

**TRADE MARKS ACT 1938 (AS AMENDED)
AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1557536
BY IFS INTERNATIONAL LIMITED
TO REGISTER A MARK IN CLASS 35**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 44258
BY AEROSPATIALE SOCIETE NATIONALE INDUSTRIELLE**

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DECISION

20 On 24 December 1993 IFS International Ltd applied under Section 17 of the Trade Marks Act 1938 to register the mark shown below for a specification of services which reads: "business services relating to the organisation of conferences and exhibitions; business advisory services relating to franchising; business management assistance consultancy services; the acquisition, collation and dissemination of information all relating to the aforesaid services; all included in Class 35".

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The application is numbered 1557536.

40 On 6 March 1996 Aérospatiale Société Nationale Industrielle filed notice of opposition to this application. The grounds of objection are in summary:-

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(i) under Section 11 by reason of the use that the opponents have made of the trade and service marks details of which are given in the Annex to this decision. Full details are given of a registration in Class 35 (the most relevant class) along with brief details of other registrations referred to

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(ii) under Section 12(1) by reason of the registrations referred to above

- (iii) under Sections 17 and 68 in that the applicants have no bona fide intention to use the mark applied for in relation to the services for which registration is sought

5 The opponents also ask for the application to be refused in the exercise of the Registrar's discretion.

The applicants filed a counterstatement denying the above grounds. They also make a number of observations about the opponents' mark. As the validity of the opponents' registrations is not at issue in these proceedings I take no account of these comments.

Both sides ask for an award of costs in their favour. Both sides filed evidence. Neither side has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

15 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponents' evidence

25 The opponents filed a statutory declaration dated 6 May 1997 by Francis Paul Wolff, their professional representative in this matter. He exhibits (FPW1) a set of photographs taken at the Farnborough Air Show in September 1996 showing Aérospatiale's exhibition stand. Also included in FPW1 are photocopies taken from the magazine Aviation Week and Space Technology. This magazine is said to circulate in this country and the exhibited advertisements by or on behalf of Aérospatiale showing their mark appeared in the editions of 30 13 September 1993, 19 July 1993, 15 February 1993 and 25 January 1993. Mr Wolff says that these exhibits are submitted in order to show use in the United Kingdom of the Aérospatiale mark. Finally, exhibit FPW1 also includes copies of the registration certificates of each of the registrations relied upon by the opponents.

Applicants' evidence

The applicants filed a statutory declaration dated 26 June 1998 by Anthony Thomas Maguire, their professional representative in these proceedings.

40 Mr Maguire describes contacts between the parties in an effort to reach an accommodation. During the course of these exchanges he reports that:

"We responded to the letter of the opponent, pointing out that the device had been independently designed by an employee of the applicant, that it had, at that time, been 45 in use for some years with total turnover of around £3 million sterling, was used in combination with other distinctive trade marks of the applicant and that there had been no reported incidence of confusion in that period, nor had the applicant received any

complaint, in that time from the opponent. There is now produced and shown to me, marked ATM.01 and exhibited hereto, copies of the relevant correspondence."

5 Subsequent attempts to reach agreement by means of an amendment to the specification or undertakings as to the manner of use of the mark appear to have failed (exhibit ATM.02 refers). Finally, Mr Maguire refers to other examples of globe devices on the United Kingdom and Community Trade Mark registers (ATM.03); exhibits a copy of the certificate of registration for THE BEST PRACTICE CLUB (ATM.04) which words also form part of the mark in suit; and notes that the applicant is the proprietor of a US application which has gone
10 unopposed by the current opponents.

That completes my review of the evidence.

Sections 11 and 12 of the Act read:

15 "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

20 12.-(1) Subject to the provisions of subsection (2) of this section, no service mark shall be registered in respect of any services or description of services that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same services, the same description of
25 services, or goods or description of goods which are associated with those services or services of that description."

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a
30 resemblance so near as to be likely to deceive or cause confusion.

The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in
35 hand, these tests may be expressed as follows:-

40 **(Under Section 11)** Having regard to the user of the mark ((a) below), is the tribunal satisfied that the mark applied for, ((b) below), if used in a normal and fair manner in connection with any services covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

45 **(Under Section 12)** Assuming user by the opponents of their mark ((a) below) in a normal and fair manner for any of the services or goods covered by the registrations of that mark, is the tribunal satisfied that there will be no reasonable likelihood of

deception amongst a substantial number of persons if the applicants use their mark ((b) below), normally and fairly in respect of any services covered by their proposed registration?

Opponents' mark

Applicants' mark

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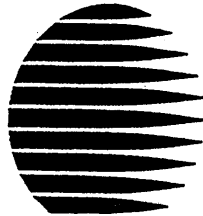
(a)

(b)

(a)

(b)

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20 I will deal firstly with the position under Section 12. As the opponents have a registration in
the same class as the mark applied for I propose to take that registration as the basis for my
consideration of the issues. Although the respective specifications of services are not framed
in identical terms the applicants do not, I think, contend that there is no overlap. In my view
either identical or very closely similar services are involved and the applicants also say that
25 they have clients in the aerospace industry. The matter, therefore, resolves itself into one of a
comparison of the marks themselves.

The opponents in their Statement of Grounds describe the applicants' mark in the following
terms:

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"The applicant's mark (the mark sought to be registered under application no. B1557536) consists of a device and words. The device is substantially identical to the opponent's mark, consisting of a shaded globe effect made up of a number of horizontal solid black elements tapering from left to right. The number of elements,
35 ten, is identical in the two marks. The words in the applicant's mark are the letters "bpc" and the words "BEST PRACTICE CLUB", which are all disclaimed, being non-distinctive elements of the mark."

40 Although the applicants' mark is a composite one and I do not forget the need to consider it as
a whole, I consider that the device is an essential feature of the mark. I note that the
opponents point to the fact that the letters and words have been disclaimed. It is, of course,
the case that disclaimers do not go into the marketplace and disclaimed elements cannot,
therefore, be ignored when comparing marks (see GRANADA Trade mark 1979 RPC 303).
45 The applicants are also said to have obtained a registration of the words THE BEST
PRACTICE CLUB though I do not know on what basis that registration was obtained.
However, as indicated, I take the view that the presence of this other matter does not detract
from the impact of the device within the mark. I also have no hesitation in finding that the

device element of the applicants' mark is remarkably similar both in concept and execution to the device of the opponents' registration. It is of course possible to identify slight stylistic differences in a side by side comparison notably in terms of the gradation of the taper effect. But given the cautionary remarks that have been made (see, for instance, De Cordova v. Vick 5 1951 RPC 103) in relation to such comparisons and the fact that the eye is not an accurate recorder of visual detail there is in my view little doubt that it is the overall structure and presentation of the devices that will live in the memory and be a likely source of confusion or deception. The applicants have, of course, supplied the results of searches intended to show that globe devices' are common. I do not find this material to be of assistance. Most of the 10 devices are quite different and/or are for unrelated goods or services. Moreover there is no indication as to whether these marks are being used. In short I find that the opponents' registration in Class 35 is a fatal barrier to the application in suit and the opposition thus succeeds under Section 12(1).

15 Although the applicants say that their mark is in use they have not claimed that they are entitled to proceed on the basis of honest concurrent use under Section 12(2). In practice their case is insufficiently substantiated for me to entertain such a claim.

20 As my finding in relation to Section 12(1) decides the matter I do not need to consider the Section 11 position in detail. Briefly, however, my view is that:

25 - the opponents' own evidence is extremely thin. The Farnborough Air Show material is well after the relevant date. Thus their position rests on the advertisements in the aviation magazine in the same year as the application was filed.

- the advertisements relate to missiles, aircraft and possibly aircraft design and do not obviously cover areas of goods or services such as might support a case against the applicants' Class 35 application.

30 - there is no further substantiation of the opponents' case in terms of trading information such as turnover, promotional expenditure etc.

- the opponents' mark appears also from FPW1 to be used in conjunction with other matter notably the word AEROSPATIALE.

35 On the basis of the above the opposition fails under Section 11.

The Sections 17 and 68 objections based upon lack of any bona fide intention to use the mark must also fail. The opponents have failed to substantiate their claim and the applicants say that they are already using their mark.

40 As the effect of my finding under Section 12 is mandatory no exercise of discretion is possible or necessary.

The opponents have succeeded and are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £635.

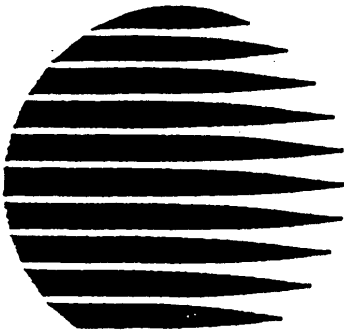
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Dated this 9th day of February 1999

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M REYNOLDS

15 For the Registrar
the Comptroller General

No.	Mark	Class	Journal	Specification
1509732		35	6003/7700	<p>Business management assistance; business planning; market research; data processing services; consultancy, advisory and agency services, all relating to commercial representation; preparing, arranging and conducting audio visual presentations for use in the field of aerospace, aeronautics and space; marketing of light aircraft; business services relating to the acquisition, creation and exploitation of aeronautical construction works; commercialisation of products incorporating composite materials; all included in Class 35.</p>

Other registrations referred to by the opponents

No.	Class
1509728	7
1509729	9
1509730	12
1509731	13
1509733	36
1509734	37
1509735	38
1509736	39
1509737	42