

**IN THE MATTER OF Application No: 1384713
by A C Nielsen Company
for the registration of a trade mark in Class 35**

**AND IN THE MATTER OF Opposition thereto
under No: 47702 by Taylor Nelson AGB Plc**

Background and Pleadings

1 On 18 May 1989, A C Nielsen Company of 150 North Martingale Road, Schaumburg, Illinois
60173, United States of America applied for registration of the trade mark shown below in
Class 35:

INSIGHT

6 Following examination under the provisions of the 1938 Trade Marks Act, the application was
subsequently converted to an application under the 1994 Trade Marks Act and given a revised
filing date of 31 October 1994. Following re-examination, the application was accepted on the
basis of Honest Concurrent Use with registration Nos:1289585 in Class 36 and 1283408 in
11 Class 35, both for the mark INSIGHT. The application was published for the following
services:

16 “Compilation and provision of business information and statistics; marketing
studies and research; business research; business management assistance; all
relating to the provision of information on marketing, product development and
product performance”.

The application is opposed by Taylor Nelson AGB Plc of AGB House, Westgate, London W5
1UA. The grounds of opposition are as follows:

- 21 1) Under Section 3(1)(b) of the Act, because the mark is devoid of any distinctive
character.
- 26 2) Under Section 3(1)(c) of the Act, because the mark indicates the intended
purpose of the services.
- 3) Under Section 3(1)(d) of the Act, because the mark is commonly used in the
relevant trade.
- 31 4) Under Section 3(6) of the Act, because the applicants were, or should have been,
aware of the opponent’s use at the date of application.

1 5) Under Section 5(1) or 5(2) of the Act, because of the existence of prior registration
No's: 1289585 and 1283408 in the names of Laurentian Life Plc and Ipsos Insight
Marketing respectively.

6 6) Under Section 5(4) of the Act, by virtue of the use the opponent's have made
of the mark INSIGHT since 1990, in relation to a computer programme which enables
one to access databases containing market research information and to then analyse
that information.

11 The applicants filed a counterstatement in which the grounds of opposition are denied. In so
far as the grounds of opposition under (5) above are concerned, the applicants say that as the
opponents are not the proprietors of the marks in question, they are not entitled to object to
registration on the basis indicated, given that the application proceeded under the provisions of
Section 7(2) of the 1994 Trade Marks Act. I will return to this point later in my decision.

16 Only the applicants ask for an award of costs. While both parties filed evidence in these
proceedings, neither side has asked for a hearing. Acting on behalf of the Registrar and after a
careful study of the papers, I give this decision.

21 **Opponent's Evidence-in-Chief**

21 This consists (essentially) of two Statutory Declarations dated 30 April 1998, by David
Bateson who is a Solicitor and assistant legal adviser to the opponents. It was necessary in the
course of proceedings for Mr Bateson to file a third declaration to correct a number of
discrepancies present in (what I shall call) his first declaration. Nothing turns on these
26 discrepancies and I propose to make no further substantive reference to them.

31 In his first declaration Mr Bateson explains that in 1988 the opponents adopted the mark
INSIGHT for use in relation to software and methodology for the analysis of market research
data. Exhibit A to Mr Bateson's declaration is a copy of a publicity leaflet describing the
opponent's product. While undated, the leaflet refers to "The following packages are planned
for 1991", so I infer that the document predates 1991, although by how long I am not told. I
also note that the word INSIGHT is not used alone, but always together with the letters pc in
lower case i.e. pcINSIGHT. Exhibit B is a copy of the reference manual for the opponent's
36 software. Dated August 1993, I note that the mark is presented in the same format as that
mentioned above.

41 Sales under the mark since 1990 have amounted to approximately £2.2m in the relevant
period, (to the end of 1994), with the opponents having approximately 60 customers for the
product, the majority of which are based in the UK.

Mr Bateson concludes his first declaration in the following terms:

46 "My company chose the name INSIGHT because it seemed an appropriate name
to describe a methodology which does indeed provide an "insight" into research
data. The main role of marketing research is to provide information that aids
in facilitating marketing decisions. Once data is collected it is only useful if it can

1 be turned into interpretable facts. The INSIGHT product is an analysis tool
which assists that interpretation”.

Mr Bateson goes on to say that INSIGHT is in fact a term commonly used in market research,
and provides at exhibit D (renamed DB1 to the third declaration) a list of references to the
6 word INSIGHT taken from various market research reference sources. Having reviewed the
various references, I note that the documents are either undated as in the case of “A
Handbook of Market Research Techniques” or after the material date in so far as the other
extracts are concerned.

11 The second of Mr Bateson’s declarations consists of the results of an informal survey he
conducted during the early part of 1998. Mr Bateson explains he sent a covering letter and
questionnaire to nine of the opponent’s customers. From the documents provided at exhibit
DB1 (which consists of the covering letter and draft questionnaire), I note that all of the
individuals were contacted by telephone prior to the questionnaire being issued. Exhibit DB2
16 consists of the responses from six of those contacted, all of whom say that they associate the
mark INSIGHT with the opponents. This is hardly surprising, given that those selected were
already existing customers of the opponents and who presumably were familiar with the
opponent’s software product. Although I note that in his declaration Mr Bateson says that
“none of the recipients of the letters were prompted as to the nature of their response in any
21 way”, I do not propose to give the results of the survey any weight in reaching my decision.

Applicants Evidence-in-Chief

This consists of a Statutory Declaration by Mary A Dresdow dated 11 August 1999. Ms
26 Dresdow explains that she is the Secretary of the applicant company. Ms Dresdow states that
the mark INSIGHT has been used by her company since 5 September 1988. Exhibit ACN1 is
a copy of the Statutory Declaration made by Leonard David Stafford dated 5 January 1995
and filed on behalf of the applicants in the ex-parte proceedings. From Mr Stafford’s
declaration (which Ms Dresdow adopts), the following facts emerge:

- 31
- (i) The mark INSIGHT was first used in the UK by the applicants in September 1988.
At exhibit LDS1 is an example of the mark in use on an invoice dated 1 October 1991.
The other documents in LDS1 are either undated, or are after the material date.
 - 36 (ii) Sales under the mark have been made throughout the UK, and in the period
1988 to 1994, amounted to some £1.9m.

Ms Dresdow states that shortly after the launch of the mark INSIGHT by the applicants in the
UK, they received a letter from the Solicitors representing the opponents predecessor in
41 business, indicating that AGB had launched a market information service at the end of
September 1988 under the name AGB INSIGHT. A copy of the letter dated 28 September
1988 is provided at ACN2. At exhibit ACN3 are copies of letters dated 30 September and 5
October 1988 respectively, from the applicant’s UK subsidiary to the opponent’s Solicitors. In
their letter of 5 October 1988, the applicants state that the first knowledge they had of the
46 opponents use of the mark was an article which appeared in Marketing Week dated 30
September 1988 (a copy of the article is provided). The applicants also state in their letter that

1 they launched their mark internally on 1 September 1988, and to their customers on 5
September 1988.

As no further communication was received by the applicants, Ms Dresdow concludes that the
opponents are estopped from opposing registration of this application, having in Ms Dresdow's
6 opinion accepted the applicants earlier right, and having acquiesced in the continued use of the
applicant's mark.

That concludes my review of the evidence filed.

11 **Decision**

I will deal with the ground of opposition under Section 3(6) of the Act first.

Section 3(6) states:

16 "A trade mark shall not be registered if or to the extent that the application is made in
bad faith".

In asserting that the application was made in bad faith, the onus rests with the opponents to
21 make a prima facie case. A claim that an application was made in bad faith, implies some
deliberate action by the applicants which a reasonable person would consider to be
unacceptable behaviour, or as put by Lindsay J in the GROMAX trade mark case (1999) RPC
10:

26 "includes some dealings which fall short of the standards of acceptable
commercial behaviour".

The opponent's have filed no evidence to support this claim, and as such this ground of
opposition is dismissed. Indeed when a similar accusation was made by the opponents in
31 September 1988, it was rebutted in the strongest of terms by the applicants, and was pursued
no further.

I now turn to consider the grounds of opposition under Section 3(1) of the Act.

36 The relevant paragraphs of Section 3(1) of the Act are as follows:

3. (1) The following shall not be registered-

(a)

41 (b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may
serve, in trade, to designate the kind, quality, quantity, intended purpose, value,
46 geographical origin, the time of production of goods or of rendering of
services, or other characteristics of goods or services,

1 (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

6 Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above, if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

11 In reaching a conclusion as to the acceptability of the word INSIGHT (absent use), I am guided by the comments of Jacob J in the British Sugar Plc and James Robertson and Sons Ltd case (the TREAT case) (1996) RPC 281: Jacob J said:

16 “Next is “Treat” within Section 3(1)(b)? What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act inherently but the idea is much the same) devoid of distinctive character. I also think
21 “Treat” falls within Section 3(1)(c) because it is a trade mark which consists exclusively of a sign or indication which may serve in trade to perform a number of the purposes there specified, particularly to designate the kind, quality and intended purpose of the product”.

26 In addition, the comments made by the Court of Appeal in Procter & Gamble Ltd’s Trade Mark Application, (1999) RPC 673 are also of assistance.

31 In an effort to substantiate their grounds of objection under paragraphs (b), (c) and (d) of Section 3(1) of the Act, the only evidence the opponents have provided is an extract from an undated handbook (A Handbook of Market Research Techniques by Robin Birn, Paul Hague and Phyllis Vangelder) and reference to three Internet “hits” from Marketing, dated 29 January and 12 February 1998, and Media Week dated 6 February 1998. While none of these documents show the position at the material date, I am prepared to accept that the position would have been much the same before the material date.

36 However, the mere fact that a word could be used as part of a descriptive sentence in a document does not mean that the word alone is capable of carrying a descriptive meaning. That said, there can be little argument that the word INSIGHT (in relation to the services for which registration is sought), is at best semi-descriptive. The evidence filed by the opponents
41 does not persuade me that the original decision to accept the application (absent use) was incorrect, and as such the grounds of opposition under paragraphs (b), (c) and (d) of Section 3(1) of the Act are dismissed. If I am found to be wrong in this conclusion, I note that the applicants can (at 31 October 1994), call upon over six years use of the mark, with sales amounting to a little under £2m. Even if the word INSIGHT is excluded from prima facie
46 registration by paragraph (c) of Section 3(1) of the Act, the word is not in my view highly descriptive and is at worst a somewhat indirect reference to the character of the services at

1 issue. In short it is the sort of word that, when used alone, has something of a trade mark
appearance and is likely to have quickly acquired a distinctive character through use. With that
in mind, I think that the applicants are entitled to rely upon the proviso to Section 3(1) of the
Act i.e. that the mark had at the date of application acquired a distinctive character as a result
of the use that had been made of it.

6 The remaining grounds are under Section 5 of the Act.

The relevant paragraphs of Section 5 of the Act read as follows:

11 **5.** (1) A trade mark shall not be registered if it is identical with an earlier
trade mark and the goods or services for which the trade mark is applied
for are identical with the goods or services for which the earlier trade
mark is protected.

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

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

21 (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,

26 there exists a likelihood of confusion on the part of the public, which includes the
likelihood of association with the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the
United Kingdom is liable to be prevented-

31 a) by virtue of any rule of law (in particular, the law of passing off)
protecting an unregistered trade mark or other sign used in the course of trade,
or

36 (b) by virtue of an earlier right other than those referred to in subsections (1)
to (3) or paragraph (a) above, in particular by virtue of the law of copyright,
design right or registered designs.

41 A person thus entitled to prevent the use of a trade mark is referred to in this Act as
the proprietor of an “earlier right” in relation to the trade mark.

6. - (1) In this Act an “earlier trade mark” means -

46 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

1 in question, taking account (where appropriate) of the priorities claimed in respect
of the trade marks.

In so far as the objection under Sections 5(1) and 5(2) of the Act are concerned, in their
counterstatement the applicants note that neither of the registrations referred to (and in the
6 face of which this application proceeded) are owned by the opponents. They add that as this
application proceeded under the provisions of Section 7(2) of the Act, the opponents are
not in a position to rely upon these registrations in opposition proceedings.

The relevant paragraphs of Section 7 of the 1994 Trade Marks Act are as follows:

- 11
7. (1) This section applies where on an application for the registration of
a trade mark it appears to the registrar-
- 16 (a) that there is an earlier trade mark in relation to which the conditions
set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out
in section 5(4) is satisfied,
- 21 but the applicant shows to the satisfaction of the registrar that there has
been honest concurrent use of the trade mark for which registration is sought.
- (2) In that case the registrar shall not refuse the application by reason of
the earlier trade mark or other earlier right unless objection on that ground
26 is raised in opposition proceedings by the proprietor of that earlier trade
mark or other earlier right.
- (3) For the purposes of this section “honest concurrent use” means such
use in the United Kingdom, by the applicant or with his consent, as would
31 formerly have amounted to honest concurrent use for the purposes of
Section 12(2) of the Trade Marks Act 1938.

Given the wording of Section 7(2) of the Act, namely “ unless objection on that ground is
raised in opposition proceedings by the proprietor of that earlier trade mark”, I have come to
36 the conclusion that the applicants are correct, and that the opponents can not rely upon these
earlier registrations as a basis of opposition. As such, the opposition under Sections 5(1) and
5(2) are dismissed. As an aside, I note that registration No:1289585 has now been Revoked,
and would no longer stand as a barrier to the progress of this application in any case.

41 I now turn to consider the opposition under Section 5(4) of the Act. Although not specifically
particularised, as the opponents state in their grounds of opposition “by reason of the use
described”, I have assumed that this ground goes to Section 5(4)(a) of the Act .This reads:

- 46 5. (4) A trade mark shall not be registered if, or to the extent that, its use in the
United Kingdom is liable to be prevented-

1 (a) by virtue of any rule of law (in particular, the law of passing off)
protecting an unregistered trade mark or other sign used in the course
of trade, or

6 (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as
the proprietor of an “earlier right” in relation to the trade mark.

11 The necessary elements of an action for passing off in terms of goodwill, misrepresentation
and damage, were set out by Geoffrey Hobbs QC in WILD CHILD trade mark (1998) RPC
455. I do not propose to repeat the very full guidance provided but it can be found in that
decision commencing at page 460 line 5 to page 461 line 22.

16 In brief the necessary elements are said to be as follows:

- 16 (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in
the market and are known by some distinguishing feature;
- 21 (2) that there is a misrepresentation by the defendant (whether or not intentional)
leading or likely to lead the public to believe that the goods or services offered
by the defendant are goods or services of the plaintiff; and
- 26 (3) that the plaintiff has suffered or is likely to suffer damage as a result of the
erroneous belief engendered by the defendant’s misrepresentation.

31 The evidence provided establishes that at the material date, the opponents had been trading in
their goods (a computer programme for the analysis of market research data) for a little over
six years. In the period 1990 to 1994 (earlier figures are not available), the opponents sales of
their software product amounted to a little over £2m. However from the evidence filed, I note
that the mark the opponents had been using was the mark pcINSIGHT and not the word
INSIGHT alone. Given the nature of the opponent’s software product, the use of the letters
pc would I think be construed as a reference to the fact that the software was suitable for use
with a desktop or personal computer. Therefore I am prepared to accept that at the material
36 date, the opponents had acquired a goodwill in the mark pcINSIGHT in relation to a computer
programme for the analysis of market research data. These are similar to (although clearly not
the same as), the applicant’s services.

41 However in order to sustain an action for passing off, the opponents must establish that there
has been a misrepresentation by the applicants which would lead the public to believe that the
services offered by the applicant are services of the opponent.

46 From the evidence filed, it appears that both parties launched their respective goods and
services to the UK market at approximately the same time. The applicants for their part refer
to a date of first use in the UK of 5 September 1988, and I note that this assertion has not
been challenged. The opponents in their evidence do not mention a specific date of first use,
but the evidence of Ms Dresdow (at exhibit ACN3) refers to an article (which it is said, and

1 once again which has not been challenged), appeared in Marketing Week published on 30
September 1988. The article includes the following text:

6 “AGB is launching a multimillion pound division which it claims is more
significant than its peoplemeter venture in the US”

The article goes on to say:

11 “Whitaker believes the AGB Insight consultancy service and the AGB Dialogue
section into which the division is split will break new ground in research”.

16 From the above, I conclude that it was the applicants who had first use of the mark INSIGHT
in the UK. Indeed as indicated above, from the evidence before me the only use on which the
opponent’s can rely, is of the mark pcINSIGHT. Given that the applicants have first use of the
mark INSIGHT in the UK, the opponents are not able to establish that there has been a
misrepresentation by the applicants. In view of this, the objection under Section 5(4)(a) of the
Act is dismissed.

21 The opposition having been unsuccessful, the applicants are entitled to a contribution towards
their costs. I order the opponents to pay to the applicants the sum of £435. 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 13 Day of June 2000.

26

31 **C J BOWEN**
For The Registrar
The Comptroller General