

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2234625
BY COMPASSMARK LIMITED TO REGISTER A
TRADE MARK IN CLASSES 16, 35 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 52113 BY KOMPASS INTERNATIONAL NEUENSCHWANDER SA**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2234625
by Compassmark Limited to register a trade mark
in Classes 16, 35 and 42**

and

**IN THE MATTER OF Opposition thereto under
No 52113 by Kompass International Neuenschwander SA**

DECISION

1. On 2 June 2000 Compassmark Limited applied to register the following mark:



for a specification of goods and services that reads:

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except

apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

Class 35

Auditing; business appraisals; professional business consultancy; business information; business inquiries; business management and organisation consultancy; business management assistance; business management consultancy; business research; commercial or industrial management assistance; efficiency experts; commercial information agency services; advisory services for business management; commercial management assistance; personnel management consultancy; marketing research and studies; opinion polling; public relations; statistical information; advertising and promotion services and information services relating thereto, provided on-line from a computer database or the Internet; compilation of advertisements for use as web pages on the Internet; on-line advertising on a data communications network; data search in computer files (for others); rental of advertising time on communication media.

Class 42

Design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information provided on-line from a computer database or from the Internet; creating and maintaining websites; hosting the websites of others; installation and maintenance of computer software; leasing access time to a computer database (other than by Internet service providers), data conversion of computer programs and data (not physical conversion), computer system design, duplication of computer programs; conversion of data or documents from physical to electronic media; providing endorsement and recognition of websites, web pages, internet and other publications according to predetermined criteria and certifying such as meeting standards set in the predetermined criteria.

2. The application is numbered 2234625.

3. On 7 February 2001 Kompass International Neuenschwander S.A. filed notice of opposition to this application. The single ground of opposition is under Section 5(2)(b) of the Act and is based on the following earlier trade marks.

No	Mark	Class	Specification
1514230	KOMPASS	9	Recorded tapes, discs, compact discs bearing read-only memories; all bearing recorded business or directory information; all included in Class 9.

791039	KOMPASS	16	Printed publications.
1292231	KOMPASS	35	Business information services; computer-based storage and retrieval of business and advertising information; all included in Class 35.

4. The opponents took an assignment of these marks and are now the proprietors of record.

5. The applicants filed a counterstatement denying the above ground and offering what are, in effect, submissions on the parties' respective marks and the issue of likelihood of confusion including material showing the state of the register in relation to 'Compass marks'.

6. Both sides ask for an award of costs in their favour. Only the opponents filed evidence. The papers were reviewed by a Hearing Officer in line with current Registry practice and the parties were advised that, in the circumstances of the case, a hearing was not considered to be necessary. The parties were nevertheless reminded of their right to be heard and/or to make written submissions. In the event neither side requested a hearing or made written submissions. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

7. Section 5(2) reads:

"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."

Paragraph (b) applies here.

8. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1988] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwin-Mayer Inc* [1999] RPC 117, *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.

Distinctive character of the opponents' mark

9. The guidance from *Sabel v Puma* is that 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.

10. The opponents have filed evidence which, I assume, is in part directed towards establishing an enhanced degree of distinctive character for their mark as a result of use. The evidence consists of a statutory declaration by Peter Snook, publisher of Kompass UK on behalf of Reed Business Information Ltd. Reed is the sole franchisee of the opponent company in this respect. Mr Snook makes his declaration from his personal knowledge and from consulting records of Reed Business Information Ltd to which he has had full access.

11. Mr Snook says that the opponents' marks were first used in 1959 and have been used continuously since that date. He exhibits promotional material (PS1), examples of the marks in use on the opponents' goods and services (PS2) and illustrations of the opponents' activity at an exhibition by way of an example of participation at such events (PS3). The goods and services have been made available at a wide range of major towns and cities throughout the UK. Turnover has averaged approximately £11 million per annum over the five years 1996 to 2000 and advertising expenditure has been approximately £500,000 per annum for most of this period. There is a further statutory declaration by Yves Wilmots, the opponents' Managing Director, the main purpose of which is to confirm that Reed Business Information Ltd is the sole distributor in the United Kingdom of the opponents' goods and services. He also confirms that he has read and agrees with Mr Snook's declaration.

12. The sales and promotional figures referred to above suggest a substantial and sustained level of activity. I have not been told what the size of the market is for business information services or what the opponents' position is within the market. It is not possible, therefore, to place their activities in context. As a result I would hesitate to say that KOMPASS enjoys an enhanced degree of distinctive character through use. But that is not a significant drawback from the opponents' point of view as the mark KOMPASS seems to me to be an entirely distinctive one in relation to the goods and services in question (business information publications and services).

Similarity of marks

13. The opponents' mark in each of their registrations is the word KOMPASS. The applied for mark is the composite one shown at the start of this decision. The guidance in *Sabel v Puma* is as follows:

"23. That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - "... there exists a likelihood of confusion on the part of the public ..." - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details."

14. The opponents submit that the words COMPASS and KOMPASS are phonetically identical; that the element MARK in the applied for mark is non-distinctive; and that the

applicants' device merely reinforces the word COMPASS. The applicants, in their counterstatement, submit that there are clear differences between the opponents' word mark and their own composite mark; that the word element alone is still distinguishable from the opponents' mark; and that their mark would be identified by the public by reference to the full word COMPASSMARK and the distinctive device.

15. Even allowing for the maxim that words talk in trade marks, arguably the most dominant element in the applied for mark is the compass device. The word COMPASSMARK is nevertheless still a significant feature of the mark. The opponents are right in my view to suggest that it will be seen as reinforcing the device. It is, therefore, in all respects a 'compass' mark. The opponents' mark requires little elaboration. It is the word KOMPASS. That is not, so far as I am aware, a dictionary word but I anticipate that for the average consumer it will bring to mind the closest English word namely 'compass'. It may be seen as either a corrupted spelling of that word or the equivalent word in a foreign language.

16. With those introductory observations I turn to the visual, aural and conceptual similarities of the respective marks. Direct visual similarity is limited to the fact that the word within the applicants' composite mark contains the element COMPASS-. This is a case where aural and conceptual considerations play a particularly important part. Aurally the applicants' mark may either be referred to by reference to the dominant element, that is the compass device, and/or by reference to the word COMPASSMARK. The different spelling of the word KOMPASS in the opponents' mark will not be apparent in oral use. Conceptually the elements that make up the applied for mark combine to focus the consumers' attention on the idea of a compass. In all the circumstances I find that there is similarity in terms of the idea, image and word at the heart of the marks.

Similarity of goods/services

17. The respective specifications are set out at the start of the decision. The parties have not commented in detail on the goods and services concerned. The opponents merely say that both marks are used or are to be used in relation to information on and for businesses and that both are available on, inter alia, the Internet.

18. In order to assess the similarity of the goods, I note the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

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

19. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgment, the ECJ stated at paragraph 23:

"23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary."

20. Additionally in this case I bear in mind the following passage from Jacob J's judgment in *Avnet Incorporated v Isoact Ltd*, [1998] FSR 16:

"... definitions of services are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes".

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

21. I will consider each of the applicants' Classes separately.

Class 16

22. The opponents' own registration in Class 16 covers 'printed publications'. The applicants' specification covers 'printed matter'. In *MINERVA Trade Mark* [2000] FSR 734 Jacob J said:

"The specification of goods poses difficulties. "Printed matter" as a pure matter of language, I suppose, covers anything upon which there is printing. In a sense, every trade mark for whatever goods could also therefore be registered for printed matter if one reads "printed matter" perfectly literally. Every packet has printed matter on it. This specification of goods has not only got "printed matter" specified, but also stationery. Mr Carr suggests that I should read "printed matter" as though it was qualified by the word "stationery" in which case, of course, he would in effect get a finding that his clients did not infringe the registration. Alternatively, he says, "printed matter" means printed matter other than "stationery" because stationery is already specified, so there should be a rectification using the powers under section 46(5).

"Printed matter" cannot in my judgment mean merely that the trade mark is printed on something. For example, if there is a registration for "printed matter" but the only use is on labels for, say, soap or bananas, there has not been use for printed matter."

23. In that case it was found that the term 'printed matter' included, for instance, printed stationery. It must equally cover printed publications or, at least to the extent that the

applicants have not sought to particularise types of printed matter that are sufficiently far removed from printed publications, these sets of goods are in conflict. The only other item in the applicants' specification that seems to me to conflict with printed publications is "instructional and teaching material (except apparatus)". Such material may well consist of, or include, printed publications. The remaining items are sufficiently far removed from 'printed publications' in terms of the TREAT/CANON test that I can find no similarity. In coming to that view I propose to comment further on just two items. 'Goods made from these materials' (that is paper and cardboard) might on a broad construction be thought to cover a printed publication which is after all made from paper and possibly cardboard. But words must be given their ordinary meaning (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* [2000] FSR 267). Despite the generality of the term in the applicants' specification it does not naturally lead itself to interpretation as meaning anything that would be, or be similar to, printed publications. The other item is 'playing cards' but again such goods are not usually said to be published. I do not regard them as conflicting with 'printed publications'.

Class 35

24. As noted by Jacob J, definitions of services are often less than precise. That is particularly the case with the applicants' broad specification in Class 35. The opponents' specification on the other hand reflects their actual activities with rather greater precision. The exhibits to Mr Snook's declaration (in particular PS1 and 2) adequately describe their activities as compilers and providers of a range of company and product information largely directed at a business to business audience. In the absence of any attempt by the applicants to qualify or further define their services in such a way as to avoid a conflict I regard the following items as being similar to the opponents' Class 35 services:

- business information
- business inquiries
- business research
- commercial information agency services
- marketing research and studies
- statistical information
- information services relating thereto (as a supplementary element to advertising and promotion services)
- data search in computer files (for others)

25. All of these services seem to me to include or relate to business information services as included in the opponents' Class 35 specification. The remaining items are in the nature of business management and consultancy services (or services at an even further remove such as auditing, opinion polling, public relations etc). The essence of the opponents' specification is the provision of business information services and the storage and retrieval of data in relation thereto. These strike me as essentially different in character to business management and consultancy services.

26. One particular area of the applied for specification calls for comment. I do not find 'advertising and promotion services ... provided on line ...' or 'compilation of advertisements

...' to be similar notwithstanding that the opponents' Class 35 specification covers storage and retrieval of business and advertising information. The essence of those services are storage and retrieval of such information. The opponents do not appear to be providers of advertising services as such despite the fact that the information they are able to supply may itself be used as the basis for identifying targets for an advertising programme.

Class 42

27. The opponents do not have a registration in this Class but that is not in itself proof that similar services are not involved. That said the only item that seems to me to be in potential conflict with the opponents' goods and services (particularly business information services) is 'information provided on-line from a computer database or from the Internet'. In the absence of argument or submission on the matter the only other items that call for comment are the various references to 'data conversion' and 'conversion of data and documents'. Data could, I assume, be business information data. But again I take the view, in line with *Avnet v Isoact*, that the core service being described is the process of conversion. The nature of the underlying data does not define or determine the nature of the service.

Likelihood of confusion

28. The likelihood of confusion must be appreciated globally taking all relevant factors into account. In *Raleigh International Trade Mark [2001] RPC 202 Geoffrey Hobbs QC*, sitting as the Appointed Person, said:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences."

29. Even if the visual differences in the respective marks is sufficient to avoid direct confusion I would nevertheless hold that there is a likelihood of confusion arising from association between the marks in the sense that the public would wrongly believe that identical or similar goods and services come from the same or economically linked undertakings (*Canon v MGM* paragraph 29).

30. The result is that the opposition succeeds but to a limited extent only. Article 13 of First Council Directive 89/104 indicates that:

"Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only."

31. Accordingly if, within 28 days of the expiry of the appeal period, the applicants file a Form TM21 restricting their specification as follows the application will be allowed to proceed to registration for the following:

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

Class 35

Auditing; business appraisals; professional business consultancy; business management and organisation consultancy; business management assistance; business management consultancy; commercial or industrial management assistance; efficiency experts; advisory services for business management; commercial management assistance; personnel management consultancy; opinion polling; public relations; advertising and promotion services, provided on-line from a computer database or the Internet; compilation of advertisements for use as web pages on the Internet; on-line advertising on a data communications network; rental of advertising time on communication media.

Class 42

Design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining websites; hosting the websites of others; installation and maintenance of computer software; leasing access time to a computer database (other than by Internet service providers), data conversion of computer programs and data (not physical conversion), computer system design, duplication of computer programs; conversion of data or documents from physical to electronic media; providing endorsement and recognition of websites, web pages, internet and other publications according to predetermined criteria and certifying such as meeting standards set in the predetermined criteria.

32. If the applicants fail to file a Form TM21 restricting their specification, the application will be refused in its entirety.

33. As both sides have achieved a measure of success I make no order as to costs.

Dated this 11th day of July 2002

**M REYNOLDS
For the Registrar
the Comptroller-General**