals, guides and newsletters.
- Class 41:** Training services relating to computer software and programs, namely arranging and conducting classes, workshops, presentations, seminars, lectures and bespoke training courses; creation and production of training materials.
- Class 42:** Design, development, installation, rental and licensing of computer programs and software for use by others; computer software consultancy; computer database consultancy; consultancy relating to computer software and networks; consultancy to include the installation of computer software; project management; licensing of computer software for data management, customer relationship management, management information and economic development activity.

2. On 27 October 2003, Captiva Import Export Beteiligungs GmbH filed notice of opposition to the application, the grounds of opposition being as follows:

**Under Section 5(2)(b)**

because the mark is similar to the opponents=earlier mark and because that earlier mark is protected for **Acomputer software@** which are goods identical to **Acomputer software; computer programs@** which are covered by the application. Due to the close similarity of the mark applied for with the opponents=earlier mark and the identity of the Class 9 goods in question, there exists a likelihood of confusion on the part of the public including a likelihood of association with the earlier mark.

because the mark is similar to the opponents=earlier mark and because that earlier mark is protected for goods identical and/or similar to those covered by the application. Due to the close similarity of the mark with the earlier mark and to the similarity of the Class 9 goods for which protection is claimed by the opponent and the goods and services in Classes 9, 16, 41 and 42 of the application, there exists a likelihood of confusion on the part of the public including a likelihood of association with the earlier mark.

3. The opponents rely on one earlier mark that has a filing date of 2 February 2002, details of which are as follows:

<b>Mark</b>	<b>Number</b>	<b>Classes</b>	<b>Specifications</b>
Captiva	CTM2069532	9	Data processing equipment and computers; computer software; electronic components, in particular transistors, microprocessors, memory modules, storage media.
		37	Configuration, namely the customised assembly of electronic components.
		38	Telecommunications.

4. The applicants filed a counterstatement in which they concede that **Acomputer software; computer programs@** are similar goods to **Acomputer software@** but deny the ground on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Only the applicants filed evidence in these proceedings, which, insofar as it may be relevant to these proceedings I have summarised below. Neither side took up the offer of a hearing, electing instead to have the matter determined from the papers in lieu of a hearing.

### **APPLICANTS= EVIDENCE**

7. This consists of a Witness Statement dated 1 April 2004, from David Marshall, Finance Director of Initiative Software Limited.

8. Mr Marshall gives details of the value of products and total sales of services provided under the CAPTAVIA trade mark in the years 2003 and 2004. The goods he describes as being mainly the sales of perpetual software licences for which they achieved , 44,755 and , 122,278 in sales. The services provided under the mark are stated to be the provision of training, installation, development and support services related to the product, for which they derived , 171,404 and , 568,404 in income. Mr Marshall gives the total spend on advertising products and services under the CAPTAVIA trade mark since 2003 as at least , 40,000.

8. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

### **DECISION**

10. The opposition is founded on Section 5(2)(b), which reads as follows:

**A5.**-(2) A trade mark shall not be registered if because -

(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.@

11. An earlier trade mark is defined in Section 6 of the Act as follows:

**A6.**- (1) In this Act an Aearlier trade mark@ meansB

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

12. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

13. The applicants concede that the computer software and computer programs contained within Class 9 of their application are similar goods to the computer software covered by the corresponding class of the opponents' earlier mark. In fact, these goods are quite clearly identical, and as the opponents' earlier mark covers all computer software regardless of its functionality, so are the programs and software for data management, customer relationship management, management information and economic development activity. The electro-magnetic and optical data recording means covered by the application are goods on which programs are recorded, and in my view are closely allied to the material they are intended to bear so as to be considered similar.

14. The term **Printed matter** in Class 16 of the application would include **Computer programmes in printed form** which are similar goods to the computer software in Class 9 of the opponents' earlier mark. The items **Manuals** and **Guides** are often provided by the software supplier in conjunction with the primary goods to explain the use and functionality of programs, and as such are closely allied goods. The remaining goods covered by Class 16 of the application, in my view, are not similar to the goods or services covered by the opponents' earlier mark.

15. Even though the services covered by Class 41 of the application may be provided in relation to the use of the goods, and provision of the services covered by the opponents' earlier mark, there is no evidence that traders in such goods and services also provide training. In my view these goods and services are different and distinct.

16. The services covered by Class 42 of the application, for example, the design, development, installation, rental and licencing of software is but another facet of the goods covered by goods of Class 9 of the opponents' earlier mark, and I consider them to be similar services.

17. The goods and services covered by the respective trade marks are of a technical nature. As such they are likely to be bought by a knowledgeable and well informed consumer, or at the very least by those who will have given a good deal of consideration to their suitability for their intended purpose. Apart from this there is nothing that I can see in any of the specifications that limits the stated goods and services as being of a particular specialism or for a specific group or market sector, and this being the case I must proceed on the basis that they reach the market through the same channels of trade, and are available in the same market to the same consumers.

18. Turning to the respective marks. In any analysis it is inevitable that in any comparison for the purposes of establishing similarity, reference will be made to the construction of the respective marks, and rightly so, for the case law requires consideration to be given to the distinctiveness and dominance of any discernible component parts. However, it must be remembered that it is the marks as a whole that are to be compared.

19. The mark applied for is the word **CAPTAVIA**; which the opponents assert is similar to their trade mark **CAPTIVA**. As far as I am aware, and there is no evidence to the contrary, neither of these words is an ordinary English word. They should be regarded as invented words having no recognisable meanings, and certainly none that is relevant to the respective goods or services. As such, both should be considered to possess a strong distinctive character, which, as there is no evidence of enhanced distinctiveness or a reputation acquired through use, is particularly important for the opponents' earlier mark.

20. In a visual comparison of such marks the impression on the eye is brought about by similarities in their structure created by the sequencing of the letters, and whether there are elements that would be, stronger, recognisable and memorable to the consumer. Seen together it is clear that the respective marks share the same first four letters, have the same terminal letter and that the ending is of a similar construction. As a whole the respective marks are very similar in appearance.

21. Both of the respective marks commence with the letters ACAPT which has a strong sound. Although words are not generally spoken with regard to each and every syllable, being such a strong sound and particularly given its positioning at the beginning of the word, this element is likely to be clearly enunciated. The following syllable is softer in sound and being in the body of the word will have lesser impact as the tongue forms on the strong letter AV. Whilst both marks end in the letter AA, the preceding letter AI in the applicants' mark creates a sound that if pronounced with regard to the lettering will be different to the ending of the opponents' mark. But as I have already said, this is not how words are usually spoken, and being at the end of the word (which has a tendency to be slurred) will diminish the differences. Taken as a whole in ordinary usage I would say that the words will sound similar.

22. The respective marks have some resemblance to the ordinary English word Acaptive, the applicants' mark more so than the opponents, and this may be the idea that forms in the consumers' mind on seeing the marks. It may also be that they will not see the similarity to the word. Consequently, I cannot be sure that if the respective marks say anything to the consumer, this will be the same in both cases.

23. Balancing the similarities against the differences, I come to the view that the respective marks should be regarded as being similar.

24. Taking all factors, in particular, the identity in the goods/services, channels of trade and consumer, the similarities in the respective marks and the potential for confusion through imperfect recollection into account, I come to the view that if the applicants were to use their mark in connection with the goods and services that I have found to be identical/similar in Classes 9, 16, and 42, that there is a real likelihood of confusion. The objection under Section 5(2)(b) succeeds in respect of these classes, but in relation to the services covered by Class 41 the opposition fails.

25. The opposition having been successful, albeit in part, the opponents are entitled to a contribution towards their costs. I therefore order that the applicants pay the opponents the sum of , 750 towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 8<sup>th</sup> day of February 2006**

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