

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER  
2164931 BY GARY BURNETT TO REGISTER A  
TRADE MARK IN CLASS 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 50554 BY DATACOLOR AG**

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Trade Mark in Class 42**

**and**

**IN THE MATTER OF Opposition Thereto  
Under Number 50554 by Datacolor AG**

**BACKGROUND**

1. On 24 April 1998 Gary Burnett applied to register the following series of two trade marks in Class 42 for a specification of

“Printing services; offset printing; lithograph printing; report printing; graphic design; colour screening; printing of colour screens and pictures; printing paper articles” -

**DATA COLOUR IMAGING**  
**DATA COLOR IMAGING**

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 22 December 1999 Stevens Hewlett & Perkins on behalf of Datacolor AG filed a Notice of Opposition against the application. In summary, the grounds of opposition were:-

- (i) Under Section 5(2)(b) of the Act because the trade mark applied for is confusingly similar to the following UK registered trade marks owned by the opponent and registered for similar goods and there exists a likelihood of confusion on the part of the public -

**NUMBER:** 1540268

**MARK:**


**datacolor**   
international

**REGISTRATION:** 1 April 1993  
**EFFECTIVE**

**CLASS:** 9

**SPECIFICATION:** Spectrophotometers; optical apparatus and instruments; computer hardware and software; measuring and dispensing apparatus and instruments; apparatus and instruments, all for colouring, dyeing and matching computer data and images; parts and fittings for all the aforesaid goods; all included in Class 9.

**NUMBER:** 2041959

**MARK:** The logo for Datacolor International, featuring the word "datacolor" in a bold, lowercase sans-serif font, followed by a thick black horizontal bar. Below this bar, the word "international" is written in a smaller, lowercase sans-serif font.

**REGISTRATION** 19 October 1995  
**EFFECTIVE:**

**CLASS:** 16

**SPECIFICATION:** Printed matter; manuals; instruction books; paper tapes and cards for the recordal of computer programs.

- (ii) Under Section 5(4)(a) of the Act in that use of the mark applied for is liable to be prevented by the law of passing off in light of the opponents significant use of the trade mark DATACOLOR INTERNATIONAL and the reputation they have build up in the field of printing and imaging.

3. The applicants, through their agents Kennedy & Co, filed a Counterstatement denying the grounds of opposition. Both sides have asked for an award of costs in their favour and have filed evidence. At the hearing which took placed on 28 January 2001, the applicants for registration were represented by Mr Kennedy of Kennedy & Co and the opponent by Mr Sutton of Stevens Hewlett & Perkins.

#### **Opponent's Evidence**

4. This consists of a statutory declaration dated 29 September 2000 by Dr John R Bamforth, the Managing Director of Datacolor International Limited which is a sister company of DATACOLOR AG (the opponents).

5. Dr Bamforth draws attention to the two UK trade mark registrations - 1540268 and 2041959 - and states that the trade mark subject to these registrations (DATACOLOR INTERNATIONAL and Logo) has been in continuous use throughout the whole of the UK since 1980 upon and in relation to “computer hardware and software products used in colour measurement, colour formulation, colour communication, laboratory dyeing and laboratory dispensing and printed matter relating thereto”. He refers to Exhibit JRB 1 to his declaration which contains a selection of brochures and print-outs from his company’s web-site bearing the trade mark DATACOLOR INTERNATIONAL in relation to some of these goods. Most of those documents are clearly after the relevant date. However, two brochures publicising a Datamatch Colour Matching System refer to 04.96 ie. April 1996.

6. Mr Bamforth states that turnover of goods bearing the opponents mark in the UK since 1993 has been as follows:-

<b>YEAR</b>	<b>TURNOVER(£)</b>
1993	5,600,000
1994	4,400,000
1995	6,000,000
1996	6,200,000
1997	5,900,000
1998	5,400,000
1999	4,400,000

7. Turning to the advertising and publicity given to goods sold under the mark, Dr Bamforth states that on average the amount spent has been in the region of £150,000 per annum which is approximately £1,050,000 gross between 1991 and 1998. He draws attention to Exhibit JRB 2 to his declaration which contains copies of a selection of advertisements and articles relating to goods bearing the DATACOLOR INTERNATIONAL trade mark in the following publications, all of which are circulated in the UK - International Dyer; SDC Journal; Polymers Paint Journal. All publications are after the relevant date with the exception of one page from a publication which refers to a series of Datacolour International Roadshows at the end of 1996/early 1997. He adds that his company produce an occasional magazine entitled DATACOLOR DIMENSIONS for the UK textile industry which relates to his company’s products including imaging systems. A selection of these news magazines are at Exhibit JRB 3 to Dr Bamforth’s declaration. They are undated.

8. Next, Mr Bamforth points out that his company has attended the following exhibitions where goods bearing the DATACOLOR INTERNATIONAL trade mark have been promoted:-

<b>DATE</b>	<b>EXHIBITION</b>
June 1999	ITMA, Paris
October 1999	Interplas Exhibition, NEC Birmingham
October 1999	Colour Conference, Royal Horticultural Halls, London
November 1999	Paints & Plastics Roadshow, ICC Centre, Nottingham

February 2000	UK & Northern Ireland Textile Roadshow, 5 Venues
April 2000	Northern & Southern Ireland Paints & Plastic Roadshow - various venues
June 2000	Surfex Exhibition - Harrogate International Conference Centre

and at Exhibit JRB 4 to his declaration is a photograph from the Interplas Exhibition in October 1999 and a photograph depicting the a demonstration at the Textile Roadshow in February 2000. However, it must be pointed out that the opponent's evidence in relation to these exhibition relate to a period after the relevant date, as the application date for the mark in suit is 24 April 1998.

9. Dr Bamforth states that goods bearing the DATACOLOR INTERNATIONAL trade mark have been sold and distributed throughout the whole of the UK and Exhibit JRB 5 to his declaration comprises a list of towns and cities in the UK where the mark is used. He adds that orders for goods bearing the mark are received regularly. At Exhibit JRB 7 are example purchase orders relating to hardware and software largely for use in colouring processes, sold under the DATACOLOR INTERNATIONAL trade mark. . Of the ten purchase orders, eight are after the relevant date for these proceedings.

### **Applicants Evidence**

10. This consists of a statutory declaration dated 5 April 2001 by Neil McKechnie, A Director of Kennedy's Patent Agency Limited who are the professional trade mark advisors to the applicant.

11. Mr McKechnie draws attention to the specifications of the opponent's registrations and the application in suit. He makes the following submissions on whether similarity of goods and services exists:-

**"(i) The respective uses/users of the respective goods or services**

The opponent provides specialised computer software and hardware products used in "colour measurement, colour formulation, colour communication, laboratory dyeing and laboratory dispensing and printed matter relating thereto". The end users of such specialised goods are likely to be print workers and technicians with expertise in the use of the goods provided by the opponent.

The applicant provides printing services of various types to customers who will not necessarily be aware of the specialised computer hardware and software, which may or may not have been used to carry out the printing service. Such customers are even more unlikely to be aware of the brand names of such hardware and software. Thus, the respective uses and end users of the applicant's services are extremely different from those of the opponent.

**(ii) The physical nature of the goods or acts of service**

The goods specified for the opponent's mark are particular types of scientific

and technical apparatus in Class 9. The applicant's mark relates only to services and makes no direct reference to the apparatus used in the provision of such services.

(iii) **The respective trade channels through which the goods or services reach the market**

The apparatus provided by the opponent is sold to specialised printing service providers thus is not generally provided directly to consumers. It is therefore sold by advertising in print trade channels (such as those shown in the opponent's evidence). The applicant's services are provided to consumers thus advertising would be through publications read by such consumers. Such publications are extremely distinguishable in nature and content to the above mentioned print trade publications.

(iv) **The extent to which the respective goods or services are competitive**

The goods supplied by the opponent and the services provided by the applicant are in no way in direct competition. The opponent's goods are not of a nature to be used by the customers of the applicant, who generally lack expertise in the printing processes and procedures."

12. Mr McKechnie also submits that the respective marks, as a whole, are distinguishable and confusion is unlikely.

### **Opponents Evidence in Reply**

13. This consists of a statutory declaration dated 26 June 2001 by Peter William Cornford, a trade mark attorney employed by Stevens Hewlett & Perkins, the applicant's professional representatives.

14. Mr Cornford makes the following submissions in relation to the similarities of the goods and services in issue:-

“There is no limitation within the specifications to the application or use of any of the above goods, and as was shown in Dr John R Bamforth's 29 September 2000 Statutory Declaration filed as Rule 13(7) evidence, the goods are in fact used by the opponent in printing and in the printing industry. The opponent's marks appear prominently on and in relation to the goods for which the marks are registered and are clearly visible at point of use. There is no limit to the range of applications to which the opponent's goods can be put, and as the Rule 13(7) evidence shows, the goods are used in the textiles, plastics and paint industries as well as in printing. All of the applicant's services can be categorised as either printing or design services. Since the opponent's goods can be and are used predominantly in this sector there is every reason to fear public confusion as a result of the similarity of the respective parties' marks.

I would draw the tribunal's attention to lines 48-49 on page 288 of the Treat case in which Jacob J states "*It does not matter if those other uses are much commoner; the fact that the product could be used as a desert sauce means it is one*". By the same reasoning, the fact that the goods covered by the opponent's earlier registrations may be purchased and used by non specialist personnel as well as by specialist print workers and technicians (there is not restriction within the opponent's specifications on how the goods are sold or through which trade channels they pass) means that the goods covered by the opponents' registrations on which it relies in these proceedings must make them similar to the services applied for under the subject application."

15. Turning to the marks themselves, Mr Cornford submits that as DATACOLOR is the distinctive element, the likelihood of confusion between the respective parties marks must be considered great.

16. This completes my summary of the evidence filed in this case. I now turn to the decision.

## **DECISION**

17. Firstly, I consider the ground of opposition based upon Section 5(2)(b) of the Act which reads as follows:-

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

- (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,

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

18. An earlier right is defined in Section 6, the relevant parts of which state:-

6.-(1) .....

- (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,"

19. 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] 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.

20. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection afforded to such a mark. The opponent has filed evidence relating to the reputation of the mark covered by their prior registrations and at the hearing Mr Sutton submitted that the opponent was a market leader in providing goods in the printing, design and graphics field. However, Mr Kennedy was understandably critical of the



opponent's evidence for a number of reasons. The vast bulk of the supporting exhibits filed in relation to the opponent's reputation is in respect of information and events after the relevant date for this opposition ie. the date of application for the mark in suit. The turnover details provided in Mr Bamforth's statutory declaration were in Mr Kennedy's submission inconclusive in that, in themselves, they could not provide evidence of repute. I share Mr Kennedy's concerns. While I have no doubt that the opponent has a real presence in the market place, the evidence filed in this case does not demonstrate a reputation that will enhance the inherent distinctiveness of the mark to the point where the likelihood of confusion is increased amongst the relevant public (the customer of the products), for the opponent's trade marks. While I accept that evidence filed in cases before the Registrar should be proportionate to the costs involved in what is essentially a lower cost option for dispute resolution, an opponent seeking extended protection for a trade mark because of its reputation and enhanced distinctive character is under an obligation to demonstrate the repute of their mark with the average customer for the relevant goods. In my opinion this requires, at least, the filing of specific and relevant documentation which goes directly to the repute of the mark e.g. market share, press cuttings, advertisements, independent trade support or analysis. In the present case there is a paucity of evidence filed in this regard and the vast bulk of the evidence, that has been filed on the promotion of the mark, relates to promotional material and events which took place after the relevant date for these proceedings. To conclude, I do not consider the opponent to have established an enhanced distinctive character in their mark for the purpose of these proceedings. I must therefore compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks.

21. In essence the test under Section 5(2)(b) is whether there are similarities in marks and also goods and services which would combine to create a likelihood of confusion and in my considerations I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, taking into account the categories of goods and services in question and how they are marketed.

22. The application in suit consists of a series of two marks, DATACOLLOUR IMAGING and DATACOLOR IMAGING, the difference between them being the first word in both marks. One contains the British English version of the word "colour" and thus reads DATACOLLOUR and the other the American English version and thus reads DATACOLOR. The word DATACOLLOUR or DATACOLOR is a combination of the obvious dictionary words DATA and COLOUR/COLOR. While the word DATACOLLOUR/DATACOLOR may allude to "coloured data", the allusion is in my view sufficiently indirect and I have no doubt that the word DATACOLLOUR/DATACOLOR would be seen as an indication of origin for goods or services. The second word in the mark applied is IMAGING, an obvious dictionary word which directly refers to goods or services which produce/provide images by e.g. photography, filming, taping or screening. Turning to the prior registrations of the opponent, both contain the word "datacolor" (lower case) over the word "international". A rectangular device appears after the word datacolor and a line runs under that word and the device. The word international is an obvious dictionary word which in my view directly describes goods or services which may be provided on an international basis. However, as indicated earlier, I believe the word DATACOLOR to have no direct reference to the goods of the opponent and

to be an inherently distinctive component which deserves a reasonable penumbra of protection. It is of course possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

23. How then should I approach the comparison of the marks? Mr Sutton argued that I should pay particular attention to the dominant and distinctive component in the marks of the opponent and applicant, which in his view is the word DATACOLOR, and that the additional material in both marks should be discounted. It is right in my view to give additional weight to arbitrary and distinctive features in assessing the impact a mark is likely to have in the mind of the average customer and I am fortified in this by the guidance of the European Court of Justice in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, paragraphs 24 and 26. However, even elements which are totally descriptive cannot be entirely discounted as respective marks must be considered in their totality.

24. Turning to a visual and aural comparison of the marks, it seems to me that the word DATACOLOR is a dominant and distinctive component of both the opponents and applicants marks and is an element which is likely to be quickly recognised and retained by customers. The remaining elements of both marks, the descriptive words INTERNATIONAL and IMAGING and the device element are less striking and in oral use the device element is unlikely to be a factor in descriptions as "words speak louder than devices." Although the additional elements in both marks assist in distinguishing the respective marks on a side-by-side comparison, the prominence and impact of the word DATACOLOR is such that when the marks are compared in their totality, there is a likelihood of confusion resulting from both visual and oral use of the marks, particularly when imperfect recollection is taken into account. Many persons could consider the common element DATACOLOUR to be an indication that the goods and services come from the same undertaking or economically linked undertakings.

25. On a conceptual comparison of the marks it, once again, seems to me that the distinctive word DATACOLOR will be remembered and retained by customers and notwithstanding the additional elements in the respective marks it is likely that customers, particularly when imperfect recollection is taken into account, may not distinguish the origin of the respective goods or services through the respective marks.

26. In my comparisons of the marks I do not lose sight of the fact that the first mark in the series applied for comprises the mark DATACOLOUR IMAGING, so that it contains the British English version of the word "colour" as opposed to the American English word "Color". Also the applicant's marks are presented in upper case and the opponent's mark in lower case. However, in my view, nothing turns on these points.

27. I now go on to take into account the goods and services covered by the specifications of the respective marks. In my determinations on this point I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

- (a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

28. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods and services.

29. The services of the application in suit cover (inter alia) printing services, graphic design, colour screening and printing of colour screens and services, whereas the opponent's goods cover (inter alia) spectrophotometers, optical apparatus, computer hardware and software, measuring and dispensing apparatus, apparatus and instruments for colouring, dyeing and matching computer data and images.

30. At the hearing Mr Kennedy submitted that the customer for the respective services and goods would be relatively sophisticated and discerning. While I have no evidence on this point I think Mr Kennedy must be correct in this assumption.

31. The uses or purpose of the respective services or goods can be said to overlap in that they may be for the same specialised purpose ie. the production of printed material, in particular specialised colour matched material. Indeed, the opponents "Datamatch" brochures of April 1996 show that they are active in this field. I consider it very likely that one could be used as an alternative to the other or in conjunction with the other, for example the opponent's goods could be used to produce printed material etc. "in-house" while the applicant's services could be used to obtain printed material etc. through "outsourcing". Furthermore, the opponent's goods could be used in the provision of the service. On the other hand the physical nature of services is obviously quite different to that of goods even where the respective purposes are the same.

32. Turning to the respective trade channels and the extent to which the goods and services are competitive, while I have no evidence before me on the point, it seems to me very likely that businesses operating in the printing and colour graphics industry could provide both goods and services. My own knowledge tells me that some customers for printed material and colour graphics use "in-house" production or "outsourcing" for such material as alternatives and

although they may possess "in-house" resources they regularly make decisions on whether to go "in-house" or to "outsource" on a commercial basis.

33. On a global appreciation, taking into account all the relevant factors, I come to the following conclusion on the Section 5(2) ground:-

- (i) the respective marks are visually, aurally and conceptually very similar;
- (ii) the respective specifications of the applicant's services and the opponent's goods are similar
- (iii) while the customer for the goods and services is likely to be relatively sophisticated and discerning given the specialised nature of the goods and services they would be in such close proximity that if sold under such a similar brand name even a knowledgeable consumer is likely to consider that they originate from the same undertaking or economically linked undertakings.

34. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in Cannon:-

"Accordingly the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL paragraphs 16 to 18)."

35. The opposition is successful under Section 5(2)(b) of the Act and as I have found for the opponent under Section 5(2) I have no need to consider the other ground raised.

36. As the opponents have been successful they are entitled to a contribution towards their costs. At the hearing, Mr Kennedy argued that if they were successful, any costs awarded to the opponents should be reduced as they made no attempts to settle the dispute through negotiation. In response, Mr Sutton stated that the applicants had not at any time put forward any proposals with a settlement in mind. In any event, an opponent is under no obligation to attempt to reach a settlement with an applicant and I have no hesitation in rejecting Mr Kennedy's submissions on this point. I intend to order costs according to the normal scale. I order the applicants to pay the opponents the sum of £850. 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 this case if any appeal against this decision is unsuccessful.

**Dated this 08 day of February 2002**

**JOHN MacGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**