

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2041047  
IN THE NAME OF EXPERT SOFTWARE INC**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 49786 IN THE NAME OF  
TRANSWORLD PUBLISHERS LTD**

## TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2041047  
in the name of Expert Software Inc**

**and**

**IN THE MATTER OF Opposition thereto under  
No 49786 in the name of Transworld Publishers Ltd**

### **Background**

1. On 12 October 1995, Expert Software Inc applied to register a trade mark in respect of the following goods:

Computer programmes; all being for household use with personal computers and relating to topics of general interest such as entertainment, education, publishing, lifestyle, astrology, astronomy, health, fitness, gardening, maps, typing, creating labels, creating presentations material and creating business forms.

The marks is as follows:



2. On 17 May 1999, Transworld Publishers Limited filed notice of opposition to the applications, in which they say that they are the proprietor of various trade mark registrations, including:

<b>Number</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
1588506	EXPERT	16	Printed publications, printed matter, posters, magazines, periodicals, books; all relating to home-making, gardening and relating domestic activities; all included in Class 16

3. Two other trade marks are mentioned but as they have a date later than the date of application of the opposed application, and as no priority is claimed, they do not constitute earlier trade marks within the meaning of Section 6(1)(a) of the Act.

4. The opponents say that the opposition is not against the application as a whole, but in respect of the following goods:

Computer programmes; all being for household use with personal computers and relating to publishing, gardening and lifestyle.

5. The grounds of opposition are in summary:

1. **Under Section 5(2)(b)**

Because the mark applied for is similar to the opponent's earlier trade mark and is to be registered for goods or services similar to those of which it is protected and there is likelihood of confusion.

2. **Under Section 5(4)**

By virtue of the law of passing off.

3. **Under Section 3(1)(c)**

Because the mark applied for consists exclusively of signs or indications which may serve in the trade to designate a characteristic of the goods.

4. **Under Section 3(1)(d)**

Because the mark applied for consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

5. **Under Section 3(3)(b)**

Because the mark is of a nature as to deceive the public as to the origin of the goods supplied, particularly given the opponent's reputation.

6. The applicants filed a Counterstatement in which they deny all of the grounds on which the opposition is based.

7. Both sides request that costs be awarded in their favour.

8. Only the opponents filed evidence in these proceedings. The matter was set to be heard on 15 May 2001, but was subsequently postponed to allow a settlement to be investigated. The parties being unable to reach an agreement they asked that a decision be made from the papers.

### **Opponent's Evidence**

9. This consists of a Statutory Declaration dated 24 November 1999, and comes from Ian Manhire, Sales Operations Director of Transworld Publishers, a division of Random House Group Limited. Mr Manhire says that he has been associated with his company since the 1970's and that the evidence given in his Declaration comes from his own personal knowledge,

from company records or from the records of the predecessors in title to the mark EXPERT.

10. Mr Manhire begins by referring to and setting out the details of his company's trade mark registered under No 1588506, and to two other registrations, 2067293 and Community Trade Mark 219766. Details of these registrations are given in exhibit IM1 and show that only 1588506 has a date earlier than the date of application for the mark in suit.

11. Mr Manhire says that the EXPERT mark has gained in fame in the field of gardening and home making since the launch of the first EXPERT book in 1959. He says the books are written by Dr David Hessayon, have been widely reviewed and have sold millions of copies, being particularly well known in the United Kingdom which is their home market. He refers to exhibit IM2 which consists of an article published in The Mail on Sunday in September 1995, which profiles Dr Hessayon, referring to his first book in 1959 and the extensive sales. Mr Manhire says that the series of books, now standing at 18, has become known as EXPERT books. Exhibit IM3 is a selection of front covers and title pages from some of the range. All have a descriptive heading including the word EXPERT for example "Be your own greenhouse EXPERT". Some have reference such as "A new title in the best-selling EXPERT series" and "By the author of the best selling EXPERT books", "An EXPERT step by step guide ..." and "the secrets of growing under glass, EXPERT style". He continues saying that the books have been widely available and sold throughout the United Kingdom, referring to exhibit IM4 which consists of photographs showing how the books are displayed.

12. Mr Manhire sets out the turnover figures for the years 1993 to 1998, which for 1993 and 1994 amount to £1,750,000,000 and £2,406,000,000 respectively, the remainder being or including time after the relevant date. He says that the average price is between £5 and £10.

13. Mr Manhire goes on to say that there has been significant promotion of the books, with advertisements appearing in nationally published newspapers and magazines and he refers to exhibits IM5 and IM6 which show examples of the advertising, and an advertising schedule. The earliest advertisement appeared in Homes & Ideas in December 1994. This depicts the front cover of one of the gardening books and includes statements such as "From the expert who made gardening simple" and "EXPERT - the world's best selling gardening books". Other advertisements bear the EXPERT and OWL logo from registration 2067593. An advertisement that appeared in The Gardening Year - Winter refers to more books being published "in the "EXPERT" series". All of the material in exhibit IM6 originates from after the relevant date and beyond confirming the existence of the range of books available, add nothing to the case.

14. Mr Manhire refers to exhibit IM7, which consists of "best seller" charts for 1992, and "The 10 best selling books of the 1980's", two of the opponent's books appearing in each list. He next goes to exhibit IM8, which, he says, consists of articles from the 4 February 1999 edition of The Guardian, and 5 February 1999 edition of The Mirror newspapers, which refer, inter alia, to Dr Hessayon as having started the EXPERT range of titles some forty years previous, to having sold 43 million books, and to his being the second best selling author of the 1990's. Mr Manhire says that with such enormous sales anyone seeing the mark EXPERT in a gardening context would associate it with the EXPERT books. He goes on to name some events at which the books have been promoted but gives not further details.

15. Mr Manhire next refers to exhibit IM9, which consists of a sheet headed “publicity roundup September 1995”. The exhibit lists the regional and national publications in which details of the books entitled “The Container Expert” and “The Bulb Expert” have been published in the period June to September 1995, and copies of the articles, some of which mention the “EXPERT” series of books and refer to Dr Hessayon’s move into garden design.

16. Mr Manhire comments on the scope of the application under opposition, stating that the opponent’s objection is directed specifically at computer software relating to gardening, publishing and lifestyle, the fields in which their EXPERT brand has a reputation. He says that as books can now appear in the form of a CD ROM it is not longer possible to draw a clear distinction between computer software and printed matter, and that the question of similarity must depend upon the area of activity. Mr Manhire goes on to say where he considers that the respective goods would meet in the retail chain and to the consequent similarity in consumer. He says that software for garden design is more likely to be purchased by those interested in gardening rather than software at large. He goes on to refer to the proportions of the word EXPERT in relation to SOFTWARE, and to the fact that EXPERT is represented in the same manner that the opponents use the word in connection with their books, namely, in white block capitals on a black rectangular background, Mr Manhire saying that as a result of the public will retain the EXPERT element.

17. That concludes my review of the evidence insofar as it is relevant to these proceedings.

## **Decision**

18. The ground of opposition based upon Section 3(3)(b) I dismiss as being without foundation. The opponents say that the mark is of such a nature so as to deceive the public making particular reference to the reputation that they have built. This section relates to absolute ground which in my view is intended to prevent the registration of a trade mark because some intrinsic or inherent feature of the mark itself would deceive the public. The question of the other party’s rights in a trade mark is a matter to be dealt with in considering relative grounds for refusal to which I will come later in this decision.

19. Turning first to the grounds under Section 3(1)(c) and (d). Those sections read as follows:

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

- (a) .....
- (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, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (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:

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.

20. I have no evidence of use before me so the proviso to Section 3(1) does not apply and I have only the prima facie case to consider. I have included subsection (b), for if the mark is found to be open to objection under subsection (c) or (d), it will also fall foul of subsection (b) because it will, prima facie, be devoid of the distinctive character necessary to function as a trade mark.

21. In determining these grounds I have regard to *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] FSR 332 in which it was said:

“... according to the settled case-law of the court, the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all goods bearing it have originated under the control of a single undertaking which is responsible for their quality.”

22. I begin by looking at how the law stands. In the case of *Phillips Electronics NV v Remington Consumer Products Ltd* [1999] 23 RPC 908, Aldous LJ considered the scope of Section 3(1) saying:

“The more a trade mark describes the goods, whether it consists of words or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of use, whether or not it be monopoly use and whether or not there is evidence that the trade and public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader’s mesh from another trader’s mesh.

The requirement under section (Article 3(1)(b)) is that a mark must have a distinctive character to be registrable. Thus it must have a character which enables it to be distinctive of one trader’s goods in the sense that it has a meaning denoting the origin of the goods.”

23. The mark applied for is for the words EXPERT, with the letter X stylised, larger and in a contrasting shade to the other letters, and placed above the word SOFTWARE which is

shown in smaller lettering and proportions. The relative size and positioning of the words, and that the word SOFTWARE is directly descriptive of the goods leads me to the view that this will be seen and regarded as an EXPERT mark.

24. EXPERT is an ordinary English word that is widely used and likely to be known and understood by those conversant with the English language. It is perfectly apt to describe goods that are of a sophistication such as to be for use by those proficient in a particular subject or skill, that provides guidance from such persons, or that will enable the user to become proficient themselves, which is no doubt why two traders wishing to educate or advise have chosen to use EXPERT in relation to their goods. I also take judicial note of an entry for EXPERT SYSTEM in Collins English Dictionary, which has the definition “a computer programme that can offer intelligent advice or make intelligent decisions using rule base programs”. Consequently, I consider the word EXPERT to be, prima facie, devoid of distinctive character in relation to the goods of the application. I do not consider that the stylisation of the letter X, nor the use of the word in combination with the word SOFTWARE gives the mark the distinctive character to qualify for registration, and particularly so given the mode in which it is represented. Accordingly the opposition succeeds under Section 3(1)(c).

25. Although there is no evidence that the term EXPERT (solus) is commonly used in the trade, given that it is an ordinary description apt for such use I see no reason why it would not be so. However, in the absence of evidence I am not prepared to find on an assumption, and the ground under Section 3(1)(d) is dismissed.

26. In case I am found to be wrong I will go on to consider the remaining grounds of opposition, turning first to the ground under Section 5(2)(b) of the Act. That section reads as follows:

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

(a) ...

(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.

27. The term earlier trade mark is itself defined in Section 6 as follows:

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

(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,

28. The opponents rely on three trade marks, although as I have already indicated, two have a

date of application later than the application and as there is no claim to an earlier priority they do not qualify as earlier marks within the meaning of Section 6(1)(a) above.

29. This leave registration No 1588506 which is for the word EXPERT. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (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; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (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; *Sabel BV v. Puma AG*, paragraph 24;
- (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); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) 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; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

30. The opponent's mark consists of the word EXPERT placed above the word SOFTWARE. I have already said that I consider the mark applied for to be an EXPERT mark and that the stylisation of the letter X does not alter or disguise this, if anything, it points to the fact and makes it more likely that the consumer will regard EXPERT as the trade mark. I therefore find the mark applied for and the applicant's earlier mark to be visually similar, and identical in sound and concept.

31. In my decision in respect of Section 3(1)(c) I found the word EXPERT to be, prima facie, devoid of distinctive character, and in the absence of considerable use, it must be considered to warrant a narrow penumbra of protection.

32. The evidence provided by the opponents shows that they have made long and extensive use of the word EXPERT in relation to books on gardening activities and plants. Although this has primarily been in conjunction with other descriptive terms, for example, THE LAWN EXPERT, THE GARDEN DIY EXPERT, THE HOUSE PLANT EXPERT, the evidence shows that the opponents have promoted the books under the name EXPERT (solus), and the repetitive use of the same title format has led to the books being referred to in reviews as the EXPERT series. The scale and length of use is such that I would say that it has added significantly to the distinctiveness of the word EXPERT, but only in respect of matters related to gardening and plants.

33. Turning to the respective goods. In determining whether they are to be regarded as similar I look to the guidance of Jacob J in the TREAT trade mark case [1996] RPC 281 in which he set out the following factors as being relevant when assessing the similarity of the respective goods or services.

- (a) the respective users
- (b) the respective uses
- (c) their physical nature
- (d) the respective channels of trade through by which reach the market
- (e) in the case of self-serve consumer items, whether they are or are likely to be found on the same or different shelves
- (f) the extent to which they are competitive (and whether they are in the same or different trade sectors)

34. The opponent's earlier mark is registered in Class 16 for a range of printed matter related to gardening, home making and the like activities. The application is in Class 9 and seeks registration in respect of computer programs relating to topics of general interest, including

gardening, and lifestyle which I would consider to include both gardening and home making. I do not consider publishing to be covered by the opponent's registration. These computer programs are restricted to being for household use with personal computers, but as the specification of the opponent's earlier mark is not limited in any way this must mean that the respective users are notionally the same, and I believe that the opponent's evidence shows that this is the reality of the market.

35. In his declaration Mr Manhire took the view that software related to garden design is more likely to be purchased by those interested in gardening rather than software at large. Although there is no evidence to support this contention, it does not seem to be an unreasonable view, and in some way is, I believe, supported by the fact that the applicants state that their goods are for household use where functionality is likely to be the primary reason for buying any software.

36. Books and computer software are quite clearly different in their physical nature. They may well originate from different sources of manufacture, but reference works of this type seem likely to meet in the wholesaler, and I know from experience, actually will be stocked by the same retailers, be it garden centres or book shops, although are placed in different parts of the store. I have no evidence relating to how the trade classifies such goods or whether they would be regarded as being in the same trade sectors, but they should, at the very least, be considered as trading in close proximity.

37. Mr Manhire argued that as books can now appear in the form of a CD ROM it is no longer possible to draw a clear distinction between computer software and printed matter, and that the question of similarity must depend upon the area of activity. In the case of reference works, for example, a book about gardening and a computer program providing the same information, I would consider this to be a reasonable contention. In such cases the respective users will be the same, the only difference being the means of storage and access. Such goods in my view are in competition in that one is able, and likely to be used in place of the other. I would not, however, go so far as to say that all books and software having a common field of activity should be regarded in the same way.

38. Taking a balanced view of the above, and particularly taking into account the widespread use of home computers, I come to the view that reference books related to gardening, plants and home making should be regarded as similar goods to computer software of the same ilk for household use.

39. The respective goods are most likely to be available by self selection, making the appearance of the mark of primary significance. That the goods are likely to be displayed in different parts of a retail establishment, or at the very least, on different shelves, means that the consumer will not be able to compare the marks side by side, but instead will fix the dominant component, in this case EXPERT in their mind. Mr Manhire compared the similarity in the appearance of the mark applied for and the way in which the opponents use the word EXPERT, making particular reference to the white block capitals on a black rectangular background, concluding that this would add to the likelihood of confusion. If taken in conjunction with the identity in subject matter, it seems to me that through imperfect recollection these factors increase the likelihood of confusion.

40. Taking all of the above into account and adopting the global approach advocated, I consider that notwithstanding that EXPERT has a low degree of distinctiveness per se, that the extent and manner of the opponent's use of the mark EXPERT, and the way in which their goods have come to be referred to in the media, that in relation to the subjects of gardening, plants and aspects of home making, that they have established a strong degree of distinctiveness, such that, use of the mark applied for in relation to similar goods, in this case computer software on the same subjects will cause the public to wrongly believe that the respective goods come from the same or linked undertakings. Consequently I find that there is a likelihood of confusion and that the ground under Section 5(2)(b) succeeds but only in respect of:

Computer software relating to gardening and lifestyle

41. My decision under Section 5(2)(b) effectively decides the matter and I therefore do not need to go on to give full consideration to the ground of opposition under Section 5(4)(a). Had I done so I do not consider that the opponents would have been in any better position than under Section 5(2)(b). From the evidence it appears that they have used the mark EXPERT in relation to books on gardening, plant and flowers and some aspects of home making and that any reputation and goodwill would be in respect of these goods and would not extend to all of the goods covered by the application. Having concluded that the respective marks are similar and that there is identity in respect of the aforementioned goods, a finding that the public will be led to believe that the goods of the applicant are those of the opponent or that the two undertakings are associated, would, I believe have followed.

As the opponents have been successful they are entitled to a contribution towards their costs. I order the applicants to pay the opponents of the sum of £735 in respect of this opposition. This to be paid within seven days of the expiry of the period allowed for filing an appeal or, in the event of an unsuccessful appeal, within seven days of this decision becoming final.

**Dated this 4<sup>TH</sup> Day of December 2001**

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