

O-128-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2291389  
BY ELECTRONIC DOCUMENT SERVICES LIMITED  
TO REGISTER THE TRADE MARKS:**

**docucentre  
Docucentre  
DocuCentre  
DOCUCENTRE**

**(SERIES OF FOUR TRADE MARKS)**

**IN CLASSES 16, 35, 38, 39 AND 41**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 91369  
BY XEROX CORPORATION  
BASED UPON THE EARLIER TRADE MARKS:**

**DOCUCENTRE  
DocuCentre  
DOCUCENTER**

**(SERIES OF THREE TRADE MARKS)**

## **Trade Marks Act 1994**

**In the matter of application no 2291389  
by Electronic Document Services Limited  
to register the trade marks:**

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**as a series of four  
in classes 16, 35, 38, 39 and 41  
and the opposition thereto  
under no 91369  
by Xerox Corporation**

### **BACKGROUND**

1) On 30 January 2002 Electronic Document Services Limited, which I will refer to as EDS, applied to register the above trade marks as a series of four. The application was published for opposition purposes in the "Trade Marks Journal" on 25 September 2002 with the following specification:

*printed matter; instruction manuals; directories and listings; technical and educational publications;*

*data, document and image handling, reproduction and processing; document production and finishing; photocopying services; publication of advertising and publicity texts; computerised information storage; archiving and retrieval services; database management; document file creation; consultancy and advisory services relating to all the aforesaid services;*

*direct mailing services; transmission of documents; computerised transmission of documents and images; electronic mail services; electronic distribution of documents and images;*

*transporting and storage of letters, files, documents, images and printed matter and electronically stored media; warehousing; and archiving;*

*electronic publishing services; document publishing services; publication of manuals.*

The above goods and services are in classes 16, 35, 38, 39 and 41 respectively of the “International Classification of Goods and Services”.

2) On 24 December 2002 Xerox Corporation , which I will refer to as Xerox, filed a notice of opposition. Xerox is the owner of United Kingdom trade mark registration no 2291389 for the trade marks: **DOCUCENTRE**, **DocuCentre** and **DOCUCENTER** (a series of three). The trade marks are registered for the following goods:

*copiers; digital color copiers; photocopying apparatus; optical measuring, signalling and control apparatus and instruments; apparatus for recording, transmission and reproduction of images and color images; facsimile transmitting and receiving apparatus; multifunctional devices which incorporate a copier and facsimile functions in the standalone mode; multifunctional devices which incorporate a copier, facsimile, scanner and/or printer functions when the multifunctional device is attached to a personal computer; computer controlled sheet feeding apparatus; computer apparatus, calculating and counting devices; word and data processors, plotters, pre-recorded material for use with computers; computer hardware, peripheral devices, software, disc memories, magnetic wires, discs and tapes; semi-conductor memories; visual display apparatus; apparatus and instruments for storage, retrieval and display of data; modems; telecommunications apparatus and equipment; keyboards for use with computers and print out apparatus; computer programmes; electromagnetic devices containing or carrying data or information; parts and fittings for all the aforesaid goods; all included in Class 9.*

The registration includes the following disclaimer:

“Registration of these marks shall give no right to the exclusive use of the word “Centre”.”

3) Xerox states that the registrar has accepted the four trade marks of the application as a series. Consequently, he regards the trade marks as differing only as to matters of non-distinctive character not substantially affecting the identity of the trade marks (section 41(2) of the Trade Marks Act 1994 (the Act). Xerox states that the three trade marks of its registration are also registered as a series. It states that two of the trade marks of the application, DocuCentre and DOCUCENTRE, are identical to two of its trade marks. Xerox states that the other two trade marks of the application are effectively identical to the trade marks of its registration, in accordance with the opinion of Advocate General Jacobs in *SA Société LTJ Diffusion v SA Sadas*.

4) Xerox states that the goods and services of the application are all entirely ancillary to the goods of its registration. It states that its registration includes *copiers, digital color copiers; photocopying apparatus* and the application includes *photocopying services*. Its registration includes *apparatus for recording, transmission and reproduction of images and color images; facsimile transmitting and receiving apparatus*, the application includes *transmission of documents; computerised transmission of documents and images; electronic distribution of documents and images*. Its registration includes

*apparatus and instruments for storage, retrieval and display of data*, the application includes *storage of letters, files, documents, images and printed matter and electronically stored media*. Xerox states that in effect the application covers the services which it is possible to provide by utilising the goods of its registration. Xerox states that it is possible that EDS uses its goods to supply the specified services. Xerox states that the goods in class 16 of the application are merely the end product of making use of the apparatus included in its registration.

5) Xerox claims that because the respective trade marks are identical and the respective goods and services are similar there is a likelihood of confusion. Registration of the trade marks of EDS would, therefore, be contrary to section 5(2)(a) of the Act.

6) In the alternative, Xerox claims that because the respective trade marks are similar and the respective goods and services are similar, there is a likelihood of confusion. Registration of the trade marks of EDS would, therefore, be contrary to section 5(2)(b) of the Act.

7) Xerox seeks the refusal of the application and an award of costs.

8) EDS filed a counterstatement. EDS states that the nature and purpose of the respective goods and services are not similar. As there is no similarity of goods and services there is no likelihood of confusion. EDS states that given the different fields of activity between the respective goods and services, neither the trade marks nor the respective goods and services will ever compete in the market place. Consequently, EDS denies that registration of the trade marks would be contrary to section 5(2) of the Act.

9) EDS states that registration of the trade marks would not interfere with the legitimate conduct of Xerox's business. It states that Xerox is engaged in the sale and supply of photocopiers and ancillary equipment whilst it is engaged in the provision of outsourced office mailroom and document production services. EDS states that it does not manufacture photocopiers or other electrical equipment. It states that the provision of photocopying services forms a very small part of its outsourcing service and accordingly there is no likelihood of confusion. EDS states that it has used its trade mark continuously in the United Kingdom since September 2002. EDS states that it understands that Xerox does not use its trade marks other than the manner specified on the register in respect of certain specified goods in class 9.

10) EDS denies that the respective goods and services are ancillary, wholly or partially. It states that taking into account the nature and composition of the respective goods and services, the respective uses to which the trade marks are put and the trade channels through which the respective goods and services are sold, the average, reasonably informed consumer of the goods is not likely to confuse the goods of Xerox with its services.

11) EDS requests that the opposition is dismissed and seeks an award of costs.

12) Both sides filed evidence.

13) 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. Xerox submitted written submissions, which I take into account in reaching my decision.

## **EVIDENCE**

### **Issue of confidentiality**

14) Part of the evidence of EDS consists of a witness statement by Margaret Walker Lang. Ms Lang has exhibited to her witness statement a schedule to an agreement between EDS and Martin Currie Investments, this schedule sets out the specification of services which EDS supplies to Martin Currie Investments under the brand DOCUCENTRE. Ms Lang states in her statement:

“(please note that the terms of the attachment hereto are strictly confidential and must not be disclosed to any party or parties other than the Patent Office and the Opponents, and then only for the purpose of determining the Opposition);”

Unfortunately this request for confidentiality has not been addressed by the registrar. I will, therefore, deal with the issue now. The exhibit could be of use to trade rivals, for instance in tendering. I do not see that there is any public interest in having it open to third parties. This is especially the case as I do not consider that the detail of the document has any major bearing upon the issues under consideration in relation to section 5(2) of the Act. It would have been far better if the issue had been addressed at the time the statement was filed; giving Xerox a chance to comment. However, confidentiality being granted will not prejudice the case of Xerox. Rather than delay a decision by going back on this issue, I will grant an order of confidentiality. I will grant it in slightly different terms than those requested in order to take into account the eventuality of this decision being the subject of an appeal. If either side objects to the order it can make that a matter of appeal, either on its own or as part of an appeal against the substantive issue.

15) Pursuant to rule 51 of the Trade Marks Rules 2000, on 29 April 2004 I signed a confidentiality order. The confidentiality order reads as follows:

“The document in this folder, being exhibit 1 of the witness statement of Margaret Walker Lang, is subject to confidentiality. It is not open for public inspection.

The document is open to Xerox and its legal representatives for the purposes of this opposition only. It cannot be used by Xerox or its legal representatives for any other purposes. The document is also open to staff of the Patent Office and its officers for the purposes of deciding and administering this opposition. In the

event of an appeal it will also be open for consideration by the appellate body(ies).

Signed this day the 29<sup>th</sup> of April 2004 at Newport, South Wales by David Landau.”

### **Evidence of Xerox**

16) This consists of a witness statement by Michael Arthur Lynd. Mr Lynd is a trade mark attorney who is acting for Xerox.

17) Mr Lynd states that on 4 July 2003 he carried out a search of the worldwide web using the Google search engine. He exhibits the results of the search. The search term entered was “docucentre” and the request was for “pages from the UK”. Forty five “hits” are displayed. Mr Lynd states that 35 of them relate to Xerox products. He has indicated these with a cross in blue ink. Mr Lynd appears to make this statement on the basis of the words Xerox or Fuji Xerox appearing in the same summary, if not always in direct conjunction. In fact, as far as I can see, in ten of the entries there is no mention of Xerox or FujiXerox and in three of these ten no mention of “docucentre” at all. Other “hits” include references to “Docucentre and Shopping”, “Mayfair Docucentre”, “For Photocopying, transparencies, and computer printing, go to the Docucentre, located off the level 2 walkway of the Sherfield building” and “docucentre is closed, have to find a photocopier”. Mr Lynd states that this search shows that the main association in the minds of the public of the word DOCUCENTRE is with the products and services of Xerox. Mr Lynd states that Xerox has operated “Xerox Copy Shops” in the United Kingdom. He gives no further details of this. The rest of the statement is submission rather than evidence of fact and so I will say no more about it here, but bear it in mind in reaching my decision.

### **Evidence of EDS**

#### **Statutory declaration of Andrew Charles Ley**

18) Mr Ley has acted as the trade mark attorney of EDS. Mr Ley starts his declaration with submissions and I will treat these in the same way as those of Mr Lynd. Mr Ley exhibits a copy of a case study from EDS’s website which deals with Henderson Boyd Jackson WS outsourcing various office services to it, these include: mailroom, reprographics, stationery procurement, filing, archive administration and courier coordination. Mr Ley is an associate partner of Henderson Boyd Jackson WS and states that EDS set up a DOCUCENTRE at Henderson Boyd Jackson WS’s offices in October 2002.

19) Mr Ley exhibits a copy of the results of a search conducted on yell.com on 22 October 2003. He searched for all companies in the United Kingdom called DOCUSERVE, which he describes as the trading name of EDS. He had two “hits”, one of which is EDS. The business of both undertakings is described as document

management. Mr Ley searched for all companies in the United Kingdom called Xerox. There were fifteen “hits”, most for Xerox (UK) Ltd. Of the hits eleven refer to photocopiers, one to office equipment retailers, one to printing machine manufacturers and suppliers, one to office stationery and one to conference facilities and services. Mr Ley searched for businesses in Scotland operating in the field of document management. There are 33 “hits”, one of which is for DOCUSERVE. Mr Ley makes the point that Xerox is not one of the hits. Mr Ley finally searched for businesses in the United Kingdom operating in the field of copying and duplicating services. Neither Xerox nor EDS appear in the list of “hits”.

20) Mr Ley states that he conducted a search on Google on 22 October 2003 on the same basis as Mr Lynd had. Mr Ley states that the “hits” are almost identical to the “hits” found in Mr Lynd’s search. He states that all of the hits which relate to Xerox are preceded by the word Xerox and/or followed by a sequence of numbers designating the specific model of the equipment to which reference is being made. Mr Ley states that none of the “hits” relate to services provided by Xerox.

21) Mr Ley exhibits a list of trade marks registered in the names of Xerox or Xerox Limited in the United Kingdom. He also exhibits a similar list of trade marks in the name of Canon Kabushiki Kaisha.

22) Mr Ley states that there is no evidence exhibited in relation to Xerox branded copy shops in the United Kingdom. He states that he understands that any such copy shops were sold to The Color Company a number of years ago. Mr Ley exhibits a cross-search list for class 9 downloaded from The Patent Office’s website on 21 October 2003. He states that this cross-search list does not show any of the services provided by EDS under DOCUCENTRE. The cross-search list includes telecommunications at large in class 38.

23) There is much submission and argument in the declaration as well as that referred to above. Again, it is not appropriate to summarise it here but I bear the comments in mind when reaching a decision.

**Witness statement of Margaret Walker Lang**

24) Ms Lang is the managing director of EDS. She exhibits a copy of the specification of services schedule to an agreement between EDS and Martin Currie Investments (the subject of a confidentiality order). Ms Lang states that this exhibit indicates the type of services which EDS provides under the trade mark DOCUCENTRE. She states that EDS are involved in the back-office functions of its clients including mailroom, reprographics, stationery procurement, filing, archive administration and courier coordination.

## DECISION

### Likelihood of confusion – sections 5(2)(a) and (b) of the Act

25) Sections 5(2)(a) and (b) of the Act state:

“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.”

The term ‘earlier trade mark’ is defined in section 6(1) of the Act as follows:

“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”.

Xerox’s trade marks are earlier trade marks within the terms of section 6(1) of the Act.

26) In determining the question under section 5(2) of the Act 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 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

27) EDS has not denied that the respective trade marks are identical, as claimed by Xerox. In the absence of any denial I accept that the respective trade marks are identical.

28) Unfortunately, EDS has cast most of its seed on stony ground in relation to its evidence and the submissions linked to that evidence. It deals with what services it supplies and what it considers Xerox does. However, what I have to consider is normal and fair use in relation to the specifications of both the earlier registration and the application. (EDS’s argument does not even take into consideration that trade marks can be sold to third parties.) This is a matter which has been said on many occasions and is something that was touched on recently by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] EWCA 520 (Ch) where he stated:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

### **Comparison of goods and services**

29) In its evidence EDS refers to *Jellinek's Application* [1946] 63 RPC 59. This provided the basis for the test of goods of the same description under the 1938 Act, it is not the basis for the consideration of the similarity of goods and/or services under the 1994 Act. EDS has referred to the Registry's cross-search manual in its evidence. This is a tool for examiners, it is not a definitive statement as to the similarity or otherwise of goods and services. The decision as to similarity of goods/services has to be based upon the nature of the goods and services within the context of the relevant case law. This consideration can also take into account any evidence as to what happens in trade. Mr Lynd states that Xerox has operated “Xerox Copy Shops” in the United Kingdom. However, he fails to give any details as to the nature of this business.

30) In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, the European Court of Justice held in relation to the assessment of the similarity of goods and services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. I do not consider that there is any dissonance between the two tests. However, taking into account the judgment of the European Court of Justice, it is necessary to consider whether the goods and services are complementary.

31) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). In relation to the comparison of services I firmly bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Although it dealt with a non-use issue I consider that the words of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

32) The goods of the earlier registration are:

*copiers; digital color copiers; photocopying apparatus; optical measuring, signalling and control apparatus and instruments; apparatus for recording, transmission and reproduction of images and color images; facsimile transmitting and receiving apparatus; multifunctional devices which incorporate a copier and facsimile functions in the standalone mode; multifunctional devices which incorporate a copier, facsimile, scanner and/or printer functions when the multifunctional device is attached to a personal computer; computer controlled sheet feeding apparatus; computer apparatus, calculating and counting devices; word and data processors, plotters, pre-recorded material for use with computers; computer hardware, peripheral devices, software, disc memories, magnetic wires, discs and tapes; semi-conductor memories; visual display apparatus; apparatus and instruments for storage, retrieval and display of data; modems; telecommunications apparatus and equipment; keyboards for use with computers and print out apparatus; computer programmes; electromagnetic devices containing or carrying data or information; parts and fittings for all the aforesaid goods; all included in Class 9.*

The goods and services of the application are:

*printed matter; instruction manuals; directories and listings; technical and educational publications;*

*data, document and image handling, reproduction and processing; document production and finishing; photocopying services; publication of advertising and publicity texts; computerised information storage; archiving and retrieval services; database management; document file creation; consultancy and advisory services relating to all the aforesaid services;*

*direct mailing services; transmission of documents; computerised transmission of documents and images; electronic mail services; electronic distribution of documents and images;*

*transporting and storage of letters, files, documents, images and printed matter and electronically stored media; warehousing; and archiving;*

*electronic publishing services; document publishing services; publication of manuals.*

33) In its statement of case Xerox states that its registration includes *copiers, digital color copiers; photocopying apparatus* and the application includes *photocopying services*. Its registration includes *apparatus for recording, transmission and reproduction of images and color images; facsimile transmitting and receiving apparatus*, the application includes *transmission of documents; computerised transmission of documents and images; electronic distribution of documents and images*. Its registration includes *apparatus and instruments for storage, retrieval and display of data*, the application includes *storage of letters, files, documents, images and printed matter and electronically stored media*. Xerox states that in effect the application covers the services which it is possible to provide by utilising the goods of its registration. Xerox states that it is possible that EDS uses its goods to supply the specified services. Xerox states that the goods in class 16 of the application are merely the end product of making use of the apparatus included in its registration.

34) There are large parts of the specification about which Xerox puts forward no argument as to similarity other than vaguely saying that the respective goods and services are ancillary. I do not find the argument that goods and/or services are similar because one uses one to produce the other very convincing. Does this mean that a novel and a printing press are similar? Restaurant services and frying pans? Other than what can be considered to fall within the bounds of judicial notice, this is an evidential matter.

35) I intend dealing firstly with those services of the application that Xerox has not identified specifically. These are:

*data, document and image handling, reproduction and processing; document production and finishing; publication of advertising and publicity texts; computerised information storage; archiving and retrieval services; database management; document file creation; consultancy and advisory services relating to all the aforesaid services - class 35*

*direct mailing services; electronic mail services -class 38,*

*transporting of letters, files, documents, images and printed matter and electronically stored media; warehousing; and archiving - class 39;*

*electronic publishing services; document publishing services; publication of manuals – class 41.*

I cannot see where the class 38, 39 and 41 services listed above coincide in any meaningful way with the goods of the earlier registration. Even the general argument that the goods of the registration will be used in the commission of the services does not hold sway for various of the services eg *warehousing* and *transporting of letters*. I am of the view that this absence of meaningful coincidence relates also to *publication of advertising and publicity texts; computerised information storage; archiving and*

*retrieval services; database management; document file creation; consultancy and advisory services relating to all the aforesaid services* in class 35.

36) I am aware of undertakings which supply such services as photocopying, binding of documents and facsimile transmission services under one roof. No evidence has been furnished in relation to such undertakings. However, I am of the view that they are so well established that they fall within the bounds of judicial notice. EDS seeks in its evidence to establish that it does not provide such services, it is mainly a back-office undertaking. It has also tried to establish that Xerox does not provide such services. However, as I have stated above, I have to consider what the specifications cover, not the actual businesses of the two sides. In class 35, I am of the view that *data, document and image handling, reproduction and processing; document production and finishing; photocopying services* are very much the sort of services that are provided by the sort of undertaking to which I have referred. The aforesaid services would certainly be likely to use various of the goods of Xerox's registration eg *digital color copiers; photocopying apparatus multifunctional devices which incorporate a copier, facsimile, scanner and/or printer functions when the multifunctional device is attached to a personal computer and copiers*. Consequently, the goods and services can be considered to be complementary. An undertaking could own the machines of Xerox or use the services of EDS for the same purpose eg the production of a document. Consequently, the respective goods and services are in competition. The user is defined by the purpose of the goods or services. In both cases this could be to copy and/or produce documents. Therefore, I am of the view that the respective users are potentially the same. **Taking the above into account I find that *data, document and image handling, reproduction and processing; document production and finishing; photocopying services* are similar to the goods of the earlier registration.**

37) Xerox has claimed that *apparatus for recording, transmission and reproduction of images and color images; facsimile transmitting and receiving apparatus* of its registration are similar to *transmission of documents; computerised transmission of documents and images; electronic distribution of documents and images* of the application. The services of EDS have to be given a normal meaning, not a stretched one but not one that unreasonably restricts the breath of the natural meaning (*British Sugar Plc v James Robertson & Sons Ltd, Thomson Holidays Ltd v Norwegian Cruise Line Ltd, Avnet Incorporated v Isoact Ltd* and *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*). *Transmission of documents* must include the facsimile transmission of documents, inter alia. I have had some difficulty in coming to a view as to what the rest of the terms under consideration could encompass in a normal and fair reading. It clearly could cover sending documents by e-mail; not something that I consider can represent a realistic proposition in terms of similarity of goods and services. However, facsimile transmission is not just effected by the traditional facsimile machine. It is also effected by computer terminals making use of fax modems, indeed this is a common way of making facsimile transmissions. However, there is no evidence to show that the type of undertaking that I have referred to in paragraph 36 would go to the bother of scanning a document into a computer system and then use the system to transmit it as facsimile transmission. It strikes me as an unlikely

possibility. I have referred back to the type of undertaking in paragraph 36 as this, in my view, represents the only serious basis for a finding of similarity; on the evidence before me, or more correctly the absence of evidence before me, it is the only trade reality in which the parameters of similarity can be set. In the reality of trade, and the absence of evidence, I am of the view that the only case that Xerox has relates to its *facsimile transmitting and receiving apparatus and transmission of documents* of the application. As *transmission of documents* can encompass facsimile transmission there is a complementary relationship with the goods of Xerox's registration. Someone who wants to send documents by facsimile transmission can purchase a machine for the purpose or use the services of the paragraph 36 type of enterprise, consequently, the goods and services are in competition. The end user will be the same, someone who wishes to transmit documents by facsimile transmission. **Taking all the above factors into account I find that *transmission of documents* is similar to the goods of the earlier registration.**

38) Xerox claims that *apparatus and instruments for storage, retrieval and display of data* is similar to *storage of letters, files, documents, images and printed matter and electronically stored media* of the application. The bulk of the services in question are about storage of physical matter. I can see no way that such services bear any meaningful similarity with the goods of the earlier registration. This leaves the *storage..... of electronically stored media* part of the specification to consider. The goods of Xerox's registration could be used for the electronic storage of data. The issue of similarity has to be contextualised within the reality of trade. As I have already stated there is an absence of evidence as to the reality of the trade. There is nothing to suggest that any undertaking supplies the service under question to the person in high street premises. In the absence of evidence to the contrary, the service is likely, in my view, to be offered by an undertaking offering back office services, as EDS does. It is likely to be offered as part of a package of services, as EDS does. In the context of the reality of trade I cannot see that one would substitute a machine which has the potential to perform the service for the service. The channel of trades are likely to be very different; one is not likely, for instance, to find the service supplied by an office supplies shop. The end user might well be the same, the undertaking which wants data stored. However, owing to the nature of the service I cannot see that in reality the services and the goods are in competition. I am of the view that the similarities are superficial rather than real and find that the services under consideration are not similar to the goods of the earlier registration.

39) This leaves the class 16 goods of the application. The basis of the attack is that the goods are "merely the end-product of making use of the apparatus protected by registration number 1588309". As I have indicated this is not an argument that I find convincing. In my view there is potentially only an issue in relation to *instruction manuals*. Such goods could be instructional manuals for the goods of the registration and so could be complementary and have the same user, they could also share the same channels of trade. The general term *printed matter* will encompass *instruction manuals* and so must be judged upon the same basis. Equally, the term *technical publications* will

encompass *instruction manuals*. **I find that *printed matter, instruction manuals and technical publications* are similar to the goods of the earlier registration.**

## **Conclusion**

40) For there to be a likelihood of confusion there has to be a similarity of goods and/or services, that is what section 5(2) of the Act demands. Consequent upon my findings above, I can only possibly find a likelihood of confusion in respect of the following goods and services:

*printed matter, instruction manuals and technical publications* in class 16;

*data, document and image handling, reproduction and processing; document production and finishing; photocopying services* in class 35;

*transmission of documents* in class 38.

41) However, it is not an automatic sequitur that because goods and/or services are similar and the signs in relation to which they are used are identical or similar, that there is a likelihood of confusion. The consideration of likelihood of confusion is a global appreciation, it is not a simple matter of totting up points. The question I have to consider is as to whether, taking into account all the facts and factors, there is a likelihood of confusion, a likelihood not a risk. In this case this is not a matter that I have found easy. The case law demands that certain matters have to be taken into consideration. Where trade marks are identical the issue of imperfect recollection does not come into play; there is nothing to distinguish the trade marks. 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 the trade marks are identical. 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 evidence that Xerox has furnished certainly does not establish that its trade mark has established a reputation, indeed it hardly establishes anything. 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, *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v Boots und Segelzubehör Walter Huber, Franz Attenberger* (Joined Cases C-108/97 and C-109/97) [1999] ETMR 585). The trade marks of the earlier registration give an indication as to the purpose of certain of the goods, machines that can perform several functions in relation to documents.

However, many trade marks do a successful job whilst having an allusion to the goods. In this case the main clashes centre upon the *photocopying apparatus* and *facsimile transmitting and receiving apparatus* of the earlier registration, in relation to such goods the allusion is diluted. I am of the view that the trade marks of the earlier registration enjoy a reasonable degree of inherent distinctiveness.

42) As I have stated there is no establishment of a reputation of the trade marks of Xerox. Such a reputation could make the consumer more ready to believe that there was an economic link between the goods of Xerox and the goods and services of EDS. However, that the earlier trade marks are reasonably distinctive and that the respective trade marks are identical must assist the case of Xerox. There is no evidence to suggest that undertakings supply the goods of Xerox and the services of EDS under the same trade marks, or indeed that undertakings supply such goods and services even under different trade marks. Xerox's case really rests upon the paragraph 36 type business, a shop that will supply business requirements such as copying and facsimile transmission. If the consumer was aware of Xerox's trade mark for photocopiers for instance, would he or she seeing the same trade mark being used for photocopying services believe that the goods and services were supplied by the same undertaking or economically linked undertakings (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)? Taking into account all the factors of this case I consider there would be more than a mere association in the minds of the public owing to the identity of the signs. There would be the likelihood of confusion.

43) In relation to the goods which I have found similar, the answer is more clear cut. If one saw the name on a manual for any of the goods of the earlier registration, I cannot see how the average consumer for the goods would not consider that the respective goods came from the same undertakings.

44) The registration of Xerox has a disclaimer of the word centre. Xerox has no rights in this word on its own. However, it does have rights in its trade marks in their entirety and so the issues considered in *Paco/Paco Life in Colour Trade Marks* [2000] RPC 451 do not come into play.

45) Taking into account the nature of EDS's actual business and the specification of Xerox's earlier registration, it is doubtful in the real world if there would be confusion in the market place. However, as I have emphasised, I have to take into account notional use of all the services of the application. I also have to bear in mind that EDS's intentions might change or that the trade mark might be sold.

**46) I find that there is a likelihood of confusion in respect of the following goods and services of the application:**

***printed matter, instruction manuals and technical publications in class 16;***

***data, document and image handling, reproduction and processing; document production and finishing; photocopying services in class 35;***

*transmission of documents in class 38.*

47) EDS should file, within one month of the expiry of the appeal period from this decision, a form TM21 to amend the specifications of its application in classes 16, 35 and 38 so that they read as follows:

*directories and listings; educational publications;*

*publication of advertising and publicity texts; computerised information storage; archiving and retrieval services; database management; document file creation; consultancy and advisory services relating to all the aforesaid services;*

*direct mailing services; computerised transmission of documents and images; electronic mail services; electronic distribution of documents and images.*

**If no form TM21 is filed within the period set the application will be refused in its entirety. (If an appeal is filed the period for filing the form TM21 will be one month from the final determination of the case, if the appeal is unsuccessful.)**

#### **Costs**

48) EDS has for the most part been successful and so is entitled towards a contribution towards its costs. In making the award I take into account that the evidence which EDS submitted did not really go to the issue under section 5(2) of the Act, likewise the evidence of Xerox. Consequently, the only award I will make in relation to the evidence is in relation to EDS having to consider the evidence of Xerox. That Xerox's evidence was not germane to the issues in this case does not affect the fact that it had to be considered. **I order Xerox Corporation to pay Electronic Document Services Limited the sum of £600. 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 12th day of May 2004**

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