

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2023701
IN THE NAME OF C.D.S. COMPUTER DESIGN SYSTEMS LIMITED
TO REGISTER A TRADE MARK IN CLASSES 9, 37, 41 & 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 46224
IN THE NAME OF CODA LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2023701
in the name of C.D.S. Computer Design Systems Limited
to register a trade mark in Classes 9, 37, 41 & 42**

And

**IN THE MATTER OF Opposition thereto under
No 46224 by Coda Limited**

DECISION

On 22 April 1995, C.D.S. Computer Design Systems Limited, of Gresham Mill, South Hall Street, Salford, Manchester, M5 4TP, applied to register the trade mark Codas in Classes 9, 37, 41 and 42 for the following specifications of goods:

Class 9

Computers; apparatus for computers; apparatus for receiving, processing, storing, displaying, recording, retrieving or transmitting data; computer hardware; computer programs; computer software; computer firmware; all for use in relation to the oil distribution industry

Class 37

Installation; repair; maintenance; all in respect of computers, apparatus for computers, apparatus for receiving, processing, storing, displaying, recording, retrieving or transmitting data, computer hardware, computer firmware or parts and fittings therefor; installation of computer programs and computer software; all for use in relation to the oil distribution industry.

Class 41

Educational and training services; all relating to computers, apparatus for computers, apparatus for receiving, processing, storing, displaying, recording, retrieving or transmitting data, computer hardware, computer programs, computer software, computer firmware; or relating to the use of the same; or relating to computing; all for use in relation to the oil distribution industry.

Class 42

5 Technical and professional consultancy and enquiry support services; all relating to computers, apparatus for computers, apparatus for receiving, processing, storing, displaying, recording, retrieving or transmitting data, computer hardware, computer programs, computer software or computer firmware or relating to the use of the same, computing or systems integration; services for the design and updating of software; computer programming services; repair and maintenance of computer programs and computer software; the provision of facilities to provide access to and use of a computer database; computer facilities management, security and back-up; the provision of services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; all for use in relation to the oil distribution industry.

15 The application, numbered 2048360 was published for opposition purposes on 16 October 1996, and on 14 January 1997, Coda Limited filed notice of opposition to the application. They say that they are the proprietors of eight trade marks, details of which are set out as an annex to this decision. The grounds on which the opposition is based are, in summary:

- 20 **1. Under Section 3(6)** Because the application is made in bad faith.
- 2. Under Section 5** Because registration of the mark does not comply with the provisions of Section 5.

25 The opponents ask that the Registrar refuse the application and that costs be awarded in their favour.

30 The applicants filed a counterstatement in which they deny the grounds of opposition. They ask that the application be allowed to proceed and that costs be awarded in their favour.

35 The matter came to be heard on 20 June 2000, when the applicants were represented by Ms McBride of Garretts, their trade mark attorneys, and the opponents by Mr Richard Hacon of Counsel, instructed by Urquhart, Dykes & Lord, their trade mark attorneys.

The opponents' evidence

40 This consists of a Statutory Declaration dated 19 November 1997 which comes from David Gresford Belmont, Company Secretary of Coda Limited, a position he has held since 1993.

45 Mr Belmont says that the opponents first used the trade mark CODA in the United Kingdom in 1981 and have used it continuously to date in respect of computer software for various financial, accounting and sales purposes, and design, consultancy, management and training services related to such software. He gives details of registrations for the trade mark CODA owned by the opponents in the United Kingdom (and other countries) and to a Statutory Declaration (DGB1) which he says he executed in support of two United Kingdom applications, numbers 1417540 and 1417726. The exhibit makes the following claims:

S continuous use of the trade marks CODA (from April 1980) and CODA - IAS (from September 1983) in respect of computer software.

S use throughout the United Kingdom.

S turnover for the years 1983 to 1989, ranging from £505,778 in 1983 showing a year on year increase to £4,183,670 in 1989.

S publicity expenditure for the years 1983 to 1989, ranging from £18,000 in 1983, rising to £236,000 in 1989.

S promotion in various computer and accounting publications, the earliest dating from 1983, in corporate brochures from 1982, and at various trade exhibitions.

The Declaration makes reference to various exhibits although these have not been provided.

Mr Belmont says that goods have been sold throughout the United Kingdom, directly to customers and through distributors, referring to exhibit DGB2 which confirms the geographical spread of his company's customer base.

Mr Belmont sets out his company's turnover for the years 1987 to 1996, which he confirms is in respect of goods sold under the trade mark, and which range from £1,996,836 in 1987, showing a year on year increase to £14,583,000 in 1996.

Mr Belmont next gives details of the amounts spent promoting goods sold under the mark in the years 1994 to 1997, and which ranges from £398,000 in 1994, rising year on year to £1,002,000 in 1997. He says the trade mark has been publicised at exhibitions, and advertised in various national financial and computer publications, and refers to exhibit DGB3 which is a schedule giving the name of the publication, dates on which the advertisement was to appear and the cost of the advertisement, but nothing relating to the mark or goods being advertised.

Mr Belmont says that many of his customers are in the oil industry, and he refers to a list of the same shown as exhibit dGB4.

Mr Belmont refers to exhibits DGB5 to DGB7, which consist of various computer related items such as a compact disc containing financial software, mouse mat and a floppy disk containing screen saver software, an audio cassette containing commentary on accounting issues, labels to be affixed to products and items of promotional and information literature and company stationery. Many are undated and where dated originate from after the relevant date. Some exhibits such as DGB6(I) contain historical information on Coda Limited, and refer to CODA - Financials (software) being first available in the United Kingdom in 1992.

Mr Belmont goes on to claim that through the use made of it the trade mark CODA has gained a reputation in relation to computer software for financial applications and related services. He says why he considers the respective marks and the goods/services to be similar, and outlines the potential for confusion, deception and damage should the application be allowed to proceed.

Applicants' evidence

5 This consists a Statutory Declaration dated 7 April 1998, and comes from William Lea, Managing Director of C.D.S. Computer Design Systems Limited. Mr Lea confirms that the facts in his Declaration come from his own knowledge or from the company records to which he has full access.

10 Mr Lea says that the trade mark CODAS was first used by his company in the United Kingdom "as early as 1975", and has been in continuous use since that date. He lists the goods and services in respect of which the trade mark has been used, which is essentially computer software and systems for management, sales and accounting, and services related to the installation, repair and maintenance of computers, and education, training and consultancy in computer hardware and software.

15 Mr Lea confirms that the trade mark has been used throughout the United Kingdom, and refers to exhibit WL1 which consists of a list of his company's customers. This confirms the geographical spread stated.

20 Mr Lea next sets out details of turnover relating to goods sold under the trade mark from 1975 to 1997, and which ranges from £650,000 in 1977, rising to a peak of £2,200,000 in 1989/90, and falling back to £1,500,000 in 1994, the last full year before the material date. He says that some £110,000 has been spent on advertising and promotional activities which have included attendance at exhibitions, and through advertisements in industry magazines and journals.

25 Mr Lea refers to exhibits WL2 and WL3 which consist of:

30 S a letter dated 23 January 1976 to Shell U.K. Oil from the applicants, acknowledging receipt of requirement specifications for a computer system, and stating that the proposal will be based upon their existing oil distribution package, CODAS.

35 S a copy of Petroleum Times Price Report dated 1 August 1982 containing an article confirming the sale of a CODAS on-line computer system for handling order processing and customer accounting, and the installation of the same for ESSO and Shell.

40 S an extract from Fuel Oil News indicated as dating from 1981, setting out the history of the applicants' company and its CODAS system (said to stand for Computerised Oil Distribution and Accounting System).

S a company brochure (undated) giving details of the functionality of the CODAS system.

45 Mr Lea denies the assertion that use of the trade mark by his company will damage any goodwill of the opponents, commenting that his company used and acquired a reputation in their mark over some six years prior to the opponents using theirs, and have used it concurrently with no known instances of confusion. He denies the marks are similar and dismisses the opponents registrations

in countries other than the United Kingdom as irrelevant. He concludes his Declaration by saying that registration should be allowed on the basis of Honest Concurrent Use under Section 7.

Opponents' evidence in reply

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This consists of a Statutory Declaration dated 26 January 1999, and comes from Gordon P Kushner, Chief Technology Counsel for Baan Company N.V., who confirms that he has worldwide responsibility for intellectual property matters, including trade marks, for his company. He confirms that he has held this position for 4 months, and has unlimited access to the company records of Baan.

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Mr Kushner begins by saying that his company acquired the assets, including the trade mark rights and goodwill, of Codas Limited in 1998. He refers to the Declaration by William Lea on behalf of the applicants in which he says that they have used the trade mark in respect of computer related goods and services, which Mr Kushner notes are not all limited to fuel distribution and that the applicants do not give the date that they first started each activity.

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Mr Kushner gives his views on the applicants' evidence which he says is limited and inconclusive and does not support a claim by the applicants to having established a reputation. He comments on the extent of the goods and services covered by the application and explains why he believes the respective trade marks to be visually and phonetically similar.

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That concludes my review of the evidence insofar as it is relevant to these proceedings, and I turn to consider the respective grounds upon which the opposition has been brought.

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Decision

At the hearing Mr Hacon confirmed that the grounds of opposition were to be found in Section 3(6), Section 5(2) and Section 5(4)(a). I turn first to consider the ground under Section 5(2), which, as the marks are clearly not identical falls to be determined under subsection (b), which reads as follows:

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

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(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,

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

An earlier right is defined in Section 6 the relevant parts of which state:

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

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

In my determination of the likelihood of confusion I look to the approach adopted by the European Court of Justice in *Sabel v. Puma* 1998 RPC 199 at 224, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* Case C-39/97) and in *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* (1999 ETMR 690 at 698). It is clear from these cases that:

S the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

S 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;

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

S 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;

S a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

S 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.

The applicants have claimed the sanctuary of Section 7(1) relating to Honest Concurrent Use . Mr Hacon citing the Road -Runner trade mark case (1996 FSR 805) sought to persuade me that where an application was found to be open to objection, inter alia, under Section 5(2)(b) because of an earlier trade mark, and the proprietor of that mark filed an opposition raising that ground, the provisions of Section 7(2) made refusal of the application mandatory.

Section 7 of the Act states as follows:

7.-(1) This section applies where on an application for registration of a trade mark it appears to the Registrar-

(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,

but the applicants shows to the satisfaction of the Registrar that there has been honest concurrent use of the trade mark for which registration is sought.

5 (2) In that case the Registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless the objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right,

10 (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 have amounted to honest concurrent use for the purposes of Section 12(2) of the Trade marks Act 1938.

(4) Nothing in this section affects-

15 (a) the refusal of registration on the grounds mentioned in Section 3 (absolute grounds for refusal), or

(b) the making of an application for a declaration of invalidity under Section 47(2) (application on relative grounds, where no consent to registration).

20 (5) This section does not apply when there is an order in force under Section 8 below.

25 First of all I note that this provision of the Act does not derive from Council Directive No 89/104/EEC of 21 December 1998 to approximate the laws of the Member States relating to trade marks. It is thus a piece of home spun legislation which can only be interpreted as complementing rather than conflicting with the Directive. I say that because Article 5 of the Directive (the equivalent of Section 5 of the Trade Marks Act) requires a trade mark to be excluded from the register if it conflicts with an earlier trade mark or other earlier right. However, the fifth recital to the Directive gives Member States latitude as to the stage at which such relative grounds are to be taken into consideration. The fifth recital states:

30 Whereas Member States also remain free to fix the provisions of procedure concerning the registration, the revocation and invalidity of trade marks acquired by registration; whereas they can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an *ex officio* examination procedure or both; whereas Member States remain free to determine the effects of revocation or invalidity of trade marks;

40 In relation to all applications for registration under the Act, the Trade Marks Registry must examine them against the provisions of Sections 3 and 5 and undertake a search under the provisions of Section 37 for that purpose. If, and when, as a result of the search an earlier trade mark or earlier right is identified which is considered to be the same or similar in respect of both the trade mark and the specification of goods and services, then the Trade Marks Registry must
45 raise an objection to the application for registration. However, if the applicant is able to show, to the satisfaction of the Trade Marks Registry, that there has been honest concurrent use of the trade mark the subject of the application with the earlier mark, under the provisions of Section

7, and with due regard to the fifth recital, the application may be accepted and published. Where the concurrent use has not been in respect of all of the goods or services for which the application is sought to be registered, the acceptance will be for those goods where there has been honest concurrent use. If there is no opposition to the application for registration either from the owner
5 of the earlier right against which the applicant for registration claims honest concurrent use or any third party, then the application will in due course be registered. However, if opposition is filed then the registrar must determine whether the grounds for refusal upon which the opposition is based are made out. If the opposition is based upon Section 5 then the provisions of the appropriate subsections must be considered. The fact that honest concurrent use has been shown
10 at the examination stage cannot overcome the objection.

If, for example, the trade mark the subject of the application for registration and the trade mark the subject of the earlier right were identical, and the specification of goods or services of the application was identical to the specification of the goods or services covered by the earlier trade
15 mark, then refusal must follow under Section 5(1), which bars absolutely the registration of identical trade marks in respect of identical goods or services (unless the proprietor of the earlier trade mark consents to the registration of the later trade mark). But in relation to Section 5(2) the respective trade marks or respective specifications of goods or services may only be similar and the fact that there has been actual use of the trade mark in suit concurrently with the earlier
20 trade mark, may be relevant in determining whether there is a likelihood of confusion.

In the circumstances and for the reasons above I reject Mr Hacon's submission that because the proprietor of the earlier trade mark against which the applicant for registration has claimed honest concurrent use has opposed the application, the provisions of section 7(2) make the refusal
25 mandatory. However, as I have already said, the mere fact that there has been honest concurrent use is not a defence, which in itself will save an application, but it is one of the "relevant" factors which should be taken into account in determining whether there is a likelihood of confusion.

In the statement of grounds the opponents mention eight trade mark registrations, although four
30 of these, Nos. 2038160, 2038453, 2038456 and 2038563 all have application dates falling after that of the opposed application and do not, therefore, constitute earlier trade marks.

Registrations Nos. 1417726 and 1587155 are for the trade mark CODA which by any standards of comparison would be considered visually and aurally all but identical to CODAS, and
35 particularly so when the likelihood of its use in the plural or possessive form is taken into account. Of the two remaining registrations, No. 2009483 is for the mark CODA OAS and 1417540 for the mark CODA-IAS. The differences in the respective marks are plain to see, but equally, with all three marks having CODA as the first element and the letters "AS" at the end, there is an appreciable degree of similarity. The suffixes are separate and are not recognisable words which
40 in my view makes it likely that they will be seen as and pronounced as separate letters. However, CODA is a strong sound and to that extent I would say that there is some aural similarity. Insofar as these are all word marks which do not appear to have any meaning or to convey any particular idea, I do not consider that conceptual similarity has much part to play in a comparison.

The opponents' earlier trade marks are registered in Class 9 in respect of computer software for
45 financial and accounting purposes and for use in the composition of music, and Classes 41 and 42 for design consultancy and training services for such software. The application covers Classes 9,

37, 41 and 42, and in the case of Classes 9, 41 and 42, self evidently, the same goods and services for which the opponents' mark is registered, albeit qualified as being "all for use in relation to the oil distribution industry". Mr Hacon submitted that such a limitation has no practical effect because any type of goods or service could be used in a particular industry. I believe Mr Hacon to be correct. With respect to the services covered in Class 37 of the application, I take the view that these are closely allied to the goods and services covered by the opponent's earlier trade marks and would be considered similar.

If similarity of the respective marks and the goods and services were all that is required for the objection under Section 5(2) to be valid, then I would have no hesitation in finding in favour of the opponents on this ground. However, the above cases indicate that similarity of marks and goods/services is but part of the global assessment in determining whether there is a likelihood of confusion, and I go on to consider other relevant factors.

There is no evidence that the opponents' trade mark CODA has any particular meaning in respect of the goods and services and I can only conclude that it is prima facie distinctive. They have made substantial use of the mark but not to the extent that would be considered exceptional, at least not to the extent that it raises the distinctive character so as to warrant a wider degree of protection.

The goods and services for which the opponents' earlier marks are protected, and for which the applicants seek to register their mark are either the same or similar, and assuming notional use, could be used in the same area of trade to the same customers. The qualification of the applicants' specification to being for use in the oil distribution industry does not change this.

The applicants evidence (exhibit WL3) shows that they have only used CODAS in relation to a product which they describe as being a "comprehensive set of software designed for oil distribution" that can be supplied using personal computers through to mainframe computers. It also says that this software is for use in the management of businesses involved in oil distribution and goes on to give details of the functionality of the applicants' CODAS system. There are references in the evidence to various computer "support" services being available from the applicants but it is not clear whether this is under the umbrella of the company name rather than specifically under the CODAS trade mark. In any case, there is nothing to say whether, from what date or to what extent the applicant may have provided such services. It would seem, therefore, that the applicants have only used CODAS in relation to some items of computer hardware and software falling in Class 9, and then, only for use in the management of businesses involved in oil distribution.

The applicants say that they have used the trade mark CODAS from "as early as 1975" which is supported by the evidence which shows that in January 1976 the applicants had a computer system described as an "oil distribution package" known as CODAS, and were tendering for a contract with Shell U.K. Oil to deliver a system based on their existing package. While this does not establish that an actual sale took place, it does show use of CODAS in the course of trade, and it is possible to draw the inference from the evidence that the applicants did, in fact, fulfill the contract. An article in the 1 August 1982 edition of Petroleum Times reported the purchase of the applicants' CODAS package for use with an on-line computer system for order processing and centralised customer accounting, and confirms the installation of the CODAS system in Esso and

Shell distribution systems. A further item extracted from the February 1981 edition of Fuel Oil News establishes that the applicants were trading in a computer system under the name CODAS, (an acronym for Computerised Oil Distribution and Accounting System) and that the system was at that time in use by Shell and Esso.

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The opponents in turn say that they commenced use of their mark in 1981 which means that the applicants and the opponents have been concurrently using their marks for upwards of fourteen years. Both appear to have made substantial use of their respective marks. Despite this, the opponents have not cited any instances where confusion has arisen although given that the applicants appear to have been trading in a limited area of the oil industry this is perhaps not surprising.

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Taking all of the above into account, I come to the view that on a comparison based solely upon the similarity and scope of the opponents earlier trade marks there is every likelihood of confusion arising should the application be allowed to proceed as applied for. However, the evidence shows that the respective marks have been able to work as trade marks for their respective owners for a considerable period of time without any apparent confusion, and it seems to me that if the application were limited to the goods for which there has been clear concurrent use, that that would continue to be the position. I therefore find the objection under Section 5(2)(b) to be successful in respect of all goods and services, other than:

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Computer hardware, computer software; all for use in the management of customer records, sales order processing, sales reporting, cash and credit control, stock control, planning of deliveries, load scheduling, boiler maintenance, telephone sales canvassing, management accounting, vehicle costing and performance reporting, payroll management, and the generation of reports relating to the aforesaid; all for use in the operation and management of businesses engaged in oil distribution

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I turn next to the ground under Section 5(4)(a). That section reads as follows:

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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-

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(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

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

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No reference is made to any rule of law other than the law of passing off. Mr Hobbs QC set out a summary of the elements of an action for passing off in WILD CHILD Trade Mark 1998 RPC 455. The necessary elements are said to be as follows:

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S that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

S that there is a misrepresentation by the defendant (whether or not intentional

leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

5 **S** that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

10 The evidence shows that at least as early as 1976 the applicants were using the name CODAS in the course of trade. Although there is no conclusive evidence of sales being made, for the reasons set out above I consider it reasonable to infer that the applicants did, in fact sell a limited range of goods under the mark. It would therefore seem that at the date that the opponents commenced use of their mark the applicants had already established a significant trade under their mark and had acquired the usual trapping of goodwill and reputation that go along with this. They may well have a limited customer base but this extends throughout the country and is of sufficient extent to warrant a national registration. In the circumstances I do not see how I can come to the view that should the applicants use their mark this will amount to misrepresentation, or that damage will be caused to the opponents, and I therefore dismiss the ground founded under Section 5(4)(a).

This leaves the matter of Section 3(6). That section reads as follows:

20 **3(6)** A trade mark shall not be registered if or to the extent that the application is made in bad faith.

25 At the hearing Mr Hacon explained that the objection is that the application essentially covers all computer software and he referred me to the Mercury Communications trade mark case (1995 FSR 850) in which Laddie J expressed his disapproval of such a claim.

30 Section 32(3) of the Act requires that an application state that the trade mark is being used in relation to all of the goods or services for which registration is sought, or that there is a bona fide intention that it will be so used. It is therefore clear that an applicant need not be using the trade mark on all, or indeed any of the goods at the time the application is made. However, while the Act allows for some futurity in putting the trade mark into use, from Section 46 it appears that the Act envisages that an applicant should have a real intention of doing so within the five years following registration. Notwithstanding this, the Registrar may raise an objection under Section 3(6) to the breadth of a claim during the ex parte examination but only in the most obvious or serious of cases, leaving other instances to be challenged under the provision of the Act intended to deal with such matters, an outcome envisaged by Laddie J. in the Mercury case.

40 The futurity envisaged by the Act means that an objection under Section 3(6) based on the assertion that the applicants do not have a bona fide intention of trading in all of the goods/services covered by an application (and have therefore acted in bad faith) is, in the absence of evidence unlikely to succeed. Distinct from an application under Section 46 where the position will be factual, the mark having either been used or not used in respect of all or any of the goods/services for which it is registered, the past actions of the trade mark applicant can at best give an indication of the extent to which they may use the mark in the future. Trading conditions change and companies develop new products and markets, making history an unreliable basis on which to say that they will not use the mark on a broader range of goods/ services in the future.

5 It is clear that Laddie J. considered the term computer software (unqualified) to be too wide and that it was undesirable that a trader interested in one limited type of software should be able to obtain the monopoly of a trade mark registration covering all types of software. Whilst I cannot take issue with this view, the position remains that the Registrar will accept applications for such claims.

10 If through evidence it can be established that an application covers goods/services which the applicant knows the trade mark will never be used in connection with, there is every likelihood that they would be found to have acted in bad faith in making the application. However, in this case there is no evidence. There is also the matter of the limitation to the goods and services which are said to be for use in the oil distribution industry, the area in which the applicants specifically aim the CODAS software. Although the limitation has no practical effect in restricting the scope of the goods and services (for the reasons I have already given), it may well be that the applicants believed this to be the case. Accordingly, I find that the objection under Section 3(6) fails.

15 Given my findings under Section 5(2)(b), if the applicants file a Form TM21 within one month from the end of the appeal period to reduce their application to Class 9, and to a specification in that class of:

20 Computers hardware, computer software; all for use in the management of customer records, sales order processing, sales reporting, cash and credit control, stock control, planning of deliveries, load scheduling, boiler maintenance, telephone sales canvassing, management accounting, vehicle costing and performance reporting, payroll management, and the generation of reports relating to the aforesaid; all for use in the operation and
25 management of businesses engaged in oil distribution

30 I will, in the event of no appeal, allow this application to proceed to registration. If the applicants fail to file a TM21 within one month from the end of the appeal period the application will be refused.

35 Although the opposition has technically failed and the application is to proceed, this is in respect of Class 9 only, and for a limited range of goods within that class. The applicants sought to defend the entirety of what I would consider to be a very wide claim for protection and tendered little in the way of evidence support their case. I therefore consider that no award of costs should be made.

Dated this 6 day of October 2000

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45 **Mike Foley**
for the Registrar
The Comptroller General

Annex

	Number	Mark	Class	Specification
5	1417726	CODA	9	Computer software for financial and accounting purposes, computer software for use in composing music; all included in Class 9.
10	1417540	CODA-IAS	9	Computer software for financial and accounting purposes; computer software for use in composing music; all included in Class 9
15	1587155	CODA	42	Computer software design consultancy services, all relating to computer software for financial accounting purposes or for use in composing music; all included in Class 42
20	2009483	CODA OAS	9	Computer software for financial and accounting purposes, computer software for use in composing music.
25			41	Training services relating to computer software for financial and accounting purposes or for use in composing music.
30			42	Computer software design consultancy and management, all relating to computer software for financial accounting purposes or for use in composing music.
35	2038160	CODA LINK	9	Computer software for financial and accounting purposes.
	2038453	CODA ASSETS	9	Computer software for financial and accounting purposes.
40	2038456	CODA FINANCIALS	9	Computer software for financial and accounting purposes.
	2038563	CODA PURCHASING	9	Computer software for financial and accounting purposes.