

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2163445A BY
MULTICORE SOLDERS LIMITED TO REGISTER
THE MARK SOLDAPRO ORACLE IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 49571 BY ORACLE CORPORATION**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2163445A**
by Multicore Solders Limited to register the mark
Soldapro Oracle in Class 9

and

10 **IN THE MATTER OF Opposition thereto under**
No 49571 by Oracle Corporation

15 **DECISION**

On 8 April 1998 Multicore Solders Limited applied under the Trade Marks Act 1994 to register the mark SOLDAPRO ORACLE for the following specification of goods in Class 9 "weighing and measuring apparatus and equipment; electronic apparatus and instruments for measuring temperature versus time of printed circuit boards during assembly process; temperature indicators, thermostats; time-recording apparatus and automatic time switches; parts and fittings for all the aforesaid goods".

On 9 March 1999 Oracle Corporation filed notice of opposition to this application. They say they are the proprietors of the registrations shown in the Annex to this decision and have used those marks for many years. Objection is said to arise under Section 3(6), 5(2)(b), 5(3) and 5(4)(a). The wording used closely mirrors the wording of the Act. There is also a reference to the Registrar's discretion. However under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

The applicants filed a counterstatement denying the above grounds.

Both sides ask for an award of costs in their favour.

Both sides filed evidence. The parties were invited to say whether they wished to be heard in the matter. No such request was made. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Opponents' evidence

The opponents filed a declaration by Brenda G Woodson, Vice President and Associate General Counsel of Oracle Corporation and Alan Wallace Laing a Vice President of Oracle Corporation UK Limited.

Ms Woodson's declaration deals with Oracle Corporation's claimed status as the world's second largest software company. The information given is impressive but for the most part fails to deal specifically with the position in this country. I do not propose or need to record the details of Ms Woodson's declaration.

5

The opponents' activities and position in the UK market are dealt with specifically in Mr Laing's declaration:-

10

"6. Oracle Corporation is the world's second largest software company. It has two major businesses: one aimed at providing the lowest cost information technology infrastructure, and the other to provide business and competitive advantage through high value applications. Oracle Corporation, its subsidiaries, including Oracle UK, and affiliates ("Oracle") design, develop, market and support computer software products with a wide variety of uses, including database management and network products, applications development productivity tools, and end user applications. Oracle offers consulting, education, support and systems integration services to back up its customers' use of ORACLE software products in the UK and elsewhere throughout the world. Oracle presently operates in over 140 countries and is one of the companies capable of implementing end-to-end enterprise IT infrastructure and applications solutions on a global scale.

15

20

25

7. Throughout the world, Oracle works closely with clients in all the major fields of business and industry, including manufacturing, telecommunications, chemical and pharmaceutical industries, defence, computer hardware and software, healthcare, energy, the public sector, media and entertainment, transport, financial services and retail businesses. In the United Kingdom, some of the major clients supported by ORACLE software are Unilever, Glaxo Wellcome, Rover Group Ltd, BT Conferencing (a division of BT plc), the Royal Air Force, Royal Dutch Shell Group and Shell Oil Company. There is now produced and shown to me marked "Exhibit AWL2" two Oracle Guide to References and a sample selection of Oracle at Work brochures demonstrating the breadth of Oracle's customer base.

30

8. Oracle's annual world-wide gross revenues now exceed 8 billion US dollars. Annual turnover of Oracle UK in the United Kingdom is listed below:

35

Fiscal Year	Turnover (US\$)
1988	24,727,813
1989	47,978,667
1990	84,405,206
1991	102,856,026
1992	120,081,000
1993	160,170,000
1994	184,480,000
	UK annual revenue (£)
1995	208,236,000

40

45

1996	243,020,000
1997	334,641,000
1998	297,915,000

5 9. Oracle UK spends considerable sums on sales and marketing activities, including
production of catalogues and sales materials, corporate and product-specific
advertising, product training and education, technical writing, publication of "THE
ORACLE" magazine, seminar presentations, trade-specific, industry and consumer
10 shows, annual local marketing meetings with its sales representatives and customers,
and activities within the community."

In support of this Mr Laing also exhibits:

- 15 AWL3 - the Oracle Products Guide, the Oracle Guide to Customer Satisfaction
and Quality and the Oracle Kiosk Solutions brochure
- AWL4 - examples of advertisements
- 20 AWL5 - examples of press coverage, feature articles and editorials
- AWL6 - the Oracle Education Catalogue and Oracle Worldwide Customer
Support brochure
- 25 AWL7 - samples of publications put out by Oracle to its business partners,
customers and other interested parties along with a page from the
company's website
- AWL8 - a website extract detailing Oracle seminars and events
- 30 AWL9 - a copy of the applicants' brochure

Applicants' evidence

35 The applicants filed a statutory declaration by Gordon Arbib, Chairman of Multicore Solders
Ltd. Much of his declaration is taken up with submissions. He does, however, explain the
basis for adoption of the mark namely that it is a thermal profiler which serves a predictive and
forecasting function enabling a desired heat profile to be achieved at all stages of a circuit
board or other product's progress through a soldering oven. Thus he suggests the mark
40 alludes to the goods.

He goes on to consider the meaning of the word ORACLE and its likely signification to
people in this country. He concludes with information on other registrations of the word
ORACLE in this country by parties other than the opponents.

45 That concludes my summary of the evidence.

Section 3(6) reads:

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

5

The opponents say in their statement of grounds that the bad faith arises "in view of the opponents' use and reputation in the trade mark". That wording suggests the claim is in reality a relative ground of objection dressed up as an absolute ground. The opponents have not pointed to any specific aspect of the application which suggests that the applicants have in some way fallen short of "the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined" (*Gromax Plasticultures Ltd v Don & Low Nonwovens Ltd* 1999 RPC 367 at page 379). The applicants have explained how they came to adopt the mark. I have no reason to doubt their claim. The Section 3(6) ground fails.

10

15

Section 5(2) reads as follows:

"5.-(2) A trade mark shall not be registered if because -

20

(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,

25

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

As identical marks are not involved sub paragraph (b) applies here.

30

I take into account the guidance provided by the European Court of Justice in *Sabel BV v Puma AG* (1998 RPC 199 at 224), *Canon v MGM* (1999 RPC117) and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BC* (1999 ETMR 690 at 698).

35

It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

40

(b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, 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;

45

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- 5
- (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;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- 10 (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;
- (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);
- 15 (h) 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.
- 20

The opponents have referred to a large number of earlier trade marks but have not said which ones they rely on to support particular grounds of opposition. In the absence of written submissions I assume that they consider their best chance of success under Section 5(2)(b) rests on their registrations in Class 9, the same Class as the application in suit. The most relevant registration appears to be No. 1313522 for the mark ORACLE solus covering computer programmes and associated tapes, discs and wires etc. I also bear in mind No. 2101538 for the mark ORACLE NC as this registration covers computers themselves along with computer peripheral and communication devices. Somewhat different issues arise in respect of these earlier trade marks.

25

30

The parties' marks are not the same but self evidently the applicants' mark contains the whole of the opponents' mark ORACLE as a separate and distinct element. The presence of the word SOLDAPRO as the first word may suggest that it is a housemark and ORACLE a second tier mark. But that in itself does not dispose of the element of visual and aural similarity. The applicants claim that their choice of ORACLE is an allusion to the predictive functionality of the product. That may be so but it is an oblique allusion and one that may not always be understood.

35

The tests set out above require me to take into account both the inherent characteristics of the opponents' earlier trade marks but also the extent to which a heightened degree of distinctive character exists as a result of use. I find as follows:

40

- 45 **S** the mark ORACLE is inherently distinctive for the goods at issue. It is a dictionary word but not one that has any direct reference to the opponents' goods

S the opponents have a significant reputation under the mark for computer software

5 S that reputation is in two main areas - database business and applications' business (paragraph 6 of Mr Laing's declaration and exhibit AWL3). The applications business is said to be further divided between so-called front office functions (sales and marketing, customer relationship management, E-commerce etc.) and back - office functions which are more concerned with the management and efficient operation of a business and relationships with suppliers.

10 S the major industry and client list (paragraph 7 of Mr Laing's declaration and AWL2) suggest a broadly based business

15 S the evidence does not provide disaggregated information in relation to sales of computer hardware. I am therefore in some doubt as to the extent (if any) of the opponents' reputation in this area. The 'Oracle at Work' brochure at AWL2 contains customer/project profiles and inter alia, gives details of hardware and software involved. The hardware items invariably refer to third party equipment. The Oracle contribution is the software and associated support services.

25 Turning to the goods themselves I find that on the basis of the descriptions offered they are not identical. Are they similar? The item of particular interest to the applicants is a thermal profiling device. I note from the 'Systems Requirements' box of the product literature at GA1 that it needs to be linked to a computer presumably to process and display the data collected by the device itself. The essence of the product is that it is a device for improving process control. I must not forget, however, that the applicants' specification of goods is cast in broader terms than the specific piece of equipment illustrated and described in the evidence.

30 But it seems to me that all the items in the applicants' specification share (with the thermal profiler and each other) the characteristic that they are apparatus and equipment dedicated to particular purposes (weighing, measuring, time - recording etc.). All of them may, and in this day and age, probably do rely to a greater or lesser extent on computing power for their operation. But then so do a very wide range of goods which in other respects would not be

35 regarded as similar to computer software or computers.

Jacob J laid down guidance on this particular aspect of the overall test in *British Sugar PLC v James Robertson & Sons Ltd*, 1996 RPC 281 at pages 296/7. He suggested that the following factors should be taken into account - the uses of the respective goods, their users, their physical nature, their trade channels and the extent to which they are in competition with one another. On virtually all of these accounts there is no conceivable similarity. I would tentatively exclude users from that general finding simply on the basis that there may be some coincidental overlap but I do not regard even this much as being very likely or of any consequence if it did happen. It was open to the opponents to point to some particular aspect

40 of the trade or their own reputation which might point to a contrary conclusion. Simply

45

having a wide ranging customer list does not do it. I therefore, conclude that even allowing for the undoubted reputation the opponents enjoy in the area of computer software there is no similarity between the goods and no likelihood of confusion in terms of the global test. The opposition fails under Section 5(2)(b).

5

The opponents' ground under Section 5(4)(a) does not specify the law of passing off but I infer from Mr Laing's comments that that is what they had in mind. This is a case where the mark as used is the same as the mark registered and the good and services traded (computer software and services) also mirror or are contained within the scope of the specifications of the registrations. In these circumstances the opponents are unlikely to be in a better position under Section 5(4)(a) than under Section 5(2)(b). This ground also fails.

10

Section 5(3) reads:

15

"(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, and

20

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

25

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

30

I have already found that the opponents have a reputation under their ORACLE mark in respect of computer software and associated services. I have also reached the view that the applicants' mark is tendered for registration in respect of goods which are not similar to those goods and services for which the opponents' earlier trade marks are protected. The opponents must also show that the adverse consequences envisaged by the Section will apply either in terms of unfair advantage or detriment to the distinctive character or repute of their mark (and not forgetting that the respective marks are not in any case identical).

35

Ms Woodson says:

40

"Use by the Applicant of the trade mark ORACLE will be detrimental of the Opponent's rights and will dilute its existing and extensive reputation in the mark ORACLE. Additionally, given the extensive use of the ORACLE trade mark it is submitted that members of the public may assume that goods bearing the Applicant's SOLDAPRO ORACLE trade mark are in some way connected with Oracle Corporation's business in the United Kingdom and may accordingly be confused as to the origin or nature of the products. This is especially likely in that Oracle Corporation provides support to major business."

45

Mr Laing says

5 "I am of the view that, given the extensive use of the ORACLE trade mark in the United Kingdom, there is a likelihood that members of the public may assume that the Applicant's goods bearing the ORACLE name are in some way associated with Oracle Corporation when in fact no such association exists. Any such usage by Multicore Solders Ltd of the SOLDAPRO ORACLE name in its mark will dilute a strong trade mark which Oracle Corporation has worked hard to earn."

10 Thus the opponents make general claims as to the consequences but fail to provide any detailed explanation as to the reasons why their declarants have reached the views they have. There appears to be a suggestion in both claims that use of the applicants' mark may point to an association of some kind with the opponents'. In Oasis Stores Ltd's Trade Mark Application 1998 RPC 631 the Hearing Officer said:

15 "I do not consider that simply being reminded of a similar trade mark with a reputation for dissimilar goods necessarily amounts to taking unfair advantage of the repute of that mark. The opponents chances of success may have been better if they were able to point to some specific aspect of their reputation for batteries etc sold under their mark which was likely, through (non-origin) association to benefit the applicants' mark to some significant extent."

20 I accept that the opponents have a wide and impressive range of customers. These customers are in turn involved in a diverse range of activities. There is no indication that the customers, actual or potential, would have any expectations in respect of the mark ORACLE outside the area of computer software or associated services. I am not persuaded, therefore, that use of the mark SOLDAPRO ORACLE for any of the goods of the specification applied for would result in the applicants taking unfair advantage of the earlier trade marks. The opponents have not pointed to any specific aspect of their reputation that would produce such a result. Nor is it evident how the later mark will affect the distinctive character or the repute of the earlier trade marks. The opponents have not identified any specific basis for their claim. The Section 5(3) ground also fails.

30 The opposition has failed on all the grounds on which it was brought. The applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435. 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 the case if any appeal against this decision is unsuccessful.

40 **Dated this 13 Day of November 2000**

45 **M Reynolds
for the Registrar
the Comptroller-General**

REGISTRATIONS RELIED ON BY THE OPPONENTS

5	No.	Mark	Class	Journal	Specification
10	2115435	ORACLE	38	6164 Page 02011	Telecommunications, communications, telephone, facsimile, telex, message collection and transmission, radio-paging and electronic mail services; transmission and reception of data and of information; on-line information services; data interchange services; transfer of data by telecommunications; telecommunications of information (including web pages); provision of telecommunication access and links to computer databases and to the Internet; satellite communication services; leasing or rental of apparatus, instruments, installations or components for use in the provision of all the aforementioned services; advisory, information and consultancy services relating to all the aforementioned services.
15	1282825	ORACLE	42	5815 Page 1662	Computer design services; feasibility study services relating to computers and to computer software; computer software consultancy services; information services relating to computers; all included in Class 42.
40	1313522	ORACLE	09	5765 Page 01437	Computer programmes; tapes, discs and wires, all being magnetic and cassettes for use therewith, all for computers; parts and fittings for all the aforesaid goods; all included in Class 9; but
45					

					not including any such goods relating to prophecies.
5	1564103	ORACLE	16	6118 Page 02555	Books, manuals, user guides, magazines, newsletters, technical publications and printed matter, all relating to computers, computer software and their use and applications; all included in Class 16.
10					
15	1564104	ORACLE	35	6095 Page 08089	Data processing services; technical assistance to businesses in the field of computers, computer software, database development and design, information processing and management, communications and business operations; management consulting and business management assistance services relating to computers, computer software and computer systems; arranging and conducting trade shows; all included in Class 35.
20					
25					
30	1564105	ORACLE	36	6086 Page 05569	Financing, insurance and brokerage services with respect to computers, computer software, computer systems and computer peripheral devices; all included in Class 36.
35					
40	1564107	ORACLE	41	6090 Page 06643	Education, instructional and training services; planning of and participation in conferences and seminars; all relating to computers, computer software and databases; all included in Class 41.
45					
	1561374	ORACLE MEDIA SERVER	09	6084 Page 05050	Computer programs for business, scientific, technical, commercial, educational, and personal computing uses; all included in Class 9.
	1561795	ORACLE MEDIA	16	6177	Books, manuals, user guides,

SERVER

Page 02283

magazines, newsletters, technical publications and printed matter, all relating to computers, computer software and their use and applications; all included in Class 16.

5

2101538

ORACLE NC

09

6143

Page 11893

Computers, computer peripherals and communication devices for business, scientific, technical, commercial, educational and personal computing uses, computer programs therefor.

10

2057267

ORACLE
NETWORK
COMPUTER

09

6134

Page 09038

Computers, computer peripheral devices and communication devices for business, scientific, technical, commercial, educational and personal computing uses, computer programs therefor.

15

20

1369833

ORACLE
SQL*PLUS

09

5907

Page 00394

Computer programs included in Class 9.

25

2152161

09

6218

Computer programs for business, scientific, technical, commercial, educational and personal computing uses, in the fields of database management, local and global computer networks, and text, videos and graphics on demand.

30

35

