

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. 2100504
BY MAI CONSULTANTS LTD
TO REGISTER A TRADE MARK
IN CLASS 9

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DECISION AND GROUNDS OF DECISION

10 On 17 May 1996 Mai Consultants Ltd of The Old School House, Hook Road, Epsom, Surrey, KT19 8TQ, applied under the Trade Marks Act 1994 for registration of the trade mark AS\$ET in Class 9 of the Register in respect of

“Computer software; computer programs.”

15 Objection was taken to the mark under paragraphs (b) and (c) of Section 3(1) of the Act on the grounds that it is devoid of any distinctive character and may serve in trade to designate the characteristics of the goods, for example, computer programs which protect one’s assets.

20 Objection was also taken to the mark under Section 5(2) of the Act because of the likelihood of confusion with numerous earlier marks. As a result of correspondence prior to the hearing and during discussions at the hearing the following limited specification was agreed:

“Computer software relating to lifecycle cost modelling and operations management systems including field development strategy; all for use in oil and gas platforms and fields.”

25 In the light of this, all bar one of the Section 5(2) objections were waived. Details of the remaining citation, in the ownership of Catsoft UK Ltd, are shown below:

30 2044239 ASSETPRO Pending Computer software; computer programs; all included in Class 9.

At a Hearing at which the applicants were represented by Ms Claire Hutchinson of The GSCP Partnership, their agents, the Section 3(1) and Section 5 objections were maintained. The applicants were allowed three months in which to consider their position, and subsequently

requested a further three months extension, which was granted. Nothing further was heard from them during this period and the application was refused. Following the refusal, Ms Hutchinson wrote requesting that the refusal be withdrawn and including a retrospective extension of time, should her request be granted. I confirmed that the notice of refusal was correctly issued in line with Section 37(4) of the Act and am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

10 **Section 3(1)**

Objection was raised under Section 3(1)(b) and (c). This section of the Act reads:-

“The following shall not be registered:-

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

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

20 The mark in question is presented as follows: AS\$ET. This does not, as far as I am aware, appear in any dictionary, but I take it to be a trifling variation of the word ASSET. This is defined in Collins English Dictionary as:

“Anything valuable or useful.”

This entry also refers the reader to the word “assets”, the references for which are shown below:

25 “1. Accounting. the property and claims against debtors that a business enterprise may apply to discharge its liabilities. Assets may be fixed, current, liquid, or intangible and are shown balanced against liabilities.

2. Law. the property available to an executor or administrator for settlement of the debts and payment of legacies of a deceased person's estate.

3. any property owned by a person or firm.”

30 From these references and from my own knowledge, it seems that the singular and pluralised versions of this word are so closely related, that there is little to distinguish the two. If anything, the singular version would seem to be the wider term, incorporating within it the more specific pluralised term. I take it therefore that “asset” also refers to any items of property owned by a business.

The goods the applicant is interested in are quite specific. They are computer programmes (software) used in the gas and oil industries for lifecycle cost modelling. I take it from the specification that these programmes may be used to assess, for example, the costs associated with drilling from oil rigs, and by doing so, to identify their value to the operating company at any time during their working lives. As such the programme may be used to calculate the value of the company's assets. It therefore seems to me that the word ASSET is descriptive of computer programmes used to assess assets. I use this merely as an example, but the descriptive nature of the word could equally well apply to programmes which manage assets, protect them, or simply help identify them. In any case, I take the word ASSET to be descriptive of the intended purpose of the goods within the meaning of Section 3(1)(c).

If I am wrong about this, I believe there is a further objection under Section 3(1)(c) of the Act on the basis that the word ASSET is laudatory and apt to describe the **quality** of business software.

However, the mark is not written simply as the dictionary word ASSET, but is written AS\$ET, the second 'S' being replaced by the dollar symbol, '\$'. At the hearing I confirmed that I believed the mark to be so close to the descriptive word ASSET, that the Section 3(1)(c) objection was valid, even though, in the strictest sense, it did not consist "exclusively" of that word alone. However, since then Geoffrey Hobbs, Q.C, acting as the Appointed Person in the Automotive Network eXchange case (application no. 2103490, as yet unreported), commented that the presentation of that mark

"... may possibly be sufficient to prevent the designation from consisting "exclusively" of a sign which may serve in trade to designate the characteristics of the services of interest to the Applicant for the purposes of Section 3(1)(c)..."

In view of this, I am doubtful that the Section 3(1)(c) objection can be sustained. However, I go on to consider the mark under Section 3(1)(b).

This Section refers to marks which are "devoid of any distinctive character". The meaning of this was considered by Justice Jacob in the TREAT case (1996 RPC 281) who considered that it referred to words (or other signs) "which cannot do the job of distinguishing without first educating the public that it is a trade mark." I believe this mark is just such a sign. Although the presentation of the word ASSET is not as it appears in the dictionary, I do not believe it is sufficiently different from the dictionary word to be recognised as a distinctive trade mark in the

prima facie case. The '\$' symbol is only a very minor variation to the spelling of an ordinary dictionary word, which I have already said is very descriptive of the goods. I believe therefore that AS\$ET will be seen and pronounced in exactly the same way as the true spelling of the word ASSET, and that it will fail to have any impact as anything other than a description of the goods. Indeed, it is just possible that this variation, if it serves any function at all, enhances the laudatory and descriptive meaning of the word as it includes a symbol which relates to monetary assets.

Regarding the presentation of the mark, I also take note of the summary of a decision by the German Appeal Senate (GRUR 1996 Vol 5), relating to the stylised "Color Collection" mark:

"According to a decision of the twenty-fourth senate, the graphic form of words incapable of protection may provide the necessary distinctiveness only if it provides a "surplus" which justifies protection. The necessary extent of the "surplus" would then depend upon the descriptive nature of the words in question. To that extent the pictorial design of a word mark would be less likely to provide its distinctiveness the more clearly a directly descriptive reference to the goods or services claimed could be recognised."

I perceive the mark to be little more than a trivial variation on the very descriptive word ASSET, with almost no "surplus" to enhance its registrability. I therefore find the mark is not acceptable under Section 3(1)(b) as it is devoid of any distinctive character for computer programmes (software) which for example, assess, determine, monitor or otherwise relate to a company's assets.

Section 5

Objection to the mark was also raised under Section 5(2) of the Act. I have found that the word ASSET is descriptive of these goods and does not possess a trade mark character by nature. If I am right about this the objection under Section 5 is irrelevant. However, in case I am found to be wrong about this and the word ASSET is found to be distinctive by nature, I go on to consider the relevance of the earlier mark on this footing.

Section 5(2)(a) is not applicable as the applicants' mark is not **identical** to the earlier mark. However Section 5(2)(b) applies. It says:

"(2) A trade mark shall not be registered if because
(b) it is **similar** to an earlier trade mark and is to be registered for goods or

services **identical with or similar** to those for which the earlier trade mark is protected,
there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

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For convenience, I consider first the respective goods of these marks. The goods of this application are computer programmes for use in quite specific areas of industry. The goods of the cited application are also computer programmes, but there is no indication as to their purpose or even as to the industry most likely to use them. Without such a limitation, I believe these
10 programmes may well be used in the same industry and for the same purposes as the applicants'. I therefore consider that the respective goods are identical to each other. Indeed, Ms Hutchinson did not argue this point. Instead she sought time to narrow the specification of this citation.

Turning now to the marks, I have to determine whether they are similar to each other, and if so,
15 whether or not there is a likelihood of confusion on the part of the public. The classic test of whether or not two marks are confusable was given by Parker J, in Pianotist Co's application (1906) 23 RPC 774 at page 777 line 26 et seq:

“You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You
20 must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in the normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will
25 will be confusion - that is to say, not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration or rather you must refuse the registration in that case.”

30 The cited mark consists of the word ASSETPRO, whereas the mark of this application is AS\$ET. They have visual differences - one is longer than the other by some 3 letters, and one includes a '\$' symbol rather than the letter 'S'. However, it is well established that it is not useful to compare marks by placing them side by side, but rather they are remembered by some general impression (DE CORDOVA AND OTHERS VS VICK CHEMICAL COMPANY (1952) 68 RPC at page

106, lines 17-23). The general impression given by both marks to my mind is that they deal with assets. The addition of PRO, being to my own knowledge a common abbreviation for “professional” (The Collins English Dictionary, Second Edition also refers) does not detract in any way from this impression. Indeed, I believe it would merely serve to indicate perhaps a newer, more powerful version of the original software. I therefore find that this addition is of little assistance in distinguishing between the two marks. I should add that I have not overlooked the presence in one of the marks of the ‘\$’ symbol, but conclude that it is insignificant in helping to distinguish between the two marks.

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10 Given that the overwhelming impression given by both marks is the same, and that the goods in relation to which they are to be used are also the same, I conclude that there is a likelihood of confusion in the mind of the public. This application is therefore debarred from acceptance because it conflicts with an earlier mark under Section 5(2) of the Act.

15 In this decision, I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and Section 5(2) of the Act.

20 Dated this 7th day of August 1998

25 Janette McNeill
For the Registrar
The Comptroller General