

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2005203
BY FINANCIAL MANAGEMENT CONSULTANTS LIMITED
TO REGISTER A TRADE MARK IN CLASSES 35 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO. 44760 BY BARCLAYS BANK PLC**

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 2005203
BY FINANCIAL MANAGEMENT CONSULTANTS LIMITED TO
REGISTER THE TRADE MARK FMC AND DEVICE
IN CLASSES 35 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 44760 BY BARCLAYS BANK PLC**

DECISION

On 29 November 1994 Financial Management Consultants Limited of Wellington, Somerset applied to register the trade mark:



in Class 35 in respect of:

Business management consultancy and services, business administration services and consultancy.

and in Class 42 in respect of:

Computer consultancy and services, computer hardware consultancy and services, computer software consultancy and services, business legal services, litigation support consultancy and services.

On 18 June 1996 Barclays Bank PLC filed notice of opposition to this application. In summary the grounds of opposition are:

- (i) under Section 3(1)(a) as the trade mark is not capable of distinguishing the services of the applicant from the services of third parties unconnected with the applicant.
- (ii) under Section 3(3)(a) as use of the trade mark would be contrary to public policy.
- (iii) under Section 3(3)(b) as use of the trade mark would deceive the public.
- (iii) under Section 3(4) as use of the trade mark would amount to passing-off and copyright infringement.
- (iv) under Section 3(6) in that the application was made in bad faith.

5 (v) under Section 5(2)(b) because the trade mark is similar to earlier trade marks in the ownership of the opponents and is for similar or identical services. It is also stated that the opponents' trade mark is entitled to protection as a well known trade mark (see annex for full details of earlier trade marks upon which the opponents rely).

10 (vi) under Section 5(3) in that use of the trade mark would take unfair advantage of and be detrimental to the distinctive character or the repute of the opponent's trade mark which enjoys a reputation within the United Kingdom.

(vii) under Section 5(4) in that use of the trade mark is liable to be prevented by rule of law, in particular the law of passing-off and the law of copyright.

15 (viii) that the Registrar use his discretion and refuse the application.

The applicants for registration filed a counterstatement commenting at some length on the above grounds but in essence denying them. The applicants also requested that the Registrar exercise his discretion in their favour.

20 Both sides asked for an award of costs in their favour.

Both sides filed evidence. The matter came to be heard on 10 February 1999 when Dr. Mary Vittoria of Her Majesty's Counsel, instructed by Moon Beaver, represented the applicants. The opponents were not represented and did not file written submissions.

25 **Opponents' Evidence**

30 The opponents filed a statutory declaration dated 2 May 1997 by Antony Francis Williams who declares that he is Assistant Company Secretary of Barclays Bank PLC, the opponents. He declares that amongst other things he is responsible for trade mark matters relating to the opponents. He states that he has been employed by the opponents for 30 years. He states that he makes his declaration on the basis of personal knowledge or information derived from the records of the opponents.

35 Mr Williams gives an account of the origins of the Bank, which was established in 1896, although its origins go back to the seventeenth century. In 1917, the name Barclays Bank Limited was adopted. This was changed in 1982, in compliance with the Companies Act 1980 to Barclays Bank PLC. Further changes occurred subsequently and as a result Barclays Bank PLC is the wholly owned subsidiary of Barclays PLC which is the holding company for the Barclays group of companies.

40 Mr Williams states that from at least 1917 the Bank has been known as "Barclays Bank" or "Barclays" and has provided financial and other services continuously since that time under the trade mark BARCLAYS and/or its eagle device.. Mr Williams exhibits as AFW1 a number of leaflets which describe the financial services provided by the opponents under the eagle device trade mark.

45 Mr Williams states that an eagle device has been used in connection with the Bank's business since 1728 when it first moved to premises at 54 Lombard Street, London EC3. He exhibits at AFW2

examples of the different forms which the emblem has taken over the years together with an extract from the Bank's design guide (AFW3) (which specifies the use of the Bank's various marks and its house style) showing the present version of the eagle device in various styles. He states that by 1972 its present form was established, as registered under trade mark number 1301397:

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Mr. Williams declares that the opponents are the registered proprietors of a number or registered trade marks for its eagle device and he lists four of them: 2004233, 1327699, 1420294, and 1301397. (The statutory declaration refers to 1402294 instead of 1420294 but from the statement of grounds I can ascertain that 1420294 is meant - 1402294 is not in the ownership of the opponents.) He also states that the opponents have two registered trade marks for its eagle device as used on and in connection with its "Connect" debit business card business: 1297055 and 937030. Mr. Williams also declares that the opponents have trade mark registrations for the eagle device coupled with the word BARCLAYS, he gives 1272889 as an example of this.

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Mr. Williams declares that the eagle device is often depicted in blue but also appears in black and white and other colours.

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In view of the constant use by the opponents of an eagle device in connection with all areas of its business, Mr Williams submits that there is an association in the minds of the public between the device and the services provided by the opponents.

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Mr. Williams continues his declaration with more details about the opponents use of the eagle device. He states the eagle device appears on the exterior of the opponents' banks, of which there are some two thousand in the United Kingdom. He states that under the eagle device the opponents provide a comprehensive range of banking related services through its branch network, via its Barclaycard Division, which deals with the opponents' credit card operations, and through various subsidiaries which conduct merchant banking activities, life assurance, unit trusts, insurance booking, asset management and retail stockbroking activities. He also advises that through Barclays Bank Trust Company Limited, personal financial planning, investment management, trust administration, pension fund advice and personal taxation activities are carried out. Mr. Williams goes on to state that the eagle device appears on all letters, cheques, cheque cards, statements of account, holders' statements and other documentation issued by the opponents. He avers that this has ensured that the eagle device has been firmly established in the minds of the public as being associated with the opponents. He exhibits a bundle of documentation issued by the opponents in relation to its banking and financial services which bears the eagle device.

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Mr. Williams goes on to state that the opponents use the eagle device in connection with the provision of computer services, for example, its PDQ machines used by businesses to debit

payments directly from customers' cards.

Mr. Williams declares that the opponents have offered business consultancy services to its small business customers under the eagle device through its branch network for at least 90 years and more recently using the Internet and other direct promotional material. Exhibited as AFW7 are a bundle of promotional materials for these services.

Mr. Williams states that the opponents are one of the leading domestic banks in the United Kingdom. In respect of the United Kingdom business, banking services made the following profits:

Year	Amount
1994	£690 million
1995	£754 million
1996	£801 million

Mr. Williams states that the eagle device was modified for use with the opponents' "Connect" debit card services as represented in registration number 1297055:



This trade mark, he states, is used by the opponents on all its PDQ machines and all cards and advertising and promotional literature issued in connection with the Connect debit card services. A leaflet showing use of the "Connect Eagle" is exhibited at AFW9.

Mr. Williams then goes on to state that he became aware of the applicants and their trade mark when a letter addressed to Barclays Registrars (a division of the opponents) was passed to him. He declares that, having responsibility for the opponents' trade marks he was immediately concerned about the possibility of confusion between the applicants and the opponents. He was particularly concerned that the boxes surrounding the eagle and the letters FMC are similar to those used in the opponents' registration 1272889, amongst others. He was worried that use of the trade mark by the applicant would lead to confusion in the minds of the public and that this use would deceive the public as to the origins of the goods and services of the applicants. He further considered that the opponents could bring proceedings for copyright infringement.

Consequent upon this Mr. Williams instructed Messrs Lovell White Durrant to write to the

5 applicants seeking undertakings that they would cease and desist from using the double headed eagle which formed part of their trade mark. A copy of this letter, which was sent on 21 November 1994 and the response from the applicants is exhibited as AFW10. Mr. Williams describes the response of the applicants as “non-committal”. Mr. Williams states that on 29 November 1994 the application, subject of the current proceedings, was filed.

10 Mr. Williams believes that the application was made in bad faith and at a time when the applicants were aware of the objections of the opponents to the use of the trade mark. Mr. Williams in particular states that by virtue of the goodwill and reputation which the opponents have established in the eagle device that use of the applicants’ trade mark would amount to passing-off.

15 Mr. Williams goes on to state that the trade mark in suit is not capable of distinguishing the applicants’ goods and services from those of the opponents and that the application is contrary to public policy and is of such a nature that it would deceive the public.

20 Mr. Williams states that the application is for services identical or similar to the goods and services for which the opponents have registrations for its eagle device. Therefore there is a likelihood of confusion on the part of the public, including the likelihood of association with the opponents’ trade marks. He further believes that the application would take unfair advantage of, and/or be detrimental to, the distinctive character and/or the repute of the opponents’ eagle device whether or not the services for which the application is applied for are similar to the goods and services for which the bank has registrations.

25 Mr Williams gives his views on the potential for confusion between the applicants' trade mark and the opponents’ eagle devices.

30 Finally Mr. Williams states that the opponents have acquired a substantial reputation in the services sector over the past 200 years for its eagle devices and in the combined form with BARCLAYS. This reputation he avers will lead to considerable risk of confusion in the mind of the public.

Applicants’ Evidence

35 The applicants filed a statutory declaration dated 31 July 1997 by Mr. David Wilkins who declares that he is co-chairman of Financial Management Consultant Ltd and that he makes his declaration on the basis of information known personally to him or derived from the company records of the applicants.

40 He states that the applicants were incorporated in 1980 and have offices in Epsom, Surrey and Milverton, Somerset. He states that the applicants are in part computer litigation consultants, they act for clients in producing and interlinking forensic evidence for use in civil legal proceedings. He states that the applicants provide expert witnesses and assist in the negotiations of settlements of civil cases with computer suppliers. Mr. Wilkins states that in 1994 the applicants were involved in management consultancy, corporate fraud investigation and consultancy, computer consulting (including project management) and quantum measurement, including the calculation of damages in computer litigation.

45 Mr. Wilkins states that in November 1994 the applicants were well known for offering the above services. He declares that the device in the form shown in the application in suit was first used in

1990; prior to that, and from 1980, the device was used in the form exhibited as DW1. Mr. Wilkins states that previous trade mark varied from the trade mark in suit in that the eagle and letters were not in boxes and the letters FMC were presented in bold type. Mr. Wilkins states that after joining the applicants in April 1987 it was decided that they needed to improve their corporate image. Consequent upon this the current trade mark was adopted, in use in relation to various materials the trade mark has gold blocking used.

Mr. Wilkins states that the trade mark has been used continuously since its adoption. He exhibits as DW2 a brochure which he states dates from 1991. Further use of the trade mark is exhibited as DW3 - DW5.

Mr. Wilkins states that there has been little advertising in the form of placing notices in the trade press except when recruiting, an example of this is exhibited as DW6. He declares that the applicants prefer to rely on targeted mailshots. He goes on to quantify the number of mailshots sent out in recent years:

1989-90	9863
1990-91	18450
1991-92	41016
1992-93	144737
1993-94	208263
1994-95	299626
1995-96	290233
1996-97	307341

He states that the relevant public are well acquainted with the applicants and the services they offer.

Mr. Wilkins goes on to state that the turnover figures for the applicants are as follows:

1989-90	£ 228327
1990-91	£ 318688
1991-92	£ 448979
1992-93	£ 508537
1993-94	£ 1100948
1994-95	£ 1761295
1995-96	£ 1832505
1996-97	£ 1176048

He states that he does not believe that there is any real prospect of confusion between the financial services offered by the opponents and those offered by the applicants. He states that he is not aware of any examples of confusion having arisen. Mr. Wilkins declares that the opponents are the applicants' bankers and consequently must have seen their trade mark on many occasions. He expresses surprise therefore that in 1994 the opponents considered the applicants' trade mark to be a threat.

Mr. Wilkins goes on to state that eagles are common signs. He refers to a letter from the Bluemantle Pursuivant of The College of Arms, exhibited as DW7, which gives his opinion of the respective eagles and the commonness of the eagle in heraldry. Mr. Wilkins exhibits as DW8

various examples of the use of the eagle as a heraldic device, these include both single headed and double headed eagles. He also exhibits copies of details of registered trade marks for Crystal Palace Football Club (1986) Limited and The Royal Bank of Scotland Group plc as DW9 and DW10 respectively. Mr. Wilkins goes on to exhibit copies of details of various other registered trade marks, DW11-DW14, which he considers contain representations of eagles. He states that because of the number of eagle devices used by various traders, including those in the business and financial fields, that the public are capable of discerning the differences between the eagle of the opponents and that of the applicant.

Mr. Wilkins goes on to state that it needs to be held in mind that the application in suit is not just for the eagle device but also for the letters FMC. He further comments that the opponents have not instituted proceedings for passing-off or trade mark infringement.

Mr. Wilkins states that the opponents have been the bankers for the applicants since long before 1994 and no suggestion of similarity was raised prior to then. He declares that personnel of the opponents must have been aware of the use of the applicants' trade mark as they were present at a lecture he gave in November 1990 where promotional material bearing the eagle device was distributed.

Mr. Wilkins states that the opponents state that the eagle device is always used in connection with their services. He declares that this is not the case and to demonstrate this he exhibits as DW15 a copy of an envelope relating to BARCLAYCARD upon which a different device is present.

Mr. Wilkins concludes that his eagle device was never intended to conflict with that of the opponents and that the two are clearly different. Alternatively or additionally, in view of the applicants' honest concurrent use of its trade mark, he believes that the two trade marks are perceived by the public as relating to different services of different origins.

Opponents' Evidence In Reply

Mr. Williams made a further statutory declaration dated 31 October 1997.

Mr. Williams refutes that there is not a likelihood of confusion between the respective trade marks, and states that the likelihood is increased by the blocking around the trade mark in suit. He rejects the heraldic research and other eagle devices as being irrelevant. Mr. Williams states that the view of the Bluemantle Pursuivant is not relevant in trade mark matters and comments that the letter the applicants sent to the Bluemantle Pursuivant is not exhibited. He declares that this letter might have been couched in prejudiced terms. Mr. Williams also states that the other registrations referred to by the applicants are irrelevant because they are so diverse and so different from the trade mark in suit and the trade marks of the opponents.

Mr. Williams states that although the opponents' staff in the branch used by the applicants may have been aware of the trade mark in suit the necessary personnel in their head office were not until October 1994, as per his first declaration. He believes that the matter has been dealt with as expeditiously as possible. He declares that as the applicants have relied on targeted mailshots it was unlikely that the opponents would have come across their use of the trade mark in suit. He further states that the opponents have reserved their position with regard to proceedings for trade mark infringement.

Mr. Williams declares that although the Barclaycard credit card division might not use the eagle device he does not consider that this has a detrimental effect on the reputation of the eagle device.

That concludes my review of the evidence filed in these proceedings.

Decision

In my view the opponents have filed no evidence bearing directly on the grounds under Section 3(1)(a), 3(3)(a) and (b) and 3(4). The side note to Section 3 of the Act indicates that that Section is concerned with “absolute grounds for refusal of registration”, that is to say some inherent characteristic of the mark that disqualifies it from registration. I do not see any such issues arising in the context of this application. Section 3(4) is being pursued upon the basis of passing-off and copyright infringement. I do not consider that this part of the Act can be used in pursuit of passing-off or copyright infringement. The Act makes specific provision for opposition based upon the common law tort of passing-off under Section 5(4)(a) and copyright infringement under 5(4)(b), and the opponents have attacked the application under these provisions. As an absolute ground this part of the Act is, in my view, limited to the prevention of registration of trade marks which would contravene the law, arising from the intrinsic feature or features of the trade mark rather than by taking into consideration other parties’ rights; the consideration of another party’s rights would bring the matter into the area of relative grounds. Therefore the opponents’ opposition based upon Section 3(1)(a), 3(3) (a) and (b) and 3(4) are dismissed.

I turn now to the grounds of opposition under Section 3(6). Section 3(6) of the Act reads:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

In an earlier decided case, YOOHOO (SRIS No. 0-100-97) the Assistant Registrar deals with the issue of bad faith. At page 3 he states:

“The Act does not give any guidance on what would constitute bad faith and I am not aware that there is as yet any judicial authority on the subject so far as an invalidity action under the 1994 Act is concerned. Bad faith was considered in the ROADRUNNER case (CH 1996 R.No. 745) but the circumstances were different and that case does not assist here. However, the Notes on Clauses which were prepared for use in Parliament while the Trade Marks Bill was before it, were intended to reflect the purpose and effect of the provisions of the Act (subject, of course, to the necessary caveats that the Notes themselves do not have the force of law and that the interpretation of an Act of Parliament is ultimately a matter for the Courts). In relation to Section 3(6) the Notes read as follows:-

Subsection (6) declares that a trade mark is not registrable if the application for registration of the trade mark was made in bad faith. The provision does not attempt to indicate what is meant by “bad faith”, thereby leaving it to the registrar or the courts to decide in a particular case what amounts to bad faith. Examples of circumstances where bad faith might be found are

- (i) where the applicant had no bona fide intention to use the mark, or intended to use it, but not for the whole range of goods and services listed in the application;
- (ii) where the applicant was aware that someone else intends to use and/or register the mark, particularly where the applicant has a relationship, for example as

employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the United Kingdom;

(iii) where the mark incorporates the name or image of a well-known person without his agreement. (This should not be taken as meaning that this provision is legislating for the protection of a personal name or reputation - these remain unprotected under English law, but the nexus between unregistrability and the name of a well-known person is that of the bad faith in which the application is made.)

The opponents have based this ground upon the fact that the applicants filed their application in the knowledge that the opponents objected to the use of the trade mark in suit. The opponents also consider that this objection is applicable owing to their assertion that the use of the trade mark in suit would be prohibited by the common law tort of passing-off and because of infringement of copyright.

Dr. Vittoria submitted that the filing of the application following the receipt of the cease and desist letter was not an action committed in bad faith. Dr. Vittoria pointed out the applicants had been using the trade mark in suit since 1990 and a similar trade mark since 1980. Owing to the length of use of the trade mark in suit it was perfectly reasonable for the applicants to try to protect their position by applying for a trade mark following the receipt of the cease and desist letter, she argued.

The applicants, as indicated above, have been using the trade mark in suit since 1990 and previously a similar trade mark since 1980. I cannot find that there can be a well founded accusation of bad faith in relation to the application when the applicants have been using the trade mark for such a period of time without any indication of problems until the receipt of the cease and desist letter from the opponents. It is reasonable for the applicants to try to protect their position by making a trade mark application; successful registration representing a defence under Section 11. In relation to the issues of passing-off and copyright infringement these are matters encompassed by Section 5(4)(a) and (b), these are not matters which represent an application being made in bad faith. I can find no substantiation for the grounds under Section 3(6), the basis for the objection do not fit within any of the parameters set out above. Moreover, I can find nothing that indicates to me that the applicants have acted in anything other than a proper and reasonable fashion in relation to the filing of the application in suit. I dismiss the objection under Section 3(6) accordingly.

I turn now to the objection under Section 5(2)(b).

“5.-(1)

(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.”

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,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

In considering the issue of confusion I also take account of the guidance given by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* (1998 RPC 199). The relevant sections of the ECJ’s decision are set out below:-

“..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

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.

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

I also take into account the decision of the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117. In particular I take note of the following:

5 A global assessment of the likelihood of confusion implies some interdependence between
the relevant factors, and in particular a similarity between the trade marks and between
these goods or services. Accordingly, a lesser degree of similarity between these goods or
services may be offset by a greater degree of similarity between the marks, and vice versa.
10 The interdependence of these factors is expressly mentioned in the tenth recital of the
preamble to the Directive, which states that it is indispensable to give an interpretation of
the concept of similarity in relation to the likelihood of confusion, the appreciation of
which depends, in particular, on the recognition of the trade mark on the market and the
degree of similarity between the mark and the sign and between the goods or services
identified.

and

15 It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade
mark may have to be refused, despite a lesser degree of similarity between the goods or
services covered, where the marks are very similar and the earlier mark, in particular its
reputation, is highly distinctive.

20 Finally the court gave the following judgement on the interpretation of Article 4(1)(b):

25 “On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21
December 1988 to approximate the laws of the Member States relating to trade marks, the
distinctive character of the earlier trade mark, and in particular its reputation, must be taken
into account when determining whether the similarity between the goods or services
covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

30 There may be a likelihood of confusion within the meaning of Article 4(1)(b) of Directive
89/104 even where the public perception is that the goods or services have different places
of production. By contrast, there can be no such likelihood where it does not appear that
the public could believe that the goods or services come from the same undertaking or, as
the case may be, from economically-linked undertakings.”

35 In the view of Mr. Geoffrey Hobbs QC, acting as the Appointed Person, in the Balmoral case
(Application No. 2003949):

40 “The tenth recital to the Directive and these observations of the Court of Justice indicate
that an objection to registration under Section 5(2) of the Act should be taken to raise a
single composite question: are these similarities (in terms of marks and goods or services)
which would combine to create a likelihood of confusion if the “*the earlier trade mark*”
and the sign subsequently presented for registration were used concurrently in relation to
the goods or services for which they are respectively registered and proposed to be
registered?”

45 [This represents the “holistic” approach to the issue of confusability rather than the previous
dualistic approach.] Dr. Vittoria submitted that it was first necessary to consider if similar goods
or services were involved and referred to the criteria set out in TREAT [1996] RPC 281 at page
296. I cannot agree that the dualistic approach as submitted by Dr. Victoria is correct in the light
of Canon v. MGM. The interdependence between the similarity of the good and services and the
similarity between the trade marks militates against adopting the old dualistic approach. The two

elements cannot be divorced from one another; they must be considered together. It is of course still necessary to consider the issue of similarity of goods and services but within the context of the composite question.

5 In their statement of grounds the opponents cross-refer paragraphs 4 and 12. Paragraph 12 identifies the grounds of opposition under Section 5(2)(b) and refers to paragraph 4 in relation to the earlier trade marks from which they claim protection. These trade marks are identified as registration numbers 1327699, 1420294, 1301397 and 2004233. In the first statutory declaration of Mr. Williams he refers to various other registrations: 1297055, 937030 and 1272889. There has
10 been no request to amend the statement of grounds to include these registrations into the proceedings. As the latter registrations are outwith the pleadings it is not appropriate to consider them; I confine my deliberations therefore to registration numbers 1327699, 1420294, 1301397 and 2004233. (Details of these trade marks can be found in the annex to this decision.)

15 These trade marks are all device only trade marks, all of them bear a similar if not identical representation of a double headed eagle. The evidence supplied by the applicants shows that devices of eagles similar to those depicted in the registered trade marks are common, they are not creatures of one particular imagination. The judgement in *Sabel v. Puma* quoted above requires
20 me to have to consider whether the trade marks of the applicants and the opponents have a great deal of intrinsic distinctiveness. There is a clear parallel with the bounding feline. The trade marks in the terms of the judgement do not possess a great deal of distinctiveness, they are similar to common heraldic devices. (I do not take into account the issue of the other trade marks referred to in the applicants' evidence. Beyond the issues of whether they are on a par with the current application and whether they encompass similar goods and services, to give them any weight
25 would require evidence of their use in the marketplace - see *BECK KOLLER* 64 RPC 76.) Advocate General Jacobs in his opinion differentiates between the ordinary representation of the bounding feline and such images as a puma playing a violin or a puma grouped with a snake. There is no extraordinary element in the trade marks in question, the two headed and single headed eagles are doing nothing untoward or unusual. However, I must go on to consider whether the
30 devices of the opponents have acquired greater distinctiveness through reputation. The evidence of the opponents is deficient in proving such a reputation. The exhibits of the opponents show the eagle for the major part used in a subsidiary and subservient position to *BARCLAYS*. As Dr. Vittoria correctly submitted in such a case to prove a reputation in the device element of the trade marks would require "picking out" evidence, i.e. evidence to show that the "eagle device" *solus*
35 has a reputation. Such evidence has not been adduced into these proceedings. The evidence also showed that the opponents have a reputation in relation to banking and closely allied functions. There is certainly no indication that this reputation extends to the services of the applicants included in Class 42.

40 In considering the issue of confusability I must consider the trade marks as wholes and at the same time balance this with the proximity or lack of proximity of the specifications. [In relation to registration nos. 1301397, 1327699 I find that there is little if any proximity in relation to the goods and services of the opponents and those of the application in suit. In relation to registration
45 no. 1420294 I find there is a close proximity with the Class 35 specification of the application in suit, in relation to registration no. 2004233 I find there is a close proximity with the Class 42 specification of the application in suit.] I refer back to *Sabel v. Puma*, in particular the following passage:

"That global appreciation of the visual, aural or conceptual similarity of the marks in question,

5 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.”

10 A significant element of the trade mark in suit is the letters FMC, this is the dominant element. It is the part of the trade mark that is likely to strike the eye first. The eagle devices are different in several elements; that of the opponents has, for instance, only one head. The presumption of the opponents is that the single element of a heraldic type eagle, although having significant differences from that in the application in suit, combined with similarities in goods and services, leads to registration of the application in suit being contrary to Section 5(2)(b) of the Act. Taking into account all the elements relating to the issues pertaining to Section 5(2)(b) which I have
15 rehearsed above I do not find that registration of the trade mark in suit would be contrary to Section 5(2)(b). I dismiss this ground of opposition.

20 The opponents have also claimed that their “eagle device” trade mark is a well known trade mark within the meaning of Section 56(1) of the Act. Section 56(1) of the Act states:

“56-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well known trade mark are to a mark which is well known in the United Kingdom as being the mark of a person who -

25 (a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

30 whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

35 Section 55(1)(b) defines a convention country as follows:

“(b) a “Convention country” means a country, other than the United Kingdom, which is a party to the Convention.”

40 As I have indicated above that the evidence does not demonstrate a reputation in the “eagle device” this claim must fall, the hurdle for being accepted as a well known trade mark under the Paris Convention is higher. Dr. Vittoria submitted that the opponents cannot claim protection under Section 56(1) anyway. She submitted that Section 56(1) relates to non-United Kingdom based companies, it is designed to protect foreign traders who are well known in the United
45 Kingdom but do not carry out business here. Dr. Vittoria referred me to the definition of a convention country, she submitted that as the opponents were domiciled in the United Kingdom they could not benefit from the provisions of Section 56(1) as the opponents are not nationals of a Convention country.

I have also taken note of the following comments of Professor Bodenhausen in the “Guide to the Application of the Paris Convention for the Protection of Industrial Property”:

(at page 30 in relation to Article 2 paragraph 1):

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“The question has been raised whether nationals of a country of the Union will be able to claim application of the Convention also *in their own country*. This question is of no importance with respect to the rule of “*national treatment*” because nationals of a country will enjoy such treatment in their own country anyhow. The question remains, however, whether, in these conditions, nationals can also claim application in their own country of *the common rules of the Convention* in so far as they are accepted as “self-executing” when these rules have not been incorporated in the national law. The provision under examination only states that nationals of a country of the Union can claim application of the national laws and of the Convention “in all the *other countries*” of the Union. This is logical, because the Convention is an international instrument destined to govern international situations. The protection of a national in his own country depends on the domestic legislation of that country and such national will therefore not be able to claim application of the Convention in his own country unless its legislation entitles him to do so.”

(and at page 90 in relation to Article 6bis)

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“The purpose of the provision under consideration is to avoid the registration and use of a trademark, liable to create *confusion* with *another* mark already *well known in the country of such registration or use*, although the latter well-known mark is not, or not yet, protected in that country by a registration which would normally prevent the registration of a conflicting mark.”

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I consider Dr. Vittoria’s interpretation of the relevant parts of the Act correct, a position that is reinforced by the comments above of Professor Bodenhausen.. The purpose of Section 56 is to protect the well known trade marks of foreign proprietors, not domestic proprietors; domestic proprietors will already enjoy the relevant protection without recourse to aid from Article 6bis.

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Even if the opponents had demonstrated that the “eagle device” was a well known trade mark they could not benefit from the provisions of Section 56(1) as they have not adduced evidence to demonstrate that they are nationals of a Convention country or domiciled in, or have a real and effective industrial or commercial establishment in, a Convention country.

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I go on to consider the grounds of opposition under Section 5(3) which states

“(3) A trade mark which -

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- (a) is identical with or similar to an earlier trade mark, and
 - (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the

United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

5 I have already decided above in another context that the opponents have not proved a reputation in respect of the “eagle device”. This ground of opposition must therefore be dismissed.

10 I go on to continue to consider the grounds of opposition under Section 5(4)(a). Section 5(4)(a) reads:

Section 5(4)a reads:

15 “ (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 -

(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

20 (b)

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

25 No reference is made to any rule of law other than passing-off. Mr Geoffrey Hobbs QC set out the basis an action for passing-off in WILD CHILD Trade Mark (1998) RPC 455:

30 ‘A helpful summary of the elements of an action for passing-off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

35 “The necessary elements of the action for passing-off have been restated by the House of Lords as being three in number:

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

40 (2) 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

45 (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing-off in the form of this classical trinity has been

5 preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing-off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing-off which were not under consideration on the facts before the House"

10 Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

15 "To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

20 (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

25 While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

30 (a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

35 (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

40 (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

45 In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action." '

It is not an automatic sequitur that because the opposition has failed under Section 5(2)(b) that it must also fail under Section 5(4)(a) in relation to passing-off. The tests for confusion under Section 5(2) have been clearly prescribed by the European Court of Justice. Such tests of

confusion (deception) do not define the considerations in relation to deception under passing-off.

5 The opponents must show goodwill in their business and that they are recognised by the “eagle device”. The evidence adduced proves that goodwill exists in relation to their business in relation to BARCLAYS but they have not demonstrated that such goodwill also exists in the “eagle device”. I have already dealt with the problems relating to the evidence supplied by the opponents in relation to their reputation; it relates very much to trade marks containing other prominent matter, any reputation would also accrue to banking and closely allied services. The failure of the evidence to demonstrate good will in relation to the “eagle device” causes the objection under 10 Section 5(4)(a) to fail. However, although I do not need to consider the issue of deception/confusability, as the opponents must pass all three tests of the classic trinity, I consider it appropriate in this instant case. I do so because this is an unusual case in that the opponents must have been aware of the trade mark in suit and its predecessor for some time, it was before them in the course of their business.

15 As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 407 the question of deception or confusion is:

20 “is it, on a balance of probabilities likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product]?”

25 Dr. Vittoria submitted with some force that the opponents had produced no evidence of confusion despite the lengthy period of the use of the trade mark and its similar predecessor. (The argument is slightly but not fatally weakened as the services for which use has been demonstrated are narrower than those encompassed by the specification.) In the instant case the opponents, if not their intellectual property experts, were aware of the trade mark in suit and its predecessor for a considerable time. The applicants bank with the opponents, staff of the opponents even attended a lecture by the applicants at a conference in 7 November 1990. Despite this the opponents could 30 not produce one instance of confusion, they must have been aware of the trade mark in suit from letter heads etc. The opponents have not denied the applicants’ statement that because of their business relationship they must have been aware of the trade mark in suit and its use by the applicants. It is clear that until Barclays Registrars referred the matter to Mr. Williams there had been no issue of potential confusion. This occurred after a considerable period during which the 35 trade mark in suit and its predecessor were before the opponents. The issue of confusion/deception is one that relates to the public, not specialists in intellectual property such as Mr. Williams. There is a complete lack of evidence of confusion and a reasonable inference from the opponents’ position as bankers to the applicants that there has been no confusion. The business relationship of the parties in these proceedings is a clear indicator that for a large period of time there was no 40 perceived danger of confusion.

I therefore also dismiss the objection under Section 5(4)(a) on the basis of their being no deception.

45 In relation to Section 5(4)(b) the opponents have adduced no evidence to show the ownership or existence of copyright of the “eagle device”, therefore this ground of opposition is dismissed.

Finally the opponents request the Registrar to exercise his discretion in their favour. Under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse trade marks as he did

under the old law. Therefore the opposition on this basis must fail.

5 Dr. Vittoria made submissions as to costs. She requested that owing to the general nature of many
of the grounds of opposition and what she described as the “scatter gun approach” to the grounds
of opposition an award of costs over the scale should be made. I have considered this request very
carefully, especially in the context of those grounds of opposition for which there was no evidence
adduced but for which Dr. Vittoria, as she stated, had to prepare. It is appropriate that an additional
10 £100 to the normal scale of costs should be awarded. As the applicants have been successful in
these proceedings I order the payment of the sum of £735 by the opponents as a contribution to
their costs.

Dated this 12 day of April 1999

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D.W.Landau
For the Registrar
the Comptroller General.

ANNEX

Registration No. 1301397 in Class 36.

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Financial services; included in Class 36.

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Registration No. 1327699 in Class 16.



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Paper, paper articles, cardboard, cardboard articles; printed matter, brochures, books, periodical publications, photographs, stationery, bank cheques, instructional and teaching material; document files; document wallets, envelopes; cards; paper tapes for computer programmes; manuals; all included in Class 16.

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Registration No. 1420294 in Class 35.

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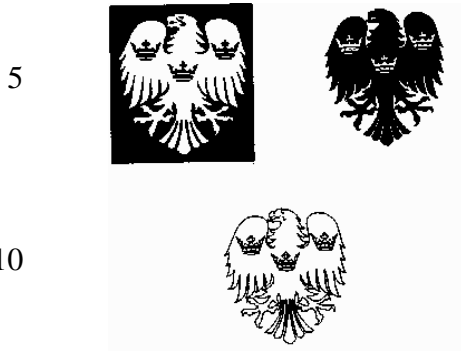


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Business advisory and enquiry services; provision of information concerning accounts and provision of statements of account; business consultancy and management assistance; document reproduction; registration, administration and secretarial services for companies; all included in Class 35.

Registration No. 2004233 in Classes 9 and 42.



15 Computers; computer systems; apparatus for input, output, storage and/or data processing; apparatus for the processing of card transactions; apparatus for processing data relating to card transactions and for payment processing; computer software; computer programmes; smart cards; cartridges, discs and tapes all for bearing data; recording materials all for collecting and storing or bearing data; punched cards and magnetic, optical and electronic materials and components all bearing or for bearing computer programmes and data; cash registers; telephone apparatus; video recordings; parts and fittings for all the aforesaid goods.

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25 Computer software services; leasing, hiring and rental of computer software and equipment; card authorization or validation, none being financial; legal services; catering services; printing services; architectural services; building inspection services; engineering consultancy services; energy auditing; building and interior design services; letting and rental of temporary accommodation; surveying; information, consultancy and advisory services relating to all the foregoing